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**THE INTERACTION OF FREEDOM OF EXPRESSION WITH TRADEMARK
RIGHTS IN DOMAIN NAMES**

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INTRODUCTION

Freedom of expression and right to property, including intellectual property, are both fundamental and important human rights and both are protected by several international and legal instruments. However, there is a need to strike a fair balance between them. In situations where freedom of expression is in conflict with trademark rights, trademarks tend to get stronger protection over freedom of expression.¹ The thesis focuses on the interaction of interaction of freedom of expression with trademark protection in domain names.

The growth of the internet and e-commerce has created new challenges for the protection of domain names as well.² It's common for a company to market and sell their products and services in web pages that contain their protected trademark in the domain name. However, sometimes others than the trademark holders register a domain name which includes a protected trademark. This could be done for cybersquatting, parody, criticizing or commenting on the trademark. In these cases the interests of domain name owners and their freedom of expression may conflict with the trademark holder interests.

The new media connected to internet has risen over recent years and that has intensified the conflicts between freedom of expression and trademark protection. Internet as a medium saw a rapid growth because of its global reach, low cost and easily accessible multidimensional platform for social, political and cultural communication. Internet can be seen as an important tool for enabling the creation of parody and criticism. At the same time with non-commercial use, it also offers a platform for commercial use such as marketing. This has drawn the trademark holders' attention to protect their marks in domain names and on web pages. On the other hand, freedom of expression enables the use of trademarks in both commercial and non-commercial expression by informing others but it also raises a question if freedom of expression is weakened disproportionately in the domain names due to strong protection of trademark rights.³

The thesis focuses on the collision situations of domain names and trademarks in situations where the protection of freedom of expression needs to be evaluated, especially when a domain name registrant uses defamatory words linked to another's trademark in a domain

¹ J. Lipton and M. Wong. Trademarks and Freedom of Expression in ICANN's New gTLD Process. – 38 Monash University Law Review 2012(1), p. 188.

² L. Bently and B. Sherman. Intellectual Property Law, 3rd ed. Oxford: Oxford University Press 2009, p. 724.

³ W. Sakulin. Trademark Protection and Freedom of Expression. An Inquiry Into the Conflict Between Trademark Rights and Freedom of Expression Under European Law. Great Britain: Kluwer Law International B.V. 2011. pp. 15–16.

name, such as “trademarksucks.com”. Disputes relating to freedom of expression usually rise in situations where the domain name is used to parody or criticise another’s trademark. The situations relate to finding a balance in the conflict situations pertaining to who has the right to a domain name and who has the right to freedom of expression as well as to which right should be protected over another, trademark rights or freedom of expression.

Some universal attempts to solve disputes regarding trademark rights and domain names have been established. Most notable one is the Universal Dispute Resolution Policy⁴ (UDRP) established by Internet Corporation for Assigned Names and Numbers (ICANN) in 1999. The Policy is incorporated into every domain name agreement which the domain name registrant makes with the domain name registering body. If any conflicts arise from registering the domain, the registrant is obliged to submit to the UDRP procedure on the basis of the agreement. The UDRP can be used only in situations where all three prerequisites are fulfilled, and the complainant has to show that the prerequisites are fulfilled in order to the complaint to succeed. The complainant must show that the domain name is identical or confusingly similar with the trademark of the complainant, that there is no legitimate use for the domain name by the registrant, and that the domain name has been registered or used in bad faith.⁵

However, the UDRP was established to handle issues of cybersquatting⁶ which means an act of registering or using a domain name either identical or confusingly similar to a protected trademark and bad faith intent to use it by profiting from such an act.⁷ Even though the purpose of the UDRP was not to solve other types of cases, i.e. cases concerning freedom of expression in domain names, the UDRP panels widened the arena of the system and several decisions have been given concerning cases that are not merely cybersquatting. These types of cases include situations where domain name has been used for criticism, parodying or defaming another’s trademark.

The aim of the research is to outline criteria how to strike a fair balance between trade mark protection and freedom of expression in cases where another’s trademark has been used in a domain name for parody or criticism. The thesis aims to provide insights into instances that make the trademark use in a domain name offensive and establishes a threshold for freedom

⁴ Uniform Domain Name Dispute Resolution Policy. Accessible at: <https://www.icann.org/resources/pages/policy-2012-02-25-en> (30.4.2019).

⁵ Uniform Domain Name Dispute Resolution Policy, *op. cit.*, para. 4(a)(i-iii).

⁶ World Intellectual Property Organization. The Management of Internet Names and Addresses: Intellectual Property Issues. Final Report of the WIPO Internet Domain Name Process, para. 135(i). Accessible at: <https://www.wipo.int/amc/en/processes/process1/report/finalreport.html> (30.04.2019).

⁷ *Ibid.*, para. 171.

of expression in those cases. It further aims to analyse this threshold and make conclusions to whether it is adequate and meets the current needs. The object of the study is on the trademark infringements in domain names and their connection to freedom of expression. The freedom of expression is in the central focus of the study and it is examined through cases related to domain name disputes cases that include the use of another's trademark in a domain name.

The primary focus of the study is the use of another's trademark in a domain name and the relation of this usage to freedom of expression. The subject is analysed from international and European perspectives. The study slightly touches upon cybersquatting but it is not to the main focus. The study also shortly analyses the use of personal names in domain names but the use of geographical names in domain names are not analysed. The used cases focus mainly on UDRP decisions by World Intellectual Property Organisation⁸ (WIPO) from ICANN's approved dispute resolution centers. WIPO has produced most decisions and the case law is comprehensive. The UDRP Policy and Rules are assessed. The thesis will not focus on the processual side of UDRP as it is not necessary for the analysis of the topic. The study relies on UDRP Policy evaluation and its developments through WIPO panel decisions, legislation, and legal literature to establish the extent of protection of the freedom of expression in context of domain names.

The thesis analyses these competing interests of trademark holders and domain name registrants in an attempt to answer the following questions:

- Whether domain names including parody or criticism can infringe trademark rights and how freedom of expression is protected in these cases.
- Does the current Policy of the UDRP adequately address the problems relating to freedom of expression in domain names in situations when the domain name includes another's trademark? These situations are narrowed down to situations such as including parody or criticism in a domain name.
- Does the current legal framework sufficiently guarantee freedom of expression in the field of domain names and are there any ways in which the situation could be improved if necessary?
- How could cases linked to trademark infringement and including freedom of expression in domain names be categorised within the UDRP? Could such categorisation be utilised to develop the UDRP system in parody and criticism cases?

⁸ Convention Establishing the World Intellectual Property Organization. Stockholm. 14.07.1967, e.i.f. 26.4.1970.

- What could be done in UDRP to secure the protection of freedom of expression? How could the process be improved to handle issues that are not merely cybersquatting? Or is it necessary to create new body for that?

The study attempts to categorise the infringement situations of trademarks in domain names under the UDRP Policy through cases that contain a clear connection to freedom of expression of the domain registrant. The study aims to find solutions for these types of diverse cases and sets forth recommendations to protect freedom of expression in domain names. The types of infringements include trademark parody, criticism, otherwise offensive words, and those that cause goodwill damage to the trademark. Trademarked personal names are investigated as well. The thesis tries to set new tools to make decisions in cases of trademark and freedom of expression conflict.

The hypothesis is that within the framework the UDRP the protection of trademarks takes precedence over freedom of expression, even in cases that are not mere cybersquatting. As the UDRP was mainly created to protect trademarks from the harms of cybersquatting⁹, it means that it is not necessarily well suited for situations where there is also freedom of expression concerned. The hypothesis thus focuses is in cases of parody, criticism or in otherwise offensive domain names including another's trademark.

Current state of knowledge regarding the problem is that some earlier studies have been conducted in the field of non-cybersquatting domain name cases and referred to in the thesis. The referred literature and journal articles most notably take into notice Jacqueline Lipton's research in the United States in the area of freedom of expression in domain names. The studies conducted in this area of conflict sometimes focus on cybersquatting only, without clear aspects on freedom of expression. The sources of the thesis include The Uniform Domain Name Dispute Resolution Policy¹⁰ and the Rules for the Uniform Domain Name Dispute Resolution.¹¹ In this study, mainly the UDRP decisions given by WIPO are referred to. This is because as a domain name dispute resolution center WIPO is the most popular among from all ICANN's approved dispute resolution centers and has thus produced most decisions.

⁹ World Intellectual Property Organization. The Management of Internet Names and Addresses: Intellectual Property Issues. Final Report of the WIPO Internet Domain Name Process, para. 134 (iv-v). Accessible at: <https://www.wipo.int/amc/en/processes/process1/report/finalreport.html> (30.04.2019).

¹⁰ Uniform Domain Name Dispute Resolution Policy, *op. cit.*

¹¹ Rules for Uniform Domain Name Dispute Resolution Policy. Accessible at: <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en> (30.4.2019).

The legal methods used in the study rely on traditional legal methodology like analysis. Analysis is carried through the whole study, also in assessing current state of research, relevant legal framework and relevant cases to the topic.

In the first chapter the basic elements of domain names and the domain name system are overviewed as well as the other governing organisations of internet and the general layout of internet governance. ICANN and its policies are presented. An overlook into UDRP Policy and Rules is provided for more comprehensive analysis of the topic. In the second chapter the point is on freedom of expression and its function on the internet world, more specifically in domain names. The international instruments protecting freedom of expression, the Universal Declaration of Human Rights¹² (UDHR), the International Covenant on Civil and Political Rights¹³ (ICCPR) and the European Convention on Human Rights¹⁴ (ECHR) are overviewed and their relation to protection of freedom of expression in the internet is analysed. Also, the relations between trademark rights and domain names are viewed. As a base for the analysis of the study, in the third chapter cases from WIPO decisions applying UDRP are used and based on the case analysis further recommendations are given.

Keywords

intellectual property, domain names, internet, freedom of expression

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¹² Universal Declaration of Human Rights. Paris. 10.12.1948, e.i.f. 3.1.1976.

¹³ International Covenant on Civil and Political Rights. New York. 16.12.1966, e.i.f. 23.03.1976.

¹⁴ European Convention on Human Rights. Rome. 4.11.1950, e.i.f. 3.9.1951.

