



The recent exponential growth in the number of registered domain names poses problems for trademark owners worldwide, says Alessandra Ferreri.

Since the mid-1990s, we have witnessed an exponential growth in the registration of domain names coinciding with distinguishing signs (sign boards, corporate names, trademarks, trade names) owned by market operators. We can safely say that there is currently no shop, firm or business entrepreneur that has not registered the domain name corresponding to its own most celebrated trademarks or the name of its products or its own business name, or even the generic name of the product being offered on the market.

It is sufficient to remember that, each month, for the .com suffix alone, an average of 668,000 domain names are registered; in 25 years, a full 78 million .com addresses have been registered.

The increase in registrations has naturally led to an increase in the number of disputes over domain names and, in particular, in the conflicts that arise between domain names and other distinguishing signs. The increase in these disputes is caused by two different phenomena.

On the one hand, there is the now notorious practice of domain-grabbing: an increasing number of people are 'blanket registering' domain names coinciding with the most famous trademarks belonging to others, with the clear purpose of reselling the domain name at an extremely high price to the legitimate owner of the homonymous rights.

Over the years, domain-grabbers or cybersquatters have developed and demonstrated increasing imagination in their methods of grabbing domain names corresponding to the distinguishing signs

of others: from domain names coinciding precisely with the rights of others, there are now domain names containing variants of the homonymous distinguishing signs, consisting of added hyphens and interjection signs, or spelling or so-called typing errors (typosquatting). In addition to the traditional extensions such as .com, .net, .biz and .info (gTLDs), registrations have been made with all possible suffixes, as they have been gradually approved and introduced onto the Internet (such as .mobi, .cat, .aero, .biz and .travel).

Domain-grabbing is currently concentrated, for example, on domain names that have the extensions of new countries in the emerging economies (China and India): there are therefore numerous domain names coinciding with the trademarks of others with the suffixes .co.in, .in, .cn, .com.cn, .net.cn and .org.cn, as well as 34 sub-suffixes corresponding to each of the Chinese provinces.

However, there is another reason determining the increase in conflict between the owners of domain names and between the domain names and distinguishing signs of another competitor. It is clear that, with the registration of a domain name corresponding to one of its own rights, even the smallest entrepreneur can obtain an international showcase, since all domain names, with any extension, are visible throughout the world. The greater the visibility acquired, the higher the risk that conflict will arise between those competitors that have similar distinguishing signs (such as two entrepreneurs that have a highly similar company name) or that market the same products, but

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whose coexistence was possible before because it was limited in territorial terms and related to different geographical zones.

In the case of conflicts relating to domain names, the most widely adopted remedy continues to be offered by Alternative Dispute Resolution (ADR)—alternative procedures for bringing action before the ordinary courts. ADR is based on the simultaneous existence of prerequisites simpler than the principles that govern the rules on distinguishing signs.

The oldest, most widely used and reliable of the various ADR procedures is the one used by the World Intellectual Property Organization (WIPO) and, in particular, its Arbitration and Mediation Center. Initially, this procedure could only be used for domain names registered with generic extensions (gTLDs), such as .org, .net and .com. Nowadays, it is usable not only for those generic extensions introduced over the years, such as .biz, .info, .aero, .asia, .cat, .coop and .jobs, but also for many domain names registered on international circuits (ccTLDs). The table below shows domain names with ccTLDs for which it is possible to contact WIPO and request the relevant procedure.

List of ccTLDs	
A	B
.AC (Ascension Island)	.BM (Bermuda)
.AE (United Arab Emirates)	.BO (Bolivia (Plurinational State of))
.AG (Antigua and Barbuda)	.BS (Bahamas)
.AM (Armenia)	.BZ (Belize)
.AO (Angola)	
.AS (American Samoa)	
.AU (Australia)	
C	D
.CC (Cocos Islands)	.DJ (Djibouti)
.CD (Democratic Republic of the Congo)	.DO (Dominican Republic)
.CH (Switzerland)	
.CO (Colombia)	
.CR (Costa Rica)	
.CY (Cyprus)	
E	F
.EC (Ecuador)	.FJ (Fiji)
.ES (Spain)	.FR (France)
G	H
.GT (Guatemala)	.HN (Honduras)
I	K
.IE (Ireland)	.KI (Kiribati)
.IO (British Indian Ocean Territory)	.KY (Cayman Islands)
.IR (Islamic Republic of Iran)	

On the basis of the WIPO model and for those 'national' domain names not included in the list, and for which it is therefore not possible to contact the Arbitration and Mediation Center directly, numerous national registration authorities, including the Italian authority, have adopted similar procedures that offer the advantage of rapidity, simplicity and limited costs.

It is important to note that the only possible subject of all these alternative procedures is a request by the applicant for transfer to it of the disputed domain name or, alternatively, a request for cancellation: the possibility of requesting any other provision or measure (such as a request to prohibit use or a check on aspects of illegality in the contents of the site linked to the disputed domain name) is excluded, including damages claims.

In 2009, 2,107 procedures were brought before WIPO; since 1999 (the year when the ADR was introduced), decisions have been reached in more than 17,000 cases.

By way of conclusion, it is worth looking briefly at what could be defined as a 'preventative policy' adopted by certain companies to identify the registration

of domain names by unauthorised third parties: registrations that constitute rights infringements.

This policy is carried out by activating a surveillance service on domain names registered at supra-national and national level. This control is normally performed on a quarterly basis among domain names that are identical or similar to the trademark on which the inquiry is being conducted. This gives an outline of new registrations of domain names that could possibly interfere with the company's own trademark or other distinguishing signs, such as trade names, common law trademarks, company names and other domain names.

Once the illegal registration is identified, before starting any judicial proceedings or arbitration, it is advisable to contact the possessor of the disputed domain name, in order to check whether there is the possibility of making an amicable transfer to the owner of the homonymous rights.

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Alessandra Ferreri, attorney at law and Supreme Court lawyer, has been with Rapisardi IP since 2000. Specialised in domain name issues and in the protection of IP on the Internet; she has dealt with several cases of cybersquatting and has assisted clients in litigation and arbitration in Italy and abroad for Internet-related matters. As a panelist for the WIPO Arbitration and Mediation Center and for the Arbitrator's Chamber of Milan, she has written several decisions according to the Uniform Dispute Resolution Policy and other arbitration procedures. She has extensive experience in IP law, particularly in court litigation and extra-judicial procedures for patents, designs and trademarks.