

The Recognition of Rights and the Use of Names in
the Internet Domain Name System

ANNEX XV

WIPO Questionnaire on Trade Names and Summary of Responses

In the course of the Second WIPO Process, a questionnaire was conducted of WIPO's Member States, designed to gather information on the treatment in national laws of trade names, pursuant to the Paris Convention for the Protection of Industrial Property. Responses were received from 71 countries. The questions posed and a summary of the responses received are set out below:

- (1) *How (i.e., under which law(s) or pursuant to which legal principle(s)) are trade names protected in your country? If trade names are protected by legislation, please include details of the legislation and, if possible, attach a copy of the law(s) or relevant sections of the law(s).*

The summaries of the 71 countries' laws and legal principles applied to protection of trade names are set out below, with respect to each of the responses received. The responses indicate overall that there is considerable variety in the means by which protection is granted for trade names in each jurisdiction.

- (2) *Are trade names required to be registered? If so, please specify;*
(i) the circumstances, if any, in which registration is required; and
(ii) the conditions that a name must satisfy to qualify for registration.

A significant majority of countries required some form of registration of trade names of local and foreign trading entities (whether as trade names or as company names) if and when such entities register a locally operating business. The following countries required trade names to be registered in some form, although not always as a precondition to protection: Armenia (foreign names only), Australia (business and company names), Bahrain (as trade names and service marks), Botswana, Bulgaria, Burkina Faso, Canada, Cyprus, Denmark (public and private limited companies only), Eritrea, Estonia, Ethiopia, Finland, Georgia, Honduras, Hungary, Ireland, Japan (incorporated companies only), Kyrgyzstan, Lithuania (but not in the Civil Code that will apply from 2002), Monaco, Mongolia, Morocco, Norway (company registration), Republic of Moldova, Romania, Russian Federation, Saudi Arabia, Singapore, Slovenia, Spain, Sweden (company registration), Switzerland, Tajikistan, The Former Yugoslav Republic of Macedonia, Turkey, Ukraine (company registration), United Kingdom (limited company names only), Uzbekistan and Viet Nam.

The following countries provided for optional registration of trade names: Andorra, Austria, Barbados, Brunei Darussalam, Colombia, Côte d'Ivoire, Germany, Niger, Portugal, San Marino and Venezuela.

Legal systems vary widely in the manner in which trade names are protected, through statute or common law, or a combination of both (e.g., Australia, Barbados, Canada,

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 2

Mauritius, United Kingdom, United States of America). Some countries provide that trade names may enjoy protection through use alone (e.g., Colombia, Norway, Denmark, Latvia, Netherlands, Peru, Russian Federation, United States of America).

Most countries expressly impose restrictions on the names that are permitted to be registered as trade names. The following restrictions or prohibitions on trade names were commonly indicated:

- A majority of countries expressly prohibit use or registration of trade names that are the same or confusingly similar to local or foreign trade names or trademarks, whether registered or unregistered (e.g., Armenia, Austria, Belarus, Botswana, Brunei Darussalam, Bulgaria, Canada, Cyprus, Eritrea, Estonia, Ethiopia, Finland, Germany, Honduras, Hungary, Moldova, Mongolia, Morocco, Netherlands, Norway, Romania, Singapore, Spain, Sweden, Uzbekistan, Viet Nam).
- Many countries, particularly those of common law jurisdictions, prohibit trade names that are misleading or likely to cause consumer or public confusion (e.g., Andorra, Australia, Austria, Barbados, Botswana, Colombia, Costa Rica, Cyprus, Finland, France, Georgia, Honduras, Hungary, Lithuania, Netherlands, Peru, Philippines, Portugal, Russian Federation, Slovenia, Sweden, The Former Yugoslav Republic of Macedonia, United Kingdom, United States of America).
- A minority of countries expressly prohibit names that infringe copyright (e.g., Finland, Lithuania).
- Some countries limit the enquiry as to identical or confusingly similar names to enterprises in the same field of trade or amongst competitors (e.g., Denmark, Hungary, Netherlands, Peru, Spain, United Kingdom), within the national territory or locality (e.g., France, Denmark, Estonia, Japan, Republic of Korea, Russian Federation), whereas others apply the restriction as against all enterprises, internationally (e.g., Bahrain, Cyprus, Eritrea, Lithuania).
- Numerous countries do not grant protection to trade names that are based on generic words (e.g., Brunei Darussalam, Cyprus, Lithuania,) or are otherwise not distinctive (e.g., Denmark, Georgia, Norway, Russian Federation), although some specify that distinctiveness can be acquired through use (e.g., Denmark).
- Many countries prohibit trade names that are offensive or contrary to public policy or morality (e.g., Andorra, Armenia, Australia, Benin, Brunei Darussalam, Canada, Costa Rica, Côte d'Ivoire, Cyprus, Eritrea, Estonia, Ethiopia, Honduras, Lithuania, Netherlands, Peru, Philippines, Slovenia, Sweden, Viet Nam).

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 3

- Numerous countries prohibit trade names that include geographic terms or indications (e.g., Estonia, Russian Federation, The Former Yugoslav Republic of Macedonia), place names, including foreign countries' names (e.g., Botswana, Slovenia), famous persons (e.g., Eritrea, Finland, Hungary, Slovenia), personal names (e.g., Finland, Norway), historical names of persons or places (e.g., Cyprus, The Former Yugoslav Republic of Macedonia), connotations of government connections (e.g., Botswana, Canada, Mauritius, Russian Federation), names of international organizations (e.g., Lithuania, Slovenia) or official signs (e.g., Mongolia).
- Some countries prevent trade names from being registered in foreign languages or scripts, or the registration of trade names expressed in numbers (e.g., Bulgaria, Estonia, Hungary, Mongolia, Saudi Arabia, Viet Nam).
- Some countries require trade names to comprise the names of the owner, founder or partner of the enterprise (e.g., Bahrain, Georgia, Japan, Republic of Korea), plus some indication of the form or type of the enterprise, such as 'Pty Ltd.'
- Many countries impose different restrictions or regulations depending upon the type of commercial name, whether a trade name, company name, limited partnership, foreign company, etc. (e.g., Australia, Canada, Slovenia, Switzerland).
- In countries with federal government systems, trade names may be protected at a national level, and separately and to a different extent at the state or province level (e.g., Australia, Canada, United States of America).

(3) *Is there a publicly available database of trade names in your country? If so, is it available and searchable on the Internet? If applicable, please specify the URL (web site address).*

The majority of countries that do require registration of trade names, also maintain a database of such names or company names, as follows: Andorra, Armenia, Australia, Austria, Bahrain, Barbados, Bulgaria, Canada (national fee based search system, plus free regional databases), Colombia, Cyprus, Denmark (limited companies register), Estonia, Ethiopia, Finland, Georgia, Germany (companies register), Hungary, Japan, Kyrgyzstan, Lithuania, Moldova, Monaco, Morocco, Romania, Russian Federation, Saudi Arabia, Singapore, Slovenia, Spain, Sweden, Switzerland, Tajikistan, The Former Yugoslav Republic of Macedonia, Turkey, Ukraine (companies register), United Kingdom (limited companies register). In nearly all countries, this database was publicly accessible (except in Belarus, Eritrea, Mongolia, Niger, Republic of Korea, Uzbekistan or Viet Nam), sometimes upon payment of a fee (e.g., Austria, Saudi Arabia, Spain, Sweden).

A minority of countries maintain a database of trade names that is currently available online, as follows: Australia, Canada (fee-based access), Colombia, Estonia, France, Hungary (fee-based access), Ireland, Japan, Mexico, Peru, Romania (restricted access), Singapore, Switzerland (partial database) and the United Kingdom (limited companies register), although several countries indicate future plans to make their databases available online (e.g., Finland from June 2001).

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 4

(4) *Does the national country-code top level domain (ccTLD) administrator impose any restrictions on domain name registration based on trade names?*

A minority of ccTLD administrators impose restrictions on applications for domain names based on trade names, as follows: Andorra, Armenia, Australia (certain second level domains), Austria, Barbados, Colombia, Cyprus, Estonia, Finland, France, Ireland (certain second level domains), Latvia, Netherlands, Norway, San Marino, Saudi Arabia, Slovenia, Spain, Sweden, Switzerland, Thailand, Turkey (certain second level domains), United Kingdom (certain second-level domains) and Viet Nam.

