

**THE REGULATION OF DOMAIN NAME UNDER ETHIOPIAN
TRADEMARK LAW: EMERGING LEGAL ISSUES!**

LLM Thesis

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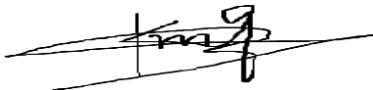
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List of Abbreviations

ICANN: Internet Corporation for Assigned Names and Numbers

UDRP: Uniform Domain Name Dispute Resolution Policy

URS: Uniform Rapid Suspension System

EIPO: Ethiopian Intellectual Property Office

TCP/IP: Transmission Control Protocol/Internet Protocol

Art. : Article

WTO: World Trade Organization

TRIPS: The WTO Agreement on Trade-Related Aspects of Intellectual Property Rights

WIPO: World Intellectual Property Organization

LANs: Local Area Network

WANs: Wide Area Network

ARPANET: Advanced Research Project Agency Network

DNS: Domain Name System

IANA: Internet Assigned Numbers Authority

TLDs: Top-Level Domain

gTLDs: generic top level domains

ccTLDs :country-code TLDs

PDDRP: Trademark Post-Delegation Dispute Resolution Procedure

LRO: Legal Rights Objection

RDNH: Reverse Domain Name Hijacking

DNH: Domain Name Hijacking

ACPA: Anti-Cybersquatting Consumer Protection Act.

TDRA: Federal Trademark Dilution Revision Act

TMA: Trademark Modernization Act

TIPO: Taiwan Intellectual Property Office

DPMA: German Patent and Trademark Office

ECA: Ethiopian Communication Authority

EIPA: Ethiopian Intellectual Property Authority

UNECA: United Nation Economic Commission for Africa

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Abstract

Trademarks have ancient origins and the history of trademark law shows incremental development that shaped their current form. This development is based on the evolution of the value and purpose served by trademarks within the society in development. In recent history, the development of computer connections especially the development of the World Wide Web enabled the free flow of information and connections in a way unthinkable for many before. The internet enabled the achievement of human developmental transformation faster, easier, and broader than what could have been achieved without it. In his way eventually allowed broader commerce in the online sphere. However, trademarks as one of the tools used in the ordinary market faced significant threats from the use of domain names which is attributable to the nature of domain names and market development in the online sphere. This problem is even aggravated by the international nature of use and essential governance of domain names, unlike trademark and trademark rights. In line with this trademark rights were sufficiently threatened and being affected by domain name use in Ethiopia. Several countries attempted and not few countries were able to provide significant trademark law solutions to the threat of domain name use to trademarks. Among those United States was able to legislate and provide solutions that are more comprehensive by enacting ACPA. United States being the first to do so may be partly because United States is the central country in the development of internet. However, the lesson from United States cannot be underestimated due to its importance in tackling the problems generated by domain name use over trademark use. Taiwan, Iran, and Germany are also among those countries who attempted to provide solutions worthy of lesson. The relatively recent Ethiopian trademark law specifically trademark use protection is facing a real challenge from domain name practice. This thesis essentially focuses on identifying possible challenges to trademark use by domain name use in the Ethiopian context. And attempts to draw important lessons as possible from investigated countries in this regard. In doing so the study found a significant gap in Ethiopian trademark law and practice. And proposed the need to reformulate trademark rights in the trademark law based on the actual purpose served by the trademark in the country currently.

CHAPTER ONE

Introduction

1.1 Background

The use of trademarks is as old as trade. Evidence showed guild signs were used for identification of traders' products during medieval period. The first statute governing trademarks in Europe enacted already in the thirteenth century demonstrates the recognition and social and economic importance of such labeling.¹ From a legal point of view as with other forms of intellectual property, a trademark constitutes 'property rights' conferring the exclusive right to certain forms of use of the mark.² In line with this, traditionally trademark law protects against consumer deception in the ordinary market place. Gradually, property rights on the goodwill conveyed by the trademarks and, more recently on trademarks as such have been recognized.³ Just as it is in older times, still today trademarks are considered as designations of particular good or service that makes their existence possible only when the trademarks are assigned to goods or services.⁴ Moreover, trademark recognition and protection is acquired in each country individually. This will create challenges as the commercial attractiveness of the World Wide Web increases and many businesses have sought to develop a presence. And as the sale of goods and services online has brought a new dimension of trade and service mark law and practice, where traders or companies have opted to use domain names.⁵ This phenomenon is what set up the current dynamic between domain names and trademark law.

Internet is a global network of interconnected networks operating by way of TCP/IP protocol system.⁶ It was initially designed to achieve an efficient method of communication between

¹Thomas Korman, *The Relationship Between Domain Name and Trademark*, Central European University, Unpublished Master thesis,p.1-59 (2013),at.4.

²Ian J.Llyod, "Information Technology Law", Oxford University Press, 5th ed., 2008, at. 427.

³S. M. Maniatis, "*Trade Mark Rights: A Justification Based on Property*", [2002] I.P.Q. at.123.

⁴ Korman, *supra* note 1, at13.

⁵Kinfe Micheal Yilma and Halefom Hailu Abraha, *The Internet and Ethiopian's IP Law, Internet Governance and Legal Education: an overview*, Vol.9 Mizan Law Review 154-174(2015),at.163, available at , <http://www.ajol.info/index.php/mlr/article/view/124826> (Accessed on 13th of February, 2021).

⁶ Adam Dunn , *The Relationship between Domain Names and Trademark Law*, Central European University, Unpublished Master thesis,p.1-63 (2014),at.2.

networks of computers as a result of research funded by the government of United States. In addition to this during these days internet was used primarily for academic and governmental purposes creating no major challenge to trademark infringement.⁷ It was in these times domain name system was developed as part of a way to direct information to the proper point from one computer to another, which is human readable form of a particular address on the internet.⁸ In today's world domain names remain alphanumeric addresses that authorities assign to businesses, organizations, and individuals to communicate on the internet. This domain name has its own parts. For instance, "acer.com" the top-level domain is '.com' which indicates the domain name is owned by a commercial enterprise.⁹ And 'acer' is the second-level domain name that identifies the source of goods.¹⁰ Country-code top-level domain names are also available like .us for United States and .et for Ethiopia. The international organ to administer domain names is ICANN. ICANN accredited registries that are found throughout the world register top-level domain names and are subject to ICANN policy concerning their administration. Moreover, country-code top-level domains are under national jurisdiction for the definition of their policies and legal responsibilities. As a principle registrants register domain names on first come first served basis. Traditionally domain names are under Latin alphabet and zero to nine numbers including hyphens. Now it is possible to have domain names under different languages. There is nothing in this developing field, which prevents from reaching Ethiopian language in the near future. Currently Ethiopian government, through Ethiopian Communication Authority manages the '.et' domain name. Overall, the point to emphasize here is the fact that the creators of the domain name never anticipated trademark infringement on one side, and trademark laws cannot be said anticipating domain names use in their earlier form. This is in addition to domain names have undergone to the stage where they are administered by special organs destined specially for this purpose that might give them a different and unique nature as compared to trademarks.

On the other side of the picture, the technological development taking place in the last number of decades has brought a new era. The internet enabled a worldwide flow of information

⁷ *Id.*

⁸ *Id.*

⁹ Mayuri Patel and Subhasis Saha, *Trademark Issue in Digital Era*, Journal of Intellectual Property Right, Vol-13, p118-128(2008), at 118.

¹⁰ *Id.*

accessible from any place at any given time a flow of information independent from material mediums or national borders, creating a global network.¹¹ Internet is increasingly being used for communication, commerce, advertising, banking, education, research, and entertainment.¹² Even more businesses and trades are promoting themselves through it. Therefore, there is a need for business to protect their trademark and goodwill for customer retention and increased online marketability. Whereas, domain names serve as an address of a particular internet location. Question will arise when someone uses a domain name identical or substantially similar to trademark of someone else given the extended use of internet for commerce as the domain name are not initially designed to award intellectual property rights.

At the beginning of the development of this issue, there was significant understanding by observers questioning the appropriateness of applying trademark law to domain names. After all, they argue, "domain names are not trademarks, are not used as trademarks, and should not be open to challenge by the owners of arguably similar registered marks".¹³ Moreover, they further argue that a domain name is simply an address, and should not be subject to cancellation for likelihood of confusion with a registered trademark. But as the dispute between domain name use and trademark right intensifies growing number of scholars stated, because consumers who don't know company domain name often merely type in the company name in the hope of locating the company site, domain name becomes more than internet address it has also functioned as a designation of origin and symbol of goodwill i.e. trademark and therefore entitled to protection.¹⁴ This scholars suggest, that the close similarity of internet domain name addresses to more traditional trademarks both in their intrinsic value to their owners as well as in the purposes they serve mandates that traditional trademark doctrines should be applied to determine whether domain names are capable of infringing, and indeed, whether they have infringed, existing trademarks.¹⁵ Courts facing controversies involving the infringement of domain names should be encouraged to turn to traditional tenets of trademark law for guidance in resolving such disputes.¹⁶ Additionally, they say domain name is more than address it

¹¹Korman, *supra* note 1, at 1.

¹²Patel et al, *supra* note 9.

¹³Gayle Weiswasser, *Domain Names, the Internet, and Trademarks: Infringement in Cyberspace*, Vol.20 (1) Santa Clara High Technology Law Journal 215-260 (2004) at 241.

¹⁴ Patel et al, *supra* note 9, at 119.

¹⁵ Weiswasser, *supra* note 13, at 258.

¹⁶*Id.*

conveys more than location. Internet users readily interpret a domain name as reflecting the identity of its owner in a way that a postal address does not.¹⁷ Trademark law, therefore, appears to be the appropriate legal mechanism through which companies can be assured that their intellectual and commercial property will be protected on the internet.¹⁸ WIPO has also a similar finding; WIPO Internet Domain Name Process Final Report stated precisely because they are easy to remember and identify, however, a domain name has come to acquire a supplementary existence as a business or personal identifier.¹⁹ As commercial activities have increased on the internet, domain names have become part of standard communication apparatus used by businesses to identify themselves, their products, and their activities.²⁰ In particular, domain name because of its purpose of being easy to remember and identify, often carries additional significance that is connected with the name or mark of business, its products, or its service.²¹ This report idea and scholars' suggestions made can be taken as valuable input or measure assertions indicating the need for protection of trademarks through trademark laws against abuse by domain name use.

The problem is not yet solved, for the above assertion to work, it may be important to identify the legal status of domain names. However, the legal status of domain name is controversial in many jurisdictions because of contractual right nature and property right nature of domain name remains confusing. Regarding trademark and domain name dispute, if specific law allows registration of domain name as a trademark this allows the domain name to acquire a secondary character as a trademark. Similarly, if a law recognizes domain name use as trademark exploitation within the meaning of trademarks law nothing prevents parties from bringing infringement action against infringing domain name at national level. There is nothing in our trademark law that mentions about domain name specifically. According to the new Electronic Transaction Proclamation of Ethiopia, Ethiopian Communication Authority was identified as an organ to administer specifically “.et” domain name and is empowered to enact directives for

¹⁷*Id.* at 241.

¹⁸ *Id.* at 258.

¹⁹ Panel of Expert appointed by WIPO, WIPO, The Management of Internet Names and Address April 30 (1999), available at, <https://www.wipo.int/amc/en/processes/process1/report/finalreport.html> (Accessed on 13th of February, 2021).

²⁰*Id.*

²¹ *Id.*

the administration of this domain name together with the Ministry of Innovation and Technology.²² A dispute settlement mechanism is also to be set up for disputes in relation to the .et domain name. This can be taken as a substantial development but left trademark domain name conflict issue without a specific regulatory article.

Moreover, a new form of trademark domain name dispute that depart from traditional trademark infringement claims are also emerging, to mention some cybersquatting and reverse domain name hijacking. Cybersquatting is the practice of registering trademarks especially well-known trademarks as a domain name to resell them on profit and figuratively hold the domain name captive until the trademark owner pay a ransom amount. Reverse domain name hijacking refers to an attempt to use procedures with bad intent to deprive a registered domain name of a domain name holder.²³ The situation in which, a trademark owner takes advantage of an administrative policy in bad faith to grab a domain name from a registrant. These are emerging problems related to the nature of use and administrative remedies attempted to be given for infringement of trademark rights. Some countries are already providing solutions to these problems with in trademark law regime reasoning necessitated by adequate and effective trademark right protection as well as by the need to regulate undue stretching affecting the purpose of trademark rights. Studies indicated cybersquatting already made its way to Ethiopia. There is no specific legislation governing this area in our country so far. Even more, there is little awareness about the issue in law enforcing organs of the country.

In addition to attempt to govern domain name trademark disputes at national level, at international level on December 1, 1999 ICANN implemented administrative solutions UDRP upon WIPO recommendation. It has also brought the URS and similar systems later. UDRP was designed to provide a fast and inexpensive procedure used by trademark holders around the world against those who register internet domain names in bad faith and without rights or other rightful interests. The scope of UDRP is limited and applies only to cybersquatting and similar abusive forms of domain name registration. It applies only to domain names registered in the generic top-level domains (.com, .org, .info etc.), which constitute the bulk of the domain

²² Electronic Transaction Proclamation No. 1205/2020, FED. NEGARIT GAZETA, 26th Year No. 57, 2020. (Hereinafter referred to as Electronic Transaction Proclamation).

²³ Chin Hong Tsai, *The Trademark/Domain Name Protection War: A Comparative Study of the U.S, UDRP and Taiwanese*, 12 The John Marshal Law Review of Intellectual Property Law p.350-402 (2013).at.376.

names registered worldwide for so-called country-code top-level domain names (.uk, nl, .de etc.) the UDPR only applies if a country administrator has voluntarily adopted it. UDRP is a legally qualified specific contract term that does not prohibit any trademark owner or a domain name holder from going to court before during or after the UDRP proceedings. Which raise question on the process. A dispute is handled through a panel, a dispute resolution panel of three can cost approximately up to 7000 dollars. Limited remedies only cancelation or transfer of offending domain name is available.²⁴ Similarly, URS is used for clear cut trademark infringement cases therefore faster and less costly than UDRP but it applies only to those new generic top-level domain name whose registration policy include such procedure which excludes generic top-level domain name such as “.com” and “.net” but it may be voluntary adopted by incumbent operators and less common.²⁵ This fact can also be taken as additional factors necessitating the need for country level court based legal protection of trademark right abuse by domain name use. As the system cannot be said adequately and effectively handling problems. This is in addition to the practice of domain name registries in Ethiopia of not incorporating specific regulatory articles as to this issue in their agreement with domain name registrants. The current Electronic Transaction Proclamation also empowers Ethiopian Communication Authority with the power to establish mechanisms in relation to domain name dispute handling and directs formation of an arbitration organ for domain name dispute. Whether this can lead to a domain name use conflicting trademark right disputes administrative regulation mechanism similar to UDRP is a wait and see issue. Nevertheless, what will be its effect on the domain name use conflicting trademark right dispute regulation in Ethiopian in a broader sense also demands thorough review.

1.2 Statement of the Problem

Currently, Ethiopia is working to transform internet marketing into e-commerce meaningfully. The introduction of e-commerce would be a significant move to conduct effective marketing and promote technological innovation through competition. It also enables businesses and

²⁴ Dunn, *supra* note6, at 44.

²⁵ James L. Bikoff David K. Heasley Griffin M. Barnett Valeriya Sherman Justin Miller, American Bar Association, The Uniform Suspension System: A New Weapon in the War against Cybersquatters, available at https://www.americanbar.org/groups/intellectual_property_law/publications/landslide/2013-14/january-february/uniform-rapid-suspension-system (Accessed on 23rd of March, 2021).

consumers to buy and sell products and services within a short period. Besides this, it can also make it easier to promote products and brands domestically and internationally. This may play its part in the increased use of web pages for commercial purposes, which ultimately facilitates the condition for domain name use trademark right conflict interplay in general. Even more, studies have shown the threat is emerging in Ethiopia. Moreover, there is a trend of moving into a digital economy globally which Ethiopia as one member can't escape. In order to facilitate conditions there is a need to thoroughly investigate the legal hurdles involved and provide solutions. For effective e-commerce safety, security, and justice in cyberspace is crucial.

The draft national ICT policy although it recognizes the need to regulate false information over the internet failed to mention the need to regulate the threat of domain name use against trademark rights specifically.²⁶As an important governmental circulating document, it can be taken as an important indicator of absence of concern for the issue given intensive focus by the regulators internationally. In order to bring due concern for the matter there is a need to conduct a comprehensive study.

Proclamation no.501/2006 on trademark registration and protection and regulation no.273/2012 on trademark registration and protection mention nothing about domain name use specifically. However, the current Electronic Transaction-Transaction Proclamation did provide an administrative organ for (et.) domain name with the power to issue directive in consultation with Ministry of Innovation and Technology to domain name dispute. There is a need to thoroughly investigate, in light of the practices of other countries whether our legal regime in relation to trademark is capable of regulating domain name use that affects trademark right. More specifically, whether our trademark law is still capable of regulating domain name trademark rights conflict or infringement cases in light of the practice of other countries and suggestions made needs to be reviewed. If not what is to be done, special law or an amendment to existing law is also another issue demanding an investigation. In addition, what will be the effect of the Electronic Transaction Proclamation on this area also demands investigation.

²⁶ The National Information and Communication Technology (ICT) Policy and strategy is a policy document of which its final draft prepared in 2016, available at <http://www.mcit.gov.et/web/guest/-/the-national-information-and-communication-technology-ict-policy-and-strategy> (Accessed on 13th of February, 2021).

Some studies have also shown the threat of cybersquatting being high and emerged significantly in the country creating a meaningful hurdle to the appropriate enjoyment of trademark rights. Moreover, the status of Ethiopian law regarding capability in cybersquatting regulation is not scholarly attested. This coupled with limited awareness about the issue may create difficulty in enforcing or protecting a trademark right using existing law. If Ethiopian law is to be sufficient based on the result of this study. Unless some scholarly identification and clarification to the subject matter is conducted. Overall based on the practices of other countries, whether to enact a new law or the existing law might be sufficient to govern in light of the matter needs to be reviewed. If legislation is preferred in what form and scope is also demanding an answer.

The issue of reverse domain name hijacking is also not to be ignored. The situation in which trademark owner misuse his right under the policy were he try to in force a right not recognized within the limits of trademark law regime. This undue stretching of a right may contradict with the very purpose of trademark law by way of excessive protection as well as domain name holder legitimate right to use his domain name. There is a need to balance interest. Currently the status of our law is unclear in this area.

The policy term for registration provided by domain name registration service providers in Ethiopia does not expressly provide for trademark infringement issue.²⁷ Although it imposes a duty not to infringe any intellectual property right and the possibility for domain name cancelation for third party right because of court decision or out of court settlement. Failure in the part of the contract to expressly provide trademark rights despite the detailed rules available internationally will have significant capacity to create doubt as to whether this matter is regulated properly. Absence of clearly working administrative mechanisms to regulate the matter will aggravate the situation. This fact also really necessitates the need to conduct through study of the area.

²⁷Ethio telecom contractual terms can be a good indication for practice in the area and this contract fails to make any express provision regarding trademark and UDRP is not applicable as the contract stands. Note that the term of service is also applicable for web hosting and email address, available at <https://myportal.ethiotelecom.et/register.php>. (Accessed on 13th of February, 2021).

1.3 Objective of the Study

To identify the status of the Ethiopian trademark right legal framework as to adequacy in relation to regulating the conflict between trademark rights and domain name use.

1.3.1 Specific Objective

- To examine the sufficiency of Ethiopian trademark rights including those in electronic transaction legal framework to regulate traditional trademark infringement cases of domain name use.
- To examine the sufficiency of Ethiopian trademark laws including those in electronic transaction law (if any) in regulating typical cybersquatting cases.
- To examine the sufficiency of Ethiopian trademark laws including those in electronic transaction law (if any) in regulating reverse domain name hijacking based on administrative practice in the country.
- To recommend possible solutions if insufficiency is identified in the above scenarios based on experience of foreign jurisprudence.