I. THE EVOLUTION OF DOMAIN NAME CONFLICTS AND DISPUTE RESOLUTION

1.1. The emerging of conflicts in domain names

The internet has made it possible to trade across the world in a glimpse of an eye. The vast growth of e-commerce has made the worldwide direct sale of products and services a new normal but it has also brought some new issues relating to intellectual property rights, especially on trademarks and more specifically on the relationship between trademarks and domain names. Unfair trading and trademark infringements happen more frequently in the internet and the issues in domain names have raised attention both internationally and at national level.¹⁵ One of the most prominent problems in domain name space has been cybersquatting which means that in addition to registering a domain name including another's protected trademark, the registrant tries to sell the domain name to the person or entity that has legal rights to the registered name.¹⁶ It can be assessed that the growing of the internet has effected on creating the conflicts between domain names and trademarks as to who has a right to use a certain domain name if it includes a trademarked name. In turn, also easy registering of domain names have encouraged to internet to grow rapidly.¹⁷ Domain names are indeed essential in the world of internet and finding of and entering certain web pages. They are easier to remember and refer to than long IP-addresses that consist of numbers. Domain names consist on mixture of letters and numbers, usually words or abbreviations, but behind domain names, the internet functions through IP-addresses and binary numbers.¹⁸ At national level, cybersquatting has been targeted differently to prevent it from happening, whereas at the international level different approaches have been taken to address the new questions that are testing the legal systems globally. The establishment of Internet Corporation for Assigned Names and Numbers (ICANN) and the dispute resolution system, the UDRP, administered by World Intellectual Property Organisation (WIPO), among other operators, have been the most prominent approaches so far.¹⁹

It may not be easy to fit freedom of expression principles into the rather new media of internet world. Internet is a universal medium and thus contains cross-cultural behaviours on

¹⁵ L. Bently and B. Sherman, *op. cit.*, p. 724.

¹⁶ J. Lipton. *Internet Domain Names, Trademarks and Free Speech*. Edward Elgar 2010, p. 5.

¹⁷ Final Report of the WIPO Internet Domain Name Process, *op.cit.*, para. 49.

¹⁸ W. Cornish and D. Llewelyn. *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, 6th ed. London: Sweet & Maxwell 2007, p. 862.

¹⁹ L. Bently and B. Sherman, *op. cit.*, pp. 724-725.

expressing oneself. Although it brings out many new possibilities to express one's opinion from the other side of the world, at the same time it also creates many new problems that have never been faced in other types of more traditional media.²⁰ Freedom of expression is protected rather similarly in three instruments, the Universal Declaration of Human Rights²¹ (UDHR) Article 19, the International Covenant on Civil and Political Rights²² (ICCPR) Article 19 and the European Convention on Human Rights²³ (ECHR) Article 10. It is notable that the limitations to freedom of expression are similar in the instruments: they must be well established and provided by law, and they must be proportional and necessary to achieve the aims.²⁴

It can be argued that in contemporary world one of the most important functions of the internet is to enable people to express ideas and information globally. For domain name registrants, the worldwide function of the internet and domain names of course also means that the exact verbal form of a domain name that the registrant wants to register may already be registered by someone else, even if the registrant tried to register many closely similar names. Indeed, some people seek to register a name or a name closely resembling a name that he knows to have a certain commercial or other type of interest. These kinds of names can be the name of another's protected trademark or a name resembling it, for example "mcdonalds.com" and "macdonalds.com". Especially commercially valued trademarks can be in conflict with domain names as regards of who has the right to register them and use the web pages where these domain names direct to. The registrant may also register a celebrity's name or a certain geographical name. These kinds of cases have occurred a lot during the past decades and have been handled in dispute resolution systems as cybersquatting. As the technique develops, internet continues to grow and the markets and e-commerce globalise, it may create problems also to legislation and legal processes. In 1998 a non-profit organisation ICANN was established and it started to function as the registrant for generic top level domains such as .com, .org, and .int.²⁵ In the beginning of the new millennium, the number of cybersquatting cases started to grow in amount and effective systems to tackle cybersquatting were started to develop, which led into the creation of the UDRP. Traditionally trademark infringing type of action is cybersquatting and closely related to it is typosquatting.

²⁰ D. Cucereanu. Aspects of Regulating Freedom of Expression on the Internet. School of Human Rights Research Series, Vol. 27. Intersentia 2008, p. 215.

²¹ Universal Declaration of Human Rights. Paris. 10.12.1948, e.i.f. 3.1.1976.

²² International Covenant on Civil and Political Rights. New York. 16.12.1966, e.i.f. 23.03.1976.

²³ European Convention on Human Rights. Rome. 4.11.1950, e.i.f. 3.9.1951.

²⁴ D. Cucereanu, *op.cit.*, p. 217–218.

²⁵ W. Cornish and D. Llewelyn, *op. cit.*, p. 863.

1.1.1. Cybersquatting

Cybersquatting is a problem related trademarks and created by the emergence of domain names. Cybersquatting can be described as an act of registering or using a domain name that is either identical or confusingly similar to a protected trademark, and there must be the intent to use it in bad faith by profiting from the act.²⁶ The registering can happen speculatively and usually the domain name corresponds to a commercially valuable trademark. The profiting economically can come from selling the domain name or from using it.²⁷ For solving the issues of cybersquatting, ICANN adopted UDRP in 1999 and it quickly became the most attractive method to resolve the disputes related to cybersquatting.²⁸

1.1.2. Typosquatting

In typosquatting the registrant registers a domain name very similar to a well-known trademark, for example “tescp.com” instead of “tesco.com” Here, the registrant would expect internet users to mistype the word into their browser, when he could for example get revenues by forwarding the internet users to the real Tesco web page or he could have other plans for example criticising Tesco. It is sometimes hard to assess if the registrant has potential legitimate use for the name similar to a well-known trademark. In a case in United Kingdom the registrant registered a domain name “fcuk.com”.²⁹ The registrant claimed that he did not intend to sell it forward but to use it by himself as it might be useful name for internet and e-mail. However, the claim of the registrant could not be seen without a problem, as the wording “fcuk” is commonly used in the internet to access pornographic sites instead of the word “fuck”. Such case is also close to typosquatting.³⁰

1.2. Internet governance and the effect on the emergence of conflicts in domain names

During the recent decades, internet has become an important tool for disseminating and receiving information. It reaches worldwide but there is no common governor or common international regulations on the internet. The governance of internet composes of various private and public bodies of which some are as old as the internet and some newer. For these

²⁶ J. Lipton 2010, *op. cit.*, p. 5.

²⁷ J. D. Lipton. Who Owns “hillary.com”? Political speech and the First Amendment in Cyberspace. – 49 Boston College Law Review 2008(55), pp. 57 – 58.

²⁸ J. Lipton and M. Wong, *op. cit.*, p. 201.

²⁹ Judgement of the United Kingdom High Court in French Connection Ltd. v. Sutton, 2000 ETMR 341, Ch D.

³⁰ L. Bently and B. Sherman, *op. cit.*, p. 767.

reasons, the governance of internet is rather complex and it cannot be said to be transparent. The private bodies have usually focused more on the management and design tasks of the internet whereas the governments have had the tasks of facilitating the private bodies as their partners. At least in Western democracies, the governments have also not acted as harsh regulators of internet. The governance of the internet can thus be called to be a cooperative network where public and private entities work together but where lines of responsibility and funding are somewhat unclear. No worldwide treaty sets rules on how the internet should be governed and the powers disseminated. The governance of the internet is not outside either the ambit of international law or national laws but there is simply not such treaty framework that would define the central elements on the structure of internet governance. What plays more prominent role in governing the internet are contracts and quasi-contractual instruments.³¹

The internet has become an important new medium for communicating globally.³² As the e-commerce has increased so has the importance of internet and web pages since they have a major role in marketing and selling products and services. The functioning of the internet is based on Internet Protocol (IP) system where every computer is connected to this network and internet by its individual and unique IP-address.³³ Every computer has its own distinctive IP address and there cannot be two identical ones. In the IP system the IP addresses are created by rather long number series. However, as the internet became more popular and the use of it expanded from scientific functions, it became difficult to use several different numerical addresses.³⁴ For practical reasons, the number based IP addresses are transferred into domain names in Domain Name System (DNS).³⁵

1.2.1. The practical functioning of domain name system

Each of the unique IP addresses corresponds to a unique domain name. When a person logs into the internet through a server by using a domain name the DNS interprets the domain to its corresponding IP address.³⁶ A web page is thus a file saved on the server and readable by

³¹ L. A. Bygrave, and T. Michaelsen. *Governors of Internet*. – L. A. Bygrave and J. Bing. *Internet Governance. Infrastructure and Institutions*. Oxford: Oxford University Press 2009, p. 92.

³² P.B. Maggs et al. *Internet and Computer Law: Cases – Comments – Questions*. West Group 2001, p. 457.

³³ P. Jain and P. Sangeet Rai. *Copyright and Trademarks Laws Relating to Computers*, 1st ed. Eastern Book Company 2005, p. 89.

³⁴ P. Sugden. *Trademarks and Domain Names*. – Forder, Jay and Quirk, Patrick. *Electronic Commerce and the Law*. Australia: John Wiley & Sons 2003, p. 202.

³⁵ M. Froomkin. *ICANN's Uniform Dispute Resolution Policy – Causes and (Partial) Cures*. – 67 *Brooklyn Law Review* 2002(3), p. 615.

³⁶ S. Ghosh. *Domain Name Disputes and Evaluation of the ICANN's Uniform Domain Name Dispute Resolution Policy*. – 9 *Journal of Intellectual Property Rights* 2004, p. 425.

the internet users. It can be interpreted that domain name is part of the web site but sometimes the two terms are used simultaneously and there may not be such big difference between them. However, in day to day basis is friendlier for the internet user to use a DNS that is based on alphanumeric system than the totally numeric IP system. Domain names are easier to remember and also more comfortable to use in discussions.³⁷ The DNS system is a global domain name database which means that the DNS system and domain name database is distributed globally. This means that there are several servers so that the burden on a single server would not be too much and it also creates credibility on the working of the system.³⁸

The domain name system consists of different levels. The parts of the domain name are separated by dots. The first level of domains is usually in the most further right section of the domain name and are called top level domain (TLDs).³⁹ For example, in a domain `www.trademark.com` the “.com” is the top level domain. TLDs can further be divided into two groups: generic top level domains that contain organisational symbols and country code top level domains (ccTLDs) that contain country symbols. The gTLDs like .org, .net, .edu, .int, .gov and .mil. give information about the type of organization that has registered the domain and its area of activity.⁴⁰ In the three gTLDs .com, .org, and .net there are no restrictions in who can register them being a person or an entity.⁴¹ These gTLDs are registered based on ‘first come, first served principle’.⁴² The ccTLDs comprise of the country code two letters and indicate the country in which the domain owner operates.⁴³ For example .us indicates United States, .uk United Kingdom and .ge Germany. Each country thus has its own distinctive ccTLD. Both gTLDs and ccTLDs are generic in nature and open for registration by anyone.⁴⁴

The second level domain is located next on the left from the top level domain. In the example “`www.trademark.com`” the .trademark would be second level domain. This is the most common form of domain to be included domain name disputes.⁴⁵ Domain names can also have sublevel domains, for example in a domain name “`domain.trademark.com`” .domain

³⁷ M. Chissick and A. Kelman. *Electronic Commerce: Law and Practice*. London: Sweet & Maxwell 1999, p. 17.