The majority of ccTLD administrators place no substantial restrictions on applications for domain names based on trade names, although applicants are usually required to warrant that their domain name registration does not infringe third party rights, and are required to indemnify the registrar in case of infringement, as follows: Argentina (warranty, and limited verification), Bahrain, Belarus, Belgium (warranty), Bulgaria, Burkina Faso, Cambodia (warranty), Canada (presence in country required), Costa Rica (limited verification), Denmark (can appeal to overturn name based on trade name), Ecuador (warranty), Ethiopia, Georgia, Germany (warranty), Guatemala, Honduras, Hungary (warranty, and refers applicants to trademark and trade name register), Kyrgyzstan, Lithuania (warranty), Mauritius, Mexico (warranty), Mongolia, Morocco, Philippines (warranty), Portugal, Republic of Korea, Republic of Moldova (restricted to applicants from the medical industry), Romania (warranty), Russian Federation, Singapore (warranty), The Former Yugoslav Republic of Macedonia, Ukraine, United States of America (limited verification), Uruguay, Uzbekistan and Venezuela.

The domain name registration policies of the following ccTLD administrators could not be located online: Benin, Botswana, Brunei, Côte d'Ivoire, Brunei Darussalam, Eritrea, Niger and Tajikistan.

Survey of national approaches to protection of trade names

The following paragraphs summarize each of the 71 countries' responses to the WIPO trade names questionnaire, illustrating the diversity of approaches to protection of trade names worldwide.

1. In **Andorra**, trade names are protected by the Law of Commercial Names, Social Denominations and Signs (June 20, 1996). Although trade names are protected without registration, trade names are required to be registered for any commercial activity based in Andorra, although this requirement is not derived from any industrial property legislation. Trade names that contravene public morality or create a risk of public confusion are prohibited. There is a database of trade names, although it is not yet available online. The ccTLD administrator for .AD requires applicants for a domain name intended for commercial use to prove that they have legitimate rights in a trade name registered in Andorra. (Domain names are only available to Andorran citizens or

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 5

persons resident for over 20 years, and domain names are limited to three per applicant and are non-transferable.)

2. In **Argentina**, trade names are protected under the Law 22.362 (Chapter II), and protection is limited to the field of activity of the business enterprise. Trade names are not required to be registered in order to enjoy protection. There is no database of trade names that is publicly available. The ccTLD administrator for .AR does not impose any restrictions on domain name registration based on trade names. However, the ccTLD administrator does endeavor to check requests for registration of obviously well-known trade names, and will request from such registrants the relevant authorization for use of the trade name.

3. In **Armenia**, trade names are protected by the Law on Trade Names, and all enterprises active in the country are required to register in a State Register. Trade names of foreign legal enterprises are protected without registration, pursuant to the Paris Convention. Trade names cannot be similar or confusingly similar to local or foreign trade names or marks, or appellations of origin, cannot be contrary to public policy, nor resemble names of foreign States or international organizations. The database of trade names is publicly available, although it is not online. The ccTLD administrator for .AM specifies that applicants whose domain name contains or resembles a well-known trademark, service mark, or company name, may need to provide a letter of authorization and/or other documents, so that only the owner of the trade name may register it as a domain name. Applicants must warrant that their domain name does not infringe any trade name rights of third parties.

4. In **Australia**, trade names are taken to include business names, protected registered company names and trading designations. ‘Business names’ are registered on a state by state basis under state law, ‘company names’ are recognized Australia-wide and are registered and protected by the Federal Corporations Law, under a cooperative arrangement with the Australian states. ‘Trade names’ and ‘trade designations’ are protected by common law. Company names must be registered under the national Corporations Law and, if a company wishes to trade using a name other than its registered company name, the trading name must be registered as a business name. A business name is a name under which a business operates, and must be registered in each state in which business will be conducted. Fair trading and consumer protection legislation, particular to each state, may be used to indirectly protect trade and business names. In addition, the Trade Practices Act 1974 (Cth) restricts practices by corporations that may affect consumer or trading interests, including unfair conduct (Part V) that is likely to mislead or deceive, and thereby may constrain the misleading or deceptive use of trade or business names. Trade names are required to be registered where a person is trading under a name other than their personal name. Company names and corporate names must be registered. However, there is no requirement to register a trading designation that consists of the owner’s name. Business names must be registered in the state(s) in which they operate if it differs from the owner’s name (first name and surname

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 6

or initials and surname). Generally, a business name cannot be registered if it is likely to cause confusion with a registered business name, is misleading, offensive or includes certain words (e.g., implying a connection with government, or suggestive of illegal activity). Company names must be registered by the Australian Securities & Investments Commission, which allocates each company an Australian Company Number. Company names cannot be identical to an existing company name, and certain restricted words and phrases are excluded. The databases of registered business, corporate and company names (not including all trade names) are publicly available, and the Australian Business Register and National Names Index of Australian Corporate and registered business names are both available online. The ccTLD registration authority for .AU imposes certain restrictions on the registration of domain names based on trade names. The 'com.au' sub-directory is designed to enable eligible commercial entities in Australia to have a domain name that is closely aligned to their commercial name. Only commercial entities registered and trading in Australia are eligible to register a domain name, and applicants are required to prove that they have the rights to the commercial name, or that the commercial entity is registered with a recognized Government or industry authority. Registrants must fall into one of the following categories: trading names and legal names, companies including foreign companies registered to trade in Australia, registered business names, incorporated associations, commercial statutory bodies, financial institutions or registered superannuation funds.

5. In **Austria**, trade names are protected under the Austrian Trade Mark Protection Law (Articles 12, 32 and 60(2)) (amended 1999) and the Law Against Unfair Competition (Article 9), which protect trade name owners against unauthorized use, or registration as a trademark, of their trade name or a misleadingly similar version of it. Registration is not a prerequisite for protection. There is a database of registered company names that is publicly available for a fee. The ccTLD administrator for .AT requires applicants to declare that their domain name does not infringe third party rights, especially rights based on names or other distinguishing marks or signs, and may refuse an application for evident infringement or abuse.

6. In **Azerbaijan**, trade names are protected pursuant to the Paris Convention. Trade names are not required to be registered and there is no publicly available database of names. The ccTLD administrator for .AZ is not listed online.

7. In **Bahrain**, trade names are required to be registered in the Commercial Register under the name in which the business is being conducted, in accordance with Decree #1 (Finance) 1961 and Amendments, and Section 2, Article 50 et seq of the law of Commerce Decree #7 of 1987. Trade names may also be registered as 'service marks' under the Trade Mark Law Decree #10 of 1991. Trade names must be the name under which business is being conducted, and may consist of the trader's name and surname, or any innovative name, must be indicative of its object, followed by letters depicting the legal type, and must not be similar to an existing name or famous name (whether nationally or internationally registered). There is a publicly available database of trade

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 7

names, that will be available online in future. The ccTLD administrator for .BH does not impose any restriction on domain name registration based on trade names, although there is currently discussion on this issue.

8. In **Barbados**, trade names are protected pursuant to the Trade Marks Act (Cap. 319) and by the common law principle of passing off. Trade names are not required to be registered and, although there exists a publicly available database of trade names, it is not yet available online. The ccTLD administrator for .BB prohibits the registration of well-known marks, and of previously registered trade names, and will withdraw names that subsequently become the subject of dispute.

9. In **Belarus**, trade names are protected under the Civil Code (July 1, 1999) (para. 1 'Trade Names', Articles 1013-1016, of Section 67 'Modes of Individualization of Participants in the Civil Cycle of Operations, Goods, Jobs or Services'). Trade names are registered as designations identifying legal entities, recorded in the Unified State Register of Legal Entities. Trade names must not be confusingly similar to previously registered names. The database of trade names compiled in the State Register is not publicly available. The ccTLD administrator for .BY does not impose any restriction upon domain name registration based on trade names, but recommends that applicants use the name of their organization as their domain name.

10. In **Belgium**, trade names are protected under the Law of Methods of Commerce and Information and Consumer Protection (July 14, 1991). Trade names are not required to be registered and there is no publicly available database of names. The ccTLD administrator for .BE requires applicants to warrant that their domain name does not infringe the rights of any third party.

11. In **Benin**, trade names are protected under the Bangui Agreement of March 2, 1977, Annex V (Trade names and protection against misuse). Pursuant to Article 2, a trade name must not contravene public morality or create a risk of public confusion regarding the nature of the designated commercial establishment. Trade names are not required to be registered. The legitimate trade name owner is considered to be the person or entity who first used or registered the name. There is no database of trade names that is publicly available. The ccTLD administrator for .BJ is not available online.