1.4 Research Questions

- Is Ethiopian trademark right including those in electronic transaction legal framework sufficient enough to regulate traditional trademark infringement cases of domain name use?
- Is Ethiopian trademark laws including those in electronic transaction law (if any) sufficient enough to regulate typical cybersquatting cases?
- Is Ethiopian trademark laws including those in electronic transaction law (if any) sufficient enough to regulate reverse domain name hijacking?

1.5 Scope of the Study

The manner a particular domain name is found by a particular user during search, this means the use of Meta- tags is left out of the study. Because Meta- tags indicate the content of particular web site they are related to the way domain names are found, they involve technological issues outside of this study. Jurisdictional issues that emanate from internationalized nature of domain

names are also left out of the study in order to focus on main issues involved. Administrative policy measures conducted through ICANN and supposed to be conducted through Ethiopian Communication Authority as the case are not the point of focus for this study. Nevertheless, certain investigations relevant for reverse domain name hijacking purpose and other issues as the case may be conducted. The main reasons for this subject left out are because administrative policy based solutions are not the central focus of this study and due to limited time available to conduct this study. The study area will be the Federal Democratic Republic of Ethiopia. To this end, the study will focus on Ethiopian law and practice.

1.6 Significance of the Study

The study will have a great contribution to the countries endeavor towards technologically oriented development, as it will contribute by way of indicating the appropriate ways to enforce trademark right in cyberspace. The research will also address an almost new topic. This will open the way for further studies and make major steps in legal clarification in the topic to be analyzed.

1.7 Literature Review

This part of the document focus on the relevant articles which are essentially international experience contributing to the shaping of idea on the issue at hand. This is because the writer is unable to locate sufficiently descriptive literature on the situation in Ethiopia save Kinfu Micheal Yilma and Halefom Hailu Abraha works included here. Hence, this paper will contribute a lot in filling the gap in the future. The first point to discuss is the legal nature of domain names. Chin-Hong Tsai identified three grounds on which different United States courts based their decision as to the legal status of domain names when they litigate trademark rights and domain name use conflict. The first is contractual right. This approach is straightforward because the registrant obtains the right to hold and use the domain name under its registration contract with the registrar.²⁸ It is based on the idea that domain names do not exist separate and apart from the registry function of making domain names into operational internet addresses. The second is

²⁸ Tsai, *supra* note 23, at 355.

based on it is intangible property. It is a well-defined interest. Ownership is exclusive in that the registrant alone makes that decision in relation to control. Moreover, like other forms of property, domain names are valued, bought, and sold, often for millions of dollars, and they are now even subject to in rem jurisdiction in United States. Finally, registrants have a legitimate claim to exclusivity.²⁹ The third one is domain name is tangible property for the purpose of conversion action. This is based on the idea that domain names like web pages can be perceived and physical access can be restricted by passwords. However, he stated the idea of tangible or intangible property is of no help in case of trademark domain name conflict because domain name registrant cannot rely upon a “first come, first served” defense against trademark owners.³⁰ Domain name registrants who find themselves in a conflict with registered trademark owners have no inherent legal rights to assert.³¹ The contractual right is also problematic because the registrant would have no rights to a domain name if he or she lost the registration against his or her will.³² As to its implication in trademark domain name conflict, he says the domain name registrant’s best argument may rely on trademark law itself. That is, if the law does not provide trademark owners with a mechanism through which they can request the return of a domain name from its registrant, the registrant will be entitled to retain the domain name.³³ Hence, we may concluded whatever the legal basis for a domain name it is better to rely on trademark law to identify the legality of domain name use as his article stands.

Mustafa Bakhiarvand on Iranian law as to legal nature of domain names also stated the Iranian legislator does not passed an exhaustive law to regulate domain names that may cause uncertainties.³⁴ However, a domain name cannot be considered intangible property as the legislator does not passed a law that declares as such. However, if a domain name is registered as a trademark, which the Iranian law allows, it will be protected as such by acquiring a secondary character. Domain names may be property rights, since property is defined as a thing, which, inter alia, has economic value. According to Iranian law, there is no problem for a right

²⁹*Id.* at 356.

³⁰ *Id.* at 358.

³¹*Id.*

³²*Id.* at 356.

³³ *Id.* at 358.

³⁴ Mostafa Bakhairvand, *The legal Nature and protection of domain name with emphasis on Iranian law*, Vol 21 Journal of Intellectual Property Right 166-174, (2016), at.173.

to be proprietary and contractual at the same time.³⁵ From Iranian point of view as per the scholar, protection through trademark law of domain name use is possible as it is possible to register it as a trademark and as the law expressly prohibits infringement of trademark rights by domain name users. Overall, the idea of this scholar also shows trademark rights laws can recognize domain names by an express provision to this effect, despite uncertainty in their status.

Mayuri Patel and Subhasis Saha identified traditional domain name litigation encircled on three claims. The first cause of action is based on trademark infringement actions, the second claim is based on dilution doctrine i.e. the assertion that the domain name dilutes the value of the trademark and the third claim is to prevent cybersquatting.³⁶ We will not look into trademark infringement and dilution concepts in detail for a moment as both are trademark law concepts but we will look into important cases to identify application of trademark law in case of trademark domain name conflict.

Several trademark domain name litigations appeared before different courts, most of them could be categorized under one of these categories. In relation to trademark infringement for instance in United States in CD Solutions Inc. Vs CDS Network Inc. Plaintiff, CD Solutions - owner of the domain name cds.com - was granted declaratory judgment that the cds.com did not infringe the trademark CDS registered by CDS Networks.³⁷ The District Court stated the relevant confusion is the confusion that affects the purchasing decisions of the customers. CD solutions sell compact disks while the CDS trademark of CDS Networks is registered for printing and document services. Additionally, the court notes that there is no prohibition against the use of trademarks as domain names, only those that infringe or dilute are prohibited. The case illustrates direct application of trademark law to domain names. Cases where the plaintiff use of similar domain name to trademark confuses customers hence trademark infringement or not?

The second case is the case of dilution in relation to famous mark use in different kinds of business. In the case between Panavision Vs Toeppone, Dennis Toeppen had registered several

³⁵ *Id.*

³⁶ Patel et al, *supra* note 9, at 119.

³⁷ CD Solutions Inc. v. CDS Network Inc., USA 15 F.Supp.2d 986, (April 1998), case summary, *available at* <https://cyber.harvard.edu/property00/domain/CaseLinks.html> (Accessed on 23rd of March, 2020).

domain names incorporating famous trademarks including panavision.com.³⁸ He offered to sell the domain name to trademark owner for \$13,000, he also offered a similar sale previously. Panavision filed suit claiming trademark dilution and Toeppen responded that the requirements for dilution were not met because his use of the domain name to display the city of Pana did not constitute commercial use. The court determined that Toeppen's business is to register trademarks as domain names and then sell them to the rightful trademark owner's hence commercial use.³⁹ This case establishes the principle in cybersquatting cases that the offer to sell a domain name to the trademark holder constitutes use in commerce for purposes of dilution claim. In relation to presence of dilution, the Ninth Circuit indicates that a court need not rely on the traditional definitions of blurring or tarnishment to find dilution. Because Toeppen's conduct diminished the capacity of the Panavision marks to identify and distinguish Panavision's goods and services on the internet, hence dilution has occurred.⁴⁰ Its interpretations have been questioned by scholars but still it is frequently been relied on by courts throughout the United States in subsequent cases. This case is before United States Anti Cybersquatting Consumer Protection Act. Nevertheless, it is relevant as it indicates commercial use of domain names that are dilutive to famous marks can be subject to trademark law.

The third one is cybersquatting; Adam Dunn analyzed the case of United State, United Kingdom, and Germany on cybersquatting and found that United States enacted Anti-Cybersquatting Consumers Act to govern such matters. The Anti-Cybersquatting Consumer Protection Act largely alleviated tension of courts struggling to fit domain name infringement into traditional trademark cases.⁴¹ While United Kingdom dealt the matter through trademark act and cases. English court stretched the classical trademark infringement elements to fit into cybersquatting.⁴² German courts handled cybersquatting cases through trademark law principles. German civil code also provides protection in case a company business is affected by use of mark outside its normal operation. The German unfair competition act and the general provision of the civil code can also be used to combat such situations.

³⁸Panavision V.Toeppen, USA 141 hF.3d 1316 (9th Cir. 4/17/98), case summary, available at <https://cyber.harvard.edu/property00/domain/CaseLinks.html> (Accessed on 23rd of March, 2021).

³⁹*Id.*

⁴⁰*Id.*

⁴¹ Dunn, *supra* note 6, at 18.

⁴²*Id.* at 36,

There are also other cases Chin-Hong Tsai explains one, reverse domain name hijacking by sitting UDRP. It is a situation in which a trademark owner takes advantage of administrative policy in bad faith to grab a domain name from a registrant.⁴³ Charlotte Waelde defines it as cases where the owners of well-known or famous marks have aggressively pursued policies to prevent other internet participants from using any rendition of a name that includes or alludes to their registered trademark, in some cases quite unjustifiably.⁴⁴ The first definition as policy right abuse by trademark owner is based on UDRP provision and better. The second can be seen as instance of reverse domain name hijacking. In United States, for example it is possible to recover your domain name. A court may issue an order requiring the registrar to permit you to register the domain name or to transfer the domain name back to you. What you need to show is you are the registrant of the domain name, the registration was suspended, disabled or transferred under a registrar's policy, the owner of the trademark that caused the domain name to be suspended, disabled or transferred has notice of the law suit by service or otherwise, and your registration or use of the domain is not unlawful under Lanham act as amended.⁴⁵ Jacqueline D.Lipton also viewed situation were two legitimate interest contests. The obvious contest here is between two or more parties who each hold trademark interests that correspond with the same domain name.⁴⁶ And proposed peoples with competing legitimate interests in a domain name having the opportunity to 'share' the name by a joint registration which leads to a home page with HTML links to individual websites of each respective interest-holder. On Ethiopian context, Kinfе Micheal Yilma and Halefom Hailu Abraha stated threat of cybersquatting is high. There are actually peoples who registered trademarks of well-known businesses in the hope of selling it to trademark owners. However, Ethiopian trademark law legal framework don't address the issue of cybersquatting.⁴⁷ The term 'domain name' in the trademark context is not mentioned in any existing or draft legislation in Ethiopia. This makes it difficult to enforce the existing laws in the area of domain names. However, the writers discussed the matter as part of an overview of Ethiopian IP law and the internet, this assertion

⁴³ Tsai, *supra* note 23, at 369.

⁴⁴ Charlotte Waelde, AHRB Center publication Section, Trademarks and Domain Names. There's is a lot in names. (15/12/2006), available at <https://era.ed.ac.uk/handle/1842/2288> (Accessed on 4th of February, 2021).

⁴⁵ Tsai, *supra* note 23, at 371.

⁴⁶ Jacqueline D.Lipton, *Beyond Cybersquatting: Taking Domain Name Dispute Past Trademark*, 40 Wake Forest Law Review 1361-1440 (2005) at.1411, available at https://scholarship.law.pitt.edu/fac_articles/182 (Accessed on 4th of February, 2021).

⁴⁷ Yilma et al, *supra* note 5, at 165.

needs concrete study, especially in light of the practice of other countries. Whether the absence of a domain name in a trademark context is the only criterion and why is not answered properly. There is a need to study the sufficiency and adequacy of our law in relation to domain name trademark conflict on issues of trademark infringement, cybersquatting, and reverse domain name hijacking. The new Electronic Transaction Proclamation vests power in relation to the management and administration of the (.et) domain space to the Ethiopian Communication Authority and directs this organ to handle disputes in relation to this matter by dispute settlement mechanism to be set up. What will be the effect of this in relation to overall domain name use trademark rights infringement issues needs to be reviewed as it says nothing about trademark right in general.

1.8 Research Methodology

1.8.2 Research Approach

The methodology employed in this study is mainly doctrinal legal research including both field and desk studies. An analysis of both international and domestic relevant legal instruments including the existing literature, police, and laws were conducted. A comparative analysis of legal framework of the United States, Taiwan, Iran, and Germany is part of the study. This is based on the idea that United States is a country where internet started and having well-developed law in the area. Experience from such country will be expected to have a meaningful contribution in shaping Ethiopian law. The laws of Taiwan and Iran have also shown certain similarities to that of Ethiopia on the issue investigated. Which eventually made experience from them quite important and therefore included. The experience of Germany was included for the fact that Germany has a developed legal system worthy of lessons. The study approach was essentially a qualitative method that utilized relevant primary and secondary data sources.

1.8.2 Method of Data Collection

The researcher used both primary and secondary sources of data, data collection was conducted by applying data collection techniques like document review and interview as much as it is necessary to collect different important information regarding the problem under study.

Accordingly, the researcher reviewed primary sources of data like data collected by interviewing key personnel's from Ethiopian Communication Authority, Ethiopian Intellectual Property Authority and companies engaged in web hosting and domain name registration services using semi-structured interview. The interview is limited to one officers of administrative organs mentioned and at least two companies engaged in web hosting and domain name registration services to manage time and resources, personal observation was also conducted.

Besides to primary sources to be reviewed, the researcher also reviewed secondary sources like domestic trademark laws (trademark proclamation, regulation), Electronic Transaction proclamation, laws of other states, including potential international legal instruments and other related instruments, books, different documents, journal articles, working papers, conference and seminar proceeding, internet sources and case if any and also experience from the case of other countries.

1.8.3 Method of Data Analysis

To examine the data collected from primary and secondary sources, the researcher employed an essentially qualitative method of data analysis. This research was also having comparative nature, hence foreign legislations and court jurisprudences were analyzed. In addition, the legal interpretation rules or statutory interpretation were used for legal documents based on its importance

CHAPTER TWO

Conceptual Frame Work of Trademark, Trademark Law, Domain Name and the Possible Relationship

2.1 Trademark Nature and Concept

2.1.1 Definition

WIPO defined trademarks as any sign that individualizes the goods of a given enterprise and distinguishes them from the goods of its competitor.⁴⁸ Another definition provided by WIPO states a trademark is a sign that identifies and distinguishes in the marketplace the products of one enterprise from those of other enterprises.⁴⁹ The products that it identifies may be goods or services. WIPO definition has undergone change from treating trademark and service mark as a similar mark to both can be indicated as trademark. This is due to historical phenomena, which is not part of this study. An additional point to note is WIPO currently provides a definition that omits the marketplace requirement its website. This latter definition introduced flexibility and definitely will have meaningful contribution to broader understanding of trademark use. As this agency has a mission to lead the development of a balanced and effective international intellectual property system that enables innovation and creativity for the benefit of all as stated in his website. The definitions provided by it will provide one solid ground for trademark definition with universal acceptability.

The TRIPS agreement also provides trademark constitutes “*any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as*

⁴⁸World Intellectual Property Association, Introduction to Trademark Law & Practice: The Basic Concept: A WIPO Training Manual, (WIPO) (1989) at 10.

⁴⁹World Intellectual Property Organization, Making a Mark: An Introduction To Trademark For Small And Medium-sized Enterprises (WIPO) (2017), at.8, *available* at <https://tind.wipo.int/record/29006> (Accessed on 23rd of October, 2021).

*a condition of registration, that signs be visually perceptible.*⁵⁰ The TRIPS agreement is especially relevant for the determination of trademark and trademark law on an international basis. Since acceptance is a mandatory requirement for joining WTO plus so far 164 nations have accepted the TRIPS agreement. This creates another solid universal basis for trademark law or a specific definition of a trademark. Ethiopia is also in the process of accession to this organization. Overall the definition provided by TRIPS and WIPO will allow us to safely deduct potential universal definitions of trademarks that can be used in this paper.

2.1.2 Basic Characteristics of Trademark

In line with the idea of providing a definition this part also frames the basic traditional natures of trademark and trademark rights having relation or leading to domain name regulation. In addition, the scope of this conceptual base is definitely universal understanding including variations between countries in accordance with the status of the concept.

2.1.2.1 Signs that Constitutes Trademark

Any sign capable of distinguishing goods or services can be used as a trademark, such as words, names, letters, numerals, drawings, pictures, shapes, colors, labels, or any combination of these.⁵¹ In most countries, taglines, advertising slogans, and titles may also constitute trademarks. An increasing number of countries also allow for the registration of non-traditional trademarks such as single colors, three- dimensional signs (shapes of products or packaging), moving images, holograms, sounds, smells, gestures, tactile marks (feeling or touch),and fluid/mutating trademarks.⁵²However, non-traditional trademarks are rare and many countries limit what may be registered as a trademark, generally allowing only signs that are visually perceptible or can be represented graphically.⁵³

⁵⁰ WTO, THE WTO AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS, Annex 1C of the Marrakesh Agreement Establishing the World Trade Organization, signed in Marrakesh, Morocco on 15 April 1994.[27-trips.wpf \(wto.org\)](https://www.wto.org) (Accessed on 20th of October, 2021),Art. 15(1).

⁵¹ WIPO, *supra* note 49, at 8.

⁵² *Id.*

⁵³ *Id.*

2.1.2.2 Registration or Use Requirement

Legal protection for a trademark will be obtained through registration and/or, in some countries, through use.⁵⁴ In addition, registration will be obtained by filing the appropriate application forms at the trademark office of the country where registration is requested. Many countries also protect trademarks that are used in the marketplace but are not registered even though these countries provide much stronger protection to registered trademarks.⁵⁵ It is better to register even in countries where trademarks are protected through use. In recognition to this fact, our assessment will center on the registered trademarks.

2.1.2.3 Criteria for Protection

The first kind of requirement relates to the basic function of a trademark, namely, its function to distinguish the products or services of one enterprise from the products or services of other enterprises.⁵⁶ In order to serve this function a trademark must be distinguishable among different products. Generally, a sign is distinctive for the goods to which it is to be applied when it is recognized by those to whom it is addressed as identifying goods from a particular trade source or is capable of being so recognized.⁵⁷ Moreover, trademark law protects only distinctive marks. The second kind of requirement relates to the possible harmful effects of a trademark if it has a misleading character or if it violates public order or morality.⁵⁸ These two kinds of requirements exist in practically all national trademark laws.⁵⁹ Nevertheless, the scope of trademark protection varies significantly across jurisdictions. The other point is trademark is something that only exists with respect to some other commercial activity.⁶⁰ The very nature of trademarks as designations of particular goods or services makes their existence possible only when the trademark is assigned to goods or services. And this has led to the criteria of being attached to goods or services existing almost everywhere in the world.

⁵⁴*Id* at 29.

⁵⁵*Id.*

⁵⁶WORLD INTELLECTUAL PROPERTY ORGANIZATION, WIPO Intellectual Property Handbook, WIPO, (2nd 2004) (2008) at 71.

⁵⁷ WIPO, *supra* note 48, at 17.

⁵⁸ WIPO, *supra* note 56.

⁵⁹*Id.*

⁶⁰ Korman, *supra* note 1, at 13.

2.1.2.4 Rights Acquired by Registration

The ownership of a trademark acquired through registration essentially enables the owner to prevent third parties from using this trademark in certain situations. In general terms such use by a third party can include misrepresentations affecting the distinctiveness of the trademark. More specifically the exclusive rights arising out of a trademark registration allow you to prevent all others from marketing identical or similar products under an identical or confusingly similar trademark.⁶¹ Therefore, you will be able to prohibit competitors from: (a) affixing the trademark to goods or their packaging; (b) stocking or selling goods bearing the trademark or supplying services under the service mark; (c) importing or exporting goods under the trademark; and/or (d) using the trademark on business papers, websites and in advertising.⁶² However, such exclusive rights are limited to: the country or countries in which you have registered; the goods/services for which the trademark is registered; and situations in which consumers are likely to be confused by the infringing trademark.⁶³

2.1.2.5 The Concept of Well –Known Trademarks in Trademark Law

Well-known marks are trademarks that are considered to be well-known by the competent authority of the country where protection for the trademark is sought.⁶⁴ Generally it is possible for every type of trademark to become “well known” over time there is no prohibition based on the nature of the trademark. Well-known marks benefit from additional protection. For example, well-known marks may be protected even if they are not registered (or have not even been used) in a given territory.⁶⁵ In addition, while trademarks are generally protected against confusingly similar trademarks only if used for identical or similar products, well-known marks are protected against confusingly similar trademarks even for dissimilar products, provided certain conditions are met.⁶⁶ These conditions are in broader all-encompassing sense, if the use of the mark is likely to cast it in an unflattering light, cause it to be identified with dissimilar

⁶¹ WIPO, *supra* note 49, at 34.