³⁸ J. Lipton and M. Wong, *op. cit.*, p. 193.

³⁹ European IPR Helpdesk. Fact Sheet. Domain names and cybersquatting. European Union, 11/2017, p. 3. Accessible at: <https://www.iprhelpdesk.eu/sites/default/files/newsdocuments/Fact-Sheet-Domain-Names.pdf> (30.04.2019).

⁴⁰ *Ibid.*, p. 3.

⁴¹ K.Chia. *E-World*. S. York, and K. Chia. – *E-Commerce: A Guide to the Law of Electronic Business*. London: Butterworths 1999, p. 1.

⁴² L. R. Helfer. *International Dispute Settlement at the Trademark – Domain Name Interface*. – 29 *Pepperdine Law Review* 2001, p. 90.

⁴³ European IPR Help Desk, Fact Sheet, *op. cit.*, p. 3

⁴⁴ R. Stim. *Trademark Law*. Canada: West Legal Studies 2000, p. 99.

⁴⁵ European IPR Help Desk, Fact Sheet, *op. cit.*, p. 3

would be a sub domain. As can be seen it is located left to the second level domain. The third level of a domain name, also known as a subdomain, is located directly to the left of the second-level domain. The subdomain is not used in every domain name but it can be used to identify different sections on the web site. For example, in large organisations the sub level domain may correspond with different departments.⁴⁶ The part containing the www is not as relevant as a symbol since there is no concentrated control over it and the user may choose it freely. To ease the finding of the page, many still choose www. In 2011, ICANN launched a new gTLD program where the intention was to expand the domain name system and to make it possible to register new gTLDs such as .biz for business.⁴⁷ Some of the new gTLDs include domain names as .sucks and .crit for criticism and parody web sites. These kinds of gTLDs can be seen as enabling offensive expression, both commercial and non-commercial as well as political. The Council of Europe has also argued that restricting offensive expression through .sucks or .fail in gTLDs would restrict the ability of all speakers.⁴⁸ It might be argued that for freedom of expression it is limiting the scope if a person could not express his opinion through a domain name “trademarksucks.com” but merely under a domain name “trademark.sucks.com”. Though this arrangement might help to protect the trademark holders’ rights and the issue about the location of one dot might seem insignificant in registering the domain name, the limiting of freedom of expression under certain area of domain names is not without problems as it is still affecting the expression of one’s opinion without limits.

1.2.2. The development of Internet Corporation for Assigned Names and Numbers effecting on domain name conflicts and dispute resolution

When the internet was launched there was a company located in the United States called Network Solutions, Inc. It was responsible for registration of the domain names and was dominating the markets of domain name registration services of top level domains .com, .org, and .net. The management and allocation on the contrary was administered by a computer scientist Jon Postel working under contract with US Department of Defence. When internet became more global and continued to grow a central coordination body was needed and also competition for registration systems. The United States government saw that the changes were

⁴⁶ *Ibid.*, p. 3

⁴⁷ European IPR Help Desk, Fact Sheet, *op. cit.*, p. 3

⁴⁸ M. Zalnieriute and T. Schneider. A Council of Europe Analysis on ICANN’s Procedures and Policies in the Light of Human Rights, Fundamental Freedoms and Democratic Values, p. 30. Strasbourg: Council of Europe 2014. Accessible at: <https://rm.coe.int/icann-s-procedures-and-policies-in-the-light-of-human-rights-fundament/168073e0eb> (30.04.2019).

necessary, because the use of the internet became more commercial and the stability and further growth of the internet was needed to be secured which made the United States government concerned about the lack of competition in the area. The problems between trademark holders and domain name holders were already emerging as conflicts including cybersquatting, and the US government found that a solution would be a creating of new management system through a new corporate entity. The competitive registration system would also increase public trust to the system. ICANN was found to be the best to suit these requirements.⁴⁹ In 1998 ICANN was formed and based in California as a non-profit and public benefit corporation. The domain name system is so fundamental to the internet routing that the developments are needed. It is for the public easier to use than IP addresses Ensuring Accuracy, security, reliable routing by DNS is created.⁵⁰

ICANN now visibly manages the gTLD system, especially gTLDs such as .com, .org and .net. ICANN can be seen to belong to the first generation of internet governors, as does IANA. IANA (Internet Assigned Numbers Authority) is the entity that used to coordinate the registering of domain names between different registrars before ICANN. IANA's tasks included allocation of internet numbering resources and maintenance and distributing of IP registry.⁵¹ Now ICANN is in responsible of administrating the generic domain names.⁵² These organisations have functioned largely under the influence of individual persons through their contractual and thus private law nature.⁵³ Also, the tools of private law, such as contracts and other quasi-contractual instruments have their own prominent role in these organisations.⁵⁴ As there is no common definition for internet governance, it has been tried to explain as "development and application by governments, the private sector, and civil society, in their respective roles, of shared principles, norms, rules, decision-making procedures and programmes that shape the evolution and utilization of the internet".⁵⁵

However, ICANN is not an intergovernmental organisation, although governments participate in it and in discussions with each other through the Government Advisory Committee ('GAC'). Under ICANN's rules it is a mean to advice ICANN's activities in issues that relate

⁴⁹ L. A. Bygrave and T. Michaelsen, *op. cit.*, pp. 103–104.

⁵⁰ J. Lipton and M. Wong, *op. cit.*, p. 194.

⁵¹ The IANA Functions, ICANN. Accessible at: <https://www.icann.org/resources/pages/beginners-guides-2012-03-06-en> (30.4.2019).

⁵² Kur, Annette. UDRP. A Study by the Max-Planck-Institute for Foreign and International Patent, Copyright and Competition Law. Munich 2001, p. 6. Accessible at: http://www.zar.kit.edu/DATA/projekte/udrp_705937a.pdf (30.04.2019).

⁵³ L. A. Bygrave and T. Michaelsen, *op. cit.*, p. 93.

⁵⁴ *Ibid.*, p. 92.

⁵⁵ Working Group on Internet Governance. Report of the Working Group on Internet Governance. Château de Bossey 6/2005, p. 4.

to concerns of the governments. ICANN in turn promises to take into account the advices of GAC in adopting and formulating its policies.⁵⁶

1.2.3. Registering a top level domain name

Usually the registering of ccTLDs are administered by a special national institution that is within the borders of that specific country and authorised by ICANN. The ccTLDs maintained by a national registration authority are collectively represented at ICANN through the ccTLD Supporting Organization.⁵⁷ The legal bases of the national institutions vary a lot depending on the country. That can also be seen from the rules guiding the registering the domain names as some countries do not require the registrant to give any formal prerequisites to register a domain name. It is not required that the registrant is from the country in question but the registering is strictly based on ‘first come, first served principle’.⁵⁸ The generic TLDs such as .com, .net and .org are open in a way that there are no special demands upon the registrants. However, if someone wants to register the gTLDs .int .edu .gov or .mil, certain criteria need to be fulfilled.⁵⁹ The registering of a gTLD does not require the registrant to show any proof for his right to the name but the registering happens purely on ‘first come, first served principle’.⁶⁰

When registering the domain name, the liability to check the availability and not infringing or violating another’s trademark or rights is on the domain name registrant. In the UDRP policy it is stated that upon registering the domain name the registrant has to make sure that the registration of the domain name will not infringe upon or otherwise violate the rights of any third party, the registering of the domain name is not for unlawful purpose, and that the domain name will not be used in violation of any applicable laws or regulations.⁶¹ However in practice the rules are not always respected by the registrants as can be seen from the caseload for example at WIPO.

⁵⁶ J. Lipton and M. Wong, *op. cit.*, p. 195.

⁵⁷ J. Lipton and M. Wong, *op. cit.*, p. 195.

⁵⁸ J. Lipton 2010, *op. cit.*, p. 63.

⁵⁹ Final Report of the WIPO Internet Domain Name Process, *op.cit.*, para. 6.

⁶⁰ *Ibid.*, para. 48.

⁶¹ Uniform Domain Name Dispute Resolution Policy, *op. cit.*, para. 2.

1.3. The functions of domain names and resemblance to trademarks

The internet can be seen as a wide market place for products and services. The rules on trademarks affect internet markets as well as other more traditional market places.⁶² The internet users may see the domain name as an address but also as a name or a symbol for the company it was registered for. The consumer connects the given domain to a company that has registered it and keeps up the web page as well as to its products. The consumer can also see the domain as a certain type of guarantee for quality of the product or service which earlier traditionally belonged to the function of trademark and now also to domain names⁶³

The companies also generally use domain names in connect with marketing their products so they can be a way to separate the company from its competitors and to advertise their own products with a catchy domain. Domain names are easy to remember and by remembering them from advertisements the customer can easily find a web page containing the products or services from a certain provider he is looking for and from whom he wants to purchase the product or service.⁶⁴

It has been stated that there are at least two functions to domain names. The first would be to serve to describe the underlying web content, similarly to a title describing the content of a book, a movie or a song. The second would be to identify the work through a label that the domain name serves as and by letting people to refer to the webpage in discussions, similarly to referring to a relevant work.⁶⁵ Also, in a day to day basis and conversation, it is easier to refer to the domain name than to the content on the webpage.⁶⁶

The nature of the domain names is contractual because what govern the system are the terms of the contract between the domain name registrar who administrates the domain names and each domain name registrant. The parties usually are subject to submit the dispute rising from domain names and trademarks to a relevant dispute resolution procedure, such as the UDRP. Usually, the matters are solved in dispute resolution systems but they do not shut out domestic court proceedings and applying of traditional types of IP law such as trademark law and laws

⁶² S. Maniatis. Trade Mark Use on the Internet. – Phillips, Jeremy and Simon, Illanah. Trade Mark Use. New York: Oxford University Press 2005, p. 278.

⁶³ R. Stim, *op. cit.*, p. 99.

⁶⁴ P. Sugden, *op. cit.*, p. 202.

⁶⁵ J. Lipton. Commerce versus commentary: Gripe Sites, Parody, and the First Amendment in Cyberspace. 84 Washington Law Review 2006(6), p. 1327.