12. In **Botswana**, trade names are protected under the Business Names Act, Cap.42:05. Trade names are required to be registered for the purpose of reserving that particular name for use by any person or body corporate for trading purposes. There is no publicly available database of trade names. The ccTLD administrator for .BW is not available online.

13. In **Brunei Darussalam**, trade names are protected under the Emergency (Trade Marks) Order, 1999 and the Trade Marks Rules, 2000. Trade names are defined under the Order (section 4) as "any visually perceptible sign capable of distinguishing goods or

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 8

services of one undertaking from those of other undertakings.” Trade names are not required to be registered, and are precluded from registration if they do not meet the definition of a trademark, if the name is not distinctive or consists of generic words or words indicating the type or source of goods or services, if the name is contrary to law or public policy or is deceptive, or conflicts with an earlier trade name. There is no publicly available database of trade names. The ccTLD administrator for .BN is not available online.

14. In **Bulgaria**, trade names are protected under the Commercial Law (Chapter III, Articles 7-11). Trade names are required to be registered and may be registered provided that the name is not identical to a name registered in the territory of the respective District Court where registration is requested, is not deceptive or contrary to public policy, is in Bulgarian, and indicates the type or form of the company. The database of trade names is publicly searchable, although it is not yet available online. The ccTLD administrator for .BG does not impose any restrictions on domain name registration based on trade names.

15. In **Burkina Faso**, trade names are protected under the Bangui Agreement of March 2, 1977, Annex V (Trade names and protection against misuse). Trade names are required to be registered on the Register of Commerce, although there are no conditions required to register. There is no database of trade names that is publicly accessible. The ccTLD administrators’ terms and conditions for registration in .BF are not available online.

16. In **Canada**, trade names are protected at common law under the law relating to passing off (the selling of merchandise or the carrying on of a business under such a name, mark, get-up or otherwise in such a manner as to mislead the public into believing that the merchandise or the business is that of another person). Common law rights are essentially based on use. In Quebec, the Quebec Civil Code provides protection similar to that under the common law. There are also Criminal Code provisions relating to passing off. Trade names are protected federally under the Canada Business Corporations Act (for businesses), the Canada Corporations Act (Part II, for non-profit corporations), the Cooperative Associations Act (for cooperatives), and to a limited extent, the Boards of Trade Act. Provincial corporate names are also protected by provincial legislation in each province. Trade names are required to be registered by the federal, provincial and territorial governments. All provinces and territories require that any name which is used in association with a business, other than a corporate name, be registered as a business or trade name. The abovementioned legislation requires that trade names have distinctiveness, and not connote government or other named institutions, or contain prohibited terms, be obscene or deceptively misdescriptive, or be likely to cause confusion with existing (or applied for) corporate names, trade names or trademarks. The Boards of Trade Act requires that trade names not be similar to that of another board in the same district. The Trade-marks Act provides that the rights of a user of a trade name have priority over someone who subsequently seeks to obtain rights in a trademark. There is no national database of trade names or corporate names, except for

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 9

the NUANS search system, which contains most such names and is available online for a fee. Each jurisdiction independently maintains a database of its trade and corporate names. The ccTLD administrator for .CA does not specifically restrict domain name registration based on trade names, although all applicants are required to prove a Canadian presence. The registration authority for .CA will be implementing a dispute resolution policy to resolve conflicts including domain names, including conflicts with trade names.

17. In **Cambodia**, trade names are protected under the transitional law of the United Nations Transitional Authority of Cambodia (UNTAC) (Articles 47 and 48). A new 'Law Concerning Marks, Trade Names, and Acts of Unfair Competition' is under consideration for adoption by the National Assembly and Senate. Trade names are not required to be registered, and there is no database of trade names. The ccTLD administrator for .KH requires applicants to certify that their domain name registration does not violate trade name or other statutes.

18. In **Colombia**, trade names are protected in accordance with Decision 486 of the Andean Community, in force December 1, 2000, that regulates trade names in conjunction with the Code of Commerce of Columbia. Trade names are protected in accordance with Article 609 of the Code, that establishes the legal right of owners of trade names to take action to stop infringing uses and to claim damages. In addition, Article 15 of Law 256 of 1996 establishes rights against unjust enrichment by misuse of industrial, commercial or professional reputation. Without prejudice to the Criminal Code and international treaties, Colombian law prohibits the unauthorized use of distinctive commercial signs or denominations in a misleading manner, regardless of whether such use is accompanied by a disclaimer or other true indication such as 'model' or 'imitation'. Further, Article 259 of Decision 486 of the Andean Commission establishes a principle of unfair competition in relation to industrial property, that prohibits those acts capable of creating confusion in relation to establishment of a business or commercial activity of a competitor, and the making of false declarations or acts of commerce capable of damaging the reputation of a competitor. Colombia has approved Law 59 of 1936 on protection of trademarks and commerce (la Convención Interamericana sobre Protección Marcaria y Comercial) and approved the Paris Convention through Law 178 of 1994, in force September 3, 1996. In addition, rights in trade names are acquired through use in commerce, without further formalities. However, Colombia has implemented a system of deposit of trade names that is optional and declarative. There is a database of trade names maintained by the Superintendencia de Industria y Comercio, that is publicly available for searching and is available on the Internet, although the database is not comprehensive because registration is not obligatory and protection may be gained through use alone. The ccTLD administrator for .CO requires that applicants for domain names based on trade names should justify their right to the name based on the regulations stipulated in the Code of Commerce and Colombian Law.

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 10

19. In **Costa Rica**, trade names are protected under the Law of Marks and Other Distinctive Signs (Articles 64 and 69, No.7978) (February 1, 2000). Trade names must not contravene public morality and must not create a risk of public confusion regarding the identity, the nature, the scope of commercial activities or any other related aspect concerning the designated company. Trade names are not required to be registered. There is a database of trade names, although it is not yet available online. While the ccTLD administrator for .CR does not impose, in principle, any restrictions regarding domain name registration based on trade names, it may do so when the said trade name is famous or well-known on a national level.

20. In **Côte d'Ivoire**, trade names are protected under the Bangui Agreement of March 2, 1977, Annex V (Trade names and protection against misuse). Trade names are not required to be registered in order to enjoy protection. Trade names must not contravene public morality. There is no database of trade names that is publicly available. The ccTLD administrator for .CI is not available online.

21. In **Cyprus**, trade names are protected pursuant to the Partnership and Business Names Law (CAP 116, May 12, 1928) as amended by Law 77/1977, together with Statutory Instruments (No. P.I. 18/87 of January 30, 1987 and No. P.I. 256/90 of October 26, 1990). Trade names are required to be registered by every individual having a place of business in Cyprus and carrying on business under a business name which does not consist of his true surname without any addition other than his true Christian names or initials thereof, and every company as defined in the Companies Law carrying on business under a business name which does not consist of its corporate name without any addition. The Registrar of business names will reject any business name which is undesirable, or which is identical or closely resembles the name of another company, so as to cause confusion to the public. Business names cannot be the same or misleadingly similar to internationally famous names, so as to result in unfair competition, and names cannot be common in the trade, or be letters in the alphabet or geographical names. The database of business names is publicly available, although it is not yet available online. The ccTLD administrator for .CY requires that applicants take responsibility for ensuring that their domain name does not conflict with copyright, trade marks, famous names, laws of the land and ICANN guidelines. Evidence of this may be requested by the ccTLD administrator, and may be provided in the form of a Certificate from the Registrar of Companies and Official Receiver or The Registrar of Associations and Institutions.

22. In **Denmark**, trade names are protected primarily under the Marketing Practices Act (section 5). It provides that 'distinctive business marks,' including trademarks and trade names, shall not be used by any person who is not legally entitled to do so, and may not be used in a manner which is liable to mislead or confuse the public. However, trade names receive more limited protection than trademarks, such that if a company using a trade name operates exclusively in a certain geographic area, the protection will be limited to this area. Only trade names that are distinctive will be protected, and such distinctiveness can be acquired by use. Trade name protection, as with trademarks, is

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 11

limited to certain goods and services, or a certain line of business – consequently, identical trade names can be used by companies in different lines of business. Trade names can also be protected as trade marks under the Trade Marks Act (section 4), provided they have been used specifically to market goods and services. Trade names may, but are not required to be registered, although public limited companies and private limited companies are required to register at the Danish Commerce and Companies Agency. The Danish Companies Act (sections 2(2) and 153(2)) provides that company names must clearly differ from each other and the names of private companies and registered undertakings, and must not include surnames, names of firms, specific names of real property, trade marks, logos, etc., that do not belong to the company. The law cannot, however, prevent non-limited companies from using a trade name, as such companies are covered separately under the Marketing Practices Act (section 5). Although there is no register of trade names or non-limited companies, the limited companies register is available online. The ccTLD administrator for .DK does not restrict domain name registration based on trade names, but third parties may appeal to a Board of Appeal on Domain Names, one of whose three members has knowledge of name and trademark rights, for a ruling that the name conflicts with established legal rights in the name. In the event that a settlement procedure is instigated, the Secretary to the Board can suggest to the parties that a portal covering several concurrent name or trademark rights is created, such that the one domain name can be used to establish a connection with each of the rightsholders.