⁶²*Id.*

⁶³*Id.*

⁶⁴*Id at* 15.

⁶⁵*Id.*

⁶⁶*Id.*

goods, dilute its distinctive quality, or otherwise reduce its “selling power”.⁶⁷The objective of this additional protection is the prevention of free riding on the reputation of a well-known mark and/ or causing damage to its reputation or goodwill. Most commonly, the burden of proving well-known status i.e being well-known by consuming public in a specific territory lies on trademark owner.

2.1.2.6 Trademark Infringement and Remedies

Trademark rights are infringed when a competitor uses the same or a confusingly similar trademark for the same or similar products, in a country where your trademark is protected.⁶⁸Commonly infringement is proved by showing a specific trademark is so close to yours that the consumers are likely to be confused. The confusion can be that the competitor’s products are the same as yours or that the competitor’s business is somehow associated with or approved, authorized or sponsored by your business.⁶⁹In United States trademark law as an example confusing similarity of trademark is in aid of the ultimate question of whether confusion is likely and asks if the similarity of the marks supports such a conclusion.⁷⁰Within this factor is a trilogy of similarities that must be examined: appearance, sound, and meaning.⁷¹ In addition, well-known marks are receiving broader protection in most countries currently and such protection aimed protecting the well-known mark against unfair attempts to profit from or dilute their reputation. The common civil remedies for infringement include injunction, loss of profit, and damages. Criminal procedures can be initiated in cases of willful trademark counterfeiting or copyright piracy on a commercial scale as this is the case in most countries.⁷² Measures with the objective of prevention of counterfeit trademark goods importation at the border are also available to trademark owners in many countries through the national customs authorities. And many customs can search, examine, and seize goods suspected of infringing trademarks or other IP rights.⁷³ Customs actions are principally taken against goods that are being imported into the

⁶⁷ Michael Karanicolas, *The New Cybersquatters: The Evolution of Trademark Enforcement in the Domain Name Space*, Vol.30 (2) Fordham Intell. Prop. Media & Ent. L.J. 399-446 (2020), at 407.

⁶⁸ WIPO, *supra* note 49, at 77.

⁶⁹*Id.*

⁷⁰ Farley, Christine Haight, *Confusing the Similarity of Trademarks Law in Domain Name Disputes*, Vol. 52 Iss. 3 Akron Law Review, 607, (2019), at 621.

⁷¹*Id.*

⁷² WIPO, *supra* note 49, at 78.

⁷³*Id.* at 79.

country additionally some customs also detain suspected goods that are in transit or exported.⁷⁴ In conclusion to this idea, an interesting issue not to overlook is the fact that trademark law provides remedies and sanctions for unauthorized use of the trademark. And this fact will increase the economic interests of owners of trademarks. This definitely leads to strong interest in the actual precise determination of the scope of this protection. Among other factors, this point is one of the points leading to the need for domain name regulation.

2.1.3 Use of Trademark

What use of trademark constitutes is a concept with no clear cut answers significant differences may be spotted from country to country but generally speaking the “use” of a registered trademark in the legal sense, refers to use in the course of trade and by the owner, or with the owner’s consent.⁷⁵ The use of the trademark should be on or in relation to the products or services for which it is registered, in the territory in which it is registered, and use of the mark in a form differing in elements may be regarded as use of the mark provided that there is no alteration of the distinctive character of the mark.⁷⁶ Applying the trademark to goods or materials for the labeling or packaging of goods in the territory registered solely for export purposes may also constitute use depending on the country where you register your trademark. More specifically, the legal requirements for “use” of a trademark vary from country to country, but generally, they are met if the owner: applies the sign to goods or the packaging thereof; offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers goods or supplies services under the sign; imports or exports goods under the sign; uses the sign on an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document; or uses the sign in advertising.⁷⁷ This traditional understanding of trademark use can be said based on use in the ordinary market but the absence of clear-cut answer tells, as the concept is not inherently rigid.

⁷⁴*Id.*

⁷⁵ *Id.* at 57.

⁷⁶*Id.*

⁷⁷*Id.*

2.1.4 Trademark Functions and Multifunctional Approach in Defining Scope of Trademark Protection.

The functions that a trademark performs can be categorized into three. The first one is the origin function, which indicates the commercial origin of products bearing the trademark; the second one is the quality guarantee function, which conveys information about the quality features of the products bearing the trademark in other words, it provides an economic assurance to consumers about the likely product quality.⁷⁸ Communication, investment, or advertising functions, which are also called the modern functions, can be considered as the third one. Historically, the basic function or original function of a trademark is to distinguish the goods of one enterprise from those of another. However, despite the origin function of trademark remains as the essential one, the other functions of trademark have also started to play a role that is as crucial as its essential function of origin indicating sequentially. In today's world, some trademarks signify a brand image that consumers might wish to be linked with and these may cover a range of themes such as luxury, elegance, quality, modernity, youth, or other similar desired attitudes or lifestyles.⁷⁹

Traditional scholarship on the purpose of trademark law, which draws heavily from law and economics, views them as a matter of consumer protection, insofar as they reduce consumers' search costs in obtaining products of reliable quality, while simultaneously incentivizing companies to invest resources in developing a product of consistent quality.⁸⁰ But in today's world the scope of protection on trademark is ever expanding on a number of function it encompass towards including modern function of trademarks. In line with this, with the view of attracting consumers to their products, trademark owners may invest in the creation and development of a brand image through advertising and other marketing techniques.⁸¹ And in order to safeguard this investment that trademark owners made, the protection given to the trademark owners under Article 5 (1) (a) of the European Union Trademark Directive has been

⁷⁸ Arikan Ozgur, Modern Functions and the Trade Mark use Prerequisite in European Trade Mark Law, (2014) available at https://www.law.berkeley.edu/files/Arikan_Ozgur.pdf (Accessed on 20th of October, 2021).

⁷⁹ *Id.*

⁸⁰ Karanicolas, *supra* note 67, at 406.

⁸¹ Ozgur, *supra* note 78.

expanded through the judgments of the Court of Justice of the European Union (“CJEU”).⁸²The expansion of trademark protection to cover modern functions happened on the issue as to the interpretation of the trademark use prerequisite in the mentioned article (European Union older trademark directive). This court reformulation in Europe is an important indicator of measure experience as to the fact that trademark law can be and was developed to include modern functions though originally lacking such a future.

Moreover, the historical view of United States trademark law one of the main developed legal systems in the area has shown, that as trademark function expands from designators of origin, guarantors of the quality of the trade marketed goods, embodiments of the trademark proprietor’s goodwill, up to advertising medium, consequentially these change in commercial significant of trademarks have influenced views of courts, legislators and legal scholars.⁸³ Importantly the later enactment of The Federal Anti-Dilution Act in United States is a clear signal of expansion and encompassing other non-origin functions of trademarks within trademark law scope of protection. The dilution doctrine introduced by such law provides that trademarks may suffer a second type of damage, separate from confusion as to the source of origin that diminishes the trademark’s ability to function as a recognition agent.⁸⁴Damage due to dilution weakens the strength of the trademark by dispersing the trademarks identity, thereby, causing loss of trademark ability to denote the goods.⁸⁵ In sum, it is worth emphasizing currently the value of trademarks to producers and other trademark proprietries lies in the functions, which trademarks are serving in the modern markets.⁸⁶This function essentially centered on economic benefit again highly dependent on the protection afforded to trademark holder from free riding of competitors and other profit seekers aiming to dilute, infringe , or otherwise benefits from another trademark.⁸⁷ Hence, consequentially there is a growing approach centered on the function actually served by trademark while defining, determining, and/or designing trademark law scope of protection as the practice shows this fact in major legal systems. This point is a central point that should understood as a measure base line

⁸²*Id.*

⁸³ Kalistratova Zhanna, *Modern Concepts of Trade Mark Protection and Their Application to Internet Uses* , Central European University, Unpublished Master thesis,p.72 (2007) p.5.

⁸⁴*Id.* at 12.

⁸⁵*Id.*

⁸⁶*Id.* at 62

⁸⁷*Id.*

whenever an attempt is made to determine the compatibility of domain name use to trademark law scope of protection and should be taken as the major approach to doing it.

2.2 The History and Nature of Domain Name, Domain Name System and Administration

Internet where the concepts of domain names emanate is a global network of computers. In the 1950's, local area networks (LANs) interlinking computers within a single building expanded into wide area networks (WANs) later in the 1960's interested technologists began to propose the idea of a global network following the same principle.⁸⁸ Not forgetting the efforts of many projects and networks having significant contributions in pushing the boundaries of the technology, the United States Department of Defense's ARPANET (Advanced Research Project Agency Network) is perhaps the most successful. ARPANET was begun in 1969 as a packet switching network and was the first to interconnect multiple networks as well as the first to begin using the internet protocol suite (TCP/IP) in 1982.⁸⁹ In the following year specifically in 1989, the World Wide Web first became accessible via the internet and available to the public in 1991.⁹⁰

Each computer that connects to the internet needs a unique identifying number, which serves as its individual address.⁹¹ In addition, this is its internet protocol address (IP address) which provides information about the host (or network interface identification) and location.⁹² For example, the IP address for the Forum on Franchising's home page is: 45.60.122.186.17, it is located in or around Redwood City, California.⁹³ Because people recognize words more than a string of numbers domain names were created which serve as a recognizable gateway to the internet by providing a user-friendly address system to locate the computers hosting the websites sought by the public in a vast sea of data.⁹⁴ More specifically, they are strings of letters

⁸⁸ Carol Anne Been and Susan Meyer, American Bar Association, Domain Name Management and Enforcement 34 (2018), p.1, available at [341 Meyer-ABAFOF-Domain Name Management.pdf \(greensfelder.com\)](#) (Accessed on 20th of October, 2021).

⁸⁹*Id.*

⁹⁰*Id.*

⁹¹*Id.*, at 2.

⁹²*Id.*

⁹³*Id.*

⁹⁴*Id.*

that are used for networking and routing purposes by the computers that make up the internet. Domain names serve exactly the same function for a host computer's numerical IP address. Since the internet still functions by connecting IP addresses – strings of numbers – every web server must be able to translate domain names into IP addresses and this happens via the Domain Name System (DNS), a decentralized system made of many DNS servers.⁹⁵ Essentially, the DNS is the phone book of the internet that maintains a directory of domain names and converts them to IP addresses, while a DNS server is a part of the whole system and stores DNS records for a domain, for example, the Forum on Franchising is located through the domain name www.americanbar.org.⁹⁶ This global domain name system (“DNS”) is a key to make the internet accessible and usable.⁹⁷ While computers find places on the global network via a string of numbers, like “192.0.32.7,” domain names via domain name system create shorthand that is easy to remember and share means of identification.⁹⁸

Having said this the next step is how this global connection address is being governed. Originally, an informal group formed out of the ARPANET project known as IANA (Internet Assigned Numbers Authority) administered the registries of internet protocol identifiers, including distributing top-level domain names and IP addresses.⁹⁹ IANA delegated the practical administration of assignment and registration of domain names to so-called Network Information Centers (NICs).¹⁰⁰ In this context, the assignment and registration of domain names below the generic TLDs is coordinated throughout the world by InterNIC, entrusted with this task in 1993 under an agreement concluded between the USA government (represented by the National Science Foundation) and the company's General Atomic, AT&T and, Network Solutions Inc.¹⁰¹ According to the agreement, the responsibility for the administration of the registration procedure is provided and entrusted to the private company Network Solutions, Inc. (NSI). As the internet expanded, some objected to this role being handled by the United States government and as a consequence, in 1998 key parties created a formal non-governmental

⁹⁵*Id.* at 3.

⁹⁶*Id.*

⁹⁷Karanicolas, *supra* note 67, at 403.

⁹⁸*Id.*

⁹⁹ Been et al, *supra* note 88, at 4

¹⁰⁰ Torsten Bettinger, *Trademark Law in Cyberspace -The battle for Domain Names* , Volume 28 No. 4 International Review of Industrial Property and Copyright Law,508, (1997), at 510.

¹⁰¹*Id.* at 511.

organization the Internet Corporation for Assigned Names and Numbers (“ICANN”).¹⁰² ICANN was incorporated by taking over management from Network Solutions Inc., a private United States based company. ICANN carried out this work under a memorandum of understanding from the United States Department of Commerce.¹⁰³ Its “role is to oversee the huge and complex interconnected network of unique identifiers that allow computers on the internet to find one another.” and has responsibility for IP address space allocation, protocol parameter assignment, domain name system management, and root server system management functions.¹⁰⁴ In short, ICANN’s role is to coordinate this global system of identifiers with the goal of ensuring “universal resolvability,” meaning that wherever you are in the world, accessing the network with the same query will return the same results. More specifically ICANN is responsible for managing and coordinating the Domain Name System (DNS) to ensure that every address is unique and that all users of the internet can find all valid addresses. It does this by overseeing the distribution of unique IP addresses and domain names.¹⁰⁵ It also ensures that each domain name maps to the correct IP address.¹⁰⁶ ICANN is made up of eight groups that contribute to ICANN’s final decisions representing the various interests on the internet and a Board of Directors that makes final decisions. The Board is made up of fifteen voting members and six non-voting liaisons from around the world.¹⁰⁷ An independent nominating committee chooses eight of the voting members, while the remaining members are nominated from the supporting organizations.¹⁰⁸ Because internet was initially designed and even used in the United States its governance remained United States government centered. However, as the internet grew and expanded, there was increasing pressure to “internationalize” the governance of internet identifiers to better insulate the process from partisan politics, as well as to safeguard against the erection of global jurisdictional barriers to the free flow of information.¹⁰⁹ Even though ICANN is the creation of this pressure as a result of the continued push between 2014 and 2016, ICANN and the National Telecommunications and Information

¹⁰² Been et al, *supra* note 88, at 4.

¹⁰³ Karanicolas, *supra* note 67, at 403.

¹⁰⁴ Been et al, *supra* note 88, at 4.

¹⁰⁵ ICANN, About ICANN (2014), available at <https://www.icann.org/resources/pages/faqs-2014-01-21-en> (Accessed on 20th of October, 2021).

¹⁰⁶ *Id.*

¹⁰⁷ Been et al, *supra* note 88, at 5.

¹⁰⁸ *Id.*

¹⁰⁹ Karanicolas, *supra* note 67, at 403.

Administration (“NTIA”) carried out the “IANA Stewardship Transition,” under which the agreement between ICANN and the United States government was allowed to expire and this function was delegated fully and independently to ICANN.¹¹⁰

Domain names, which are used as a user-friendly part of the address system administered by ICANN on the vast internet, are divided into levels by “dot.” To the furthest right is the top-level domain (“TLD”) and to the left are collectively “lower level domains” with each level being referred to by its ordinal rank, e.g., second-level domain, third-level domain, and so forth.¹¹¹ In `www.example.com`, “.com” is the TLD, and “example” is the second-level domain name other well-known TLDs are .net, .org, and .edu.¹¹² There are currently three main groups of top-level domains (TLDs):(i) generic top-level domains (gTLDs) mentioned above, which encompass sponsored and unsponsored gTLDs, (ii) country-code TLDs (ccTLDs), and (iii) infrastructure TLDs.¹¹³ Only six “unsponsored” gTLDs (.com, .org, .net, .biz, .info and .name) exist which are the least restrictive gTLDs.¹¹⁴ Domain names using these gTLDs may be purchased and used for most purposes, subject only to the policies of ICANN.¹¹⁵

“Sponsored” gTLDs are those sponsored by various companies, organizations, and agencies, having power to put restrictions on their use. A good example for this is “.museum” sponsored by the Museum Domain Management Association, which restricts its use to museums. When the new rollout started by ICANN end their number is expected to be up to 1,300 sponsored” gTLDs. An individual or legal entity wishing to register a domain name under a generic top-level domain in any registry may do so through an ICANN-accredited registrar.¹¹⁶There are several hundred accredited registrars located throughout the world that provide support in local languages.¹¹⁷The relationship between a domain name registrant and the ICANN-accredited registrar is governed by a registration agreement.¹¹⁸ Whereas Country-code top-level domains

¹¹⁰*Id.* at 404.

¹¹¹ Been et al, *supra* note 88, at 5.

¹¹²*Id.*

¹¹³*Id.* at 6.

¹¹⁴*Id.*

¹¹⁵*Id.*

¹¹⁶ ICANN, Information for Registrars (2012), *available at* [Information for Registrars - ICANN](#) (Accessed on 20th of October, 2021).

¹¹⁷*Id.*

¹¹⁸*Id.*

are two-letter domains (.au, .ca, .jp, .uk, etc.) that are controlled by the respective country and usually restricted to use by their government, there are approximately 250 ccTLDs currently.¹¹⁹ In general, some of these domains are open, in the sense that there are no restrictions on the persons or entities who may register names. Others are restricted, in that only persons or entities satisfying certain criteria (for example, domiciled within the territory) may register names in them. As to infrastructure TLD as an example .arpa domain which is reserved solely for internet infrastructure use by ICANN currently. The .arpa domain is the “Address and Routing Paramater Area” domain and is designated to be used exclusively for internet-infrastructure purpose.¹²⁰

The registration of domain names is governed by the first come, first-served rule.¹²¹ This means that, in principle, anyone can buy a domain name as long as it is available, meaning that it has not been registered first by someone else.¹²² Domain names are not territorial they have a worldwide geographical scope; it means that individuals and companies can register their domain names with any accredited registrar in the world and once the domain name is registered, it has a worldwide effect.¹²³ Any individual or company that wishes to register a domain name under a gTLD may do so through an ICANN-accredited registrar. Upon registration, registrants have the choice to determine the duration of their domain name registration, and usually, registrars offer the possibility to register domain names for one year or for multi-year periods, up to 10 years with the possibility to renew domain names indefinitely.¹²⁴

¹¹⁹Been et al, *supra* note 88, at 6.

¹²⁰ IANA, .ARPA Zone Management, *available at* [.ARPA Domain \(iana.org\)](http://iana.org) (Accessed on 20th of October, 2021).

¹²¹ European Commission, Fact Sheet Domain names and Cybersquatting (2017), *available at* domain-name-and-cybersquatting.pdf (ipoi.gov.ie) (Accessed on 20th of October, 2021).

¹²²*Id.*

¹²³ *Id.*

¹²⁴*Id.*

2.3 The Emerging Relationship between Domain Name Use and Trademark Right

For many years mainly the government and universities used the internet, advertising and commercialization on the internet were highly discouraged.¹²⁵ Today's users of internet range from librarians, teachers, scientists, engineers, students, and everyday consumers, to commercial and non-profit organizations.¹²⁶ Commercial interest in the internet has peaked with the web's rapidly developing graphics and multimedia capabilities and with growing consumer activity prompted by online and internet service providers.¹²⁷ The internet has now created plenty of opportunities for small and medium-sized enterprises (SMEs) as well as larger once as it has revolutionized the dynamics of international commerce. This led to facilitating the process of internationalization in general. However, in contrast to marketing directed at a passive audience with classic mass communication technology, the internet user must actively call up the information available on the internet himself.¹²⁸ Therefore, a company intending to use the internet as a marketplace must be able to inform its potential customers where it can be found on the internet. And in order to make it easier for an internet user to find a homepage on the internet, it is essential to choose a short internet address that is easy to memorize.¹²⁹ The most suitable addresses are those containing the trademark, firm name, or other designation of the company itself.¹³⁰ If a company succeeds in registering its trademark as its domain name, potential customers must merely enter the trademark into their WWW browser, supplemented by `http://www`, and can call up the homepage of the relevant company.¹³¹ It is no longer necessary to conduct a protracted and frequently unsatisfactory search via the search engines available free of charge on the internet in order to find the company.¹³² A domain name, which is part of an internet address system identifying a computer site connected to the internet.

¹²⁵ Jr.G. Peter Albert, Right on the Mark: Defining the Nexus between Trademarks and Internet Domain Names, 15 J. Marshall J. Computer & Info. L. 277 (1997), at 278.

