

## **An overview of the law relating to trademark usage in URL's.**

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While trademark law is well established in most jurisdictions the new environment of the internet has resulted in new challenges in this area. A brief survey of the current laws and treaties is followed by a general discussion of trademark law specifically in URL's.

### **Section 1: Relevant Links**

- (1) <http://www.tufts.edu/departments/fletcher/multi/texts/BH004.txt> - The Paris Convention for the Protection of Industrial Property (1883).

This is the original international convention that determined the basis for modern intellectual property law.

- (2) <http://www.wipo.int/clea/docs/en/wo/wo019en.htm> - The Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957).

The Nice Agreement set down the basis of international trademark regulations including the separation of categories of production and identity.

- (3) <http://www.wipo.int/clea/docs/en/wo/wo027en.htm> - The International Trademark Law Treaty (1994).

The most recent international treaty regarding trademark protection that Australia is a signatory to.

(4) [http://www.austlii.edu.au/au/legis/cth/consol\\_act/tma1995121/](http://www.austlii.edu.au/au/legis/cth/consol_act/tma1995121/) - Trade Marks Act (1995).

The Current Australian Legislation primarily concerned with Trade Marks, this is the basis of any understanding of the current Australian position regarding trademark usage in URLs.

(5) [http://www.austlii.edu.au/au/legis/cth/num\\_act/tma1955121/](http://www.austlii.edu.au/au/legis/cth/num_act/tma1955121/) - Trade Marks Act (1955).

The Previous Australian Legislation regarding Trade Marks. This was replaced by the 1995 act. An understanding of this act and how it differs from the 1995 act is necessary to determine the likely relevance of case rulings made prior to 1995 to current and future cases.

(6) [http://www.austlii.edu.au/au/legis/cth/consol\\_act/tpa1974149/index.html](http://www.austlii.edu.au/au/legis/cth/consol_act/tpa1974149/index.html) - Trade Practices Act (1974).

The Trade Practices Act covers deceptive and misleading conduct and so is of relevance to Trade Mark usage in URL's in instances where the Trade Marks Act may not be valid.

(7) <http://www4.law.cornell.edu/uscode/15/ch22.html> - United States Trade Mark provisions.

As much of the existing case law regarding trademarks and the Internet is US based it is necessary to understand the US trade mark provisions and the ways that these are similar to (and differ from) the Australian legislation.

(8) <http://www.patent.gov.uk/tm/legal/tmact94.pdf> - The (UK) Trade Marks Act 1994.

As with the American Act it is necessary to understand the differences and similarities between the European Union influenced UK Act and the Australian Act when looking at the likely application of British case rulings in Australian situations.

(9) <http://www.murdoch.edu.au/elaw/issues/v6n1/blakeney61.html> - Interfacing Trade Marks with Domain Names.

A detailed article discussion the legal issues relating to usage of trademarks in domain names and the legalities of ‘cybersquatting’.

(10) <http://washburnlaw.edu/wlj/40-1/articles/sear.pdf> - “What’s in a domain name?” A critical analysis of the national and international impact on domain name cybersquatting.

Examines the issues relating to cybersquatting from an American perspective.

(11)

<http://www.welshkatz.com/features/pubdetail.asp?intPubID=134605112001> - Battling the “CompanyNameSucks.com” Cyberactivists.

Looks at the legal options available to trade mark owners whose trademark is used in such a site. Includes US case rulings.

(12) <http://www.law.wayne.edu/litman/papers/DNSwars.pdf> - The DNS Wars: Trademarks and the Internet Domain Name System.

A review of the interactions between domain names and trademarks in the US.

- (13) <http://www.gigalaw.com/library/anticybersquattingact-1999-11-29-p1.html> - The (US) Anticybersquatting Consumer Protection Act (1999).

The US act aimed at providing protection against cybersquatting in circumstances not protected by existing US legislation.

- (14) [http://www.gcwf.com/articles/journal/jil\\_march00\\_1.html](http://www.gcwf.com/articles/journal/jil_march00_1.html) - A guide to the Anticybersquatting Consumer Protection Act.

Detailed discussion of the Act, the reason for its introduction, and the application of the act, including the ability to act against the domain itself if unable to locate the individual or company responsible for the site.