23. In **Ecuador**, trade names are protected under the Industrial Property Law (Articles 229 to 234) and the Decision 486 of the Andean Community (Articles 190 to 199) and the Paris Convention (Article 8). Trade names are not required to be registered and there is no database of trade names. The ccTLD administrator for .EC does not impose any restrictions upon domain name registration based on trade names. However, before granting the domain name, the applicant is required to attach to its registration request a trademark or trade name certificate or an attestation showing that the company for which the registration of domain name is requested has been registered as a company.

24. In **Eritrea**, trade names are registered in the official Commercial Register of Trade Names, maintained by the Business License Office. Registration is required if the business entity intends to use the trade name to identify itself, to reflect the name in its letterhead or other promotional activities, or to use the name in business transactions. Trade names must be distinctive, not contain any internationally well-known trade names, not have been previously registered, not be the same or confusingly similar to names reserved for national pride, local military camps, historical names or other reserved names, and not conflict with local culture, national discipline or policies. There is a database of trade names, although it is not yet publicly available. The ccTLD administrator for .ER is not available online.

25. In **Estonia**, trade names are protected pursuant to the Paris Convention and business names are protected under the Commercial Code (Chapter 2). A ‘business

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 12

name' is the name under which an undertaking operates, and is required to be registered in the commercial register. The owner of a business name has the exclusive right to use the name, and may bring an action for damages for its unauthorized use. All Estonian companies and foreign companies doing business in Estonia must register in the commercial register to qualify for protection under the Commercial Code. The business name must be clearly distinguishable from pre-registered business names and trademarks, and the name of a sole proprietorship must be distinguishable from other business names in the territorial jurisdiction. The name must not be misleading as to legal form, or scope of activity, nor be contrary to public morals. The name must not use a geographical indication in its area of protection without authorization. The name must be written in Estonian, and foreign names must be distinguished. There is a publicly available database of trade names that is freely searchable online. The ccTLD registration authority for .EE requires applicants to warrant that their domain name does not infringe the interests of third parties, and legal entities are required to prove their registration under Estonian law before registration of their domain name. Domain name registrants are usually restricted to one name, and must prove a permanent Internet connection in Estonia.

26. In **Ethiopia**, trade names are protected pursuant to Proclamation No. 67/1997 on Commercial Registration and Business Licensing (Articles 12 - 19) and Council of Ministers Regulations No. 13/1997 (Article 16). Trade names for national and foreign businesses operating in Ethiopia are required to be registered on the Trade Name Register. Trade names must not be identical or misleadingly similar to trade names that have been registered in the same nature of business, and names must not be contrary to morality or public order. Trade names that are no longer in use are cancelled. In addition, business owners are required to obtain a Commercial Registration Certificate and Business Licence. There is a publicly available database of trade names, although it is not yet available online. The ccTLD administrator for .ET does not restrict applications for domain name registration based on trade names.

27. In **Finland**, trade names are protected under the Trade Name Law (2.2.1979/128) and through registration or by right of establishment where the name is commonly known, pursuant to the Company Names Act and the Trademarks Act. Trade names must not resemble pre-existing names, especially those of competitors. Companies, with some exceptions, are required to submit a declaration to the national Trade Register, for example, announcing their establishment, and simultaneously reporting their trade name. Trade names are maintained on a register with the National Board of Patents and Registration, and registration gives nationwide protection. Unregistered names are protected in their sphere of operation by entrenchment, which is rare in practice. Trade names must not violate a third party's registered name, trade mark, subsidiary symbol, mark, abbreviation, work related to copyright or some similar object of protection, public association's name or abbreviation of its name. Trade names must differ from others so as not to be misleading or cause confusion with the names of competitors a company in an identical or similar line of business, and in some cases unrelated enterprises, and must

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 13

be capable of distinguishing the company from others. The name must also show the distinctive mark, or type, of the society. There is a database composed of the Trade Register, that will be available online from June 2001. The ccTLD registration authority for .FI, the Telecommunications Administration Centre, requires a domain name to be a company name legally registered in Finland. Any organization, practitioner, businessman, or branch of a foreign enterprise that is to be entered in the Trade Register, Register of Associations, or Register of Foundations, cannot apply for a domain name before its name is recorded in the register. The domain name can reflect the corporate name, or its abbreviation. Domain names must differ from all other names entered in the trade names and trademark registers.

28. In **France**, trade names are protected under the Civil Code (Articles 1382 and 1383) either through application of principles of unfair competition, regardless of the bona fides of the trade name user, or through application of principles of parasitism, where the parties are not competitors. Trade names are also protected by Article L.711-4 of the Intellectual Property Code, insofar as they may be recognized as a precedent to a trade mark. In addition, trade names are protected by Article L.217-1 of the Code of Consumption. In France, it is prohibited to register as a trade mark a sign that would violate pre-existing rights such as a trade name known on the national level, if there is a risk of public confusion. Companies that register for a company number on the Register of Commerce are required to declare their trade names, however registration is not required in order to enjoy protection as trade names. There is a database of trade names via the companies registration process, that is available online at <http://www.euridile.inpi.fr>. The ccTLD administrator for .FR does restrict domain name registration based on trade names, and applicants are required to provide official documentation, such as a trade mark certificate, before being granted the corresponding domain name. However, it is possible for applicants that are French or domiciled in France to register a trade name under “.com.fr” without providing any such official certificate.

29. In **Georgia**, trade names are protected pursuant to the Paris Convention, under the Law on Entrepreneurs (Article 6). Trade names are required to be registered, and must reflect the name of an individual entrepreneur, or of at least one partner in a jointly owned company or partnership, plus an indication of the type of enterprise. Trade names must not contain words likely to mislead or confuse the public as to the type of enterprise or its relationships to third parties, and must clearly distinguish the enterprise from others. There is a database of trade names, although it is not available online. The ccTLD administrator for .GE does not impose restrictions on domain name registration based on trade names.

30. In **Germany**, trade names are defined as signs used in the course of trade as the name, company name or special designation of a business establishment or an undertaking, pursuant to the Trademark Act (section 5). The acquisition of protection of a trade designation confers on the owner exclusive rights including, for example, to

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 14

prevent another from using the trade designation or similar sign in the course of trade in a manner likely to cause confusion (section 15(2)). Where a trade name fulfils the requirements for protection of the right to use a specific name (Civil Code (section 12)), or for protection of the right to use a company name (Civil Code (section 17)), the owner gains additional rights to prevent a third party from using the names and to claim compensation for damage suffered. In practice, businesses may register a trade name, but smaller enterprises are likely to use an unregistered trade name and may operate and be known by that name only in their local area.¹ Trade names are not required to be registered, but businesses must have their company and seat of business registered in the commercial register at the Court in the local district. There is no publicly accessible database of trade names, although the commercial register of company names at the Local Court is publicly searchable, although not yet online. Some private companies have provided these searches online. The ccTLD administrator for .DE does not restrict domain name registration based on trade names, but requires applicants to state that the domain name does not violate the rights of third parties, and to assume the liability risk for this assurance.

31. In **Guatemala**, trade names are protected by the Industrial Property Law, Decreto 57-2000 of the Congress of Republic. Pursuant to Article 71, protection is enjoyed from the first public use of the trade name, and within the limit of activity to which the trade name refers. Trade names are not required to be registered in order to enjoy protection. A database of trade names is publicly available through the *Registro Mercantil de Guatemala*, which can be consulted physically or by telephone. While the database is not yet available online, Guatemala is in the process of creating a web site in order to enable on line consultations of such data. The ccTLD administrator for .GT does not impose any restrictions on domain name registration based on trade names.

32. In **Honduras**, trade names are protected under the Industrial property Law, Decreto n°12-99 (Articles 118 to 120, Chapter IV, Section I) and the Code of Commerce (Articles 660 to 664, Section II, and Articles 1 to 4, Preliminary General Dispositions). Trade names are required to be registered in order to enjoy protection. In order to be registered, trade names must not contravene public morality or create a risk of public confusion regarding the identity, the nature, the scope of commercial activities or any related aspects concerning the designated company. It is also prohibited to use a trade name that would correspond to a distinctive sign that is well-known in the country or held by a third party. The ccTLD administrator for .HN does not impose any restrictions related to domain name registration based on trade names.