¹²⁶*Id.*

¹²⁷*Id.* at 279.

¹²⁸ Bettinger, *supra* note 100, at 508.

¹²⁹*Id.*

¹³⁰*Id.*

¹³¹*Id.* at 510.

¹³²*Id.*

Because as it may suggest identity, quality, and content and create an expectation about who and what is located at that address, it may be closely related to or function as a trademark.¹³³

While the original scope of domain names was to serve a technical function to convert long and complicated numerals into alphanumeric text, which is easy for internet users. However, domain names have evolved and are now considered to be much more than just a connection between the internet user and the computer hosting the website.¹³⁴In fact, domain names play a significant role in branding for e-commerce companies and are associated with goods and services, businesses, and resources.¹³⁵A domain name is the first thing an internet user comes in contact with during accessing an internet website, which practically increases the importance of domain names. A domain name that is easy to remember has the benefit of being easier for previous visitors to remember and generally drives more users to that website due to its precise relevance to the subject of the search of internet surfers.¹³⁶By using trademarks as their domain name, businesses hope to attract potential customers to their websites and increase their global market visibility, and ultimately their sales and profits.¹³⁷ Domain names are now used routinely in advertising as a means of indicating the presence of an enterprise or business on the internet with the growth of internet.¹³⁸Domain names have come increasingly into conflict with trademarks. The internet provides a scenario, where creating and disseminating content has become easier than ever.¹³⁹Furthermore registering domain names is simple, affordable, and fast. The proliferation of the new gTLDs has additionally increased the possibilities for new domain name variations. While this can boost business dynamics and therefore is appreciated by businesses, it can also be a potentially harmful threat.¹⁴⁰

¹³³Korman, *supra* note 1, at 25.

¹³⁴ Claudio Caruana, The Legal Nature of Domain Names, *available at* [5.-caruana-claudio-the-legal-nature-of-domain-names.pdf \(elsa.mt\)](https://www.elsa.mt/5.-caruana-claudio-the-legal-nature-of-domain-names.pdf) (Accessed on 20th of October, 2021).

¹³⁵*Id.*

¹³⁶*Id.*

¹³⁷WIPO, WIPO Internet Domain Name Process (1999), *available at* https://www.wipo.int/pressroom/en/prdocs/1998/wipo_pr_1998_129.html (Accessed on 20th of October, 2021).

¹³⁸*Id.*

¹³⁹ European Commission, *supra* note 121.

¹⁴⁰*Id.*

There are two main different ways under which trademark owners can see their rights infringed on the internet: First by having their trademarks replicated on third-party sites creating confusion among consumers about the origin of the goods or services advertised on those sites (e.g. a trader sells counterfeited products online) or second by having their trademarks registered as domain names by unauthorized third parties, a practice known as cybersquatting (e.g. an individual registers a third party trade mark as a domain name in, for example, the .com extension without any right to do so).¹⁴¹The term "cybersquatting" is defined by the oxford dictionary as:

*“The practice of registering names, especially well-known company or brand names, as internet domains, in the hope of reselling them at a profit.”*¹⁴²

Considering the clarity in describing the first problem, when we shift to this cybersquatting, it is a problem that started to emerge from the early to mid-1990s with the commercialization of internet, during this times as most companies did not realize the commercial potential of internet failed to register their companies as a domain name.¹⁴³It is with this understanding industrious types began registering domain names that were third-party trademarks. This activity comes partly with the realization of the fact that domain name is given at the time on first come first served basis with no need to present evidence as to attachment with name.¹⁴⁴Hence, the trademark owner is effectively barred from registering his mark as a domain name. As only one domain name can exist worldwide unlike trademarks, which can co-exist based on territory and nature of activity. Intern this activity has developed into gold rush scenario of registering trademarks of well-known companies as a domain name with the intent to resell for profit to the companies as the companies go to register their trademark and realize it is already registered.¹⁴⁵ Cybersquatters usually register such domain names and later offer them for sale

¹⁴¹*Id.*

¹⁴² Oxford University, Definition of Cybersquatting (online), *available at* [CYBERSQUATTING | Meaning & Definition for UK English | Lexico.com](#)(Accessed on 20th of October 20, 2021).

¹⁴³ Dunn, *supra* note 6, at 29.

¹⁴⁴*Id.* at 30.

¹⁴⁵*Id.*

– often to the owner of the previous domain name or trademark at a much higher price than the original registration fee.¹⁴⁶

A typical cybersquatter takes advantage of the confusion that arises from the consumers not knowing that the trademark or well-known name is not the same as a domain name.¹⁴⁷ This person expects and is actually true that people will usually search on the internet to find the companies using trademark or well-known names believing that it is associated with the company. After registration there are certain ways of making money out of it for cybersquatters: first, the cybersquatter can use the trademark or well-known name to direct traffic to his site taking advantage of the large volume of traffic searching for the trademark or well-known name, second the cybersquatter in an action akin to extortion will then demand payment from the company for the domain name.¹⁴⁸ If payment is not made, still he can post on the site something with bad content adversely affecting or diminishing the trademark or well-known name of the company. Engaging in slandering worldwide of well-known brands is also another possibility, he can register thousands of trademarks especially well-known brands, and demand payment as this is practically attempted worldwide. United States Congress in its meeting on enacting anti cybersquatting law stated cybersquatting has already caused extensive damage to rapidly growing e-commerce; it undermines consumer confidence, discourages internet use, and destroys the value of established brand names and trademarks. Therefore, cybersquatting is a growing problem emanating from the nature of internet and domain names demanding appropriate legal answers.

In conclusion to this point, it was stated elsewhere that the spread of internet access presents challenges across many different fields of legal theory, as concepts developed for an offline world have had to be revised and adapted to deal with new digital realities.¹⁴⁹ Trademark law is one of the areas of law where these challenges first emerged, as major brands sought to assert ownership over domain names associated with their products. These debates over trademark right protection and its appropriate boundaries have influenced significantly in shaping the modern internet governance space. Moreover, over the past two decades, voices calling for

¹⁴⁶ European Commission, *supra* note 121.

¹⁴⁷ Dunn, *supra* note 6, at 31.

¹⁴⁸ *Id.*

¹⁴⁹ Karanicolas, *supra* note 67, at 401.

stronger enforcement of trademark rights have been profoundly successful, not only in the establishment of specialized mechanisms to assert their interests, but in developing an emerging area of law that has become almost totally unrecognizable from its traditional origins in consumer protection, and the prevention of confusion in commerce.¹⁵⁰ And this development will be the central part of this paper in subsequent parts.

2.4 The Effort of ICANN to Tackle the Conflict between Trademark Rights and Domain Names Administratively

Originally, assignment of domain names was carried out free of charge based on the first-come first served principle. As long as the domain name did not have more than 24 letters and did not contain signs other than letters, numbers, and hyphens, companies and private individuals were able to register any conceivable domain name without legitimation being necessary.¹⁵¹ Conflicts between domain names and trademark rights were not investigated as well and there was no obligation to use after registration. Gradually, when numerous companies realized the economic value of domain names but only to find that their trademarks or firm names had already been registered by other companies or private individuals as domain names. Hence, the first-come, first-served principle resulted several trademark law disputes. When claims were filed against NSI for being an accessory to trademark infringement in the litigation between Knowledgenet, Inc. v. D.L. Boone, NSI decided to amend its assignment practice effective from November 23, 1995, NSI implemented its so-called "Domain Name Dispute Policy."¹⁵²

Under Network Solutions Inc.'s early management of the DNS, its dispute resolution policies were primarily centered on providing liability shield for the company. When its first formal dispute resolution policy was released in 1995, it required an exact match to a registered trademark.¹⁵³ Defendants could defend themselves by showing that they had their registered trademark, and if they were unable to do so, they would be offered an alternative domain, again if the registrants refused this, the domain would be placed on hold, meaning neither party would

¹⁵⁰*Id.*

¹⁵¹ Bettinger, *supra* note 100, at 511.

¹⁵²*Id.*

¹⁵³*Id.* at 416.

be allowed to use it.¹⁵⁴ In 1998, NTIA, an agency of the United States Department of Commerce that oversaw the domain name space started calling for trademark enforcement policy reform. To this end and with the idea of not imposing of United States trademark law over the global internet, the NTIA committed to having the process be led by WIPO. Later with the view of performing this mandated task, WIPO began a process of public consultation in July 1998, issuing a final report in April 1999. Although, WIPO’s role had been used as a means to move the process outside of American dominance. Still criticized for being more technically focused academics and civil society voices for viewing intellectual property holders— as opposed to technologists or individual domain name holders as its main constituency.¹⁵⁵ However, safe to the fact that it was subject to some revisions by an ICANN working group in 1999—including, most notably, the addition of a section on the rights and legitimate interests of domain registrants the final WIPO report formed the core of what became the Uniform Dispute Resolution Policy (“UDRP”).¹⁵⁶The Board of Directors of ICANN approved the UDRP on October 24, 1999, effectively imposing it on anyone who registers a domain name. Its applicability is included within domain name registration agreements as a mandatory condition of the accreditation agreement that ICANN signs with registrars, which certifies them in their role of selling domain names to consumers.¹⁵⁷

The Uniform Domain-Name Dispute-Resolution Policy (“UDRP”) is a system provided by ICANN for the resolution of disputes regarding the abusive registration and use of domain names. It is applied by all ICANN accredited registrars in their agreements with all domain name registrants. The Uniform Domain-Name Dispute Resolution Policy is applicable across all gTLDs and disputes under these policies may be filed with one of the approved dispute-resolution service providers for the given policy.¹⁵⁸It has also been adopted by certain managers of country-code top-level domains (e.g., .nu, .tv, .ws).¹⁵⁹It is incorporated by reference into your

¹⁵⁴*Id.*

¹⁵⁵*Id.* at 417.

¹⁵⁶*Id.*

¹⁵⁷*Id.* at 418.

¹⁵⁸ ICANN, Uniform Dispute Resolution Policy (2012), *available at* [Domain Name Dispute Resolution Policies - ICANN](#)(Accessed on 20th of October, 2021).

¹⁵⁹ICANN, Uniform Dispute Resolution Policy (2012), *available at* <https://www.icann.org/resources/pages/policy-2012-02-25-en>(Accessed on 20th October, 2021).

registration agreement.¹⁶⁰ And sets forth the terms and conditions in connection with a dispute between you and any party other than the registrar over the registration and use of an internet domain name registered by you.¹⁶¹ Dispute proceedings arising from alleged abusive registrations of domain names (for example, cybersquatting) may be initiated by a holder of trademark rights.¹⁶²The complainant in a UDRP case must prove that: 1) the domain name is identical or confusingly similar to a trademark or a service mark in which the complainant has rights; 2) the registrant has no rights or legitimate interests in respect of the domain name; and 3) the domain name has been registered and is being used in bad faith.¹⁶³

The UDRP procedure is much shorter than court proceedings. It usually takes 60 days from the date the complaint is received by the dispute resolution service provider for a case to be concluded.¹⁶⁴The complainant must address the complaint to a dispute resolution service provider following the UDRP rules , which among other things require the complaint to contain: the complainant’s choice of panel – single-member or three-member panel; the domain name which is the subject of the complaint; the registrar with whom the domain name is registered; the trade mark(s) or service mark(s) on which the complaint is based and the goods and services with which the trade mark is used; the grounds on which the complaint is made; the remedies sought.¹⁶⁵The UDRP is an optional procedure for a mark owner and it is mandatory for domain name holders.¹⁶⁶ In most cases the complainant bears the duty to pay all fees associated with the administrative proceeding, it does not provide for recovery of fees from the losing party.¹⁶⁷Only when the complainant elects a one-member panel and the respondent requests to expand the panel to three does the respondent incur any obligation to pay, in which case, the respondent and complainant split the fees evenly.¹⁶⁸There are two available remedies for complainants under UDRP, a cancellation of the domain name or a transfer of the domain name

¹⁶⁰*Id.*

¹⁶¹*Id.*

¹⁶² ICANN, *supra* note 158.

¹⁶³ European Commission, *supra* note 121.

¹⁶⁴*Id.*

¹⁶⁵*Id.*

¹⁶⁶ Harvard Law School, The Udrp Process, *available at* <https://cyber.harvard.edu/udrp/process.html> (Accessed on 20th October, 2021).

¹⁶⁷*Id.*

¹⁶⁸*Id.*

to the complainant.¹⁶⁹ This is one of the central point's making it difficult choice to court based resolution. The UDRP proceedings does not prevent from submitting the dispute to a court during or after the UDRP proceedings independently. In such case, the decision under UDRP will not be implemented by the registrar, and subject to compliance with the applicable formalities under UDRP, the decision of the court will prevail.¹⁷⁰

Even though ICANN the governing body appreciates the mechanisms as fast and cheap method of resolving domain name conflict, a lot of critics circulate around the system. The first one goes to academic and civil society voices. Who were heavily critical of the system as being unbalanced in favor of trademark interests, as early statistical analyses of UDRP findings showed the overwhelming majority of cases (around eighty percent) were decided in favor of the complainant.¹⁷¹ An exacerbating factor in having a system that leaves itself open to domain shopping, it incentivizes providers to develop a reputation for deciding cases in favor of complainants.¹⁷² Another criticism is lack of transparency since decisions were published but party submissions are not. Decisions are also not binding on subsequent cases leaving room for inconsistency and ambiguity. Scholars also criticize the system as leaving room for undue stretching of rights, which in fact happened. The fact that court based resolution directed by it and available to the parties is also can be seen as a problem by many on one side. As it casts doubt on the actual power of the system in resolving the dispute. This direction provided by it as an administrative proceeding to court based solution can also be taken as another ground necessitating developing adequate and effecting legal frame work for handling the issues involved despite the system by itself was developed as an option to it. Another shortcoming is that the UDRP does not apply to approximately 150 ccTLDs (.uk, .nz, etc.) including Ethiopia.¹⁷³ The list of ccTLDs adopting UDR includes:

¹⁶⁹ European Commission, *supra* note 119.

¹⁷⁰*Id.*

¹⁷¹ Karanicolas, *supra* note 67, at 421.

¹⁷²*Id.*

¹⁷³ Diane Cabell, Overview of Domain Name policy Development, Harvard Law School (2000) *available at* <https://cyber.harvard.edu/udrp/overview.html> (Accessed on 20th of October, 2021).

”.ag,.ai,.as,.bm,.bs,bz,.cc,.cd,.co,.cy,.dj,.ec,.fj,.fm,.gd,.gt,.ki,.la,.lc,.md,.me,.mw,.nr,.nu,.p
a,.pk,.pn,.pr,.pw,.ro,.sa,.sc,.sl,.so,.ti,.tt,.tv,.ug,.ve,.vg, and .ws,.”¹⁷⁴

This can be seen as another specific shortcoming. The UDRP is also limited in application essentially to cybersquatters, as defined in section 4 of the policy.¹⁷⁵ Several countries also provided a similar or containing some basic component from UDRP policies aspired by it.

The second system established by ICANN is the Uniform Rapid Suspension System (“URS”). It is only applicable to new gTLDs (such as .companyX or .city), to protect the rights of trade mark owners in a lower-cost and faster way.¹⁷⁶ This system complements the UDRP system, and is used in clear-cut cases of infringement caused by domain name registrations. These are cases where there are no open questions of fact, but are clear cases of trademark abuse (such as in cases of counterfeiting, massive fraud, or the spread of virus/malicious software).¹⁷⁷ Similarly, to the UDRP system, the complainant in a URS case must prove that: 1) the registered domain name is identical or confusingly similar to the complainant’s trademark; 2) the domain name registrant has no legitimate right or interest to the domain name; and 3) the domain name was registered and is being used in bad faith.¹⁷⁸ The URS is an expedited system as decisions are expected to be given within one month. The URS proceedings will be conducted pursuant to the approved URS Procedure.¹⁷⁹ If the complaint passes the URS Provider's administrative review, the registry operator must lock the domain name(s) in dispute within 24 hours of notification by the URS provider.¹⁸⁰ This is until final decision is reached. If a URS proceeding results in a determination that one or more domain names must be suspended, the registry operator must implement the suspension.¹⁸¹ The complaint is required to contain essentially the same elements as UDRP following the URS rules. The examiner is expected to make a decision simply by examining the documents submitted by the parties with the complaint and the

¹⁷⁴ WIPO, Domain Name Dispute Resolution Service for Country Code Top Level Domain Names, *available at* [Domain Name Dispute Resolution Service for Country Code Top Level Domains \(ccTLDs\) \(wipo.int\)](#) (Accessed on 20th of October, 2021).

¹⁷⁵ Harvard Law School, *supra* note 166.

¹⁷⁶ European Commission, *supra* note 121.

¹⁷⁷ *Id.*

¹⁷⁸ *Id.*

¹⁷⁹ ICANN, About Uniform Rapid Suspension System (2013), *available at* [About Uniform Rapid Suspension System \(URS\) - ICANN](#) (Accessed on 23rd of October, 2021).

¹⁸⁰ *Id.*

¹⁸¹ *Id.*

response without a need for further evidence and hearing. There is no transfer decision in URS and if the complainant is unsuccessful, the return of the domain to the registrant will be ordered. Still it is also possible for the parties in certain instances to move in to UDRP or to competent court. Basically, those trademark owners who are not interested in gaining ownership of the infringing domain name, but rather wish to stop the infringement in question as soon as possible should only use this procedure.¹⁸²

The third one is Trademark Post-Delegation Dispute Resolution Procedure (“PDDRP”). This is a domain name dispute resolution procedure only applicable to new gTLDs. For cases where a domain name owner believes that a registry operator, that is to say, an organization that manages the registration and operation of domain names, is intentionally and systematically infringing trademarks in its top-level domain, either by itself or by assisting third parties in doing so.¹⁸³ In addition to registry operator is on notice of possible trademark infringement through registrations in the gTLD. There is a need to prove taking of unfair advantage of the reputation of the complainant’s trademark, impairment of marks reputation or creation of confusion of complainant mark plus bad faith of registration. Considering that the defendant is a registry operator, the complainant is required to provide a statement in the complaint on how the harm suffered is the result of the registry operator’s manner of operation of use of the gTLD.¹⁸⁴ Different enforcement measures can result from the procedure if the registry operator is found liable under the PDDRP, from an obligation for the registry to employ remedial measures against allowing future infringing registrations to the total termination of the registry agreement with ICANN.¹⁸⁵

The other one is Legal Rights Objection (LRO), which is a dispute resolution procedure under which trademark owners and intergovernmental organizations (i.e. those who meet the criteria for registration of an .int domain name) can formally object to a new gTLD application on the basis of a “Legal Rights Objection.”¹⁸⁶ It is a mechanism where trademark owners or intergovernmental organizations if trademark, names, acronyms may be infringed by new

¹⁸² European Commission, *supra* note 121.

¹⁸³ *Id.*

¹⁸⁴ *Id.*

¹⁸⁵ *Id.*

¹⁸⁶ *Id.*

gTLD stop approval. By proofing that the potential use of the gTLD applied for by the applicant unjustifiably impairs the distinctive character or the reputation of the objector's mark or name or acronym, or takes unfair advantage of the distinctive character or the reputation of the objector's trademark or name or acronym, or otherwise creates a likelihood of confusion between the gTLD applied for and the trademark or name or acronym. The remedies are limited to the success or dismissal of the objection, with no monetary damages apart from the possibility for the prevailing party to obtain a partial refund of the panel fee.¹⁸⁷

2.5 Reverse Domain Name Hijacking Prevention Device

The situation in which a trademark owner takes advantage of an administrative policy in bad faith to grab a domain name from a registrant is called "reverse domain name hijacking" ("RDNH").¹⁸⁸ Reverse domain name hijacking occurs when trademark owners abusively assert their trademark rights to strip domain names from rightful owners.¹⁸⁹ You may be the victim of reverse domain name hijacking if someone tries to intimidate you to give up your domain name under the guise of trademark ownership.¹⁹⁰ This may occur even if use of your domain name does not violate any trademark laws. Some trademark owners have developed strategies to attempt to wrongfully capture, a sought-after domain name under current DNH laws and policies.¹⁹¹ Through a transfer order issued by the court or administrative body, even when it is clear that the prior domain name registrant legitimately obtained rights in the domain name.¹⁹² On this case essentially a trademark owner brings, or simply threatens to bring, a frivolous cybersquatting claim. This practice, which is known as Reverse Domain Name Hijacking (RDNH) also called reverse cybersquatting, can be said it involves the trademark owner making a false claim in order to acquire a domain name. Typically, the domain name is identical or

¹⁸⁷*Id.*

¹⁸⁸ Tsai, *supra* note 23, at 369.