## **Section 2: Discussion**

From examination of the material it is clear that there are several important aspects to determining the legal position of trademark usage in domain name URLs. These include:

- The legal scope of existing trade mark usage within Australia.
- International treaties and conventions relating to trade mark usage.
- Cybersquatting and its implications for domain name usage.
- The intent behind the use of a trademark in a domain name.

Within Australia the primary act governing trademark usage is the Trade Marks Act (1995) [4]. This act sets out the limitations to usage based on market segment, uniqueness of the trademark itself, and territorial coverage. Under the act a trade mark is registered both against a specific category of good and a specific Australian region (a business for instance must register a trade mark in each state that it wishes to conduct business in), it is therefore legally possible to have multiple separate entities using the same trade mark in separate market segments and / or states. There is also some provision for non-registered trademarks to be afforded some protection if they are “well known” in the jurisdiction.

The International Treaties relevant to current trademark activity include the Paris Convention (1883) [1], The Nice Agreement (1957)

[2] and the Trademark Law Treaty (1999) [3]. These three treaties form the current understanding of trademarks internationally. These treaties are the origin of much of the current Australian legislation and allow for trade mark usage to be regulated on a national level and allow for legal usage of the same trade mark by separate unconnected entities in separate countries as well as for separate, specified categories of goods and services.

The Australian [4] and International [1,2,3,7,8] legislation therefore poses the first major problem relating to trade mark usage on the internet – the fact that a single trademark can be legally in use by a multitude of unrelated organisations. As the Internet is a global system there is a large amount of scope for conflict between all of these legal trademark holders regarding the ownership of a domain name.

This multitude of valid claims has resulted in a second, uniquely Internet based issue, termed ‘cybersquatting’. Cybersquatting is commonly held to be the act of registration of a domain name solely for the purpose of ransoming it back to the holder of the associated trademark. Cybersquatting differs from the previous example in that the ‘cybersquatter’ is not a valid trademark holder, and does not seek to carry on a valid business using the domain. The US has instituted specific legislation aimed at cybersquatters – the Anticybersquatting Consumer Protection Act (1999) while in other jurisdictions cases

under existing trade mark and fair trading legislation has been carried out [13].

The final area of relevance to trade mark usage in domain names comes from so-called ‘cyberactivists’. This relates to sites in the form of TradeMarkSucks.com or similar. There have been a number of cases in various jurisdictions by trademark holders against such sites that provide a reasonable idea as to the legal standing of such use [11].

There are therefore two separate categories of dispute in these cases, one involving two or more valid trademark holders, the other being between a non-trade mark holding domain name holder (or in certain cases the domain name itself) and a valid trademark holder.

The links above provide some insight into the likely outcomes of disputes in both cases. In the first scenario (2 or more valid trade mark holders) the law has consistently upheld the rights of the trademark holder first registering the domain to continue use of the domain. This has led to various suggestions of alternate ways of dealing with such domains including the concept of neutral portals or gateways providing links to each valid trade mark holder site while clearly stating that the organisations in question are not related to each other or the management of the site [12]. This approach seems

most promising in cases of legitimate holders of trademarks although there is opposition to a compulsory system of this type.

In cases of dispute between a valid trademark holder and a non-trade mark holding domain name owner the law has been less consistent. Cybersquatting has been tackled in the US by the introduction of the Anticybersquatting Consumer Protection Act (1999) [13] as well as existing provisions of US trademark legislation relating to trade mark dilution [12]. In other jurisdictions the existing trade mark legislation is has proven to be non-applicable to cases of cybersquatting, resulting in reliance on such legislation as the Trade Practices Act (1974) [6] provisions against deceptive and misleading conduct, as well as concepts of defamation.

Cyberactivism has also proven to be an area that existing trademark legislation has failed to prove applicable to [11]. Cases brought against TradeMarkSucks.com style websites on the grounds of trademark infringement have failed as it is generally held to be clear that such a site is not connected to the trademark owner, and has generally been protected as a valid use of the trademark (as a review or similar). Even US cases based on trademark dilution have not been upheld for the same reason. While trademark legislation has failed to provide a legal remedy to such situations, existing defamation legislation has proven more successful as the intent of

such a site is usually held to be to cause damage to the public perceptions of the trademark holding organisation.

Unfortunately I was unable to find individual case rulings available on the Internet (although many of the sites listed mention individual rulings). The information found on these sites is very helpful in interpreting and understanding case rulings found in more traditional mediums and are in many cases the legal basis of the rulings themselves.