33. In **Hungary**, trade names are required to be registered on the Firm Register under the Act on the Registration of Firms and Court Registration Procedure (No. CXLV of 1997), with respect to companies that are set up in accordance with the Act on Business Associations (No. CXLIV of 1997), as well as other undertakings (organizations or

¹ See Comment of Deutsche Industrie und Handelstag (DIHT) (RFC1 – September 27, 2000).

persons), engaged in commercial or business activities. Companies are required to register their names, whereas registration is optional for other undertakings. Firms names must reflect the firm's main activity and form and, other than an identifying 'lead word,' must be in Hungarian, and there are restrictions on use of historical personalities' names. The firm name must be clearly distinguished from other firm names, and rights are based upon first registration. In addition, the Civil Code (Act No. IV of 1959, Article 99(1) and (3)) provides protection for the right to bear a name as a right of personality, and provides that a legal entity's name must differ from the names of previously registered legal entities engaged in similar activities – this protection extends beyond just businesses, to include all legal entities. In addition, the Act on the Prohibition of Unfair and Restrictive Trade Practices (Competition Act) (No. LVIII of 1996, Article 2) provides for a general prohibition of unfair competition that protects trade names. A Hungarian Court has prohibited a firm from use of a trade name similar to another's, based on the Civil Code (Article 77), which protects the right to bear a name, and based on the general prohibition on unfair competition in the Competition Act². Commercial names that are registered as trademarks and as corporate names, pursuant to the Act on Registration of Firms, may have priority. This entitles the owner to a priority claim to acquire domain names identical or misleadingly similar to the trade name, and to prevent others using the name, pursuant to the Registration Regulations of the Council of Hungarian Internet Service Providers. The Firm Register is publicly available for searching, published in the Official Gazette of Firms, and is available online for a fee. The ccTLD administrator for .HU requires applicants to warrant that the chosen name or its usage does not infringe the rights of any third person or organization, and to renounce the name in case of infringement. It refers applicants to check the registry database and trademark database of the Hungarian Patent Office.

34. In **Ireland**, trade names, or 'business names', are defined as the name or style under which a business is carried on, and are required to be registered with the Registrar of Companies, pursuant to the Registration of Business Names Act, 1963. There is a publicly searchable database of business names, although it is not online. The ccTLD administrator for .IE permits any company with a real and substantive connection with Ireland to register a domain name to reflect their corporate name. A company may register multiple different domain names in this commercial second level domain, provided that each one reflects the company's corporate name (optionally translated from English to Irish, or vice versa) or its abbreviation. Companies registering their name as a domain name in the corporate name category must provide proof of registration in Ireland, including registered company numbers, certificates of incorporation and registration of place of business. Applicants for a domain name in the registered business name category are required to provide registered business numbers and certificates, and proof of current trading or a serious intention and commitment to trade in the immediate future. Unincorporated associations seeking to register trade names in these categories are subject to similar criteria.

² (Decision #2, G. 40313/1991/6. of County Court of Borsod-Abaúj-Zemplén County, 84/1991. VJ)

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 16

35. In **Japan**, trade names are protected under the Commercial Code (Articles 16 to 31) and the Unfair Competition Prevention Law. Pursuant to the Commercial Code (Article 8), trade names are not required to be registered, unless and until the company is incorporated, in which case registration is required to obtain legal personality (Article 57). There is a publicly available register of trade names that is searchable online. Under Japanese law, persons are permitted to use their surname, name or any other denomination as a trade name, and must include a term indicating the corporate form. A trade name, once registered, cannot be registered in the same city, town or village, in respect of the same kind of business, and use of the same trade name in the vicinity is presumed to be unfair competition. The law stipulates that no trade name can be transferred, except with the transfer of the business. In such cases, persons who permit others to use their trade name remain jointly and severally liable to perform any obligation in favor of a third party, if that party entered a transaction in the belief that it was dealing with the proprietor. If a proprietor registers, but does not use, a trade name for two years, its use is deemed to have been discontinued.

36. In **Kyrgyzstan**, trade names are protected under the Law on Trade Names, pursuant to the Paris Convention. Trade names are required to be registered by all national business entities. The database of trade names is publicly searchable, but is not available online. The ccTLD administrator for .KG does not impose any restrictions on domain name registration based on trade names.

37. In **Latvia**, trade names are protected pursuant to the Paris Convention based on use, without registration, and under the Competition Law of the Republic of Latvia (Article 22) based on unfair competition, including use or imitation of the trade name as a 'marking' or 'distinctive sign'. There is no database of trade names. The ccTLD administrator for .LV requires that full and short names of organizations and companies registered in the Enterprise Registry of the Republic of Latvia, and Trade Marks registered in the Patent Office of the Republic of Latvia, can only be registered as domain names by their legal owners. Registrants in breach of this requirement are subject to cancellation of their domain name.

38. In **Lithuania**, trade names may be protected under the Law on Firm Names (No. VIII-1286, January 1, 2000), and against unfair competition under the Law on Competition (Article 16, No. VIII-1099), (April 2, 1999). In addition, the names of legal persons are protected under the Civil Code. Businesses are required to register their trade names under the Law on Firm Names, Article 3, until January 1, 2002, when a new Civil Code will come into force, which will consolidate the registration of all legal names, including trade names and enterprises, under one legal person's register. Currently, all firms established under Lithuanian law are required to be registered, except if the name is made up of words or abbreviations identifying the type of firm and the surname(s) of the founder. Firm names must be made up of the words or abbreviations identifying the type of firm and the name in direct meaning, in compliance with local language norms, and

must not contradict public interest or policy considerations. A symbolic firm name may not include a generic word identifying only the type of activities, or goods or services provided, or place name or non-distinctive words. A firm name must not be identical or confusingly similar with a pre-registered name, or include, without authorization, the name of another person, the names of States, international organizations or their acronyms, or the name of a distinctive literary or artistic work, such that its use infringes the copyright in the work. A firm name cannot mislead the public as to the location of the firm, its sphere of activities, or its similarity to the name of a foreign company name. A firm name is the exclusive industrial property of the firm, until its removal from the register or in certain defined circumstances. There is a publicly available database of trade names, in the Official Bulletin of the State Patent Bureau, although it is not available online. The ccTLD administrator for .LT requires that domain names shall not disturb moral norms nor mislead users as to content or affiliation, nor violate the rights of any third party. Domain name registrants are personally responsible for the property rights in industrial names, including firm and trade names, and the registration authority may suspend use of the name pending dispute resolution proceedings in any conflict over rights to use of a trade name as a domain name.

39. In **Mauritius**, trade names are protected under the Business and Trade Name Act and by application of common law principles of passing-off. Trade names are not required to be registered, and there is no publicly available database of trade names. Trade names are prohibited from including words that, without authorization, suggest a connection with the State, including 'authority,' 'corporation,' 'crown,' 'government,' 'King,' 'Mauritius,' 'national,' 'Queen,' 'regional,' 'royal' and 'state.' The ccTLD administrator for .MU does not impose any restriction on domain name registration based on trade names.

40. In **Mexico**, trade names are protected under the Law on the Promotion and Protection of Industrial Property, D.O. (June 27, 1991). Trade names are not required to be registered in order to enjoy protection. There is a database of trade names, that is available online at <http://www.impi.gob.mx>. The ccTLD administrator for .MX does not impose any restrictions upon domain name registration based on trade names, however the applicant is required to warrant that the domain name does not violate third parties' rights.

41. In **Monaco**, trade names are not protected under any specific legal text. However, trade names are protected on under unfair competition principles under the Civil Code (Articles 1229 and 1230). Trade names are required to be registered pursuant to the Law n°721 of December 27, 1961, relating to the Registrar of Commerce and Industry (Article 3). Trade name registration is subject to conditions such as an official authorization to exercise commercial activities. There is a database of trade names, although it is not publicly available. The ccTLD administrator for .MC does impose restrictions upon domain name registration based on trade names, as applicants are required to demonstrate

that the company is domiciled in Monaco and that the trade name has been notified to the Registrar of Commerce.