⁶⁶ J. D. Lipton 2008, *op. cit.*, p. 121.

on unfair competition. In general, the judicial system is used if the matter cannot for some reason be solved in the context of dispute resolution system.⁶⁷

In the internet, the domain names may seem to appear very similar to each other, but in practice even a single digit makes a difference. The domain names that have even a single digit apart from each other lead to different web pages and potentially to different service providers. Since the domain name registers function on the ‘first come, first served principle’, it means that the first to register a domain gets to use it for his own purposes. Sometimes, this can lead to a situation, where a registrant tries to register as many attractive domain names as possible, to benefit from the principle. These domain names may resemble each other and the person registering them may have different reasons for registering an exact verbal form of the domain. Sometimes, these situations lead to competitions when two or more registrants have their own reasons for a certain verbal form of a domain. These types of competitions are increased by the fact that domain names are not limited to certain type of products and services what is on the contrary to trademarks. The world of domain names is very different compared to that of the trademarks because domain names can be used also for purposes that do not include trading at all. They can serve as providing information criticism, expressing one’s opinion out loud, socialising on web page chats etc.⁶⁸

1.4. Uniform Domain Name Dispute Resolution System

In 1999 ICANN started to apply the UDRP between conflict situations of trademark rights and domain names. UDRP was meant to be an efficient, economical and just process to the disputing parties.⁶⁹ The UDRP process was developed to be targeted at solving conflicts of clear and simple trademark infringements in domain names.⁷⁰ However, the process and the decisions in it have little by little expanded from the original idea. This is a problematic aspect since the process was created for certain type of cases and it may not be as suitable for cases that might be more extensive and complex as including also fundamental rights such as freedom of expression. Through these difficulties it can be noticed that there is not clear consensus in UDRP decisions. The decisions may vary according to deciding panel and facts and broadness of the case as well as its link to freedom of expression. As a result, this may be seen to endanger the reliability of both the process and the system itself.

⁶⁷ T. Cook and A.I. Garcia. *International Intellectual Property Arbitration*. Great Britain: Kluwer Law International B.V. 2010. p. 59.

⁶⁸ W. Cornish and D. Llewelyn, *op. cit.*, p. 862.

⁶⁹ Final Report of the WIPO Internet Domain Name Process, *op.cit.*, para. 134.

⁷⁰ *Ibid.*, para. 135(i).

One aspect of the UDRP is that its decisions are final. In that way it is arbitral-like, although the decisions are made public. The decisions made by the UDRP panels cannot be appealed within the system as there is no appellate process within in. It could be argued that the non-coherency of the panel decisions could be deducted if an appellate system would be created. Of course it would mean that in total the process might last longer for some cases and the use of the UDRP as a process would not be as efficient as it now is as some parties might have to wait for the final and enforceable decision for a longer period of time. However, the handling of the case in the UDRP system does not exclude taking the dispute into competent domestic courts before the proceeding is commenced or after it has been concluded.⁷¹

Even though the UDRP process does not exclude taking the case to traditional litigation, the nature of the UDRP as an alternative dispute resolution can be seen to be used as contrary to judicial proceedings. The benefits of the UDRP process are that it can be seen as more efficient and economically friendly to the parties when compared to those features of traditional court proceedings. Also, the UDRP offers a low threshold solution to handle domain name disputes in globalizing world where the domain names usually also have international nature.⁷² Such cases having global aspect might be more expensive and more complicated to handle in competent domestic courts. Thus, the UDRP has provided an affordable and suitable solution to handle domain name disputes and trademark infringements having also global nature. When the UDRP was developed, it was meant to be quite concise in relation to what type of cases it handles. Initially, the process was meant to handle clear infringements of trademarks through domain names meaning the cases limited to cybersquatting.⁷³

From its incorporation, the UDRP has globally been very popular amongst dispute resolution systems. Since the incorporation of the UDRP in 1999, the amount of cases WIPO alone has handled is in total over 43 000. The cases have included over 79 000 disputed domain names from 179 countries.⁷⁴ The UDRP has noticeably proved to be effective and economically friendly solving cases related to cybersquatting. The policy reflects that the process for solving cybersquatting cases should handle the case promptly and without great expenses to the parties of the dispute resolution.⁷⁵ In addition of the UDRP applying to general top level domains, WIPO has been appointed as a service provider in domain name disputes handling

⁷¹ Uniform Domain Name Dispute Resolution Policy, *op. cit.*, para. 4(k).

⁷² Norton, Ben. Constitutional Internationalization of ICANN's UDRP. – 29 Arizona Journal of International & Comparative Law 2012(1), p. 137.

⁷³ Final Report of the WIPO Internet Domain Name Process, *op.cit.*, para. 135(i).

⁷⁴ WIPO Caseload Summary. World Intellectual Property Organisation. Accessible at: <https://www.wipo.int/amc/en/center/caseload.html> (30.4.2019).

⁷⁵ Final Report of the WIPO Internet Domain Name Process, *op.cit.*, para. 134.

country code top level domain of over 70 states.⁷⁶ Alone in year 2018 3452 cases were filed⁷⁷ and more can be expected in the upcoming years as the tradition has eminently been increasing.

1.4.1. Uniform Domain Name Dispute Resolution as an alternative dispute resolution system

For domain name disputes it is quite general that they are solved by various extra-judicial services such as alternative dispute resolution systems. These systems are usually low cost and simpler forms of arbitration. Traditional litigation at courts is usually commenced only if other dispute resolutions do not fit to the case for some reason. Because there is no governing structure on the internet or direct basis in treaties, but the system is based on contracts, it can be claimed that dispute resolution is better suited to this contractual system than court litigation.⁷⁸ Traditionally, however, intellectual property disputes have not been solved that much by alternative dispute resolution.⁷⁹ The situation has since changed and there are a lot of incentives from the parties of IPR disputes to avoid litigation. Dispute resolution has also become more commonly used by international bodies such as WIPO. The WIPO Arbitration and Mediation Centre was established already in 1994 but it later became to include the compulsory arbitration in domain name disputes under ICANN's UDRP. Of all ICANN approved dispute resolution services available, WIPO provides over half, making it the largest dispute resolution organisation that also publishes its decisions, unlike traditional arbitral awards. ICANN's policy and procedures are mandatory to domain name registrant through the internet registration agreement which requires the registrant to be subject to the dispute resolution. ICANN's UDRP applies to generic top level domain names and WIPO provides dispute resolution services also to country-code domains for countries where WIPO has been appointed as the chosen dispute resolution body.⁸⁰

ICANN has the powers through a contractual relationship with domain name registrars and those who want to register domain names, called domain name registrants, to vary the terms of the registrations. ICANN also has power to make relations with other independent bodies and this it has done in setting up a dispute resolution system. These dispute resolution bodies adjudicate the disputes regarding domain name registration, and through ICANN's

⁷⁶ WIPO Caseload Summary, WIPO, *op. cit.*

⁷⁷ *Ibid.*

⁷⁸ L. A. Bygrave and T. Michaelsen, *op. cit.*, p. 93.

⁷⁹ T. Bettinger. *Dom Domain Name Law and Practice: An International Handbook*. Oxford: Oxford University Press 2005, pp. 1097–1098.

⁸⁰ T. Bettinger, *op. cit.*, p. 1098.

contracting nature it binds all the domain name registrants to accept this jurisdiction. The domain name dispute resolution is governed by ICANN's Uniform Dispute Resolution Policy (UDRP) and Rules for Uniform Domain Name Dispute Resolution Policy. Even though there are a couple of adjudication service providers approved by ICANN, WIPO has become the most important and the most used one with vast amount of cases solved. The decisions vary but a possible and a usual outcome is that the registrar is ordered to transfer the domain name to the complainant, usually trademark holder, if the domain name registrant is not entitled to keep it under the UDRP Policy. The dispute resolution functions almost entirely in the internet and the independent panellists deciding the cases may be appointed by the adjudication service provider from all over the world within their field of expertise.⁸¹

In the UDRP proceedings the complainant has to show three elements that are cumulative. The complainant also has to bear the costs of the proceedings. The remedies the complainant can seek from the UDRP are the transfer of the domain name to the complainant or cancellation of the domain name. However, majority of the decisions end up in transferring of the ownership of the domain from the initial registrant to the complainant. Many disputes regarding domain names and submitted to UDRP include the registration of trademarks or trademark variants as domain names. These include the issues of cybersquatting and typosquatting that both fit under the scope of the UDRP Policy. In such cases the registrants of domain names may also wish to receive advertising revenue through click-through programs by registering variants of trademarks as domain names.⁸² Some registering trademarks as domain names for criticism purposes may also purchase trademarks as ad-words meaning that in the sponsored results of internet search machines a link to a criticism page is listed at the top.⁸³

1.4.2. The nature of the Uniform Domain Name Dispute Resolution System as a dispute resolution service

As an alternative dispute resolution the UDRP is meant to solve the disputed domain name relating to trademark rights between the parties. The legal basis of the UDRP is based on the contract between the domain name registrant and the registrar that means the body offering domain name registering services. When one registers a domain name, he accepts UDRP Policy and Rules in the case disputes rise from it.⁸⁴ As the UDRP is based on contracts, it is

⁸¹ W. Cornish and D. Llewelyn, *op. cit.*, p. 864.

⁸² *Ibid.*, p. 1099.

⁸³ W. Sakulin, *op. cit.*, p. 323.

⁸⁴ Kur, *op. cit.*, p. 10.

not in its nature as such valid and binding rules in any legal system. The validity and coerciveness of the rules in a certain individual case is based on contracts between two different entities. It can be said that the legal nature of the UDRP is very unique. In the decisions the panel in their assessment can apply any rules suitable, such as national codifications or case law, or international agreements in the meaning of public international law. The process in itself is arbitration like but differs in a sense that it does not prohibit the possibility of judicial proceedings in competent domestic court of the parties. Also, the award is made public and the award binds only the registrar who has to transfer or close the domain name according to the panel decision.⁸⁵

At the beginning of initiating the UDRP Policy, WIPO suggested that it would be the only dispute resolution body to offer the UDRP process. However, ICANN did not approve this suggestion but gave other entities also the possibility to provide dispute resolution services under the UDRP. It would have been problematic, if WIPO would have had a monopoly on serving UDRP since it might have affected increasingly on prices of the proceedings if there was no competition. Although WIPO is still the largest body, in the amount of the decisions, to offer the service, there is competition on what it comes to prices. It cannot be merely assumed that WIPO would have stayed as a neutral body if it had offered the UDRP alone because its main purpose in the initial suggestion was to protect trademark rights.⁸⁶

At the moment, WIPO provides the largest amount of domain name dispute resolution services under UDRP but alongside with WIPO there are three other ICANN approved bodies offering UDRP process: the National Arbitration Forum (NAF), the CRP Institute for Dispute Resolution (CRP) and the Asian Domain Name Dispute Resolution Centre (ADNDRC).⁸⁷ Also some domestic domain name registration authorities have appointed WIPO as the official dispute resolution center in ccTLD issues.⁸⁸ Other countries, such as the United Kingdom, have set up their own adjudicatory panels for solving domain name disputes regarding their .uk ccTLDs. The UDRP Policy has generated essential rules in the area of domain names through its large amount and strong base of case law, though they do not act as precedencies to further decisions. Interestingly, the UDRP Policy encourages the panels to apply in their decisions any rules and principles of law that they find applicable.⁸⁹ This can of

⁸⁵ Kur, *op. cit.*, p. 10.

