

INTERNET GOVERNANCE(EAIGF)

-Legal Issues on Internet

Governance (Domain Names-ccTLDs),
Nairobi 17th-19th ,2009,Mauritius

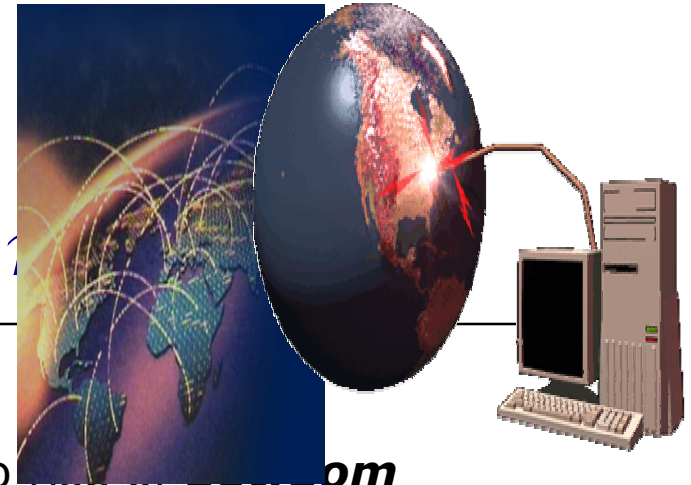
Facilitator

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The legal myth on the evolution of dot-com (.com/domain)



❑ Development of technology with the evolution of e-commerce resulted to the evolution of **Internet Domain Names**

❖ **Legal Definition of Domain Names;**

- Domain names are **Web or Internet addresses** used by web servers to identify each other on the Internet.
- It is an alternative to numerical Internet Protocol (IP) address.
- Where a Company intends to establish its web the first thing is to choose its domain name.
- establish their presence under the cyberspace.
- Each domain names must be registered on the principle of "**first come first served**".
- Domain names must not be confused with property rights in names, such as trade marks or Service Marks



Legal Rights in Domain Names

- Legal rights in Domain names derive from two sources:
- Registration of the name as a trade mark, which gives exclusive rights to use the name for particular purpose within a defined geographical area: and
- Actual use of the name for trading, which in most jurisdictions confers some limited rights to prevent others from using the same in such a way as to misappropriate the claimant's trade reputation.
- all registered are obliged to comply with ICANN policies regarding operation of the domain name system.



Misuse of Domain Names;

- The fundamental nature of domain names gives rise to an inevitable conflict between holders of legal rights to particular names
- Dispute between trade mark and domain names holders.
- In some cases domain names such as Amazon.com have been registered as trade marks
- There are so many cases on domain names dispute and Cyber Squatting



Legal issues on Dispute Settlement

- Settlement out of Court using ICANN Uniform Domain Name Dispute Resolution Policy
- The Policy obliges applicants to agree that any disputes will be adjudicated by an approved dispute resolution service
- Organizations Offering such services.
- The World Intellectual Property Organization (WIPO) (See WIPO Guide) .
- E-Resolution
- The National Arbitration Forum



Basic principles of domain name dispute Settlement Policy

- First come first served
- Any trade mark proprietor who makes genuine complaint is entitled to relief
- The administrative proceedings act where the domain name is identical or confusingly similar to the alleged trade mark
- Any suit against the defendant having a registered trade mark is most likely to fail.



How to succeed on dispute settlement using UDRP

- ❖ For the complaint on domain name cybersquatting to successfully use UDRP it is recommended to show that:
 - The domain name is identical or confusingly similar to trade mark or service mark in which the complainant has rights;
 - The domain name owner has no right or legitimate interests in respect of the domain name and
 - The domain name has been registered and is being used in bad faith.



Judicial dispute Resolutions

- There are some examples of cases indicating the conflict on domain names.
- *Marks & Spencer plc and others v One In A Million Ltd* [1998]FSR 265].

the issue of cyber-squatting was clarified and the practice of domain piracy was effectively buried

❖ **Decision making Principle**

- *In assessing the passing off, trade mark infringement and cyber-squatting, the court should consider, the similarity of names, the intention of the defendant, the type of trade and all the surrounding circumstances*



Other Cases

- British Telecommunications and Ors v One in a Million and Ors
- Nissan Motor Co. v. Nissan Computer Corp
- Panavision International LP v. Toppen (the dilution of a trade mark).
- Inset Systems, Inc. v. Instruction Set, Inc .(a trademark infringement action against Instruction Set, arising out of its use of the domain name,
- Prince Pl v. Prince Sportswear Group Inc



Legal initiatives on Domain name Disputes

- No Legal framework to regulate at EAC Level
- No Legal framework at National Level within EAC Member States
- Trade & Service Marks Laws do not Reflect Domain Names



Other Jurisdiction on Legal Issues related to Domain Names

- US the ***US Anti-cybersquatting Consumer Protection Act (ACPA)*** **[1999]** has been enacted for the purpose of regulating Domain names.
- ACPA Amends the US Trademark Act of 1946
- The Law creates civil liability for bad-faith registration with intent to profit of domain names that are identical or confusingly similar to distinctive trade marks or which dilute famous trade marks



How bad faith is legally established

- Register the domain name primarily for the purpose of disrupting the business of a competitor
- Acquire the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark
- Register the domain name to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name



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- you have intentionally attempted to attract, for commercial gain
 - by creating like-hood of confusion with the complainants mark as to the source

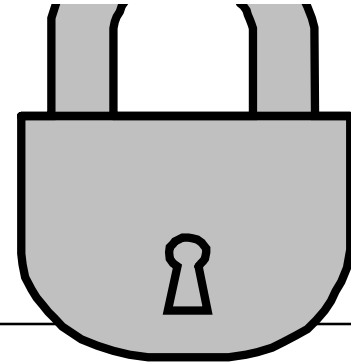


Legal Issues

- **How to regulate domain names?**
- **Need for New Laws or Amend Intellectual Property Law?**
- **Need for Regional or International Legal Instrument?**
- **How to address Legal rights in domain names at Regional and International Level?**
- **Conflict between holders of legal rights to particular names**
- **Use of ADR or Courts?**
- **How to control e-trade marks infringement and Domain Names Cyber-squatting**
- Who can stake a claim in Cyberspace domain names & trademarks

THE END .

*Thank you Very Much
for your attention*



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