42. In **Mongolia**, trade names are protected pursuant to the Trademarks and Trade Names Law. Every business entity in Mongolia is required to register its trade name on the State Register. A trade name will not be registered if it is similar or identical to a previously registered trade name, if the business is not established and registered in accordance with law, or if the trade name is expressed in numbers. Trade names must be in Cyrillic script, and may also be in Latin script, and must include a reference to the form of the entity. There is no database of trade names. The ccTLD administrator for .MN does not impose any restrictions upon domain name registration based on trade names.

43. In **Morocco**, trade names are protected under Law 15/95 (Articles 30 and 35). Trade names are required to be registered on the Register of Commerce within one year after the allocation of the trade name. Trade names are prohibited that would violate pre-existing rights such as trademarks or trade names. A database of trade names is publicly available, although it is not yet available online. The ccTLD administrator for .MA does not impose any restrictions on domain name registration based on trade names, however the establishment of rules of registration that would take account of trademark and trade names is being discussed.

44. In the **Netherlands**, trade names are protected pursuant to the Handelsnaamwet (Law on Trade Names) of 1921, aimed at preventing confusion and deception of the public through use of a trade name. This law defines a trade name as the name under which an undertaking is conducted, and rights in a trade name arise with legitimate use in trade (e.g., by use on stationery, as a domain name, in advertising or in signing a document). The name must have a certain durability and reputation. Trade names are prohibited that are identical or confusingly similar to an existing trade name, with confusion being measured by the nature of the undertaking and place of business. The ccTLD administrator for .NL imposes certain restrictions on registration of domain names, particularly as concerns names of (Dutch) provinces and municipalities, names that are in conflict with public order and contrary to good manners, and generally names that are misleading in society, trade and industry.

45. In **Niger**, trade names are protected under the Bangui Agreement of March 2, 1977, Annex V (Trade names and protection against misuse). Trade names may, but are not required, to be registered. There is no publicly available register of trade names. The ccTLD administrator's registration terms and conditions for .NE are not available online.

46. In **Norway**, trade names are protected under the Company Act of June 21, 1985 (No.79) and the Trademarks Act of March 3, 1961 (No.4). All businesses are required to register their company in order to fulfil various legal obligations, and provided that the name is used within one year of registration, it is protected thereby. Registration,

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 19

however, is not necessary to enjoy legal protection for the trade name itself, which is protected through mere use. In addition, company names can also be protected as trademarks through registration or use. Trade names must be distinctive, not deceptive or confusingly similar to trade names or trade marks with prior rights, and restrictions are imposed upon trade names that may contravene third parties' rights to personal and other names. There is a publicly searchable database of trade names that is available online. Currently, the ccTLD administrator for .NO requires companies seeking to register trade names as domain names to provide documentary proof of their legal right to the name, although this procedure will be liberalized in future, when registrants will simply be required to warrant that their domain name does not infringe third parties' rights.

47. In **Peru**, trade names are protected under Decision 486 of the Andean Community (December 1, 2000), and the Law Decreto 823 (May 24, 1996). Trade names are not required to be registered in order to enjoy protection. The right to exclusive use of the trade names results from the first use of that trade name. Trade names are also protected pursuant to the Paris Convention and the *Convención General Interamericana de Protección Marcaría y Comercial de Washington*. In Peru, third parties' use of a distinctive sign that is identical or similar to an existing company's trade name and that would create a risk of public confusion may be prohibited. In addition, the registration of a trade name will be prohibited if it contravenes public morality or creates a risk of public confusion regarding the identity, nature, scope of commercial activities or any related aspect concerning a company identified with such trade name. There is a database of trade names on the Registrar of Industrial Property, that is available online at <http://indecopi.gob.pe>. The ccTLD administrator for .PE does impose restrictions upon domain name registration based on trade names, and applicants are required to submit official documentation of their trade name registration in order to register the corresponding domain name.

48. In the **Philippines**, trade names are protected as property rights under the Civil Code of the Philippines. The Intellectual Property Code (RA 8293, Sections 165, 165.2(a) and (b), 165.3, 165.4 and Rules 103 (a)-(d) of the Implementing Rules and Regulations) also provide protection to trade names. Further protection to trade names is provided pursuant to Act No. 3883 or the Business Name Law and its Implementing Rules and Regulations, and the Department Administrative Order No. 8 Series of 1982. Trade names are not required to be registered, and although there is no database of trade names, a database system is in development. The ccTLD administrator for .PH does not impose any restrictions upon domain name registrations based on domain names, other than to require the applicant to warrant that its domain name does not infringe the intellectual property rights of third parties.

49. In **Portugal**, trade names are protected pursuant to the Paris Convention and under the National Register of Societies (DL No. 129/98 of May 13), and the Industrial Property Code (Article 232) which, once a name is registered, provide exclusive rights to use a trade name nationally. Trade names may, but are not required to be, registered in

order to enjoy protection. Trade names will not be registered if there is a risk of public confusion with other distinctive signs. There is a database of trade names in Portugal monitored by the National Industrial Property Office, although it is not available online. The ccTLD administrator for .PT does not impose any restrictions upon domain name registration based on trade names.

50. In the **Republic of Korea**, trade names are protected under the Commercial Law, Unfair Competition Prevention and Trade Secret Protection Law, and Trademark Law. Trade names are not required to be registered in order to be protected (Commercial Law, Articles 18, 22 and 23). Trade names may be composed of the full name of the merchant, or any other denomination, and must indicate the legal type of company. A trade name must differ from pre-registered names in the same kind of business in the same metropolitan city. There is no publicly available database of trade names. The ccTLD administrator for .KR does not impose any restriction upon domain name registration based on trade names.

51. In the **Republic of Moldova**, trade names are protected under Law No. 845-XII (Articles 23-27) on enterprises and entrepreneurial activity. Trade names are required to be registered as part of all registration of legal entities with the State Registration House and on the public commercial register. Trade names must describe the activity and the legal form of the enterprise, and must be distinguishable from other entities. There is a database of trade names that is publicly available, although it is not yet available online. The ccTLD administrator for .MD has reserved the domain for exclusive use by healthcare providers and consumers anywhere in the world, including but not limited to, physicians, nurses, nutritionists, therapists (all allied health personnel) hospitals, clinics, surgery centers, practice groups, health plans, healthcare maintenance organizations, physician practice management companies and groups, medical device, drug, or biotech manufacturers, suppliers, distributors (durable medical equipment, disposable supplies, diagnostic, surgical, and reference equipment) and sellers, or any other person or entity providing service to, or supplying, selling, marketing, purchasing, distributing or providing any product or service to any person or entity involved in, operating in, or providing or selling products or services to the healthcare industry.

52. In **Romania**, trade names are protected pursuant to the Paris Convention, whether registered or not, under the Law Concerning Registration of Commerce (No. 26/90), the Law on Unfair Competition (No. 11/91), and the Law of Marks and Geographic Indications (No. 84/98). Pursuant to the Law (No. 26/90), companies must register their trade names on the Register of Commerce before undertaking commercial activity, and the name must not resemble pre-existing registrations or existing companies. The database of trade names is publicly searchable and is available online, although online access is restricted. While the ccTLD administrative authority for .RO employs the first-come, first-served principle for registration, the applicant is required to warrant that the domain name does not violate third parties' rights.

53. In the **Russian Federation**, trade names are protected pursuant to the Paris Convention under the Civil Code of the Russian Federation, as well as under a Law on Societies with Limited Liability. The Civil Code grants a legal entity the exclusive right to use its trade name, and to freely dispose of it. Trade names are required to be registered, although protection is enjoyed without registration and the right to exclusive use arises upon use in the country. For commercial organizations, protection arises upon the date of registration of the company. Trade names cannot be registered that include the words 'Russia', 'Russian Federation' or 'Moscow', without appropriate Government authorization. Trade names are required to be distinctive, authentic and not liable to mislead the public as to their origin, for example, by misuse of a geographic indication. As a rule, trade names should consist of two parts, indicating the legal personality of the entity and any designating word or proper name. There is a database of trade names consisting of the Uniform Register of Legal Entities, that is publicly available, although it is not online. The ccTLD administrator for .RU does not restrict domain name registration based on trade names.

