



Joint UNESCO and ITU  
Global Symposium on Promoting the Multilingual Internet



# Multilingualism and IPR Issues

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# Overview



- o Multilingual/Internationalized Domain Names - Intellectual Property Issues
- o The Uniform Domain Name Dispute Resolution Policy (UDRP)
  - Performance and Challenges
- o Additional Mechanisms?
  1. Introductory IP Protection Mechanisms?
  2. Country code Top Level Domains (ccTLDs)?



# Trademarks (TMs)



- Identify
  - the goods/services of one business entity and distinguish them from those of others
  - “Name” of a product
- Crystallize goodwill
  - resulting from investment in advertisement, marketing, quality
- Protection
  - against consumer confusion and
  - “free riding”



# TMs in a Multilingual Context



- Trademarks must be read, pronounced and understood by consumers
  - Global mark?
  - Adaptation
    - Aspirin - Aspirine, Chokito - Ciocito
  - Translation (meaning)
    - PURE LIFE - PURA VITA (Latin American market)
  - Transliteration (Pronunciation)
    - Coke - コーク
    - Triumph - トリンプ (“Torinpu”)
    - livedoor ライブドア (“Raibudoa”)



# Conflict TMs - Domain Names



- Consumers expect trademarks to be present on the Internet ([www.TRADEMARK.com](http://www.TRADEMARK.com))
- Domain name can exist only once per gTLD and is attributed on a “first-come first-served” basis
- Trademarks are an easy target for “cybersquatters”
  - Register trademarks as domain names in order to profit financially on the expense of the trademark owner



# Conflict: Hypothetical



- o <yvessaintlaurent.com>
- o Web Site: “under construction”
- o WHOIS:
  - Domain Name registered with US Registrar
  - In December 2001
  - Domain registrant in Korea
- o Offer for sale: USD 10,000