⁸⁶ M. Froomkin, *op. cit.*, p. 672.

⁸⁷ List of Approved Dispute Resolution Service Providers, ICANN. Accessible at: <https://www.icann.org/resources/pages/providers-6d-2012-02-25-en> (30.04.2019).

⁸⁸ Domain Name Dispute Resolution Service for Country Code Top Level Domains (ccTLDs). World Intellectual Property Organisation. Accessible at: <https://www.wipo.int/amc/en/domains/cctld/index.html> (30.04.2019).

⁸⁹ W. Cornish and D. Llewelyn, *op. cit.*, pp. 864–865.

course be one of the things that make the system rapid and more affordable, providing expertise from all over the world and best suitable for the case at hand. However, there is also a downside to it, as the panels can choose the applicable rules and suitable earlier panel decisions, they can emphasise different points in similar kind of cases. Even though the panels are not required to treat the decisions as precedencies, the later decisions tend to refer to the reasoning of older decisions, some in extensive manner.⁹⁰

1.4.3. Initiating the Uniform Domain Name Dispute Resolution Process

The domain name complaint in the UDRP process cannot succeed unless the complaint meets certain cumulative requirements. There are three of these substantive conditions: (a) the respondent's domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights, (b) the respondent has no rights or legitimate interests in the domain name, and (c) the respondent's domain name has been registered and is being used in bad faith.⁹¹

According to the UDRP Policy, the process is initiated by the complainant by submitting the complaint to an ICANN approved dispute resolution provider. The provider is thus chosen by the complainant.⁹² The respondent is informed of the complaint and the respondent is reserved time to respond.⁹³ The whole process is flexible and communicated via internet⁹⁴ unless the chosen panel decides that it is necessary to have in-person hearing⁹⁵. The panel needs to confirm that the parties will be treated equally and that each party has their opportunity to give their opinions.⁹⁶ The panel will decide the case on the basis of submitted documents and statements of the parties.⁹⁷ After giving the decision ICANN enforces the decision and the decision will be made public.⁹⁸ As discussed above, ICANN takes care of the administration of domain names but it also enforces the decision given by the UDRP panel either by cancelling the domain name or by transferring it to the trademark holder.⁹⁹ However, ICANN will not interfere in any other way with the UDRP process.¹⁰⁰

⁹⁰ WIPO Arbitration and Mediation Center, *Bakers Delight Holdings Ltd v. Andrew Austin*, D2008-0006.

⁹¹ Uniform Domain Name Dispute Resolution Policy, *op. cit.*, para. 4(a).

⁹² Rules for Uniform Domain Name Dispute Resolution Policy, *op. cit.*, para. 4(d).

⁹³ *Ibid.*, para. 5(a).

⁹⁴ *Ibid.*, para. 2(b).

⁹⁵ *Ibid.*, para. 13.

⁹⁶ *Ibid.*, para. 10.

⁹⁷ *Ibid.*, para. 15(a).

⁹⁸ *Ibid.*, para. 16.

⁹⁹ Uniform Domain Name Dispute Resolution Policy, *op. cit.*, para. 4(i).

¹⁰⁰ *Ibid.*, para. 4(h).

Importantly, the UDRP process and domestic court proceedings do not shut each other out. According to UDRP Policy “the mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded.”¹⁰¹

1.4.4. The Uniform Domain Name Dispute Resolution System protecting trademark rights

As regards of the caseload of over 43 000 cases in WIPO alone¹⁰², the UDRP can be seen as a success for ICANN. UDRP has earned respect internationally as an alternative dispute resolution system to resolve trademark disputes of multiple national jurisdictions and in many cases it has been preferred over domestic litigation. It still is the only global and non-judicial dispute resolution system in trademark related issues. It was the first policy developed that was binding on the ICANN accredited registrars and through these agreements the registrars become bound on the UDRP.¹⁰³ This means that the application of the UDRP has spread globally since it has been uniformly adopted by the accredited registrars.

At least in cases where trademark interests are protected in domain names, UDRP is found to be a great success. How it suits to protecting other rights is a different thing. It can be claimed that it merely suits to cases involving cybersquatting and it tends to protect the rights of trademark holders. Trademark holders may favour UDRP over traditional domestic court proceedings because it is more cost friendly to file the complaint, it is global, it is somewhat fast to give the decision when compared to court proceedings, and through its trademark favouring solutions it may seem more attractive to trademark holders. It can even be claimed that since the trademark holders have had such a great success in the UDRP during the years that the whole system is automatically favouring the complainants. Some claim that the whole system and the panellists used in dispute resolution are biased through this favouring.¹⁰⁴ However, the questions around the UDRP system relate to its development and should any development happen within it, as the system was merely set up to handle certain situations and has not been developed accordingly to the changing situations in the developing and globalising world.

¹⁰¹ *Ibid.*, para. 4(k).

¹⁰² WIPO Caseload Summary, WIPO, *op. cit.*

¹⁰³ J. Lipton and M. Wong, *op. cit.*, p. 202.

¹⁰⁴ *Ibid.*, p. 203.

II. BALANCING OF FREEDOM OF EXPRESSION AND TRADEMARK RIGHTS

2.1. The importance of trademark protection

When compared to trademarks, the domain names currently have similar functions to them. In the rise of the internet, the original meaning of the domain names can be seen to have been granting an access for internet users to a web page they want to reach and thus easing the communication via internet. However, the internet has since developed, globalised and commercialised and the meaning of domain names has also altered and began to have a visible role in e-commerce. In the contemporary world, domain names can be seen as important to business and companies as are their trademarks since the functions of domain names are similar to those of trademarks on nowadays markets. The distinctiveness of marks on the markets is essential for several reasons, for identification of goods and services, for marketing, for protection of business and for adding value to the products.¹⁰⁵ According to the Court of Justice of the EU (CJEU) the registration of the trademark is meant to protect both the trademark holder and the consumer.¹⁰⁶ On the markets, the products can be distinguished from others with the help of trademarks and the trademarks function as an identifier and guarantee on origin of the goods and services. The function of a trademark is also to guarantee the quality of the product and the source of production of the product by a certain company.¹⁰⁷ The identification of the product also has another side as by being recognizable the trademark holder also publically takes responsibility of the product and its quality. However, the trademark has to indeed be distinctive to fulfil these functions as in trademark law only marks distinctive from others can be protected. Registration cannot be granted to marks that are too generic.¹⁰⁸

In the area of the EU the same rights to trademarks are granted and enforceable as there is full integration on trademarks. Also, within the EU, a Community Trade Mark is recognised, meaning, that the same trademark obtained is valid in the whole EU.¹⁰⁹ This also means that the procedure for defending the right to the mark in all EU countries is commenced through a

¹⁰⁵ A. Michaels and A. Norris. *A Practical Guide to Trade Mark Law*, 5th ed. Oxford: Oxford University Press 2014, p. 7.

¹⁰⁶ C-39/97, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, EU:C:1998:442, 29.09.1998.

¹⁰⁷ T. Aplin and J. Davis. *Intellectual Property Law: Text, Cases, and Materials*. Oxford: Oxford University Press 2013, pp. 318–320.

¹⁰⁸ A. Michaels and A. Norris, *op. cit.*, pp. 7–8.

¹⁰⁹ Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, adopted 20.12.1993.

single procedure making it affordable to the trademark holders. If the Community registered trademark is in conflict with a national mark, the latter prevails.¹¹⁰

The main rule about trademarks and registering them is that there has to be a distinctive character to a trademark. However, the registration of a trademark is to be allowed also if the trademark has become customary in language and it has established practices of trade, or if it had distinctive character before the registration was applied and following its use.¹¹¹

2.1.1. Common law trademark

Under the UDRP, some trademark holders can claim to have established common law trademark rights. This means that the trademark has not been registered but the rights can be established by using it in business so that consumers are exclusively associating the mark with the products of the mark owner. If the mark owner wants a domain name be transferred to him by claiming to have unregistered common law rights on the mark, he has to provide supporting evidence on this. It is not enough simply to state that the trademark has been used for a good period of time but to show evidence that can be for example recognition by consumers or in media, advertising, sales volumes or surveys. What is prominent is how the customers see the mark and the mark owner needs to show the meaning the mark has to those customers. In absence of providing evidence, the complaint can be dismissed in the UDRP Process.¹¹² Also celebrities can claim to have common law rights on their name but the burden of proof is on them to show evidence that they are known by their name in a way that it has the characteristics of a trademark.

2.1.2. The global use of trademarks

The World Intellectual Property Organization (WIPO), an intergovernmental organisation was established by the WIPO Convention in 1970 to become a specialized agency of the United Nations.¹¹³ According to the Convention Article 3 the objective of the organization is to “promote the protection of intellectual property throughout the world through cooperation

¹¹⁰ A Jolly and J. Philpott. *The Handbook of European Intellectual Property Management*, 2nd ed. London: Kogan Page 2009, p. 5.

¹¹¹ T. Aplin and J. Davis, *op. cit.*, pp. 327–328.

¹¹² J. Soong-Hoon Chay and B. Beckham. Keeping track of domain name jurisprudence. WIPO Arbitration and Mediation Center, WIPO Magazine 10/2017. Accessible at: https://www.wipo.int/wipo_magazine/en/2017/05/article_0008.html (30.04.2019).