54. In **San Marino**, trade names are protected by the Law of June 24, 1999 (No. 64, Article 22). Trade names are registered in practice, but are not required by law to be registered. Usually, the office responsible for the issue of business, trade and industrial licences applies to the Registry for the trade name registration of individual companies. There is no database of trade names. The ccTLD administrator for .SM requires commercial entities to register domain names that reflect their trade names. Domain names can be assigned either to companies, bodies and associations from San Marino or to foreign companies, bodies or associations provided that the applicable regulations and laws are respected. All San Marino companies that are regularly registered at the Industry Office and/or at the Court, all individual companies etc. are registered in the commercial category of domain names, and their existence can be proved by a certificate that certifies their registration, or an Economic Operator Code. All foreign operators are required to produce a document that certifies their company registration in their country. The ccTLD administrator for .SM requires that domain names be similar to the applicant entity's name or must be similar to one of its services, products, trade-marks etc., in order to assure an easy identification of the name itself, and the registrar will reject names that are misleading or obscure. The registrar does not restrict names based on trade names, but may communicate with the applicant if the name is ambiguous, in that it reflects a trademark or registered name. Foreign companies are required to produce a certificate of company registration in their country, in order to register their trade names in .SM.

55. In **Saudi Arabia**, trade names are protected pursuant to the Law on Trade Names, issued by virtue of Royal Decree No.15 in 1420 H. and the Law on the Commercial Register, issued by virtue of Royal Decree No.1 in 1416 H. Trade names are required to be registered, and any person who operates a commercial establishment with a capital of at least 100,000 Riyals must apply for the publication of the name at the Trade Registry, where registration is effected 30 days after application. The trade name must be in Arabic, or transliterated in Arabic characters, and must not contain foreign words, with

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 22

the exception of names of foreign firms registered outside the Kingdom, firms having worldwide famous names and joint ventures. In all cases, the Minister of Commerce retains the discretion to make any exception to these regulations. There is a database of trade names that is publicly available for searching upon payment of a fee, although it is not available online. The ccTLD administrator for .SA registers domain names in '.com.sa' on the basis of first-come, first-served although, in order to be registered, the domain name must be identical with or derived from the official name or trademark of the business establishment, or reflect its activities. The domain name must be in roman characters, and can be a transliteration, a translation or an abbreviation of the trade name. An applicant for a domain name that does not correspond to his trade name must warrant that all information contained in the application is true, that he is entitled to register the name and that the name is not in conflict with any third parties' rights.

56. In **Singapore**, trade names are protected under the Business Registration Act (Cap.32), the Companies Act (Cap.50) and the Trade Marks Act (Cap.331, 1999 Edn.), if the trade names is also registered or used as a trademark. In particular, sections 27(1)(b)-(c) of the Companies Act provide that a company shall not be registered if the name is identical or similar to that of another company, corporation or business name. Once registered under the Companies Act, the Business Registration Act restricts the registration of similar names and defines a 'business name' as the name or style under which a person carries on a business. The database of trade names is publicly available and freely searchable online, and includes a comprehensive list of names of all business firms, local companies and foreign companies registered in Singapore. The ccTLD administration authority for .SG requires the registrant to warrant that the domain name is not identical or confusingly similar to any registered trademark, company or business name in Singapore, and that registration or use of the domain name does not interfere with the legal rights of any third party in Singapore.

57. In **Slovenia**, trade names are protected under the Law on Commercial Companies (June 10, 1993). Trade names are comprised of the company title and title of an entrepreneur's business and are required to be registered in order to gain protection. A trade name owner may take legal action against a misleadingly similar company name to have it deregistered, its use discontinued and damages paid. Trade names must indicate the activity of the company and must not contain the names or symbols of foreign countries or international organizations. The word 'Slovenia', or derivatives and abbreviations thereof, and words designating the State or local community, can only be included with the authorization of the Government or competent local community body. Names of historical figures or famous persons can only be included in the trade name with the consent of the person, his or her authorized representatives, or the administrative minister. The trade name cannot contain words that contravene law or morality, include the trade marks or service marks of others, or include official signs. The trade name must be clearly distinguished from those of other companies and registered titles. Special rules apply to titles of general and limited partnerships, limited liability companies and joint stock companies. There are two publicly available databases, for company titles and for

titles of the entrepreneur's business, although these are not yet available online. The ccTLD administrator for .SI registers domain names only for legal entities registered in Slovenia, and there is a limit of one domain name per entity. The domain name must be the full or abbreviated registered trade name of the entity, and domain names that are identical to any existing domain name in an open gTLD cannot be registered in the .SI ccTLD.

58. In **Spain**, trade names are protected in three ways; first, pursuant to the Trade Mark Law (32/88), that provides for civil and criminal actions to be taken by a holder of a trade name registered in the Patent Office against any infringing uses by third parties; and second, pursuant to the Unfair Competition Law (3/1991) that protects company owners or persons or enterprises that trade under a name from acts of unfair competition. Finally, trade names are protected pursuant to the Paris Convention, whose provisions are self-executing in Spain. Trade names are registered in Spain by two means; the Ministry of Justice maintains a company register on which registration is obligatory for companies in order to acquire legal status and the authorization to trade in Spain. In addition, trade names can, but need not, be registered in the Patent Office, pursuant to the Trade Mark Law, that classifies trade names as distinctive signs capable of registration. Trade names may be registered by fiscal or legal persons as a sign or denomination that identifies a legal person in the exercise of commercial activities, and must distinguish that enterprise from others in a similar field of activity. Trade names may comprise personal names, the commercial or legal name of a company, fantasy names, names referring to the character of the commercial activity, anagrams or any combination thereof. There is a database of trade names maintained by the Patent Office that is publicly available for searching upon payment of a fee. The Registro General de Sociedades also maintains a database of trade names that must be consulted, upon payment of a fee, by any person requesting registration of a company name in order to ensure that it is not identical or confusingly similar to any pre-existing name. Neither database is available online. The ccTLD administrator for .ES does require applicants for domain names based on trade names to provide proof of registration of their company name in either the Companies Register or Patent Office Register.

59. In **Sweden**, trade names are protected under the Swedish Trade Names Act (1974: 156), which provides that a tradesman acquires exclusive rights to a trade name through registration or establishment on the market. Section 2 of that Act states that trade names shall be registered through the Swedish Patent and Registration Office. Trade names are required to be registered as part of the process of registration of a company and its articles of association. Therefore, when a new company is registered, the Swedish Patent Office examines the trade names according to the Swedish Trade Names Act (Articles 9-10). Trade names must distinguish the business from others and cannot be registered if they are confusingly similar to another trade name, or protected business or trade symbol, or are intended to mislead the public, or be contrary to accepted customs or public order. The database of trade names is publicly available for a fee, and an online database is planned for the near future. The ccTLD administrator for .SE requires that domain names

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 24

must refer to an enterprise connected to Sweden and reflect the name of the enterprise as stated on the Swedish registration certificate. In addition, if the domain name refers to a company, then the company must be registered at the Swedish Patent and Registration Office, or have been allocated a corporate name by a Swedish authority.

60. In **Switzerland**, trade names are protected under the Swiss Code of Obligations (Articles 944-956) and the Commercial Registry Ordinance (Article 44-48). The company or the sole proprietor has the exclusive right to use the registered trade name. Trade names are required to be registered for general partnerships, limited partnerships, corporations, cooperatives, limited liability companies. Sole proprietors have the legal duty to register their trade names under certain circumstances. The conditions placed upon registration depend upon the legal form or type of the company, based on statutes and practice (e.g., Directive of the Swiss Federal Registry of Commerce). There is a publicly searchable database of trade names, available online, although not yet complete. The ccTLD administrator for .CH requires applicants to warrant that they own the legal rights to the name, including a trade name, and will reject a domain name that is misleading or deceptive. The ccTLD administrator may issue warnings in case of obvious possible name conflicts or when names are likely to conflict with another name, trade name, etc., and may suspend registration until a new application is received and/or upon receipt of written proof from the trade name owner that the application is valid.

61. In **Tajikistan**, trade names are protected as a result of registration of the legal entity or company, in the Uniform State Register of legal persons, under the Civil Code, Article 51. The register of company names is publicly available. There is currently a proposal to allow voluntary registration of trade names in the Patent Office, and on a State register of trade names. The ccTLD administration authority for .TJ is not available online.

62. In **Thailand**, trade names are protected under the Civil and Commercial Code (Section 18) and the Penal Code (Section 272(1)), and are not required to be registered. There is no database of trade names. The ccTLD administrator of .TH requires registrants to provide evidence of ownership of the trade name, which must be registered in full (abbreviations are not permitted). No translations of the trade name from English can be registered. If a registrant ceases to be entitled to use of a trade name, the new trade name owner may seek the revocation of the domain name.