# Solution?



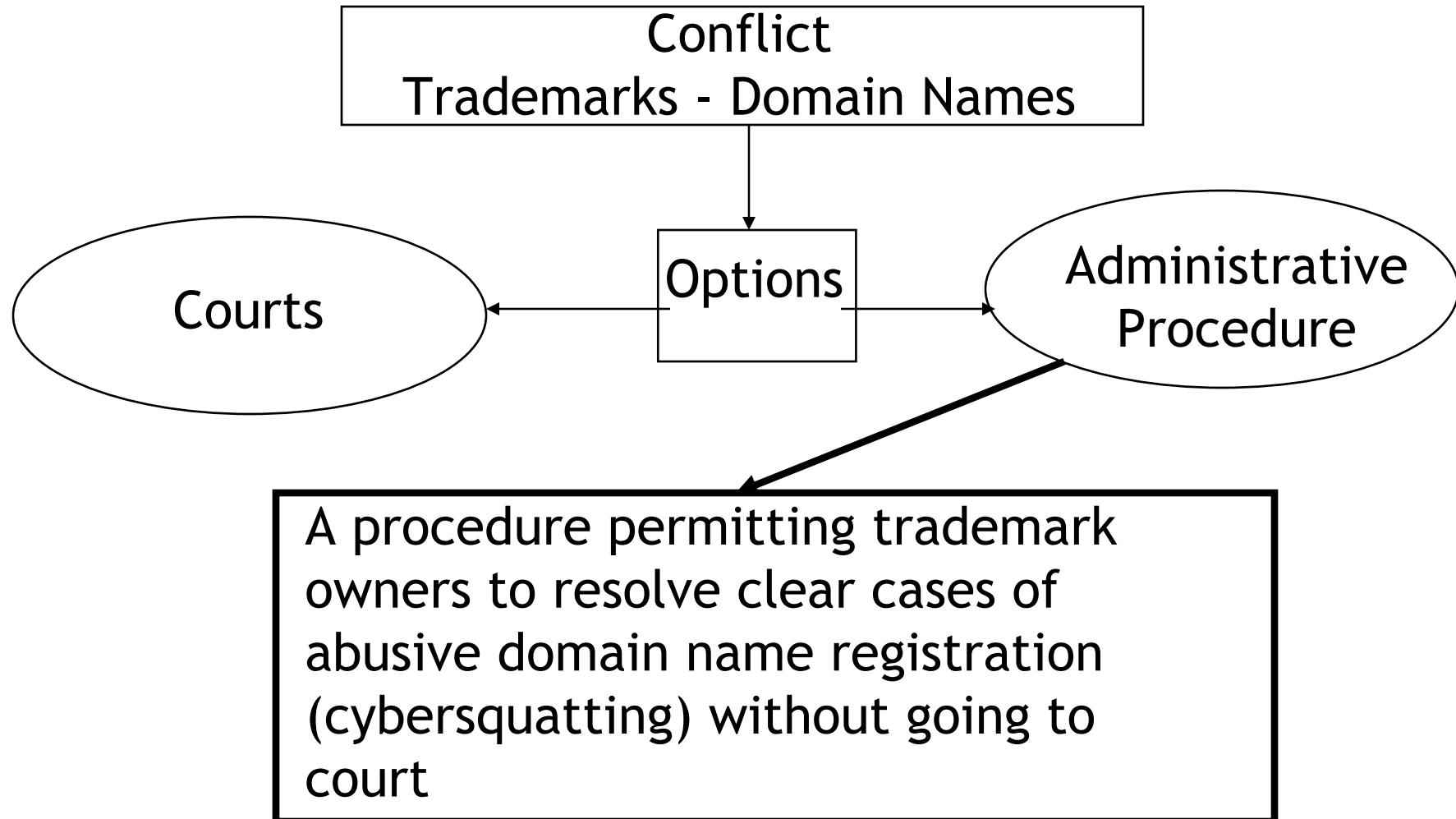
- o File a lawsuit in court

But

- o Against whom? (incorrect whois information)
- o Where? (international jurisdiction)
- o Under what law?
- o How to enforce the judgment?
- o Time and Money!



# WIPO Domain Name Process







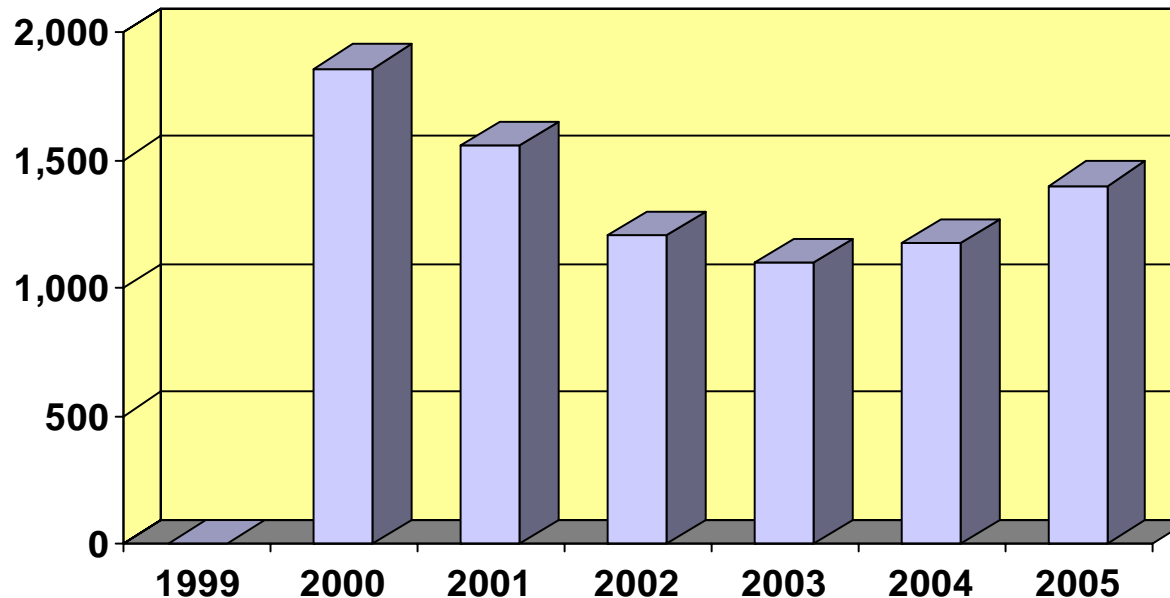
# UDRP



- Developed on the basis of WIPO Recommendations
- Adopted by ICANN
- In force since December 1999
- Applicable to all gTLDs
  - Irrespective of script!
- Can be adopted by ccTLDs
  - But no requirement



# WIPO UDRP Cases



- Total (March 2006): 8,794 cases, 16,597 DN's
- Parties from 131 countries
- 12 languages, 55 IDNs
- Fee: US\$ 1,500 (1-5 DN's, sole panelist)
- Average duration: 2 months



