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# What is a domain name?

A domain name is an internet identification label or address consisting of a string of characters separated by full stops. The most familiar domain names are website (eg. [www.mcintoship.com.au](http://www.mcintoship.com.au)) or email addresses ([daniel@mcintoship.com.au](mailto:daniel@mcintoship.com.au)).



## Do I have trademark rights in my domain name?

Similar to a business name, a domain name does not, of itself, provide any proprietary rights and its function is an identifier rather than as a provider of a monopoly. Furthermore, similarly to business names, domain names are generally allocated on a first-come, first-served basis with all that is required is to satisfy eligibility criteria.

## How to I protect my domain name from cybersquatters?

The best method to do this is through actively using your domain name. However, if it is registered by a cybersquatter, your best rights will be in a registered trademark. The registered trademark does not need to contain the “www” or “.com” elements, but the main feature. For example, the trademark NIKE can be used to stop cybersquatting on a domain name called [www.bestnike.com](http://www.bestnike.com).

## Do I need to trademark my domain name?

As can be surmised from the above, it is strongly advisable to trademark your domain name.

## Is my domain name copyright or a trademark of another party?

Domain names are generally not the subject of copyright (which is more appropriate for longer ‘works’ such as novels or songs), but can certainly be trademarks. For example, the domain name [www.nike123melbourne.com](http://www.nike123melbourne.com) would very likely be considered trademark use of “NIKE”. The best way to determine if your domain name is protected by a trademark of another party is to do a trademark search.

## Who administers domain names?

Top level domains such as .com are administered by WIPO, while Australian

website domains, such as .com.au and .net.au are administered by the government body the Australian Domain Name Administrator (auDA)). United States websites are generally administered by ICANN.

The eligibility requirements depend on the jurisdiction, but are generally minimal. In Australia, for example, for a com.au domain names the Registrant must be either a) a Registered Australian Commercial Entity (eg company, business name) or (b) the owner of registered Australian trademark/application (including non-Australian entities) AND the domain name must be either a) an exact match, acronym or abbreviation of the registrant's registered name/trademark or b) otherwise closely and substantially connected to the registrant.

## Domain name disputes

If there is a dispute regarding a domain name, an aggrieved party may seek to resolve the issue at proceedings at the relevant body that administers the domain name in question, such as WIPO, auDA or ICANN. Domain name disputes at WIPO, auDA and ICANN provide a very informal and efficient method for resolving disputes, particularly in comparison to court proceedings.

## Domain name dispute resolution policies

The bodies that administer domain names have formalised dispute resolution policies (DRP) that allow a party to challenge the basis of the registrant's non-compliance with policy. The purpose of these policies is to provide a cheaper and speedier alternative to litigation for the resolution of disputes between the registrant of a domain name and a party with competing rights in the domain name.

Each body has its particular DRP, but they share similar features. The most important of these is the WIPO Uniform Domain name Resolution Policy (UDRP). The Australian auDA equivalent is called auDA's dispute resolution policy is call auDRP.

## Domain Name Disputes at WIPO

For WIPO proceedings, generally it is a single Panel member who will read the submissions and then issue his or her decision. Disputes are resolved according to the Uniform Domain name Resolution Policy (UDRP), which gives effect to the Rules for Uniform Domain Name Resolution Policy (UDRP Rules). See below for further specifics.

In terms of timing, once the case receives a commencement date it will usually be resolved within two months of that date, involving one round of limited "pleadings" (submissions, basically) and using mostly online procedures. The only power of the tribunal is to transfer the domain name to another party – it cannot order damages or costs.

## Guide to the UDRP in a domain name proceeding

The below advice provides you with an overview of the UDRP. As stated, cases are decided according to the UDRP Rules. The UDRP procedure is designed for domain name disputes that meet the following criteria (UDRP, paragraph 4(a)):

- I. the domain name registered by the domain name registrant is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- II. the domain name registrant has no rights or legitimate interests in respect of the domain name in question; and
- III. the domain name has been registered and is being used in bad faith.

The following circumstances will be evidence of registration or use of the domain name in bad faith:

- the domain name has been registered or acquired primarily for the purpose of selling, licensing or transferring it to another party for a fee exceeding the out-of-pocket expenses directly related to the domain name;

- the domain name has been registered to prevent the owner of a trademark (or name in the case of the auDRP) from registering that mark or name as a domain name;
- the domain name has been registered primarily to disrupt the business or activities of another party; OR
- the domain name has been used intentionally to attract, for commercial gain, internet users to a website by causing confusion as to the complainant's name or mark being the source of or in some way affiliated with the website, or products or services offered via the website.

### **What are the remedies or damages for a WIPO domain name dispute?**

As discussed, the only possible consequence directly from the WIPO, auDA or ICANN hearing is that the domain be transferred to another party or cancelled. Damages or costs cannot be awarded.

However, damages or compensation for costs can be sought separately through the relevant jurisdiction's court system (though it should

be noted that given the relative low WIPO fees any compensation would be quite limited).

### **Remedies**

Remedies available to a successful complainant under each policy are limited to cancellation of the domain name or transfer of the domain name to the complainant. Damages are not available as a remedy.

#### **The take points are:**

- Domain name disputes are informal, quick and relatively inexpensive when compared to normal court proceedings.
- It is fairly simple for a complainant to lodge a claim against a domain name.
- A party must act quickly to defend a claim against their domain name.
- WIPO (or ICANN or auDA) only has the power to order the transfer or cancellation of the disputed domain.