¹⁸⁹ Greenspoon Marder LLP, Reverse Domain Name Hijacking Overview, *available at* <https://www.gmlaw.com/intellectual-property/reverse-domain-name-hijacking> (Accessed on 23rd of October, 2021).

¹⁹⁰*Id.*

¹⁹¹ Catherine A. Schultz and Courtney A. Hofflander, *Reverse Domain Name Hijacking and The Uniform Domain Name Dispute Resolution Policy: systemic Weakness, Strategies for the Respondent, and Proposed Policy Reform*, Vol. 4(2) "Cybaris® Article 2 (2013), p.220-248, at.225, *available at* <https://open.mitchellhamline.edu/cybaris/vol4/iss2/2> (Accessed on 23rd of October, 2021).

¹⁹²*Id.*

similar to a reverse domain name hijacker's trademark, though this is not always the case.¹⁹³ Reverse domain name hijacking is a serious problem and can cause you to lose your domain name and/or seriously damage your business or interest in the online sphere.¹⁹⁴ Although it is hard to determine the exact frequency of RDNH, as many instances do not make it to a forum for resolution as the registrant simply transfers the domain upon a threat or demand of the trademark owner.¹⁹⁵ It occurs more than desired and can be "equally as onerous" as cybersquatting due to the time and resources required for resolution and consequence.¹⁹⁶ The domain name registrant needs a means to fight back. As an example, it is defined in Rule 1 of the UDRP Rules as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name."¹⁹⁷ Moreover, under UDRP the burden of proof lies on the respondent to prove the presence of the element of 'bad faith' and mala-fide intention of acquiring the domain name as a mechanism of protection. Rule 15(e) of the same instruments further holds any complain made in bad faith, as an abuse of the administrative process. The Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding in the situation.

Professor Zainol conducted research on RDNH cases under the UDRP and concluded that: A new paragraph 4(d) should be inserted in the UDRP policy, outlining clearly the scope and elements of RDNH, a finding of RDNH must be accompanied by some form of sanction, either monetary or administrative as currently lack it.¹⁹⁸ From the above suggestion, we can see that the administrators of the UDRP must pay more attention to the interests of domain name registrants in the trademark/domain name protection war.¹⁹⁹ In line with this judging, the trademark/domain name protection war should be a process of interest balancing, and there should be parity between the rights of trademark owners and domain name holders.²⁰⁰ Anti-cybersquatting legislation or trademark law should incorporate an RDNH prevention

¹⁹³*Id.*

¹⁹⁴ Greenspoon Marder LLP, *supra* note 189.

¹⁹⁵ Schultz et al, *supra* note 191, at. 226.

¹⁹⁶*Id.*

¹⁹⁷ ICANN, Rules for Uniform Domain Name Dispute Resolution Policy ("The Rules")(2015), *available at* <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en>. (Accessed on 23rd of October, 2021).

¹⁹⁸ Tsai, *supra* note 23, at 378.

¹⁹⁹*Id.*

²⁰⁰*Id.*, at 401.

mechanism so that lawful domain name holders might have something with which to defend their domain names against a powerful trademark owner's unlawful move.

CHAPTER THREE

Protection of Trademark in Domain Name Space in Selected Countries

3.1 The Experience of United States

In the United States trademark, rights may arise under both federal and state law.²⁰¹ The main federal trademark statute is called the Lanham Act. Originally, state common law provided the main source of protection for trademarks. However, in the late 1800s, the United States Congress enacted the first federal trademark law. Since then, federal trademark law has consistently expanded, taking over much of the ground initially covered by state common law.²⁰² Today, federal law provides the main, and by large the most extensive, source of trademark protection, although state common law actions are still available.²⁰³ Therefore, the observation presented here focuses on the federal laws in recognition to these basic facts. Under current United States law, there are three possible weapons a trademark owner might use to fight a domain name registrant: (1) remedies under the Lanham Act, (2) injunctive relief under the Federal Trademark Dilution Revision Act (“TDRA”), and (3) the ACPA. Hence, we will briefly analyze all the three alternatives.²⁰⁴

In order to win the Lanham Act claim there is a need to prove that the owner has a valid trademark, the trademark is distinctive, the trademark has priority, and there is a likelihood of confusion about the source of the goods bearing the trademarks. Likelihood of confusion is the key element of a trademark infringement claim.²⁰⁵ Courts look in to a number of factors when determining whether a given use of a mark is likely to cause confusion with a prior mark more complete list for the “likelihood of confusion” test can be found in *In re E. I. DuPont DeNemours & Co.* The factors set forth in that case are:

²⁰¹ Harvard University, Overview of Trade Mark Law, *available at* [Overview of Trademark Law \(harvard.edu\)](http://www.harvard.edu) (Accessed on 23rd of October, 2021).

²⁰² *Id.*

²⁰³ *Id.*

²⁰⁴ Tsai, *supra* note 23, at 358.

²⁰⁵ *Id.* at 363.

1. *The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;*
2. *The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;*
3. *The similarity or dissimilarity of established, likely-to-continue trade channels;*
4. *The conditions under which and buyers to whom sales are made, i. e. “impulse” vs. careful, sophisticated purchasing;*
5. *The fame of the prior mark (sales, advertising, length of use);*
6. *The number and nature of similar marks in use on similar goods;*
7. *The nature and extent of any actual confusion;*
8. *The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;*
9. *The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark);*
10. *The market interface between applicant and the owner of a prior mark: (a) a mere “consent” to register or use, (b) agreement provisions designed to preclude confusion, i. e. limitations on continued use of the marks by each party, (c) assignment of mark, application, registration and good will of the related business, (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion;*
11. *The extent to which applicant has a right to exclude others from use of its mark on its goods;*
12. *The extent of potential confusion, i. e., whether de minimis or substantial;*
13. *Any other established fact probative of the effect of use :*

*The factors are to be considered together, and mechanical formulas and processes are disfavored.*²⁰⁶

²⁰⁶*Id.* at 364.

Developing on this it can be said, in United States trademark law there is flexibility in determining likelihood of confusion. The second is an action under trademark dilution revision act. It generally applies only to “famous” marks and this is under the federal law. In deciding whether a mark is famous, the courts will look at the following factors: (1) the degree of inherent or acquired distinctiveness; (2) the duration and extent of use; (3) the amount of advertising and publicity; (4) the geographic extent of the market; (5) the channels of trade; (6) the degree of recognition in trading areas; (7) any use of similar marks by third parties; (8) whether the mark is registered.²⁰⁷ The basic idea is that famous marks may be harmed or “diluted” by goods that are not confusingly similar, but that “tarnish” or “blur” the famous trademark.²⁰⁸ Federal law generally allows the holder of a famous trademark to enjoin use of the diluting trademark.²⁰⁹

“Dilution by blurring” is association arising from the similarity between a mark or trade name and a famous mark that impair the distinctiveness of the famous.²¹⁰ In determining whether a mark or trade mark is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

(i) The degree of similarity between the mark or trade name and the famous mark

(ii) The degree of inherent or acquired distinctiveness of the famous mark

(iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark

(iv) The degree of recognition of the famous mark

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or tradename and the famous mark.

²⁰⁷ Harvard University, *supra* note 201.

²⁰⁸ Gene K. Landy, A Comprehensive Business Guide to Software, Internet, and IP Law, Syngress Publishing Inc. (2008), at 83.

²⁰⁹ *Id.*

²¹⁰ United States Congress, Trademark Dilution Revision Act of 2006, *available at* [E:\PUBLAW\PUBL312.109 \(congress.gov\)](E:\PUBLAW\PUBL312.109 (congress.gov)). (Hereinafter referred to as TDRA) (Accessed on 23rd of October, 2021).

*(C) For the purpose dilution by garnishment, refers to “an association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”*²¹¹

Remedies in this United States Federal laws allows or plaintiffs are routinely awarded injunctions against further infringing or diluting use of the trademark 15 U.S.C & 1116(a).²¹² In trademark infringement suits, monetary relief may also be available, including: (1) defendant's profits, (2) damages sustained by the plaintiff, and (3) the costs of the action 15 U.S.C & 1117(a) damages may be trebled upon showing of bad faith.²¹³ In trademark dilution suits (TDRA), however, damages are available only if the defendant willfully traded on the plaintiff's goodwill in using the mark otherwise; plaintiffs in a dilution action are limited to injunctive relief.²¹⁴

The most important point is both a trademark infringement and a dilution claim require “use in commerce,” which is defined in the Lanham Act to mean “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”²¹⁵ A mark is deemed to be “used in commerce” in connection with goods

(1) . . . when—

(a) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(b) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United

²¹¹*Id.*

²¹² Harvard University, *supra* note 201.

²¹³*Id.*

²¹⁴*Id.*

²¹⁵ Tsai, *supra* note 23, at 361.

States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.²¹⁶

The Lanham Act goes on to define commerce to mean “all commerce which may lawfully be regulated by Congress.” Hence, the statutory construction of “use in commerce” has two layers of meaning: The first “use in commerce” is the commercial use of a mark, whether it is the use of the mark on goods or on services; and the second “use in commerce” must be a use of the mark that is within congressional regulatory powers under the Commerce Clause.²¹⁷ Because of this fact, court in United States had trouble in applying these laws to domain names and in identifying whether the use of them is a trademark infringement issue. It is by understanding that modern consumers equate domain names with the mark of business organizations that courts fitted these laws to domain name use abuse claims.²¹⁸ In doing so courts identified, that a mere registration of a trademark as a domain name does not qualify for remedies. In recognition to this trouble among other factors and as traditional federal trademark law including the Anti-Dilution Revision Act did not offer adequate redress against the actions of the typical cybersquatter. Congress on November 29, 1999 enacted "The Anti-Cybersquatting Consumer Protection Act" (ACPA). This is the third and most compressive weapon to defend your trademark. Importantly it has alleviated courts struggling to fit domain name use claims to trademark law. Although trademark infringement and dilution claims both require “use in commerce,” there is no such requirement for a cyber-piracy claim under the ACPA, both commercial and noncommercial uses may be subject to the ACPA.²¹⁹ Rather than requiring “use in commerce,” the ACPA requires a showing of “bad faith intent to profit” from a mark, which can be achieved by registering, trafficking in, or using another’s mark.²²⁰

For ACPA claim the first element needed under that act states that the defendant has a bad faith intent to profit from the mark at issue, which explains bad faith as follows:

²¹⁶*Id.* at 362.

²¹⁷*Id.*

²¹⁸ Dunn, *supra* note 6, at 21.

²¹⁹ Tsai, *supra* note 23, at 362.

²²⁰*Id.*

(i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to:

(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others

that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c).

(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.²²¹

And the second element under ACPA states there is a need that the registrant registers, traffics in or uses a domain name that is identical or confusingly similar to a protectable mark which is distinctive at the time of registration of the domain name, or identical or confusingly similar or dilutive of a famous mark at the time of registration of the domain name. Another key feature of this law is in rem civil actions against a domain name (rather than against the registrant of the domain name) are available under the law if no personal jurisdiction over the defendant exists in the United States.

The ACPA provides for an equitable remedy a court may order the forfeiture or cancellation of [a] domain name or the transfer of [a] domain name to the owner of the mark. It is also possible to elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits, an award of statutory damages in the amount of not less than \$1,000 and not more than \$100,000 per domain name, as the court considers just.

The ACPA also provides reverse domain name hijacking prevention device. Stated as:

“(iv) If a registrar, registry, or other registration authority takes an action described under clause (ii) based on a knowing and material misrepresentation by any other person that a domain name is identical to, confusingly similar to, or dilutive of a mark, the person making the knowing and material misrepresentation shall be liable for any damages,

²²¹United States Congress, Anti-Cybersequesting Consumer Protection Act (1999). Pub.L.No.106-133, §3002(a), 13 Stat.1536, 1536, 1501A-545-546, *available at* [MICROCOMP output file \(congress.gov\)](#). (Hereinafter referred to as ACPA) (Accessed on 23rd of October, 2021).

including costs and attorney’s fees, incurred by the domain name registrant as a result of such action. The court may also grant injunctive relief to the domain name registrant, including the reactivation of the domain name or the transfer of the domain name to the domain name registrant.

*“(v) A domain name registrant whose domain name has been suspended, disabled, or transferred under a policy described under clause (ii)(II) may, upon notice to the mark owner, file a civil action to establish that the registration or use of the domain name by such registrant is not unlawful under this Act. The court may grant injunctive relief to the domain name registrant, including the reactivation of the domain name or transfer of the domain name to the domain name registrant.”*²²²

Under this law to establish a right to relief against an “overreaching trademark owner” under subsection (D) (v), a plaintiff must establish:

- (1) that it is a domain name registrant;
- (2) that its domain name was suspended, disabled, or transferred under a policy implemented by a registrar as described in 15 U.S.C. § 1114(2)(D)(ii)(II);
- (3) that the owner of the mark that prompted the domain name to be suspended, disabled, or transferred has notice of the action by service of otherwise; and
- (4) that the plaintiff’s registration or use of the domain name is not unlawful under the Lanham Act, as amended.²²³

The second element above may be satisfied if the domain name registrant lost in an administrative proceeding based on the policy of the registrar, registry, or domain name authority. In addition, even if the trademark owner is a foreigner, the fourth element’s “not unlawful” requirement refers to United States law, not to the national law of the trademark owner.²²⁴ ACPA may also provide a registrant with injunctive relief against a registrar who transferred the registered domain name pursuant to its own policy as part of a foreign court

²²² United States Congress, *supra* note 221.

²²³ Tsai, *supra* note 23, at 371.

²²⁴ *Id.*

proceeding, even though the registrant's use of the domain name was not unlawful.²²⁵ However you should understand the legislative purpose of § 1114(2) (D) (v) is to protect the rights of domain name registrants against "overreaching" trademark owners, not against "foreign trademark" owners.²²⁶ To scholar's view the ACPA probably provide adequate safeguards against "reverse domain name hijacking."²²⁷ ACPA also introduced a definition for domain name and internet in the trademark law with the view to facilitate the resolution of dispute involving domain names. The Trademark Modernization Act of 2020 ("TM Act") part of series of amendments to the Lanham Act, which was signed on December 27, 2020, and go on into effect on December 27, 2021, is also another act notable for several major changes to trademark law and practice. This new act is expected to facilitate the handling of disputes by clarifying presumptions how made on injunctions. The act made the latest amendment to the Lanham Act regarding the presumption of irreparable harm when determining injunctive relief in trademark cases.²²⁸ A new addition to Section 34 of the Lanham Act (15 USC §1116(a)) requires courts to apply a rebuttable presumption of irreparable harm if the plaintiff demonstrates a likelihood of confusion.²²⁹ The act now clarifies that a nationwide uniform standard of presumption of irreparable harm should be applied in trademark cases, reducing the evidentiary burden on brand owner for obtaining injunctive relief to protect their trademark right.²³⁰ Accordingly, a brand owner who proves infringement will enjoy a legal presumption that the harm caused by continued infringement will be irreparable.²³¹ In conclusion it is important not to forget United States is the central country in the development internet as well as in the development of its administration. This makes experiences from United States critical due to broader awareness of

²²⁵ Tsai, *supra* note 23, at 371

²²⁶ Jinku Hwang, *Is the ACPA a Safe Haven for Trademark Infringers? - Rethinking the Unilateral Application of the Lanham Act*, Vol.22 (4), J. Marshall J. Computer & Info. L., p. 655-694, (2004). At.686.

²²⁷ Jason M. Osborn, *Effective and Complementary Solutions to Domain Name Disputes: Icann's Uniform Domain Name Dispute Resolution Policy and the Federal Anticybersquatting Consumer Protection Act of 1999*, Vol.(1)76 Notre Dame L. Rev.,p.210-255 (2000), at.212.

²²⁸ Bobby Ghajar and Marcus Peterson, United States: Trademark Modernization act Resolves Desperate Handling of Presumption Of Irreparable Harm in Trademark Cases, Mondaq (2021), *available at* [Trademark Modernization Act Resolves Disparate Handling Of Presumption Of Irreparable Harm In Trademark Cases - Intellectual Property - United States \(mondaq.com\)](https://www.mondaq.com/trademark-modernization-act-resolves-disparate-handling-of-presumption-of-irreparable-harm-in-trademark-cases) (Accessed on 23rd of October, 2021).

²²⁹ *Id.*

²³⁰ B.Brett Heavner, Yinfei Wu, Margaret A. Esquenet , A Practical Guide to Trademark Modernization Act 2020, Feb. 2021 ,Feengan, *available at* <https://www.finnegan.com/en/insights/blogs/incontestable/a-practical-guide-to-the-trademark-modernization-act-of-2020.htm>. (Accessed on 23rd of October, 2021).

²³¹ *Id.*

the issues involved. Even more a number of writers are recommending the inclusion of ACPA kind of articles in trademark law to a number of countries.

3.2 The Experience of Taiwan

The experience of Taiwan law is incorporated with no political motive but the writer found the experience interesting worthy of educational purpose as defacto legal system especially in light of certain similarity to Ethiopian trademark law. An amendment to Taiwanese Trademark Law passed by the Legislative Yuan (which functions as the Congress of Taiwan) promulgated by Presidential Order on June 29, 2011, and went into effect on July 1, 2012. Article 68 of the law gives the definition of trademark infringement as follows:

Any of the following act[s], in the course of trade and without consent of the proprietor of a registered trademark, constitutes infringement of the right of such trademark:

(1) using a trademark which is identical with the registered trademark in relation to goods or services which are identical with those for which it is registered;

(2) using a trademark which is identical with the registered trademark and used in relation to goods or services similar to those for which the registered one is designated, and hence there exists a likelihood of confusion on relevant consumers; or

(3) using a trademark which is similar to the registered trademark and used in relation to goods or services identical with or similar to those for which the registered one is designated, and hence there exists a likelihood of confusion on relevant consumers.²³²

Article 69 of this current Taiwan law provides remedies for infringement as damages, requests for the cessation of the infringement, and requests for an injunction where a likelihood of infringement exists and request for damage shall be presented with in two years from the time aware of the damage or within 10 years from time of infringement.²³³ In addition to actual

²³² TIPO, Trade Mark act (2016), *available at* [Taiwan Intellectual Property Office-Resources-Laws & Regulations-Trademark Act \(tipo.gov.tw\)](http://Taiwan Intellectual Property Office-Resources-Laws & Regulations-Trademark Act (tipo.gov.tw)). (Hereinafter referred to as current Taiwan law) (Accessed on 23rd of October, 2021).

²³³ *Id.*

infringement, there is also “constructive infringement” in this new law similar to the old one but the new law (the current Taiwan law) appears to modify the scope of constructive infringement, especially with respect to the pertinent portion of the domain name.²³⁴ Article 70 of the current Taiwan law uses the following conditions for constructively infringing a trademark or acts deemed infringement:

(1) knowingly using a trademark which is identical with or similar to another person’s well-known registered trademark, and hence there exists a likelihood of dilution of the distinctiveness or reputation of the said well-known trademark;

(2) knowingly using words contained in another person’s well-known registered trademark as the name of a company, business, group or domain or any other name that identifies a business entity, and hence there exists a likelihood of confusion on relevant consumers or a likelihood of dilution of the distinctiveness or reputation of the said well-known trademark; or

(3) manufacturing, possessing, displaying, selling, exporting or importing labels, tags, packaging or containers that have not been applied in relation to goods or services, or articles that have not been applied in relation to services, knowing that such articles would likely infringe trademark rights as prescribed in Article 68.²³⁵

The first main difference is that the old law which is the previous legislation requires the suspect registration to cause actual dilution of a famous, registered trademark but in the current Taiwan law, a likelihood of dilution of the registered famous trademark is sufficient for constructive infringement which alleviated the practical difficulty of proving actual dilution which is a substantial development.²³⁶ The second difference is that, under the old law, it was necessary to show that a suspect registration caused actual consumer confusion for the consumer of the goods or services, the current Taiwan law, however, removes the explicit statutory protection for the non-famous registered trademark against suspect registrations.²³⁷ This narrowed down

²³⁴ Tsai, *supra* note 23, at 381.