# UDRP Decision Criteria



- TM identical/confusingly similar to DN
- No right/legitimate interest in DN
  - *bona fide* offering of goods/services
  - Registrant commonly known
  - Legitimate non-commercial or fair use
- DN registered and used in bad faith
  - Selling/renting (etc) DN for gain
  - Preventing trademark owner from using DN + pattern of conduct
  - Disrupting business of a competitor
  - Diverting Internet traffic by creating confusion



# UDRP and IDNs



- UDRP applicable to all domain names registered in gTLDs, irrespective of script
- With IDNs, the number of confusingly similar variations of a TM increases exponentially
  - Translation or transliteration of existing trademarks
  - Mixing scripts (“TOYS Я US”)
- UDRP challenge:
  - Determining confusing similarity between domain name and trademark
  - Dealing with increased numbers



# IDNs - WIPO Examples



三共.com  
貿發網.com  
貿發靈.com  
香港貿易發展局.com  
ペンタックス.com  
トリンプ.com  
毎日新聞.com  
schöps.com  
丸三証券.com  
産経新聞.com  
恒生指数.com  
fortunéo.com

kværner.net  
ライブドア.com  
香港上海滙豐銀行.com  
太古.com  
資生堂.net  
홍콩은행.com  
홍콩상하이은행.com  
欧米茄.com  
chériefm.com  
rémycointreau.com  
rémy-cointreau.com  
西铁城.com