63. In **The Former Yugoslav Republic of Macedonia**, trade names, or the names used by companies in their operations and legal affairs, are protected under the Law of Trade Companies (Articles 450-458). Both trade names and their abbreviations are required to be registered upon registration of the company in the Trade Registry (Law of Trade Companies, Article 454). Trade names must indicate the type and activities of the company and include the company's address, and cannot mislead the public as to the company's activities or cause confusion with another trade name, trademark or person. Trade names cannot include the names of historical persons or places, nationality, the

State, its abbreviations, or place names. The owners of trade names can prohibit their use by another, and can bring actions for damages for misuse of the trade name. There is a publicly available database of trade names, although it is not yet available online. The ccTLD administrator for .MK does not impose any restriction on domain name registration based on trade names.

64. In **Turkey**, trade names are protected under the Turkish Commercial Code (Articles 41-54). Trade names are required to be registered in the location of the head office, within 15 days of commencement of the commercial undertaking. The database of trade names is publicly available, although it is not yet available online. The ccTLD administrator for .TR, requests proof of logical relationship (such as abbreviation) between the applicant and the trade name for applications to register in ‘com.tr’ and ‘net.tr.’

65. In **Ukraine**, trade names are protected pursuant to the Paris Convention, and under the Law ‘On the Defense Against Unfair Competition (Article 4), the Law ‘On the Protection of Rights in Trademarks and Service Marks (Article 6), the Civil Code of Ukraine (Article 27), the Code of Ukraine on Administrative Violations (Articles 164-3) and the Decree of the Cabinet of Ministers ‘About a Unified State Register of Enterprises and Organizations of Ukraine’ (Item 4). Trade names are not required to be registered, however all enterprise activities are liable to state registration in a Unified State Register of enterprises and organizations, that includes data about enterprises, their organization and names. The database of trade names is not publicly available. The ccTLD administrator for .UA does not impose any restrictions upon domain name registration based on trade names.

66. In the **United Kingdom**, trade names are used to describe the name under which a business operates, or to identify a commercial product or service. Trade names may be registered as trademarks, and are then protected under the UK Trade Marks Act 1994, which allows for the registration of ‘collective marks’. The trading ‘association’ of the collective mark is the proprietor of the mark concerned, and the collective mark distinguishes goods and services of members of that association from those of other undertakings.³ Trade names are also protected by common law – the tort of passing off was developed to prevent a business from misrepresenting its goods or services as those of another, and therefore to protect the goodwill of a business while preventing a competitor from unjustly benefiting from that goodwill. The jurisprudence concerning passing off was summarized in the High Court’s decision in *Chocosuisse and others v. Cadbury*⁴. Trade names are not required to be registered, and cannot be registered unless they are limited company names, in which case they are available on a publicly searchable online database. The choice of names is regulated by the Business Names Act, 1985. The ccTLD administrator for .UK, while not restricting trade names per se,

³ See Comment of British Telecommunications plc (RFC2 – December 28, 2000).

⁴ CH 1995 C No. 7397

The Recognition of Rights and the Use of Names in
the Internet Domain Name System
Annex XV, page 26

does restrict domain names that can be registered in the second level domains ‘.co.uk’, ‘.ltd.uk’ and ‘.plc.uk’.

67. In the **United States of America**, trade names are protected by Federal statute, state statutes and the common law principle of unfair competition. Under Federal Law, the Lanham Act (15 U.S.C., § 1125(a)) grants trade name owners a civil cause of action against any use of a trade name that, in an act of unfair competition, misrepresents the source of the goods or services, or is likely to cause confusion regarding the source. The U.S. trademark infringement and unfair competition laws are designed to protect the public from confusion as to the source, affiliation, association, or sponsorship of goods or services (15 U.S.C. §1125(a)(1)(A)). The Lanham Act defines ‘trade name’ and ‘commercial name’ to mean any name used by a person to identify his or her business or vocation.⁵ A trade name cannot be registered under the Lanham Act, as trade names are perceived to have more local than national significance. However, prior use of a trade name can give cause for refusing registration of a trademark or service mark, so as to avoid confusion.⁶ Trade names are also protected under state unfair competition statutes and court decisions, applied so as to prevent confusion of the public. This protection extends to the unlawful use of trade names as domain names or web addresses, pursuant to the District Court’s decision in *U.S. v Washington Mint, LLC*.⁷ The U.S. Anticybersquatting Consumer Protection Act was intended to stop these “cybersquatters who register numerous domain names containing American trademarks or trade names only to hold them ransom in exchange for money.”⁸ Trade name protection differs under state law, although most states have enacted statutes that grant trade name owners a civil cause of action against any individual or entity that uses a trade name that they are not entitled to use (e.g., California Statute: West’s Ann. Cal. Health & Safety Code, §10315). Under the common law principle of unfair competition, trade name owners may bring an action for confusing or misleading use. The standards of protection for trade names are the same as those that apply to trademarks, and protection is determined

⁵ The earlier version of the Lanham Act, Section 45, had defined a ‘trade name’ as including, “individual names and surnames, firm names and trade names used by manufacturers, industrialists, merchants, agriculturalists, and others to identify their businesses, vocations or occupations; the names or titles lawfully adopted and used by persons, firms, associations, corporations, companies, unions, and any manufacturing, industrial, commercial, agricultural, or other organizations engaged in trade or commerce and capable of suing and being sued in a court of law.” 15 U.S.C. § 1127 (amended by Pub. L. 100-677, § 13(2)).

⁶ See Donald S. Chisum, Michael A. Jacobs, *World Intellectual Property Guidebook – United States* (Times Mirror Books, 1992) at §C[1][d].

⁷ 15 F. Supp.2d 1089 (D.Minn, 2000)

⁸ H. R. Rep. No. 106-412, at 5 (Purpose and Summary). The US Anticybersquatting Consumer Protection Act Pub. L. No. 106-113, §§ 3001-3010, 113 Stat.1537, 537-43 (1999), codified at 15 U.S.C. §1125(d), was passed by the United States Congress “to protect consumers and American businesses, to promote the growth of online commerce, and to provide clarity in the law for trademark owners by prohibiting the bad-faith and abusive registration of distinctive marks as Internet domain names with intent to profit from the goodwill associated with such marks – a practice commonly referred to as ‘cybersquatting’.” See Porsche, 2000 WL 641209, at 2, citing *Sporty’s Farm*, 202 F. 3d at 495, quoting and citing S. Rep. No. 106-140, at 4).

by priority of use. Trade names are not required to be registered, and there is no publicly available database of trade names. The ccTLD administrator for .US may verify whether the information provided by a domain name applicant is false or misleading, but does not specifically restrict registration of trade names as domain names.

68. In **Uruguay**, trade names are protected under the Law of Marks (Chapter XI, No. 14.011– Articles 67 and 72) (September 25, 1998). Trade names are not required to be registered in order to enjoy protection. There is no database of trade names available in Uruguay. The ccTLD administrator for .UY does not impose any restrictions upon domain name registration based on trade names.

69. In **Uzbekistan**, trade names are protected under the Civil Code (Articles 1098-1101), under which the owner has the exclusive right within the country to use or license the use of the trade name in all commercial activities relating to the business, and the trade name is subject to registration in the State Register of juridical persons. Trade names must not be identical or similar to pre-registered names. There is a register of trade names, although it is not publicly available. The ccTLD administrator for .UZ does not impose any restrictions upon domain name registration based on trade names.

70. In **Venezuela**, trade names are protected pursuant to the *Régimen Común sobre Propiedad Industrial* (Title X Decision 486 of the Commission of the Andean Community). Trade names are not required to be registered in order to enjoy protection. There is a database of trade names that is publicly available, although not online. The ccTLD administrator for .VE does not impose any restrictions upon domain name registration based on trade names.

71. In **Viet Nam**, trade names are protected under the Governmental Decree (No. 54/2000/DN-CP, October 3, 2000) on the protection of industrial property rights with respect to business secrets, geographic indications and trade names, and the protection of the right against industrial property-related unfair competitions. Trade names are required to be registered upon business registration. Under the Enterprise Law of Viet Nam, a trade name must not be identical or confusingly similar to a pre-registered name, and must not prejudice historical, cultural or moral traditions. The name must be written in Vietnamese, and must indicate the legal form of the enterprise. There is no publicly available database of trade names. The ccTLD administrator for .VN implements the decision of the Director General of the General Department of Posts and Communications (Article 9, Decision No. 705/1998/QD-TCBD, November 17, 1998) that requires registered domain names to comply with relevant provisions on copyright and intellectual property, which currently do not contain provisions on domain names. An applicant for a domain name must explain the relationship of the domain name to its business activities and is required to indemnify the ccTLD administrator against disputes arising from infringement of third parties' intellectual property rights.