¹¹³ Summary of the Convention Establishing the World Intellectual Property Organization (WIPO Convention) (1967), World Intellectual Property Organisation. Accessible at: https://www.wipo.int/treaties/en/convention/summary_wipo_convention.html (30.04.2019).

among States and, where appropriate, in collaboration with any other international organization".¹¹⁴ It also aims at ensuring administrative cooperation among the Unions¹¹⁵ that are established by the WIPO administered treaties.¹¹⁶ WIPO was based on the International Bureau for the Protection of Intellectual Property from 1893 and it now administers several intellectual property related treaties including the Paris Convention for the Protection of Industrial Property (hereinafter the Paris Convention) which applies to trademarks also.¹¹⁷ The aim of the convention is to ensure the protection of creators' intellectual works in other countries. However, the filing and registration of marks are left to be determined by the domestic laws of the contracting countries and not regulated by the Paris Convention.¹¹⁸

As the protection to trademarks can be filed at national level through registering the mark by an application to relevant trademark office, the registering is different to get protection to the mark at international level. Internationally, the mark owner can either file application in several countries where he wants to get the mark protected or he can use the Madrid System. WIPO administrates the Madrid System for the International Registration of Industrial Designs. By a single application, a trademark holder can apply for worldwide protection to the mark. The system can be used if the person is domiciled, has commercial or industrial business or is a citizen of any of the countries covered by the Madrid system.¹¹⁹ Also, the protection of a community trademark can be extended internationally through the Madrid System. This also works vice versa, as the international marks can be extended to the EU via the System.¹²⁰

The establishing of these types of registering systems implies that the arena of trademarks has globalized and need for easier protection globally is current. This also implies that the disputes reach more globally than ever. Through the similar function of trademarks and domain names, it can be assessed that also the function of domain names as well as the disputes are reaching more global and the need for globally recognised systems and dispute settlement policies are needed. This also mirrors to cases where freedom of expression is included.

¹¹⁴ Convention Establishing the World Intellectual Property Organization. Stockholm. 14.07.1967, e.i.f. 26.4.1970. Art. 3(1).

¹¹⁵ *Ibid.*, Art. 3(2).

¹¹⁶ Summary of the Convention Establishing the World Intellectual Property Organization, *op. cit.*

¹¹⁷ Paris Convention for the Protection of Industrial Property. Paris. 20.03.1883, e.i.f. 07.07.1884.

¹¹⁸ *Ibid.*, Art 6(1).

¹¹⁹ Madrid – The International Trademark System. World Intellectual Property Organisation. Accessible at: <https://www.wipo.int/madrid/en/> (30.04.2019).

¹²⁰ A. Jolly and J. Philpott, *op. cit.*, p. 6.

2.1.3. Confusability of trademarks and well-known marks

The TRIPS Agreement impacts highly on the intellectual property rights. The Agreement is administered by World Trade Organization (WTO) and the aim of the Agreement is to provide effective enforcement for IPRs in disputes relating to them between the member states of the WTO.¹²¹

The state parties to TRIPS Agreement are required to apply the standards of Paris Convention on trademarks.¹²² As regards of trademarks, the TRIPS Agreement is strongly based on the principle of confusability. In TRIPS Agreement 16(1) it is stated that the holder of a mark has an exclusive right to prevent unauthorized use of a mark identical or similar to his registered mark in trade of goods or services identical or similar to the ones that have the registered mark if such use is causing likelihood of confusion.¹²³ Thus, when assessing the likelihood of confusion, the use of the mark needs to concentrate on identical or similar kind of products and services. This may also be seen as a downside to the provision in the trademark holder's view.

However, the rules are a bit different concerning famous or well-known marks. For example, both the EU Trademark Directive Art and the TRIPS Agreement Article cover famous marks. In the trademark directive the use of the earlier mark needs to be unjustified or to be harming to the separation or reputation of the earlier mark.¹²⁴ The Paris Convention gives protection to well-known marks but TRIPS Agreement takes the protection even further as the Art. 16(3) of TRIPS Agreement extends the Paris Convention provision also to cases where the use of an identical or similar mark in different goods and services creates a false connection and where such use is damaging the registered mark.¹²⁵

2.2. The importance of protecting freedom of expression in the internet

It can be claimed that freedom of expression and freedom of opinion, including the freedom of information, are cornerstones and prerequisites of democratic society.¹²⁶ When assessing

¹²¹ T. Aplin and J. Davis, *op. cit.*, pp. 26–27.

¹²² Agreement on Trade-Related Aspects of Intellectual Property Rights. Marrakesh. 15.4.1994, e.i.f. 1.1.1995. Art. 2(1).

¹²³ *Ibid.*, Art. 16(1).

¹²⁴ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, adopted 16.12.2015. Art. 5(2)

¹²⁵ W. Cornish and D. Llewelyn, *op. cit.*, p. 636–637.

¹²⁶ J. Kortteinen et. al. Article 19. – G. Alfredsson, and A. Eide. The Universal Declaration of Human Rights. A Common Standard of Achievement. The Netherlands: Kluwer Law International 1999, pp. 404, 410.

freedom of expression, several aims can be identified such as search for and the exchange of information and ideas and the discovery of the truth. Importantly, freedom of expression can also form a basis for forming informed opinions. In addition to self-expression, through freedom of expression an individual can aim for participation in public life at various levels, protecting other rights and legitimate interests, progress of society as a whole. The function of freedom of expression as search and exchange of information and ideas as the basis for forming informed opinions, for pluralism and tolerance, and the discovery of truth, can be described to be the basis for other aims of freedom of expression. It can be said that an informed person with opportunities both to find and receive information and opinions and to impart his own ideas is better prepared to participate in democratic society. Also, a person practicing his freedom of expression is said to be aware of his own strengths or weaknesses as well as rights and obligations. It can be said that freedom of expression enhances diversity of views if free exchange of information and opinions is enabled. All in all, to exercise freedom of expression, it enhances wider tolerance in relations with others in society.¹²⁷

Freedom of expression is protected by notable international instruments; the UDHR, the ICCPR and the ECHR. The Universal Declaration of Human Rights can be seen as the greatest achievement in the history of human rights. It was drafted by people from around the world as a common standard for all nations as it sets out universal standards of fundamental human rights and was promulgated in 1948 by the United Nations General Assembly. Article 19 of the UDHR protects freedom of opinion and expression in the following: “Everyone has the right to freedom of opinion and expression; this right includes freedom to hold opinions without interference and to seek, receive and impart information and ideas through any media and regardless of frontiers.”¹²⁸

The UDHR served as a basis when two covenants were adopted by the United States General Assembly in 1966. They were the International Covenant on Civil and Political Rights (ICCPR) and the International Covenant on Economic, Social and Cultural Rights (ICESCR) both of which have binding status under international law. With the Covenants and the UDHR they collectively form the “International Bill of Human Rights.” In the ICCPR freedom of opinion, expression and information is guaranteed by Article 19.¹²⁹ In the ICCPR it is notable that there is a clear distinction between freedom of expression and freedom of opinion. Of these, freedom of expression is subjected to certain limitations whereas freedom of opinion is subjected to no restrictions. Also, even though right to communicate is not as such referred

¹²⁷ D. Cucereanu, *op. cit.*, p. 9.

¹²⁸ Universal Declaration of Human Rights, *op. cit.*, Art. 19.

¹²⁹ International Covenant on Civil and Political Rights, *op. cit.*, Art. 19.

to in ICCPR it can be seen to be included in freedom of information.¹³⁰ States are still sovereign under international law, and it can be asked if they should be sovereign in internet and to what extent.

UDHR can be seen as a universally accepted instrument. Also ICCPR has parties and signatories almost universally so it should be assessed that the principles the instruments embody are universally accepted. However, it can be asked if internet as a universal medium can be regulated by this basis from the point of view of freedom of expression.¹³¹ This would mean that there would have to be universal application of the principles in every situation, no matter from which part of the world the expression is originated from. However, it can also be asked if there should be any individual margin of appreciation regionally or domestically because of cultural differences.¹³² Because a trademark infringement in domain name can be committed by someone from different part of the world, in domain name related issues these types of cultural differences should not be seen. Freedom of expression should be given the same standards in domain names globally.

When assessing freedom of expression protected by the UDHR, it is notable that by its original meaning the right established in the UDHR to receive and impart information is an individual right. The aim in establishing this right was to promote flow of information in all directions and without frontiers and obstructions. The states that are parties to human rights treaties agree voluntarily to be bound by international law and protect human rights universally at least to the standard set in the treaties. Also, Article 19 of the UDHR can be seen as a general principle of law on freedom of expression and it is binding on the member states of the United Nations. Thus, the freedom of expression can be considered to have the nature of customary international law.¹³³

Regarding freedom of expression in the internet, the UN Human Rights Council (hereinafter the HRC) has adopted a resolution where it has stated that “The same rights that people have offline must also be protected online”.¹³⁴ The HRC has recognised the fast transformation of the internet into a global medium where all types of expression must be allowed. The online freedom of expression was once again reaffirmed by the UN Human Rights Council in a resolution in 2018. The online freedom of expression being a human right is thus seen

¹³⁰ J. Kortteinen et. al., *op. cit.*, pp. 410–411.

¹³¹ D. Cucereanu, *op. cit.*, p. 219.

¹³² *Ibid.*, p. 219.

¹³³ J. Kortteinen et. al., *op. cit.*, p. 403.

¹³⁴ United Nations Human Rights Council. Resolution 20/8. The promotion, protection and enjoyment of human rights on the Internet. 18 July 2016, A/HRC/RES/32/13. Accessible at: https://digitallibrary.un.org/record/731540/files/A_HRC_RES_20_8-EN.pdf (30.4.2019).

applicable by all media and regardless of frontiers.¹³⁵ It should be discussed at international level, if the relevant articles of the international instruments, Art. 19 of the UDHR and Art. 19 of the ICCPR, respectively, should be amended to take into notice the rapid development of internet during the past decades. The international instruments should observe domain names as a communications medium of the internet and protect freedom of expression also in domain names by the level of both internationally binding and morally obliging instruments.

2.2.1. Freedom of expression under the European Convention on Human Rights

In the European Convention on Human Rights, Article 10 protects the freedom of communication. It entails freedom of expression, freedom of information, freedom of communication via mass media and specific parts of freedom of artistic and academic expression. Article 10(2) contains the general rule on restrictions of freedom of expression and it also allows for the member states the right and authorisation to interfere.¹³⁶ In a broader sense, freedom of expression in the ECHR includes all forms of communication between people.¹³⁷ In narrower sense it primarily protects the expression of opinions.

In ECHR the freedom of expression is differently subject to certain limitations than freedom of expression in the UDHR. This can be seen from the connection to respecting rights of others in the ECHR. However, the responsibilities of the one's exercising their freedom of expression are different in every situation and dependant on the means used to express ideas, opinions or information.¹³⁸ The communication of information and ideas is explicitly protected under the ECHR. The freedom to form and hold opinions is also protected since it is a prerequisite to communication. The communication of facts is protected without limitations, even if the facts are incorrect. This can be claimed to be an open concept which does not depend on the modalities or content of a statement.¹³⁹

In the ECHR both political and commercial advertising fall under the protection of Article 10. It has been concluded in European Court of Human Rights (ECtHR) judgements that even if the statements would offend, shock or disturbed, they are seen as information or ideas under

¹³⁵ United Nations Human Rights Council. Resolution 38/7. The promotion, protection and enjoyment of human rights on the Internet. 4.7.2018, A/HRC/38/L.10/Rev.1. Accessible at: <https://documents-dds-ny.un.org/doc/UNDOC/LTD/G18/203/73/PDF/G1820373.pdf?OpenElement> (30.4.2019).

