

Domain Name Governance

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Registering a distinctive and/or easy to remember domain name is only the first step, and probably the easiest step in effective domain name governance. Like trademarks, domain names must be protected. However, in addition, domain name administration must be given attention.

Once a domain name is secured, it should be managed properly. This can be achieved through ensuring selected individuals within the organization are given access to the account and that suitable domain continuity plans are put in place. By doing so, this may pre-empt any abuse of account information. As an example, individuals with access to the account, may leave the organization without notice and not hand over the administrative details for the series of domain names. These people may assume control of the domain and may unilaterally change details or information pertaining to the domain name such as ownership rights of the account. The result would be an apparent change of ownership from the rightful owner to a third party. This can result in the company being held 'to ransom'.

In as much as there is traditional trademark infringement where trademarks are used without authorization by the trademark owner, similar principles apply in respect of domain names. Third parties unrelated to the owner of the website could obtain registration of a domain name which is identical or similar to either a domain name or trademark belonging to another party. Such activities are commonly referred to as 'cyber squatting'.

In addition to cyber squatting, there is also a risk of activities referred to as 'phishing'. These activities are designed to steal user identities where users are deceived into disclosing personal data through websites, emails or phone calls. Where websites are used, the domain names are often similar to the legitimate websites. These deceptive websites tend to incorporate trademarks belonging to the trademark owner and information from the legitimate websites. The end result is that the look and feel of the deceptive website is similar to the legitimate website. Once users are deceived into interacting on deceptive websites, personal information is entered and disclosed into the system.

E-commerce in the Middle East, including the United Arab Emirates, is growing rapidly. Domain name disputes are now becoming more common in the UAE and the relevant authority which regulates and operates the .ae domain names in the UAE is the .aeDA. This authority was established in 2007 by the Telecommunications Regulatory Authority (TRA). The .aeDA is responsible for setting up and enforcing policies with regard to the operation of .ae ccTLD. It also facilitates disputes on domain names.

As mentioned above, the choice of a domain name often takes into account ownership of and reference to a trademark already in use. This is reflected in the general eligibility criteria of the .ae domain name policy. The policy states that the grant of a domain name is not a grant for any intellectual property rights which are proprietary rights. Accordingly, the applicant for the domain name has to ensure they have the right to use the domain name and that it will not violate any 3rd party intellectual property rights. Where the domain name sought is classified as 'restricted' such as 'co.ae', 'net.ae', 'org.ae', 'sch.ae', 'ac.ae', 'gov.ae' and 'mil.ae', there is a positive requirement that the domain name should incorporate one of four criteria, a prior trademark registration being one of them. The existing domain name policy recognizes that trademarks are often taken into account when domain names are chosen.

The same principle is reflected in the .aeDA dispute resolution policy where recognition is given to the

proprietary rights subsisting in a trademark which, as mentioned, is normally the element upon which a brand is built upon.

The .aeDA policy mirrors the Uniform Dispute Resolution Policy (UDRP) by ICANN where a third party, normally the trademark owner, would raise certain grounds for his complaint, for example:

- that the domain name is identical or confusingly similar to his trademark in which he has rights; or
- that the domain name holder has no rights or legitimate interests in the domain name; or
- that the domain name has been registered and or used in bad faith.

The .aeDA dispute resolution policy provides instances of what amounts to evidence of registration or use in bad faith. Examples as follows:

- The domain name holder secures the domain name for the purposes of selling, renting or transferring the domain name to the trademark owner for an amount exceeding the cost directly related to the domain name.
- The domain name is secured to prevent the trademark owner from incorporating his trademark in a corresponding domain name.
The domain name has been secured primarily for the purpose of disrupting the business of a competitor.
- The domain name is used to divert users to that website by creating a likelihood of confusion with the complainant's trademark in terms of origins, affiliation or endorsement by the complainant trademark owner.

The .aeDA dispute resolution policy does not require that the complainant's trademark be registered. However proof of registration of the trademark in the UAE would be cogent evidence of the complainant's proprietorship in the trademark. This can be inferred from the evidence required of the domain name holder where he may show he or his organization is commonly known by the domain name even if he has not acquired any rights in the trademark which forms or is part of the disputed domain name.

Reference is made to a dispute brought under the WIPO Arbitration and Mediation Center by the Abu Dhabi Future Energy Company PJSC, as the complainant against an individual, John Pepin, in relation to the disputed domain names masdarcity.com and masdarcity.net. It was taken into account by the panel that both the registered and unregistered trademark rights of the complainant where regard was also had to the commercial activities of the complainant upon which the trademark MASDAR was used in relation to. In particular, the panel held 'A complainant may assert unregistered trademark rights by showing that the name has become a distinctive identifier associated with the complainant or its goods and services. Relevant evidence of such 'secondary meaning' may include the nature and extend of advertising, consumer surveys and media recognition'. Given that the .aeDA dispute resolution policy is similar to the UDRP, similar outcomes can be expected from similar disputes.

The panel also made reference to the common law trademark rights, however, common law is not applied in the UAE. It is suggested a local panel considers the statutory provisions under the Commercial Transaction Code which prohibits unfair competition where among others 'a trader may not disclose such matters as are inconsistent with the reality regarding the origin or description of his goods, or any other matters pertaining to their nature'.. 'nor may he resort to any other misleading means, with the intent thereby to usurp the customers of a competitor trader; or else, he shall be liable for compensation'.

Trademark owners which have built a brand around their trademarks are able to protect their brands when used without authorization by another party within the context of domain name registered or disputed in the UAE. However, organizations should ensure that their 'house is in order' when it comes to the administration of domain names. In this way, your business can achieve effective domain name governance.