²³⁵ TIPO, *supra* note 232.

²³⁶ Tsai, *supra* note 23, at 381.

²³⁷ *Id.* at 382.

the protection under the trademark law to just famous trademarks. This is in fact reverse development as compared to others. Nevertheless, this law is still significant for the introduction of constructive infringement or acts deemed infringement concept to the realm of trademark law. Which eventually allowed addressing, the issue of domain name trademark law conflict. The Taiwan Intellectual Property Office (“TIPO”) published the Trademark law Connotation (“the Connotation”) for the old law in May 2005.²³⁸ Because TIPO is the government agency that drafted the trademark law and oversees its implementation, its Connotation is very important to the application and practice of trademark law. The Connotation gives the following instructions for constructive trademark infringement stipulated by article 62 in the old law: “Using the word(s) contained in the said famous trademark” means using the exact word(s) identical to the dominant part of the famous trademark, which is used to distinguish from others’ goods or service and draw the consumer’s attention.²³⁹ Therefore, it is narrower in scope than the identical or similar words concept in trademark infringement cases. This old law which the connotation refers is similar to the new law with regard to the area where the connotation is given. Arbitrators with regard to identifying infringing domain names in administrative settlements by applying UDRP also develop a similar understanding. Despite there is no anti-cybersquatting legislation in Taiwan. Taiwanese law takes advantage of constructive infringement, namely, anti-dilution, and unfair competition to address cybersquatters, even under the current Taiwan law, which is poor fit.²⁴⁰ If the cybersquatting involves neither competition nor a famous trademark, the anti-dilution and unfair competition laws may or may not apply.²⁴¹ The Taiwanese law is also criticized for lack of specific RNDH mechanism so scholars suggest different mechanisms in another civil branch of the law. What is important from the current Taiwan law is the introduction of constructive infringement or acts deemed infringement, which is another alternative solution to the problem we are looking for.

²³⁸*Id.* at 387.

²³⁹*Id.* at 386.

²⁴⁰*Id.* at 399.

²⁴¹*Id.*

3.3 The Experience of Iran

Iranian Electronic Commerce Act of 2003 in Article 66 clearly states:

“In order to protect consumers' rights and encourage legitimate competition in trough electronic transactions, use of trademarks as domain name or any online usage of trademarks which may mislead or deceive the other party in terms of the originality of goods and services is illegal and the offender will be sentenced according to this Law.”

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The purpose of this article is to protect trademarks against, inter alia, registration as domain names.²⁴³ The term “trademark” in this article includes all kinds of trademarks, including domain names registered as trademarks.²⁴⁴ The Iranian Electronic Commerce Act also prescribes criminal punishment for violation of article 66 in article 76 which is written as:

Section 3 – Violation of Trade Marks

*Article 76 – Those who violate Article 66 of this Law will be sentenced from one to three years in prison and a penalty of 20,000,000 to 100,000,000 Rls.*²⁴⁵

Furthermore, article 31 of the Iranian Act on the Registration of Inventions, Industrial Designs, and Trademarks of 2008 states: “*the exclusive right to exploit a trademark belongs to the person who has registered it in accordance with the provisions of this Act.*”²⁴⁶ Registering a trademark as a domain name is a kind of exploitation and therefore, is limited to the trademark owner and if done by anyone other than the owner, the latter may bring an infringement action against them (article 40b of the Iranian Trademark Act).²⁴⁷ Article 40 (b) of the Iranian Trademark Act states;

²⁴² WIPO, Iran Islamic Republic Electronic Commerce Act (2003), available at [WIPO Lex](#). (Hereinafter referred to as Iranian Electronic Commerce Act)(Accessed on 23rd of October, 2021).

²⁴³ Bakhairvand, *supra* note 34, at 171.

²⁴⁴ *Id.*

²⁴⁵ WIPO, *supra* note 242.

²⁴⁶ WIPO, Iran Islamic Republic Patents, Industrial Designs and Trademarks Registration Act (2008), available at [WIPO Lex](#). (Hereinafter referred to as Iranian Trademark Act) (Accessed on 23rd of October, 2021).

²⁴⁷ Bakhairvand, *supra* note 34, at 171.

*“The registered owner of a Mark shall have the right to institute court proceedings against any person who infringes the Mark by using, without his agreement, the Mark as aforesaid or who performs acts which make it likely that infringement will occur. This right shall extend to the use of a Mark similar to the registered Mark and the use thereof in relation to similar goods and services that shall cause confusion.”*²⁴⁸

As the article states, it does not have specific thing in relation to domain name use exploitation. Nevertheless, Iranian scholar Mostafa Bakhairvand reached this by reading this article in connection to article 66 of Iranian Electronic Commerce Act and practical Knowledge of Iranian law. Therefore the practice of including this kind domain name use specific articles in electronic commerce act can be taken as good practice.

3.4 The Experience of Germany

In German trademarks are governed by the Trademark Act, which implements the EU Trademark Directive 2015/2436, and international registrations that extend to Germany are governed by the Madrid Protocol, the Madrid Agreement and the Trademark Act not forgetting Names and non-registered commercial designations which are governed by the Civil Code and the Trademark Act.²⁴⁹The Germany Trademark Act was enacted 1995 and modified in 2019 in order to implement EU Directive 2015/2436 (known as Trademark Modernization Act).The amendment to the act allowed for the possibility to register trademarks such as sound marks, multimedia marks and holograms, trademarks can be filed in electronic formats; the requirement of graphic representation has been abolished among others.²⁵⁰

As an introductory note to the legal nature of domain name in Germany, the proprietor of a domain does not acquire an absolute right but rather only a right to use under the law of obligations based on a corresponding contract with the registrar or the registry and a claim against the registry granting the proprietor a right to use this domain and to exclude a third party

²⁴⁸ WIPO, *supra* note 246.

²⁴⁹ Cohausz & Florack, Germany (2021), *available at* [Germany | World Trademark Review](#).(Accessed on 23rd of October, 2021).

²⁵⁰*Id.*

from using it.²⁵¹ Nonetheless, using the domain may create a right to use a sign. This is because case law recognizes that domain names have a function of identification as well, anyone offering goods or services under a certain domain can therefore acquire a right to use a sign with a precluding effect towards third parties, especially rights to use a name or company designation or a work title.²⁵² As a result, registration and use of a domain can infringe rights to use a sign, the usual claims resulting from an infringement of a sign can be asserted.²⁵³ Thus if the domain shows a sign that is similar to a trademark and if the domain is used for goods or services that are equal to those that are protected under the trademark, claims can be asserted from Secs. 14 and 15 of Germany Trademark Act.²⁵⁴ The said articles are reproduced below for analytical purpose.

14 Exclusive right of the owner of a trade mark, injunction relief, Claim for damage

(1) The acquisition of trade mark protection in accordance with section 4 shall grant to the proprietor of the trade mark an exclusive right.

(2) A third party shall be prohibited in trade, without the consent of the proprietor of the trade mark in the course of trade in respect of goods or services:

1. use a sign which is identical to the trade mark for goods or services which are identical to those for which it enjoys protection;

2. use a sign where the sign is identical or similar to a trade mark and is used for goods or services which are identical or similar to those covered by the trade mark and where there is a risk of confusion for the public, including the risk that the sign will be mentally associated with the trade mark; or

3. to use a sign identical to the trade mark or a similar sign for goods or services where the trade mark is a trade mark with a national name and the use of the sign unfairly

²⁵¹ Bardehle Pagenberg, Domain Name Law, available at [Domain Name Law | BARDEHLE PAGENBERG](#) (Accessed on 23rd of October, 2021).

²⁵²*Id.*

²⁵³*Id.*

²⁵⁴*Id.*

exploits or impairs the distinctive character or the manner in which the trade mark is well-known without justifiable reason.

Goods and services are not considered similar simply because they appear in the same class according to the classification system laid down in the Nice Classification. Goods and services are not considered dissimilar simply because they appear in different classes of the Nice Classification.

(3) Where the conditions laid down in paragraph 2 are fulfilled, it shall in particular be prohibited to:

- 1. affix the sign to goods or their presentation or packaging*
- 2. offer, place on the market or possess goods under the sign,*
- 3. to offer or provide services under the sign;*
- 4. import or export goods under the sign;*
- 5. use the sign as a trade name or business name or as part of a trade name or trade name,*
- 6. use the sign in commercial documents or in advertising,*
- 7. the sign in comparative advertising in one of Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 on misleading and comparative advertising N 376, 27.12.2006, p.21)*

(4) Third parties shall also be prohibited from entering into commercial transactions without the consent of the proprietor of the trade mark.

1. affix a sign identical to the trade mark or a similar sign to presentations or packaging or to means of identification such as labels, pendants, patches or the or the like;

2.offer, place on the market or possess for those purposes any presentation, packaging or tracer bearing a sign identical to the trade mark or a similar sign;or

3.introduce or export any presentation, packaging or tracer bearing a sign identical to the trade mark or a similar sign;

Where there is a risk that the presentations or packaging will be used for presentation or packaging or the means of identification of goods or services in respect of which third parties would be prohibited from using the sign in accordance with paragraphs 2 and 3.

(5)Any person who uses a sign contrary to paragraphs 2 to 4 may be subject to an injunction by the proprietor of the trade mark in the event of a risk of recurrence. The claim also exists if an infringement threatens for the first time.

(6) Any person who commits the infringing act intentionally or negligently is obliged to compensate the proprietor of the trademark for the damage caused by the infringing act. When calculating damages, the profit made by the infringer through the infringement of the law may also be taken into account. The claim for damages may also be calculated on the basis of the amount that the infringer would have had to pay as reasonable remuneration if he had obtained permission to use the trade mark.

(7)If the infringing act is committed in a business establishment by an employee or agent, the claim for injunctive relief and, if the employee or agent has acted intentionally or negligently, the claim for damages may also be asserted against the owner of the business

15 Exclusive right of the owner of a business name, claim for injunctive relief, claim for damages

1. The acquisition of the protection of a trade name shall confer an exclusive right on its proprietor.

2. Third parties shall be prohibited from using the trade name or a similar sign in the course of trade without authorisation in a manner which is likely to cause confusion with the protected name.

(3) If the trade name is a commercial name known in Germany, third parties shall also be prohibited from using the trade name or a similar sign in the course of trade if there is no risk of confusion within the meaning of paragraph 2, insofar as the use of the sign unfairly exploits the distinctive character or the appreciation of the trade name without justifiable reason, or affected.

(4) Any person who uses a commercial name or a similar sign contrary to paragraph 2 or paragraph 3 may be subject to an injunction by the holder of the trade name in the event of a risk of recurrence.

(5) Anyone who commits the infringing act intentionally or negligently is obliged to compensate the owner of the business name for the resulting damage. § 14 (6) sentences 2 and 3 shall apply accordingly.

(6) § 14 (7) shall apply mutatis mutandis²⁵⁵

The registration and use of a domain name can constitute infringement under the Trademark Act if a trademark and a (distinctive) domain name are identical or similar, and the goods or services protected by the mark are identical or similar to those advertised and/or provided on the website.²⁵⁶ In order to assess, confusingly similarity between the trademark and domain name, the normal rules for a trademark infringement assessment apply. The application of section 14 and 15 arrived based on case law that domain names have a function of identification as well; it is not expressly mentioned in the law as you can refer from the reproduction. Moreover, transfer of domain name cannot be ordered as part of remedy. This is because case law also recognizes domain names can also be registered for a bona fide use that does not infringe trademark rights. The other point is German Trademark Act does not have provisions for the case of cybersquatting and is criticized by scholars for lack of specific provisions on this. However, it is possible to bring a claim under Unfair Competition Act section 4(10), which prohibits such registrations when this is a “deliberate obstruction of a competitor. The act

²⁵⁵ DPMA, Act on the Protection of Trademarks and other distinctive signs (Trademark act 1995), *available at MarkenG - Act on the Protection of Trademarks and Other Distinctive Signs (gesetze-im-internet.de)*. (Hereinafter referred to as Germany Trademark Act)(Accessed on 23rd of October, 2021).

²⁵⁶ Andreas Kabisch, Germany: Fight for (domain name) right (2017), *available at Germany: Fight for your (domain name) rights | World Trademark Review* (Accessed on 23rd of October, 2021).

defines an ‘obstruction’ in this sense as when the owner of a distinctive designation is prevented from registering the corresponding domain name due to the first come, first served principle.²⁵⁷ Whether the obstruction is also deliberate must be assessed by considering whether the domain’s registration constitutes an abuse of the law (eg, if it is obvious that the domain name’s owner has no intention of using it, but rather intends to sell it to the owner of a corresponding trademark or trade name).²⁵⁸

²⁵⁷*Id.*

²⁵⁸ Andreas reached to this conclusion based on case law review still similar to the Trademark Act the Unfair Competition Act has nothing to say about domain name. But practically “deliberate obstruction of a competitor” was interpreted to refer in to cybersquatting issues among others.

CHAPTER FOUR

The Status of Domain Name Trademark Right Dispute under Ethiopian Trademark Laws Regime

4.1 The Ethiopian Trademark Laws

This part of the work basically focuses on framing the relevant Ethiopian trademark law and practices in relation to domain name uses affecting trademark rights. This is partly because of absence of practices in this regard in Ethiopia to the writer's understanding. Trademark Registration and Protection Proclamation was promulgated in 2006 to replace the existing, non-statutory trademark system administered by the Ethiopian Intellectual Property Authority (EIPA).²⁵⁹The existing system has been developed since 1987 from a simple cautionary notice procedure, so as to comprise registration for the stated term of 6 years.²⁶⁰ Moreover, later the Council of Ministers Regulation on Trademark Registration and Protection was enacted in 2012. According to this proclamation, specifically Article 2(12) of the proclamation defines trademark as:

*any visible sign capable of distinguishing goods or services of one person from those of other persons; it includes words, designs, letters, numerals, colors, or the shape of goods or their packaging or the combination thereof.*²⁶¹

And as envisaged under Article 8(3) (b) and Art. 5(1) of the same be capable of distinguishing goods or services of one person from those of others, be used or proposed to be used in relation to goods and services.²⁶² Looking at article 2(12) of the Trademark Proclamation it seems that the proclamation rules out non-visible signs such as sound (aural) marks and smell marks (olfactory), this is implied from the use of the word “visible” in the definitional article 2(12)and

²⁵⁹ Tilahun Esmael Kassahun, *Protection of Well-Known Trademarks in Ethiopia: A Comparative Treatise under the Trademark proclamation*, 2(1) Haramaya Law Review 89, (2013), at 102.

²⁶⁰*Id.*

²⁶¹ Trademark Registration And Protection Proclamation No. 501/2006, FED. NEGARIT GAZETA, 12th Year No. 37, 2007. (Hereinafter referred to as the Trademark Proclamation)

²⁶²*Id.*

as it is made explicit in article 6(1)(b).²⁶³ Under the Trademark Proclamation and the Trademark Regulation, trademarks and their subsequent rights are conferred upon the trader upon the registration of the trademark and its certification, which is initiated when a trader approaches the office for such registration and certification.²⁶⁴ This is safe to unregistered internationally well-known marks right to oppose the registration of identical or similar marks for identical or similar goods as stated in article 7 (2) of the Trademark Proclamation provided that they are well known in Ethiopia. Until recent scholars suggested and even EIPA and courts decided such a right is not available in Ethiopia, as the country is not a signatory to any international convention and there is a need to be called well-known trademark within the meaning of that convention among others. However, the Federal Supreme Court Cassation Division gave a binding ruling to the effect that unregistered internationally well-known marks have the right to oppose the registration of identical or similar marks for identical or similar goods as stated in article 7 (2) of the Trademark Proclamation provided that they are well known in Ethiopia setting a new norm.²⁶⁵

The approval and certification of a trademark in general involves four steps: application for registration to be put in by the trader, examination of application, publication of notice of invitation for opposition, registration of trademarks, and issuance of certification, not forgetting notification of registration.²⁶⁶ The office will, upon receipt of the application examine it for form and content.²⁶⁷ If found insufficient notice will be given with sufficient time to remedy the defect. But if the defect is fundamental or if the applicant failed to correct defects in the granted time, the office will reject his application and inform the applicant the decision in writing. Where the application proves sufficient under examination, the office will publish a notice inviting opposition to registration at the cost of the applicant. If the request for the registration of a trademark is found to have fulfilled, conditions as to substance and form. And where it has not been opposed or an opposition filed has been rejected, the office will register the trademark and, upon the requisite payment, issue the applicant a certificate of registration

²⁶³ Endryas Tekalegn, *Trademark Protection in Ethiopia Vis-a-vis TRIPs: A Closer Look to the Requirements of Protection & Exclusive Rights of the Owner*, 90 *Journal of Law, Policy and Globalization*, (2019), at 3.

²⁶⁴ Kassahun, *supra* note 259, at 103.

²⁶⁵ Derihim industry Company limited Vs Ahujan Industry, Federal Supreme Court, Cassation Bench, File No. 143227 (21/09/2010 E.C) Vol. 23, at 175.

²⁶⁶ Kassahun, *supra* note 259, at 104.

²⁶⁷ *Id.*

conferring him rights over such trademark.²⁶⁸ In addition to this application for invalidation is also available in the law, which is another reason to remove a mark from registration. The grounds for invalidation as provided in the Trademark Proclamation indicate that a mark may be declared invalid on the basis that it was registered in breach of one of the absolute or relative grounds for refusal as stated in article 6 and 7. Which we are not going to look in detail, as it was not our center of focus. According to article 36 of the Trademark Proclamation, the registration of a trademark may be invalidated, by a written request of any interested person or by the office in its own motion. Decisions of EIPA in the opposition and request for invalidation are appealable to the Federal High Court.

Once effective registration is made, the trademark owner has a positive right to use or authorize any other person to use the trademark in relation to any goods or services for which it has been registered. And to prevent other people from using the trademark or sign resembling it in such a way as to be likely to mislead the public for goods and services where the trademark is registered or other goods or services in connection with which the use of the mark or sign likely mislead the public. The existence of a 'likelihood of confusion' will be presumed if the sign used is identical to the registered trademark or if the good or service is the same as the one for which the trademark is registered. These rights are generally provided under article 26 sub-article 1, and 2(a) of the Trademark Proclamation. These articles signals the importance of defining what this use or trademark use constitutes but the Trademark Proclamation failed to do so. But article 2(6) of the Trademark Regulation stated in order to constitute use of trademark there is a need to attach the trademark to the goods or packaging or labeling of the goods, display the trademark closely associated with the goods, place the trademark in advertising or promotional material for the goods or services, or in any other way establishing a relationship between the trademark and the goods or the services.²⁶⁹ Hence, use must be for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be.²⁷⁰ Art. 27(2) of the Trademark Proclamation is another issue, the article states:

²⁶⁸*Id.*

²⁶⁹ Trademark Registration and Protection Council of Ministers Regulation No. 273/2012, FED. NEGARIT GAZETA, 19th Year No. 10, 2012. (Hereinafter referred to as the Trademark Regulation)

²⁷⁰ Kassahun, *supra* note 259, at 103.

Registration of a trademark shall not confer upon its owner the right to preclude third parties from bona fide use of their names, addresses, pseudonyms, a geographical name, or exact indications concerning the kind, quality, quantity, destination, value, place of origin, time of production or supply of their goods or services, in so far as such use is confined to the purposes of mere identification or information and cannot mislead the public as to the source of the goods or services.

Definitely, this article is indicative of that the use of your own name or address can be precluded by the owner of a trademark within the meaning of article 26, if used for commercial purposes and mislead the public as to the source of the goods or service. This is a closer concept to the Taiwan concept of constructive infringement but clearly lacks the term domain name in the list. It might have explanatory value in relation to the use scope within the trademark law.