¹³⁶ European Convention on Human Rights, *op. cit.*, Art. 10(2).

¹³⁷ C. Grabenwater. *European Convention on Human Rights: Commentary*. Germany: Verlag C. H. Beck 2014, p. 253.

¹³⁸ J. Kortteinen et. al., *op. cit.*, pp. 399–400.

¹³⁹ C. Grabenwater. *op. cit.*, p. 253.

Art. 10(1).¹⁴⁰ Freedom of expression cannot only be applicable to information or ideas that are inoffensive or favourably received. These are the demands of pluralism, tolerance and broadmindedness which ECtHR has regarded as general principles of freedom of expression in all recent Article 10 cases the, of without which there is no democratic society.¹⁴¹ In a democratic society, even statements made against the most fundamental principles of the democracy cannot be restricted under Article 10. If the phrase used would be vulgar, it does not automatically make the expression offensive but is merely just a part in the assessment.¹⁴² Vulgar phrases can also be seen to be used only for stylistic purposes. In the ECtHR the style of the communication has been protected with the content of the expression as the style has been seen as a form of the expression.¹⁴³ In the Article 10 of the ECHR the freedom of information and right to inform others is guaranteed. It includes the right to “impart information and ideas without interference by public authority and regardless of frontiers”. In the meaning of the Article, the information can be passed in whichever way, orally, written or digitally, for example. The right to inform others is seen as active freedom of information whereas passive freedom of information is the right to access and receive information. Also, everyone has the right to seek for information without interferences or any negative impact by the state.¹⁴⁴

In the sense of the ECHR, the freedom of expression in domain names seems to be given protection in much more contemporary framework than in other international instruments, the UDHR and the ICCPR, respectively. As vulgar phrases can also be used and do not make the expression automatically offensive, it can be assessed that using for example the word “sucks” in a domain name connected to a trademark is not automatically deemed to offend. Of course the assessment needs to take into notice the trademark rights, but as the vulgar phrases can be used for stylistic purpose, it can be seen suiting the use of vulgar words in domain names for the purposes of parody and criticism. Also the right to inform others is specifically guaranteed and this can be assessed to mean also criticising another’s business or products and services and informing others about it through domain names. The ECHR also is wide enough to cover information passed in every way also digitally. This should cover information and expressions passes in domain names, too.

In the ECtHR practice the famousness of the person has been seen as a deciding factor in whether the freedom of expression can be exercised on the person and his private life. Public

¹⁴⁰ Handyside v. United Kingdom, App No. 5439/72, ECtHR 07.12.1976, para 49.

¹⁴¹ D. Cucereanu, *op. cit.*, p. 10.

¹⁴² C. Grabenwater. *op. cit.*, p. 254.

¹⁴³ Tuslap v. Turkey, App no 32131/08 and 41617/08, ECtHR 21.02.2012, para. 48.

¹⁴⁴ C. Grabenwater. *op. cit.*, p. 254 – 256.

persons, such as politicians and other celebrities, have a higher tolerance on what sort of information can be disseminated of them. In some cases the public may be entitled to know personal issues on the celebrity's life, if the details are merely from his private life and pertain to fulfil the curiosity of the public.¹⁴⁵ This can also be the case in domain names. If someone has registered a domain name including another's personal name and included personal information on the domain name about this person, the celebrity may have to bear more than an average person. Freedom of expression protects also offensive, shocking and disturbing expressions and information and the limiting of it needs to have convincing grounds. What is prominent in the limitation is, if the expression is linked wholly to the politician's or the celebrity's private life or if it has implications also in his status in the society, and if the information the expression contains is necessary for the public discussion in the society.¹⁴⁶ The case is different if the celebrity has trademarked his name. In this case, the dispute becomes a dispute in the domain names but the conflict is between the trademark rights and freedom of expression.

2.2.2. Audience as indicator for the harm caused by the expression

It has been suggested that the audience for the expression would be essential in assessing the harm caused by the expression. In such assessment, every message is meant to impart information to others and the harm caused by the message is dependent on how the audience perceives the message. The characteristics of the audience can be separated into the size of the audience and its quality.¹⁴⁷ The size of the audience can directly affect into the amount of the harm caused. However, the size of the audience the message is directed at is not always easy to determine. For example, in the internet the message in a domain name could generally be meant to be targeted to the whole world and all people because internet can be reached globally. Of course, it is not realistic that everyone in the internet would see the message or the domain. Also, the quality of the audience has impact on how much harm the expression causes because not all people understand the words or other symbols in the same way.¹⁴⁸ It is also not possible to assess how individuals would react to a message or a domain name. However, it has been suggested that approximate effects could be assessed by the overall quality of the audience. In the internet and in the domain space the message may of course be meant to be seen by a certain group or certain type of people, but the one expressing it cannot

¹⁴⁵ M. Pellonpää et. al. Euroopan Ihmisoikeussopimus. Talentum. Helsinki 2012. p. 756.

¹⁴⁶ *Ibid.*, p. 754.

¹⁴⁷ D. Cucereanu, *op. cit.*, pp. 108–109.

¹⁴⁸ *Ibid.*, p. 112.

be sure that the whole intended audience would see it, let alone that the message would not be seen by anyone who it was not intended to in the first place.

It is clear that some messages can cause more harm through certain audiences. For example, in a case decided by the ECtHR¹⁴⁹, the former employee sent circular letters to the clients of his former employer where the employee, Mr. Jacobowski, criticized his employer. The Court decided that the people the message was targeted at consisted of people that were specifically interested in the content of it and thus the harm caused to the employer's business reputation was maximized. In domain space, these sort of defamatory domain names have occurred but as said, it cannot be effectively controlled that a certain group or type of people would see the message. However, if the domain name registrant does not indicate in the domain that the page is meant for criticism i.e. using the word "sucks" in the domain, it may not be automatically clear to the audience that the web page is mere criticism and may thus reach larger audiences. It must also be taken into notice that some of the reached audience may lose interest into the page as soon as they notice it is a criticism or parody type of page.

2.2.3. The obligation of the Internet Corporation for Assigned Names and Numbers to respect freedom of expression

As a private entity located in the United States, ICANN is subject to the law of that country. Still, being a non-profit company and having a strong impact globally and also impact on issues of public interest, ICANN is also in responsible to respect human rights.¹⁵⁰ As the domain names are communicative and have expressive elements, freedom of expression is directly linked to them.¹⁵¹ ICANN should recognise its obligations under human rights law. It has been recognised that in its procedures and policies ICANN should take into notice the impact of human rights and to make sure that this impact is understood at every level of its operations. Also, a human rights policy should be developed within the ICANN and the company should develop ways to monitor the performance of it as regards of human rights.¹⁵² A further idea for development would also be that ICANN would create a body within it for ensuring the human rights protection in its procedures and policies, as currently there is no

¹⁴⁹ *Jacobowski v. Germany*, App no 15088/89, ECtHR 23.06.1994.

¹⁵⁰ Guiding Principles on Business and Human Rights – Implementing the United Nations “Protect, Respect and Remedy” Framework. The Office of the UN High Commissioner for Human Rights. United Nations 2011, p. 1. Accessible at: https://www.ohchr.org/documents/publications/GuidingprinciplesBusinesshr_eN.pdf (30.04.2019).

¹⁵¹ M. Zalnieriute et. al. ICANN's Corporate Responsibility to Respect Human Rights. ARTICLE 19: Global Campaign for Free Expression, 2/2015, p. 4. Accessible at: <https://www.article19.org/data/files/medialibrary/37845/ICANN-PAPER-WEB.pdf> (30.04.2019).

¹⁵² *Ibid.*, p. 4.

such body within ICANN. The human right body could assess ICANN's policies and their compatibility with human rights.¹⁵³

According to the ECtHR the limits of acceptable criticism can vary in different situations. The Court has stated that the limits are not as wide for private individuals as they are for politicians because as public operators the politicians need to tolerate more criticism.¹⁵⁴ Generally, politicians also increasingly use new information and communication channels¹⁵⁵ and so do large transnationally operating companies. It can thus be assessed that in general also large private companies operating on a public arena should tolerate a greater level of criticism targeted on their policies and activities.¹⁵⁶ For individuals, internet functions as enabling participating in public debates in a democratic society. Even the ECtHR has recognised the importance of the internet as regards of communication channels. In the contemporary world, the Court sees internet as “one of the principal means for individuals to exercise their right to freedom of expression”.¹⁵⁷ The internet helps at participating to debates and other activities relating to questions of public interest and also politics.

¹⁵³ M. Zalnieriute et. al., *op. cit.*, p. 6.

¹⁵⁴ Lingens v. Austria, App. no 9815/82, ECtHR 08.07.1986, para. 42.

¹⁵⁵ M. Zalnieriute and T. Schneider, *op. cit.*, p. 29.

¹⁵⁶ *Ibid.*, p. 29

¹⁵⁷ Ahmet Yıldırım v. Turkey, App no 3111/10, ECtHR 18.12.2012, para. 54.

III. IDENTIFYING THE FREEDOM OF EXPRESSION DISPUTES UNDER THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

3.1. The suitability of the Uniform Domain Name Dispute Resolution Policy to freedom of expression and trademark conflicts in domain names

The fair balancing of trademark rights and fundamental rights such as freedom of expression and their distinctive features is not an easy task to accomplish in domain names. The conflict of trademark rights and freedom of expression may become apparent in domain names and thus relate to domain name disputes. Since domain name disputes are solved by applying UDRP by different authorities, most prominently WIPO, such disputes including freedom of expression in conflict with trademark rights may become to be solved by different UDRP panels.

As there is no governing body over the internet but the governing of it is fragmented into different, usually company based and private owned, entities, the UDRP policy can also be seen as a development of different stakeholders seeking to best cover their own interests. As the UDRP was developed to solve clear cases of cybersquatting in the domain name disputes, it can be claimed that the interests of the trademark holders has been to broaden the scope of the policy to take into consideration also controversial cases. In turn, the initial interest of the domain name registrars and registrants may have been to limit the application and interpretation of the UDRP to what it was planned for, meaning the clear cases of cybersquatting.