# Identical/confusingly similar?



## Domain Name

asahi.com,

アサヒ.com

risingsun.com

三共.com

恒生指数.com

産経新聞.com

貿發網.com

トリンプ.com

ライブドア.com

fortunéo.com

dongzhi.com

## Trademark

ASAHI

三共

恒生指數

産経新聞

貿發網; tdctrade.com

トリンプ (“Torinpu”); Triumph

ライブドア (“Raibudoa”); livedoor

FORTUNEO

TOSHIBA

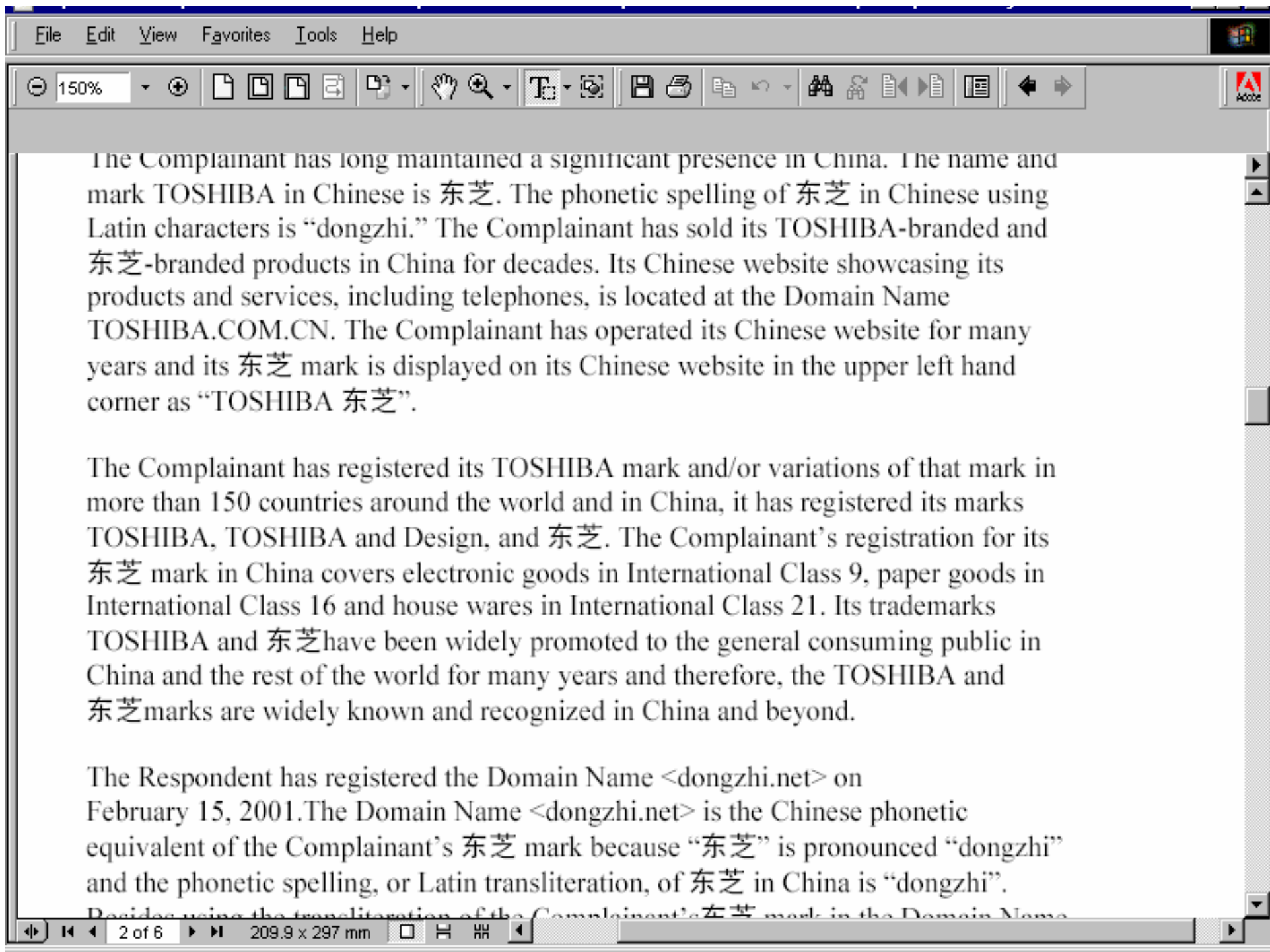


# Languages of Proceeding



三共.com - English  
貿發網.com - English  
貿發靈.com - English  
香港貿易發展局.com - English  
ペンタックス.com - English  
トリンプ. Com - Japanese  
毎日新聞.com - English  
schöps.com - English  
丸三証券.com - Japanese  
産経新聞.com - English  
恒生指数.com - English  
fortunéo.com - English

kværner.net - English  
ライブドア.com - English  
香港上海匯豐銀行.com - English  
太古.com - Chinese  
資生堂.net - Japanese  
홍콩은행.com - English  
홍콩상하이은행.com - Korean  
欧米茄.com - Chinese  
chériefm.com - English  
rémycointreau.com - English  
rémy-cointreau.com - English  
西铁城.com - English



The Complainant has long maintained a significant presence in China. The name and mark TOSHIBA in Chinese is 东芝. The phonetic spelling of 东芝 in Chinese using Latin characters is “dongzhi.” The Complainant has sold its TOSHIBA-branded and 东芝-branded products in China for decades. Its Chinese website showcasing its products and services, including telephones, is located at the Domain Name TOSHIBA.COM.CN. The Complainant has operated its Chinese website for many years and its 东芝 mark is displayed on its Chinese website in the upper left hand corner as “TOSHIBA 东芝”.

The Complainant has registered its TOSHIBA mark and/or variations of that mark in more than 150 countries around the world and in China, it has registered its marks TOSHIBA, TOSHIBA and Design, and 东芝. The Complainant’s registration for its 东芝 mark in China covers electronic goods in International Class 9, paper goods in International Class 16 and house wares in International Class 21. Its trademarks TOSHIBA and 东芝 have been widely promoted to the general consuming public in China and the rest of the world for many years and therefore, the TOSHIBA and 东芝 marks are widely known and recognized in China and beyond.

The Respondent has registered the Domain Name <dongzhi.net> on February 15, 2001. The Domain Name <dongzhi.net> is the Chinese phonetic equivalent of the Complainant’s 东芝 mark because “东芝” is pronounced “dongzhi” and the phonetic spelling, or Latin transliteration, of 东芝 in China is “dongzhi”.  
Decides using the transliteration of the Complainant’s 东芝 mark in the Domain Name





WIPO Arbitration and Mediation Center - Domain Name Disputes - Microsoft Internet Explorer provided by WIPO

Address: http://arbitr.wipo.int/cgi-bin/domains/search/legalindex?lang=eng&cmd=search&media=15310.15410