The Trademark Proclamation also provides additional rights to the trademark owner, article 26 (2) (b) and (c) and (3) grants a right to prevent any use of a trademark, or a sign resembling it, without just cause and in conditions likely to be prejudicial to his interests and other similar acts. This article is problematic some scholars suggest this article is providing dilution right similar to the United States that was provided to well-known trademarks but in a broader context as there is no such mentioning in the article to well-known marks. But recently legal writers are suggesting article 26 (2) (b) (c) of the proclamation provides an extended right than granted under the TRIPs agreement. It gives the owner the right to exclude others from using the sign (or similar signs) in any way that is “likely to be prejudicial to his interests” even if there is no likely hood of confusion.²⁷¹ And in fact, this may open a door for the owner to seek unnecessary protection without there being any confusion on the part of the mark and the product or service to which the mark is registered, that is protection on dissimilar products and there is a need to interpret it narrowly excluding such scenario.²⁷² But for now as it stands the articles mentioned have a wider scope as this point can be inferred.

The other important point is the preamble part of the Trademark Proclamation. This is because it is an important component in defining the scope of protection. The preamble states protection

²⁷¹ Tekalegn, *supra* note 263, at 7.

²⁷²*Id.*

is given with a view to have a positive impact on economic advancement especially on trade and industry, somehow indicative of concern for trademark economic values though cannot be said explicitly. The Trademark Proclamation preamble also provides that “... *trade mark ... play an important role in guiding customers` choice and protecting their interest.*” Here, the Trademark Proclamation does not explicitly mention the function of trademark registration as an incentive for the production of quality products.²⁷³ However, by emphasizing on the source-identifying role of trademark registration, it can be contended that our Trademark Proclamation as well encourages the production of quality products.²⁷⁴ The preamble further states:” *It was necessary to protect the reputation and good will of business persons engaged in manufacturing and distribution of goods as well as by rendering service ...*”. This part of the preamble shows, the law has actually the intention of including one of the modern functions of a trademark within in the scope of protection that is embodiments of the trademark proprietor’s goodwill.

The proclamation also provides remedies for trademark infringement, which can be stated as provisional measures, civil remedies, and criminal sanctions. The civil remedies include injunctive relief and an accounting for profits. Art. 40 of the Trademark Proclamation on civil remedies states:

Civil Remedies

1/ The court hearing a case of infringement of a trademark owner’s right may:

*a) pass an injunction to stop the defendant from continuing the act of infringement;
and*

b) order the defendant to compensate the damage inflicted to the claimant due to the infringement.

2/ The amount of compensation to be awarded pursuant to Sub-Article 1 (b) of this Article shall be equal to the net profit derived by the defendant from the use of the trademark or the amount of royalty the defendant could have been charged had he used the trademark

²⁷³ Kassahun, *supra* note 259, at 102.

²⁷⁴*Id.*

under the terms of a license contract, whichever is higher, plus an amount that shall cover the expenses incurred by the claimant in connection with the suit.

3/ The whole of the net profit derived from the sale of the defendant's goods or services in connection with the use of the trademark shall be attributed to the use of the trademark unless the defendant proves that part of the profit is attributive to other market factors.²⁷⁵

The Trademark Proclamation article 41 on criminal sanctions also states:

Criminal Sanction

1/ Unless heavier penalty is provided for under the Criminal Code, whoever intentionally violates a right protected under this Proclamation shall be punished with rigorous imprisonment of a term of not less than 5 years and not more than 10 years.

2/ Unless heavier penalty is provided for under the Criminal Code, who go ever by gross negligence violates a right protected under this Proclamation shall be punished with rigorous imprisonment of a term not less than 1 year and not more than 5 years.

3/ The penalty, where appropriate, shall include the seizure, forfeiture and destruction of the infringing goods and of any materials and implements used in the commission of the offense.²⁷⁶

The Customs Authority may also seize and detain goods that are subject to the alleged infringement of the applicant's right upon application by the trademark right holder, which is required to provide sufficient guaranty. In conclusion to this point, the extracts and basic assertion made in this part can constitute the basic legislative trademark provisions and cases with legal authority relevant to trademark right domain name use dispute in Ethiopia.

²⁷⁵ Trademark Proc., *supra* note 263.

²⁷⁶*Id.*

4.2 Domain Name Administration and Domain Name Use Trademark Right Disputes in Ethiopia

When we look into the brief history of the internet in Ethiopia public access links were introduced in 1990 and the Ethiopian Telecommunication Corporation (ETC) established the first internet connection in October 1996 with a T1 connection to the United States.²⁷⁷ In the early days of development specifically in and around 2000 E.C in Ethiopia, internet users were about up to 10,000, which was seen as significant. However, even though internet users were marked as below average in the African context, there has been a dramatic increase in recent times. There were 23.96 million internet users by January 2021, and the number of internet users in Ethiopia increased by 2.8 million (+13%) between 2020 and 2021; still, internet penetration was 20.6% in January 2021.²⁷⁸ Prior to the reform of the telecommunication sector in 1996, telecommunication service licenses did not exist in the telecom sector (which includes the internet service) in Ethiopia: the service was under the control of the Government, which acted as operator, regulator, and policy-maker.²⁷⁹ More recently, however, the necessity of opening the market to new investors created the need for a structured licensing system to establish conditions and requirements for the provision of telecommunication services.²⁸⁰ This implied the creation of a regulatory authority (ETA) with the power to “license and supervise operators of telecommunication services.”²⁸¹ This organization currently changed his name in to Ethiopian Communication Authority. Up to now the internet service is being provided by the Ethio telecom, the only service provider in the country. Nevertheless, the ECA has called a tender for two more telecom service providers recently. This in fact will be expected to increase access to the telecom service including internet service in general.

²⁷⁷ EITPA, Information Technology Growth in Ethiopia, *available at* [EITPA-welcome to EITPA's home page](#) (Accessed on 23rd of October, 2021).

²⁷⁸ DataReportal, Digital 2021 Global Digital Overview (2021), *available at* [Digital in Ethiopia: All the Statistics You Need in 2021 — DataReportal – Global Digital Insights](#) (Accessed on 23rd of October, 2021).

²⁷⁹ INTERNATIONAL TELECOMMUNICATION UNION, Internet from the Horn of Africa: Ethiopia Case Study (2002), *available at* https://www.itu.int/osg/spu/casestudies/ETH_CS1.pdf. (Accessed on 23rd of October, 2021).

²⁸⁰ *Id.*

²⁸¹ *Id.*

As the use of internet increases, the increased use of this communication improve the efficiency of commercial activities, enhance trade connection and allows new access opportunities for previously remote parties and markets, which play a fundamental role in promoting trade and economic development. Therefore definitely electronic transaction of goods and services what we call e-commerce will be enhanced with the enhancement of this service in general.

As noted by UNECA, the consultant to draft e-commerce (electronic transaction) law in Ethiopia, the main objective of the consultancy was to support Ethiopia's initiative to create conductive e-commerce environment with aim of:

- *Enable and facilitate the use of electronic commerce by individuals and businesses, essential for the efficiency in the international trade.*
- *Build consumer confidence and trust for the fullest economic and social benefits to flow from e-Commerce.*
- *Advance the acceptance of e-Commerce across regions and sectors in Ethiopia.*
- *Improve the e-Commerce capabilities of businesses. ...*²⁸²

These extracted points can have explanatory value in clarifying the main deriving factors necessitating the need for e-commerce law in general. In order to benefit from the fruit of e-commerce, there is a need to have well comprehended and developed body of law governing the issue. And what we call e-commerce law include domain name dispute law even though its primary focus is on enforcing the validity of electronic contract and ensuring that the parties can be held to their bargains.²⁸³ Once the contractual issues have been addressed e-commerce law analysis shifts to a series of legal issues that may govern the transaction, these include jurisdiction (which court or arbitral tribunal can adjudicate a case), consumer protection issues, taxation, privacy, the role and potential liability of intermediaries such as service providers as well as domain name dispute (intellectual property rights dispute).²⁸⁴

²⁸² The Paypers, *Ethiopian Draft E-Commerce Law*, The Paypers, 15 February 2012, available at <https://thepayers.com/ecommerce/ethiopia-drafts-e-commerce-law--746732#>.(Accessed on 23rd of October, 2021).

²⁸³ Muluneh Bayabil Dessie, *Legal Aspect of Electronic Commerce: The Case in Ethiopia*, Abyssinia Law, 24th of February 2020, available at [Legal Aspects of Electronic Commerce: The Case in Ethiopia \(abysinnialaw.com\)](https://www.abysinnialaw.com).(Accessed on 23rd of October, 2021).

²⁸⁴ *Id.*

Hence, as part of an effort to create a conducive e-commerce environment, there is a need to have adequate e-commerce law or adequate legal mechanisms to handle domain name disputes (including trademark rights disputes). Especially there is a need for having adequate legal provisions to handle trademark infringement by domain name use in cyberspace as well as adequate legal mechanisms to protect domain name holders from undue stretching of trademark rights. UNECA's remark came during the drafting of the Electronic Transaction Proclamation and was partly as well significant indicator of the situation before the proclamation.

When we came to the current status in Ethiopia. In an interview with domain registration service providers, there were nearly up to seven domain name registration service providers including Ethio telecom in Ethiopia currently.²⁸⁵ The annual domain name being registered estimated by them to be up to 4000. Trademark owners are beginning to register their trademark as a domain name for commercial purpose but the majority of them still does not have a domain name that corresponds to their trademark. However, the number of individuals or organizations trying to make online business is increasing dramatically. There are actually online sites using someone else trademark in Ethiopia though there numbers remain uninvestigated. Domain name registrants especially the private ones are doing this activity based on sub contract type of agreement they have with ICANN accredited registrants in relation to TLD. In relation to the ".et" domain name, they are administering it based on a relationship with Ethio telecom. There is no policy being implemented regarding domain name use by registrants approached by the researcher including ICANN policies. Registrants believe first come first served is the guiding principle and parties are free to register someone else trademark as a domain name. Infringement of their term of agreement might occur, if the domain name holder used the site for similar business. They are currently trying to solve the problem administratively by suspending the site if the situation is grave; though majority of the cases remain unpunished. Registrants are claiming they are doing this based on the terms of the agreement they have with the domain name holder. However usually their no specific provision as to this fact in the contract and terms of agreement they enter with the domain name holder. Most importantly, registrants do not believe Ethiopian trademark law can govern the situation. Therefore no trademark right can be required from domain name holder save to administrative remedies they are trying to provide

²⁸⁵(Telephone) Interview with Hahu Cloud personnel, Hahu Cloud, on 20th of July 2021.

on case-by-case bases. Cybersquatting is a well-established business practice in Ethiopia. There are peoples who usually register someone else trademark as a domain name in order to sell him or her to the trademark owner for profit and they are doing this as a business activity. The registrants whom the researcher approached do not believe this is illegal practice according to the Ethiopian law and their contract. A number of businesses are being affected, and parties as big as Wegagen Bank are affected by this practice.²⁸⁶ The current solution being used by this business is negotiation and adding something on their trademark to be used as domain name to open another site.

4.3 The Legal Environment in Relation to Domain Name Administration

The important document on this point is the currently enacted Electronic Transaction Proclamation. It was enacted on June 2020, quite a new law which made it difficult to observe its application. Nevertheless, with this constraint in mind still it has incorporated relevant provisions in relation to domain name governance. The first one is the preamble, which incorporated:

“WHEREAS, using electronic commerce positively affects market opportunities, thereby empowering citizens to be included in the economy, and also enable Ethiopia to be part of the digital era;...”²⁸⁷.

The objective of creation of conducive environment for electronic commerce definitely leads to the need to govern domain name dispute as stated before but this is in a border context. The proclamation also for the first time tried to define domain if not domain names and the “.et”. Not forgetting what will be the impact of this needs further assessment in light of the practice, the definitions provided under article 2(2) and (20) are extracted below for their value in the assessment.

“Domain” means the part of a network address that identifies it as belonging to a particular domain.

²⁸⁶*Id.*

²⁸⁷ Electronic Transaction Proc., *supra* note 22.

*".et domain name space" means .et Country Code Top Level Domain which is the top level of the Internet domain name system assigned according to the two-letter codes in the International Standard ISO 3166-1 to Ethiopia; ...*²⁸⁸

The Electronic Transaction Proclamation also states it will be applicable to electronic commerce, electronic government service, electronic messages, domain name administration, and related subjects. This is indicative of the fact that it was intended to make this law the prime law in domain name disputes. Ethiopian Communication Authority was given the power, as per the pertinent parts of this Proclamation, regulations thereto, and any other law, to administer and manage “.et” domain name space including acting as registrar. With regard to the management and administration of the domain space, the authority (ECA) shall establish a dispute settlement mechanism. Any still unresolved disagreement between parties shall be submitted to arbitration in accordance with the rules of arbitration of a dispute settlement mechanism established under this proclamation and the regulations and directives thereunder. Previously this job (“.et” administration) was being done by Ethio telecom as the company had monopoly of service in the area. Now the activity was handed down to the authority (ECA) and actually started to perform this job. Detail duties and responsibilities are handed over to the authority (ECA) under article 39 relevant parts are extracted for assessment value as below:

Power and Responsibilities of the Authority

1/ Without prejudice to generality of Article 38 of this proclamation, the Authority shall perform the following functions:

- a) administer and manage the .et domain name space;*
- b) issue license and regulate registries;*
- c) issue license and regulate registrars for the respective registries;*
- d) ensure compliance by users with international best practices in the administration of the “.et” domain name space;*

²⁸⁸ *Id.*

2/ Without prejudice Sub-Article (1) of this Article, the Authority shall publish directives on:

- a) the general administration and management of the “.et” domain name space;*
- b) the requirements and procedures for domain name registration; and*
- c) the maintenance of, and public access to, the registry.*

3/ The Authority shall enhance public awareness on the economic and commercial benefits of domain name registration.

4/ The Authority, in relation to domain name regulation:

- a) may conduct such investigations as it may consider necessary;*
- b) shall conduct research into and keep abreast of developments in Ethiopia and elsewhere on the domain name system;*
- c) shall continually survey and evaluate the extent to which the “.et” domain name space meets the needs of the citizens of Ethiopia; and*
- d) may issue information on the registration of domain names in Ethiopia.*

5/ The Authority shall, in relation to the “.et” domain name space existing prior to the coming into force of this Proclamation, uphold the vested rights and interests of any party involved in the management and administration of the “.et” domain name space.

6/ Those parties referred in Sub-Article (5) of this Article and have vested rights and interests in the management and administration of the “.et” domain space shall be:

- a) granted a period of six months during which they may continue to operate in respect of their existing delegated subdomains; and*

b) considered, among other persons, for appointment to the post of Registrar after the expiry of the six month period stipulated under this Sub-Article (6) paragraph (a).²⁸⁹

The authority (ECA), Council of Ministers or Minister of Innovation and Technology did not enact any regulation or directive as per the Electronic Transaction Proclamation regarding domain name dispute. The other important article is article 40 imposing criminal liability on a party using a second domain name without authority, the authority claims this article has wider implication and therefore demands assessment and is extracted below:

Administering Domain names without Authority

1/ A person who administers, manages or operates second level domain name without the Permission of the authority shall be punished with simple imprisonment not less than six months.

2/ Due to the commission of the act stated under Sub Article (1) of this Article, if the interest of third party has been affected or it has been committed with the intent to acquire undue benefit for himself/herself or third party the punishment shall be rigorous imprisonment from one year up to five years.

3/ where the acts stated under Sub Articles 1 and 2 of this Article have been committed by a legal person the punishment shall be a fine not less than one hundred thousand (100,000) Ethiopian Birr.²⁹⁰

These are the basic extracts of our laws, which are enacted regarding domain name governance so far in Ethiopia. Hence, the nature and administration of domain name disputes, and importantly the status of possible trademark right violation by domain name use should be assessed and/or established in light of these laws as well. Not forgetting the basic law to be assessed is Ethiopia trademark law wherever incorporated. The prime focus of the next part will be this issue.

²⁸⁹*Id.*

²⁹⁰*Id.*

4.4 Domain Name Trademark Right Dispute under Ethiopian Trademark Laws in Light of the Experience of United States, Taiwan, Iran and Germany Legal System

The first thing to look at is the legal status of domain name as this point might facilitate the identification of as to how domain name trademark right dispute will be resolved. This issue is unsettled everywhere in all the countries investigated. Therefore, the writer expected Ethiopian issue would not be different safe to recent scholarly suggestions on Iran and Germany stated by them as contractual rights. Nevertheless, in connection with this the new Ethiopian Electronic Transaction Proclamation defined the term domain for the first time.

Similarly, the United States ACPA defined domain name by stating:

*“The term ‘domain name’ means any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet”.*²⁹¹

The Judiciary Committee of the Senate report on the law states: *“this section creates a narrow definition of “domain name” to target the specific bad-faith conduct sought to be addressed. While excluding such things as screen names, file names, and other identifiers not assigned by a domain name registrar or registry ...”.*²⁹² Before the enactment of the Electronic Transaction Proclamation, Yilma and Abraha commented the term “domain name” in the trademark context is not mentioned in any existing or draft legislation in Ethiopian. This makes it difficult to enforce the existing laws in the area of domain names.²⁹³ The writer believes this idea is still, true especially in light of United States practices that attempted to define the term in specific

²⁹¹ United States Congress, *supra* note 221.

²⁹² United States Congress, Senate Judiciary committee report on Anticybersequatting Consumers Protection Act (1999), available at <https://www.congress.gov/congressional-report/106th-congress/senate-report/140/1?Overview> =closed. (Accessed on 23rd of October, 2021).

²⁹³ Yilma, *supra* note 5, at 165.

and narrower form in the trademark law with the view to resolve uncertainty. But still, it is good not to forget United States has the practice of regular trademark law provisions application to domain name use violation claims to the extent possible even before the definition. Similarly, the practice of German has shown the application of German trademark law arrived based on case law that domain names have a function of identification. No definition is provided for domain name under German trademark law. On interview, EIPA personnel cited the fact that domain name is unknown to our trademark law as one reason for non-application of Ethiopian trademark legislation to domain name uses violation issues.²⁹⁴ EIPA trademark section is not currently entertaining domain use violations of trademark rights issues. However, the Electronic Transaction Proclamation preamble states : “*using electronic commerce positively affects market opportunities, thereby empowering citizens to be included in the economy, and also enable Ethiopia to be part of the digital era;*”²⁹⁵ Therefore, to create an enabling environment for using electronic commerce, can be not be said outside the scope of trademark law. Hence, the definition provided by the Electronic Transaction Proclamation will be helpful on an attempt to address trademark rights violations by domain name use claims but for sure it cannot be definitive. The other problem of the definition in light of United States Senate Committee report is too broad a definition possibly creating a conducive environment for the inclusion of other identifiers, which brings confusion instead of solution. Usage of domain as a substitute of a domain name is also another problem as it contradicts international standards or common usage creating more problems. Nevertheless, the definition might also create conducive environment to treat domain names as contractual right as currently the right is being acquired through a contract similar to Germany. But this fact was not proved by court decisions or any express provisions and it might not have any negative impact on our main issue on this point, as the situation stays similar to all states investigated.

The second issue is the determination of the overall status of our law on provisions to the effect of addressing traditional trademark right violations by domain name use claims. This is because our legal system is more of rule oriented. Additionally, as the case of recent phenomena it would be crucial if there is any finding to this effect. In this regard, the Taiwan trademark law

²⁹⁴(Telephone) Interview with Trademark Section Personnel, EIPA, on 20th of July 2021.

²⁹⁵ Electronic Transaction Proc., *supra* note 22.

introduces the concept of constrictive infringement or specifically acts deemed infringement. In addition, provided the situation of domain name use which amounts to such act, even if its parts narrowed down to well-known marks contrary to development elsewhere. But still, it is a trademark law indicating expressly the need to treat domain name use trademark right violations in addition to traditional trademark violations. For comparative inference purpose, the section of Taiwan trademark law providing to this effect is reproduced as follow:“(2) *knowingly using words contained in another person’s well-known registered trademark as the name of a company, business, group or domain or any other name that identifies a business entity, and hence there exists a likelihood of confusion on relevant consumers or a likelihood of dilution of the distinctiveness or reputation of the said well-known trademark: ...*”²⁹⁶ Another development noted on the issue of express provision is the issue of Iran. This time it was Iran Electronic Commerce Act, which provides express provision. Which is according to Article 66 of Iranian Electronic Commerce Act: – *In order to protect consumers' rights and encourage legitimate competition in trough electronic transactions, use of trademarks as domain name or any online usage of trademarks which may mislead or deceive the other party in terms of the originality of goods and services is illegal and the offender will be sentenced according to this Law.*²⁹⁷ The presence of this article on the electronic commerce law has given Iran the necessary legal weapon to govern domain name use violations of trademark rights in the situation provided. Not only this, it has also facilitated the application of the Iranian Act on the Registration of Inventions, Industrial Designs and Trademarks specifically trademark infringement provisions to assimilated domain use situations. In light of this our Trademark Proclamation, Regulation, or the current Electronic Transaction Proclamation does not have similar kinds of provisions. And this can be taken as a major constrain.

The third issue is which is more specific issue of the second issue is to possible applicability of our current trademark law to trademark right violation by domain name use scenarios. In this point, it is good to remember growing approach to trademark law centered on the function actually served by a trademark while defining, determining, and/or designing trademark law scope of protection. As the practice shows this fact in the legal systems investigated manifested

²⁹⁶ TIPO, *supra* note 232.

²⁹⁷ WIPO, *supra* note 242.

in one or other way. This approach essentially centered on economic benefit again highly dependent on the protection afforded to trademark holder from free riding of competitors and other profit seekers aiming to dilute, infringe, or otherwise benefits from another trademark.²⁹⁸ Broader trademark law protection centered on the modern function of trademarks can be inferred in all countries investigated. But specifically in Germany registration and use of a domain name can constitute infringement under the Trademark Act, if a trademark and a (distinctive) domain name are identical or similar, and the goods or services protected by the mark are identical or similar to those advertised and/or provided by the website.²⁹⁹ In order to assess the confusingly similarity between the trademark and domain name, the normal rules for a trademark infringement assessment apply. This is based on case law, which established using the domain may create a right to use a sign based on the essential recognition of additional identification purpose of domain name.

Additionally, United States used a combination of method. Parties specifically a trademark owner might use to fight a domain name registrant remedies under the Lanham Act or injunctive relief under the Federal Trademark Dilution Revision Act (“TDRA”). If the domain name uses qualify “use in commerce” expressed in the law, specific use, and conditionality in the mentioned articles. This is in the of absence express provision to this effect not forgetting ACPA which introduced later the definition of domain name in trademark law. Which also provided compressive articles to govern cybersquatting and assimilated scenarios. Including a provision stating, “*a court may order the forfeiture or cancellation of [a] domain name or the transfer of [a] domain name to the owner of the mark.*”³⁰⁰ This is partly may be due to the historical view of United States trademark law as one of the main developed legal systems in the area has shown as a trademark function expands from designators of origin, guarantors of the quality of the trade marketed goods, embodiments of the trademark proprietor’s goodwill, up to advertising medium and these change in commercial significant of trademarks have influenced views of courts, legislators and legal scholars and the same was expected to happen on this point.³⁰¹

²⁹⁸ Zhanna, *supra* note 83, at 62.

²⁹⁹ Kabisch, *supra* note 256.

³⁰⁰ United States Congress, *supra* note 221.

³⁰¹ *Id.*, at 5.

In Ethiopian context whether the contextual assimilation approach of Germany and United States is possible or not issue is quite problematic. EIPA trademark section responded trademark serve identification purpose as envisaged in article 2(12) of the Trademark Proclamation. It must identify the goods or services there should be an attachment to the goods and services or at least an advertisement kind of use for any trademark right violation claim to exist.³⁰²EIPA personnel's state domain name is outside the scope of the trademark law as there is no mentioning to this effect and this understanding affected court case traffic to the writer believe (there is no court case to the writer's investigation). On the other side ECA, stated article 40 of the Electronic Transaction Proclamation which is reproduced in this material could provide criminal solution to trademark right holder. As the mentioned article uses a second domain name instead of a domain name, the article was intended to protect right holders.³⁰³ However, ECA admits currently nothing is being done in the area, and there is a need to have more elaborated rules to appropriately address the matter.³⁰⁴They are aware of the previous administrator Ethio telecom and other domain name registrants provide the remedy of pending the domain name. If they fill trademark rights would be affected. Domain name registrant claim their contract empower them to do so but nothing specific to this effect can be spotted on their contract which does not incorporate ICANN policies. EIPA practice was taken because as it is the organ providing administrative solutions to invalidation and opposition claims in trademarks. And it will play a significant role in shaping the policy in the area. ECA is also an important actor in charge of administrating ".et," the most related organ to the administration of domain name. Moreover, currently given the authority to provide rules for handling domain name disputes. On this point, for sure the definition provided for domain in the Electronic Transaction Proclamation could have some help for reasons stated as economic purpose of the proclamation. Not forgetting, the gaps in the definition given relating to the scope of the definition making him not properly identify domain name including the exclusion of name from the definition. The preambles wordings of the Trademark Proclamation indicative of the law have actually intention of including one of the modern functions of trademark within in the scope of protection, that is embodiments of the trademark proprietor's goodwill though it cannot

³⁰² EIPA, *supra* note 294.

³⁰³ (Telephone) Interview with ECA Associate Director, ECA, on 20th of July 2021

³⁰⁴*Id.*

be said sufficient. Importantly the Trademark Regulation article 2(6) defined trademark use as:” *...or in any other way establishing a relationship between the trademark and the goods or the services; ...*” among others, these could have opened a door to the assimilation of domain name use violation to appropriate articles in light of the practice of Germany and United States. Still in defaults article 26 (2) (b) and (c) of the Trademark Proclamation grants a right to prevent any use of a trademark, or a sign resembling it, without just cause and in conditions likely to be prejudicial to his interests and other similar acts . Even though it is being claimed as dilution article, with all its problems could have been of some help especially together with 27(2) of the same proclamation, which is indicative of use of your own name or address can be precluded by the owner of trademark within the meaning of article 26. If used for commercial purpose and mislead the public as to the source of the goods or services. However, this case needs to develop through scholarly writing, court decisions, and EIPA connotations, which are not available to the writer search. The claim on the Electronic Transaction Proclamation article 40 is quite problematic, as it talks only authority to use a second domain name not a right on the name used as a second domain name. If there is an in intention to this effect, there is a need for reformulation even in that scenario whether trademark owner can preclude all use is another issue since this is not the case under trademark law. Even more, criminal solution is not the only solution under trademark law the issue of redress will be left unanswered. Therefore, overall our trademark law cannot be said sufficient, developing on rule oriented nature of our legal system and in the absence of court settled cases on the issue, in light of the practice of the investigated legal system.

The fourth issue is the issue of cybersquatting. The best practice in this regard is the practice of United States, which is a more comprehensive amendment law to trademark law (ACPA). In United States, ACPA prohibits or takes action against a registrant having a bad faith intent to profit from the mark at issue, the registrant registers, traffics in or uses a domain name that is identical or confusingly similar to a protectable mark in addition alternatively dilutive for famous mark, the domain name must be identical or confusingly similar to the mark at issue, which must be distinctive at the time of registration of the domain name. ACPA rule was said to address the issue of cybersquatting (as the list of what amount to bad faith include cybersquatting scenario effectively) and much of trademark infringement issues. Importantly it

has alleviated courts struggling to fit domain name use cases to trademark law. In the Ethiopian context, EIPA currently is not considering such issues as a trademark law issue stating domain name is unknown to Ethiopian trademark law, as there is no mentioning of it. Additionally, the Electronic Transaction Proclamation does not have any specific provision on this regard. ECA again states; “*Article 40 of the Ethiopian Electronic Transaction Proclamation which is reproduced on this material could provide criminal solution to Trademark right holder against cybersquattor as the article uses second domain name instead of domain name, the article was intended to protect right holders.*”³⁰⁵ Nevertheless, admitted there is a need for more elaborated rules in this regard. Registrants do not believe this is a crime or violation as there is no specific provisions to this effect. Even though, companies are being affected by the problem of cybersquatting in the country. As to the applicability of article 40 of Ethiopian Electronic Transaction Proclamation to the matter, the article clearly talks about permission from the authority (ECA) to use a second domain name not authority or permission to use the trademark. However, the fact that the article punishes use with intent to profit or to get undue benefit might give him the power to issue administrative directives (absent) together with the Ministry of Innovation and Technology to handle cybersquatting. In light of, the preamble vision of the proclamation to create conducive environment for electronic commerce. The power given to ECA to issue directives in matters arising in Electronic Transaction Proclamation with consultation to Ministry of Innovation and Technology might substantiate this assertion.³⁰⁶ However, whether this directive governs “.et” or all domain names is also unsettled as the law stands. Since ECA is given express power in relation to “.et” while article 40 of the mentioned proclamation talk about all second domain name. The administrative remedies are totally out of the scope of this study but as trademark law remedies are concerned, Ethiopia does not have express and compressive rules in light of the practice of United States to govern cybersquatting issues. Together with this, the ECA is given the power to establish dispute settlement mechanisms in relation to the administration and management of domain names. Still unsettled issues are to be referred to dispute settlement mechanisms to be established by the Electronic Transaction Proclamation, Regulations, and directives there under. As it was said earlier, ECA has currently established nothing in this regard. Hence does those rules include domain name

³⁰⁵ ECA, *supra* note 303.

³⁰⁶ Electronic Transaction Proc., *supra* note 22.

use violation of trademark right issue is wait and see issue. But the writer believe they should do so and should remain administrative remedy not affecting parties write to court based possible trademark law remedies as stated above. Definitely, whatever happens they are not going to have a negative impact, as they are administrative by nature. This point can be substantiated more by the practice of ICANN.

The fifth issue is the issue of reverse domain name hijacking. As scholars suggest there should be parity between the rights of trademark owners and domain name holders. Definitely in line with this, there is a need for adequate RNDH provisions with in trademark law. United States ACPA provided a right to relief against an “overreaching trademark owner” under subsection (D) (v), when a plaintiff prove:

- (1) that it is a domain name registrant;
- (2) that its domain name was suspended, disabled, or transferred under a policy implemented by a registrar as described in 15 U.S.C. § 1114(2)(D)(ii)(II);
- (3) that the owner of the mark that prompted the domain name to be suspended, disabled, or transferred has notice of the action by service of otherwise; and
- (4) that the plaintiff’s registration or use of the domain name is not unlawful under the Lanham Act, as amended³⁰⁷

United States RNDH mechanisms can be said innovative and being recommended by scholars for Taiwan, Iran, and Germany to provide a similar kind of mechanisms. When it comes to Ethiopia, Ethiopian trademark law regime does not provide similar type of mechanism or totally there is no such idea in Ethiopian trademark law as the writer unable to identify compatible provisions in Ethiopian trademark law including the Electronic Transaction Proclamation. Moreover, the concept can be said, not given significant position by domain name registrants, EIPA and ECA as there is no means developed by these organs to handle such issues currently.

³⁰⁷Tsai, *supra* note 23, at 371.

CHAPTER FIVE

Conclusions and Recommendations

5.1 Conclusions

Ethiopian Trademark Proclamation, Regulation, or the current Electronic Transaction Proclamation does not have express or well-equipped provisions to handle typical trademark right violations by domain name use issues. This is coupled with EIPA practice of treating domain name issues outside the scope of trademark law. The Electronic Transactions Proclamation defined the term domain instead of domain name in boarder sense, to broad definition possibly creating a conducive environment for the inclusion of other identifiers, which brings confusion instead of solution. The concept of domain name use is new and not effectively recognized by trademark administrators.

In Ethiopia, the contextual assimilation approach of Germany and United States is not a practice being implemented. However, the possibility is open as there is practice elsewhere in well-developed legal systems. But there is a need for policy based reshaping of understanding in EIPA and concrete court decisions to this effect, which are currently lacking. Still in default a joint reading of Ethiopian Trademark Regulation article 2(6), Ethiopian Trademark Proclamation article 26 (b) (c) and 27(2) might have some help but there is a need to develop this through scholars analysis made to develop the idea (this point is also important for direct application issues). Court decisions especially to this effect are also important and are currently lacking. The Ethiopian Electronic Transaction Proclamation also failed to substantiate the Trademark Proclamation on this point. Hence the current regulation of domain name use affecting trademark rights in Ethiopian trademark law cannot be said sufficient if not absent.

Ethiopia does not have adequate rules in the Trademark law including the Electronic Transaction Proclamation to address the issue of cybersquatting. The concept remains totally new to our trademark administration. While the problem is apparent in Ethiopia, domain name registrants treat the problem as normal business practice. Elsewhere the United States Congress

stated the problem as “*The practice of cybersquatting harms consumers, and the goodwill equity of valuable brand names, upon which consumers increasingly rely to locate the true source genuine goods and services on the internet.*”³⁰⁸ The same is true for our E-commerce ambitions.

Ethiopia does not have adequate rules to address reverse domain name hijacking issues. Similarly, the concept remains unfamiliar to our trademark law in general and to both administrators of trademark and domain names. This is while there exists the practice of pending domain names by domain name registrants. Whenever they believe, trademark rights might be affected by the domain name use. Additionally, if adequate protection mechanisms are provided to protect trademark rights in domain name space, parity or justice demands the provision of an adequate protection shield for the domain name holders from undue stretching of trademark rights through abusive administrative remedies or manipulations. Which are not available in Ethiopian trademark law including the Electronic Transaction Proclamation. .

5.2 Recommendations

In order to address the problem of trademark right violation by domain name use in typical infringement cases, there is a need to have or insert Taiwan kind of provisions within the Trademark Proclamation. However, it should not be specific to well-known trademarks (but not including dilution for others), in order to appropriately address the modern function of trademark. Alternatively, Iranian kind of provision in the Electronic Transaction Proclamation with enabling power on the application of ordinary trademark rights in the domain name space can be used. This is because clear law will have a major advantage over any other means as the issue involves a new sphere of action. Guidance by the law will provide a concrete and coherent solution to the problem at hand than any other means. If we have to choose between the two modes recommended, the writer recommends the Taiwan mode but not restricted to well-known trademarks for the purpose of clarity and comprehension. This is because the practice in all the three remaining countries does not show this fact, practices of restricted protection only to well-known trademarks leaving ordinary trademark rights issue. Broader protection will enable adequate and effective enjoyment of trademarks as well as effective security for consumers.

³⁰⁸ United States Congress, *supra* note 283.

Nevertheless, this does not mean there is a need to provide dilution protection for all trademarks as this is not happening anywhere. The Iranian option can be used as an alternative in the event the first option becomes not economical as an alternative to amending the Trademark Proclamation.

In default EIPA, ECA, and the legal society should work in a direction enabling the application of the current trademark law in the domain name space in light of the Ethiopian trademark law objective, and in recognition of the economic function served by the trademark. The practice included in this document especially the practices of United States and Germany shows this point is not unachievable. Nevertheless, there is a need for the institutions mentioned above together with courts work in that direction. In order to appropriately address the issue of cybersquatting and reverse domain name hijacking there is a need to have ACPA like provisions in Ethiopia trademark law, it may be in the Trademark Proclamation or Electronic Transaction Proclamation. These issues are not distance ideas currently apparent in the domain name use in Ethiopia as illustrated in this document. The nature of the problem makes ACPA like provisions critical. There is a need to provide them in the Ethiopia trademark law regime.

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APPENDIXE ONE

Interview Questions Interview protocols prepared for EIPA on the research title:” The Regulation of Domain Name under Ethiopian Trademark Law: Emerging Legal Issues!”

- 1) What is the legal base for the IP tribunal in the Office?(starting from proclamation to directive)
- 2) What kind of trademark issues are being entertained by the tribunal?
- 3) What are the remedies available?
- 4) Can domain name (internet address) be registered as trademark in Ethiopia? Why or why not
- 5) Can using trademark of someone as a domain name be considered trademark infringement especially in light of article 26 (2) b and C and article 27(2) of the proclamation? Why or why not
- 6) Is there a trademark owner who applied for trademark infringement by domain name use?
- 7) Is EIPO aware of trademark right infringement by domain name use concept? If so what remedies are being provided or designed to be used?
- 8) ICANN the international organ for domain name administration is providing administrative remedies and directing court based solution for aggrieved party in trademark infringing domain name cases do you think our recent trademark law including the e commerce law capable of handling it
- 9) What if domain name holder lose its domain name inappropriately under such administrative process can our trade mark law including the e commerce law helpful to regain their domain name by way of proofing they are not infringing trademark right?
- 10) What do you suggest to be done for domain name alleged to infringe trademark? Do you think providing a solution to it will help e-commerce?

APPENDIXE TWO

Interview Questions Interview protocols prepared for Domain Name registrant on the research title:” The Regulation of Domain Name under Ethiopian Trademark Law: Emerging Legal Issues!”

- 1) For how long you provided this service?
- 2) Did you give registration of Top level Domain Name (.com and other administered by ICANN) service? Are you giving .et domain registration to
- 3) How many domain name registrant exist in Ethiopia?(you can make estimations)
- 4) How many domain name are being registered by you annually? Can you estimate the total amount of domain names being registered annually in Ethiopia?
- 5) Did business companies register their trademark as domain name? Are they doing it actively in Ethiopia?
- 6) Did business companies do business by using domain name they register actively in Ethiopia? explain
- 7) Can using trademark of someone as a domain name be considered trademark infringement according to your agreement? Why or why not
- 8) Did you have relationship with ICANN as part deriving authority and using ICANN policy such as UDRP?
- 9) Is there a trademark owner who applied for trademark infringement by domain name use?
- 10) ICANN the international organ for domain name administration is providing administrative remedies and directing (if not indicating possibility) court based solution for aggrieved party in trademark infringing domain name cases, do you think our recent trademark law including the e- commerce law capable of handling it?

- 11) Did Ethiopia have similar system for et domain name?
- 12) What if domain name holder lose its domain name inappropriately under such administrative process can our trademark law including the e-commerce law helpful to regain their domain name by way of proving they are not infringing trademark right?
- 13) What do you suggest to be done for domain name alleged to infringe trademark? Do you think providing a solution to it will help e-commerce?
- 14) cybersquatting (the practice of registering names, especially well-known company or brand names, as internet domains, in the hope of reselling them at a profit) in Ethiopia , Please provide information about the current situation in Ethiopia.
- 15) Do you believe Ethiopian law including administrative one capable of handling cybersquatting?

APPENDIXE THREE

Interview Questions Interview protocols prepared for ECA on the research title:” The Regulation of Domain Name under Ethiopian Trademark Law: Emerging Legal Issues!”

- 1) Do the organization have any legal rules to handle cybersquatting problem?
- 2) What kind of trademark infringement are being entertained by your organization as per the ecommerce law?
- 3) Did your organization have any rule to handle trademark infringement by domain name use (using someone trade mark as a domain name) especially for et?
- 4) Do you think such issues (question 3) are appropriately addressed by the current Ethiopian e-commerce law? If so explain
- 5) Do you think the current Ethiopian trademark law capable of handling such problems (question 3)?if so explain
- 6) Can domain name (internet address) be registered as trademark in Ethiopia? Why or why not
- 7) Can using trade mark of someone as a domain name be considered trademark infringement especially in light of article 26 (2) b and C and article 27(2) of the Ethiopian trademark proclamation? Why or why not
- 8) Is there a trademark owner who applied for trademark infringement by domain name use?
- 9) Is ECA aware of trademark right infringement by domain name use concept? If so what remedies are being provided or designed to be used?
- 10) ICANN the international organ for domain name administration is providing administrative remedies and directing (clarifies possibility)court based solution for aggrieved party in trademark infringing domain name cases do you think our recent trademark law including the e commerce law capable of handling it?
- 11) What if domain name holder lose its domain name inappropriately under such administrative process can our trade mark law including the e commerce law helpful to regain their domain name by way of proofing they are not infringing trademark right?
- 12) What do you suggest to be done for Doman name alleged to infringe trademark? Do you think providing a solution to it will help e-commerce in general?