<a href="#">Mediation</a> <a href="#">Recommended Clauses</a> <a href="#">Domain Names</a> <a href="#">gTLDs</a> <a href="#">ccTLDs</a> <a href="#">Cases</a> <a href="#">Decisions</a> <a href="#">Resources</a> <a href="#">Filing</a> <a href="#">Panelists</a> <a href="#">Search</a> <a href="#">Neutrals</a> <a href="#">Meetings and Workshops</a> <a href="#">Publications</a> <a href="#">What's New</a>	<b>V.A. Chinese</b>	<a href="#">D2001-0098</a>	寶發網.com	<a href="#">Transfer</a>	
		<a href="#">D2001-0100</a>	香港貿易發展局.com	<a href="#">Transfer</a>	
		<a href="#">D2001-0750</a>	恒生指數.com	<a href="#">Transfer</a>	
		<a href="#">D2001-0915</a>	香港上海匯豐銀行.com	<a href="#">Transfer</a>	
		<a href="#">D2001-1025</a>	太古.com	<a href="#">Complaint denied</a>	
		<a href="#">D2001-1204</a>	歐米茄.com	<a href="#">Transfer</a>	
		<a href="#">D2001-1305</a>	西鉄城.com	<a href="#">Transfer</a>	
		<a href="#">D2003-0460</a>	hkdongzhi.com	<a href="#">Transfer</a>	
		<a href="#">D2003-0756</a>	嘉禾.com	<a href="#">Transfer</a>	
		<a href="#">D2005-0528</a>	日立.com	<a href="#">Transfer</a>	
		<b>V.B. Danish</b>	<a href="#">D2002-0337</a>	flügger.com	<a href="#">Transfer</a>
		<b>V.C. French</b>	<a href="#">D2001-0781</a>	fortunéo.com	<a href="#">Transfer</a>
			<a href="#">D2001-1263</a>	rémy-cointreau.com	<a href="#">Transfer</a>
		<b>V.D. German</b>	<a href="#">D2001-0347</a>	schöps.com	<a href="#">Transfer</a>
			<a href="#">D2004-0405</a>	aüw.com	<a href="#">Complaint denied</a>
			<a href="#">D2005-0034</a>	jägermeister.net	<a href="#">Transfer</a>
			<a href="#">D2005-0942</a>	wüstenrot.com	<a href="#">Transfer</a>
			<a href="#">DCH2004-0012</a>	rhäzünser.ch	<a href="#">Transfer</a>
			<a href="#">DCH2004-0017</a>	feldschlössli.ch	<a href="#">Transfer</a>
		<b>V.E. Japanese</b>	<a href="#">D2000-1791</a>	三共.com	<a href="#">Transfer</a>
			<a href="#">D2001-0203</a>	トリンブ.com	<a href="#">Transfer</a>
			<a href="#">D2001-0307</a>	毎日新聞.com	<a href="#">Transfer</a>
			<a href="#">D2001-0532</a>	丸三証券.com	<a href="#">Transfer</a>
			<a href="#">D2001-0620</a>	産経新聞.com	<a href="#">Transfer</a>
		<a href="#">D2001-0817</a>	ライブドア.com	<a href="#">Transfer</a>	
		<a href="#">D2001-1113</a>	資生堂.net	<a href="#">Transfer</a>	
		<a href="#">D2002-0357</a>	いわさきホテルズ.com いわさきホテルズ.net	<a href="#">Transfer</a>	



# UDRP Sufficient?



- **Complication:**
  - Determining confusing similarity
  - Dealing with increased case filings
- **Important:**
  - Multilingual case administration
  - Multilingual decision making
- **WIPO Center**
  - 389 Panelists from 54 countries
  - 22 staff members from 18 countries



# Additional Protection?



- UDRP = effective remedy
  - But: limited preventive effect
  - Cybersquatting continues
- Broad introduction of IDNs
  - New “empty” domain space
  - -> Increased risk of abuse
- Preventive mechanisms?
  - E.g. priority registration period for trademark owners (Sunrise)?



# Sunrise Issues



- Large number of potentially confusing variations
- Pre-registration of identical marks only?
  - Mark must be registered in relevant script
  - How to deal with transliterations?
- How/When to determine identity?
  - Pre-registration checks?
    - Administration, delay
  - Check only upon challenge?
    - Risk of abuse
  - Linguistic competence?



## ccTLDs?



- Not required to apply UDRP
  - Reliance on national courts
  - Application of UDRP
  - Application of own DRP
    - Often UDRP-based
- Introduction of IDNs
  - Scale?
  - How to deal with increased risk of abuse?
  - Sunrise?