From the use of the UDRP in different trademark and freedom of expression related cases it can be noticed that the text of the UDRP and the applying of it by different panels gives wide discretion to interpretation. One of the reasons for it may be that the policy was not created for these types of issues but has been widened to freedom of expression cases by the panelists themselves and possibly by the urge of the trademark holders. The development of the use of the UDRP in cases including freedom of expression has become a problematic aspect and area of discussion.

Competing interest in domain names have arisen since the internet started to grow. These kinds of competing interests include freedom of expression and protection of personal names as well as protection of cultural and geographical symbols. One of the problems in the domain name and trademark arena may be the legitimate competing interests of multiple trademark

holders. It has been claimed that little has been done to efficiently allocate the domain names between the trademark holders meaning that there might be several trademark holders claiming rights to the same domain name because trademark rights for products and services are granted territorially.¹⁵⁸

It can be claimed that the protection of trademarks is currently and still too heavily weighed when compared to that of other interests such as freedom of expression. During the 1990's the domestic legislations, dispute resolution mechanisms as well as emerging case law started to largely target the cybersquatters who acted in bad faith within the domain name arena by infringing the trademark holders. Cybersquatting became known as an action where a domain name registrant registers a domain name corresponding to another's trademark and then tries to sell it to the trademark holder or a competitor in order to profit from the sale.¹⁵⁹ Even though the area of dispute resolution regarding domain names has developed drastically and the UDRP has been found generally successful in targeting cybersquatting, there are not much new developments to solve disputes that do not fall into cybersquatting.¹⁶⁰

The adopting of the UDRP was beneficial for trademark holders who wanted to protect their rights against the cybersquatters in domain names because it was easier, more efficient and more cost friendly when compared to litigation. However, there are legitimate interests to domain names also outside cybersquatting. It can be claimed that the available regulatory options do not really resolve the disputes between trademarks and other interests than cybersquatting although many of those kind of cases have occurs since the introducing of the domain name system. The decisions can be found in large diversity as to their outcome of solutions and it may be hard to find the common ground and the efficiency which in turn can be found in clear cybersquatting cases.¹⁶¹

3.2. The aims of the Uniform Domain Name Dispute Resolution Policy and different types of disputes suiting under it

The establishing of the UDRP was seen necessary mainly to solve the disputes arising from cybersquatting by which the domain name registrants were infringing the rights of trademark

¹⁵⁸ J. Lipton and M. Wong, *op. cit.*, p. 188.

¹⁵⁹ J. Nilsen. Mixing Oil with Water: Resolving the Differences between Domain Names and Trademark Law. 2002. 1 Journal of High Technology Law 47, p. 51.

¹⁶⁰ J. Lipton and M. Wong, *op. cit.*, p. 189.

¹⁶¹ J. Lipton and M. Wong, *op. cit.*, pp. 189–190.

holders.¹⁶² Because of the rapid commercialising of the internet, cybersquatting can be seen to become such a great issue globally. Earlier, the internet had mainly been used for scientific purposes and for the communication between private actors.¹⁶³ However, the development of the internet can also be seen to have effected on the functions of the domain names. The use of domain names has commercialised with the internet and domain names are currently important both for global marketing and trade of products and services.

With the commercialising and globalising of the internet, the misuses of domain names are versatile. Some issues are clear cybersquatting cases where the registrant registers a domain name identical or similar to a certain trademark and then offers the domain name to the trademark holder to gain economic benefit. In some cases, a domain name registrant acting on other markets may try to benefit from using another's trademark to market other goods or services. In this type of situation there is possibly the competing interest of two different trademark holders. Some domain name registrants may simply want to harm the trademark holder or his business but without the meaning of economically benefitting from such an act. The registrant of a domain name may simply want to prevent the trademark holder from using the domain name corresponding to the trademark. Some may not intent to harm the mark owner but simply express their opinion by criticising the trademark in the domain name, i.e. with the linked word "sucks". Also, the use of other's personal names in domain names is possible and especially concentrated on celebrities' names. In these situations the registrant may try to sell the domain to the celebrity for profit, or the domain name may include a defamatory word linked to the personal name to criticise that person. The disputes with celebrities' names can have a certain link to trademark disputes as some celebrities may hold trademark rights to their name.

When ICANN adopted the UDRP Policy in 1999 the trademark infringements in domain names were still quite new phenomena. It is understandable that initially there was a need for dispute resolution systems from the point of view of trademark holders to have their rights protected in domain names also. As well, the globalising function of the internet can be seen as a needed initiator for common international dispute resolution system to solve global conflicts between trademarks and domain names without great expenses to the parties.¹⁶⁴ Before the adoption of the UDRP, WIPO gave a Final Report on the internet domain name process and highlighted that the cybersquatting cases were most crucial issue to be solved as they were most problematic and most infringing to the trademarks. Hence, other types of

¹⁶² Final Report of the WIPO Internet Domain Name Process, *op.cit.*, para. 135(i).

¹⁶³ Kur, *op. cit.*, p. 5.

¹⁶⁴ Final Report of the WIPO Internet Domain Name Process, *op.cit.*, para. 133.

disputes were wanted to be limited outside the scope of the Policy.¹⁶⁵ It can be noticed that the UDRP was meant to solve only clear cybersquatting cases and other disputes were meant to be solved in domestic courts. To this day, it seems that cases concerning cybersquatting are still the cases to which the UDRP applies the best. However, it is interesting that despite the initial meaning, the panels have themselves widened the application of the Policy.

There is no official categorisation as regards of disputes that rise between trademarks and domain names but which are not cybersquatting. However, four types of disputes have been suggested for categorisation outside the scope of cybersquatting. The first would be the claims for free expression where the registrant of the domain name has registered a domain name corresponding to a trademark, in order to comment on, parody or criticise the trademark holder. The second would be situations where there are two or more competing legitimate trademark holders claiming rights to the same domain name. The third would be personal names in domain names and the disputes arisen from that. Fourth would be cultural or geographic indicators disputed in the domain names.¹⁶⁶ However, it must be noted that in a lot of cases the suggested categories might overlap and are not clear in all situations. It is possible, that freedom of expression, for example, is connected to all of the suggested categories of disputes.

The meaning of freedom of expression is especially significant in cases where, for example, a domain name corresponding to an individual's name is registered merely to criticise that person. In these types of situations, the outcomes of the disputes can vary largely, depending on if the personal name has been given the status of a trademark before the alleged infringement.¹⁶⁷ It is easier for the trademark holder to protect their rights under the current domain regulations which can be seen as very heavily focusing on trademark protections, whereas it is not that easy for a person trying to defend his freedom of expression. However, if the registered domain is not trademarked or it is not possible to trademark it, the current trademark favouring regulations are not very suitable.¹⁶⁸ In one domain name there can also be dispute concerning "legitimate competing interests".¹⁶⁹ This type of situation can arise when two persons have the same personal name or two trademark holders that can even operate on different territories or with different type of products have the same trademark, and this leads to dispute over legitimate competing interests. The 'first come, first served

¹⁶⁵ *Ibid.*, para. 134 (iv).

¹⁶⁶ J. Lipton, *Beyond Cybersquatting: Taking Domain Name Disputes Past Trademark Policy*, 2005. 40 *Wake Forest Law Review* 1361, pp. 1381–1384.

¹⁶⁷ J. Lipton 2010, *op. cit.*, p. 142.

¹⁶⁸ J. Lipton and M. Wong, *op. cit.*, p. 190.

¹⁶⁹ J. D. Lipton 2005, *op. cit.*, p. 1383.

principle' is the one used to solve legitimate competing interests. This means that the first to register the domain name can keep it when making claims to it and having used it in good faith. At the moment, there are no other or better approaches available.¹⁷⁰

It can be stated that there is no clear and efficient case law and guiding practice to resolve non-cybersquatting cases in domain name and trademark related disputes.¹⁷¹ Though WIPO's dispute resolution system and panels have developed something of a guideline, the given decisions are not legally binding in the UDRP system or at domestic legal systems. They also have no precedential force¹⁷² even though they are sometimes referred to in further cases. It can be stated that in the domain space, the most problematic issues are the disputes that include freedom of expression. This actualises especially in cases including parody or criticism. It can be claimed that the developments made by ICANN have not really focused on protecting other interests as it still merely protects trademarks over competing rights.¹⁷³

3.3. The requirements of the Uniform Domain Name Dispute Resolution Policy paragraph 4(a)

The UDRP be used only in situations where all three requirements are fulfilled. The complainant has to show that the requirements are fulfilled in order to the complaint to succeed. The burden of proof is thus on the complainant to show that the domain name is 1. identical or confusingly similar with the trademark of the complainant, 2. that there is no legitimate use for the domain name by the registrant, and 3. that the domain name has been registered or used in bad faith.¹⁷⁴

3.3.1. First requirement: Identical and confusingly similar

In the UDRP Policy 4(a)(i) requires the disputed domain name having to be either identical or confusingly similar with the trademark on which the complainant has rights. As can be noticed, the requirements of identical and confusingly similar are alternative to each other.

¹⁷⁰ J. Lipton 2010, *op. cit.*, p. 63.

¹⁷¹ *Ibid.*, p. 278.

¹⁷² J. Lipton and M. Wong, *op. cit.*, p. 191.

¹⁷³ *Ibid.* p. 191

¹⁷⁴ Uniform Domain Name Dispute Resolution Policy, *op. cit.*, para. 4(a)(i-iii).

Identical mark does not have to cause confusability and a domain name causing confusability does not have to be identical with the trademark.¹⁷⁵

From a case concerning Microsoft¹⁷⁶, it can be noticed that only the second level domain has been taken into account when assessing if the domain is identical with the trademark. In this case, a person had registered a domain name `www.microsoft.org`. From the top level domain `.org`, it was clear to assume that the domain belonged to an organisation. However, the domain was seen identical with the trademark name of Microsoft Company and was transferred to Microsoft. In another decision¹⁷⁷ a panel has established that dots or lines in the domain name do not make enough difference between the domain name and the trademark. However, the practice is a bit different when assessing the confusability of the domain name and trademark. In this assessment not only the second level domain is assessed but the whole domain, including both the top level domain joined with second level domain. In a case concerning a registered trademark “Sixnet” the dispute arose from the registering of a domain name “`www.six.net`”. The panel concluded that the domain name was assessed in entirety and was confusingly similar with the trademark and transferred the domain name to the complainant.¹⁷⁸

In the cases of parody and criticism the domain name is usually registered to criticise the trademark or to parody the trademark. In parodying, criticising or defaming another’s trademark the registrant might have slightly changed the vocabulary of the trademark for the domain name, or something may have been added to it. In the parody and criticism cases the trademark is usually joined with another word or words but the trademark may still be recognised from the domain name. For example, a well-known trademark Harry Winston was parodied in a domain name “`hairywinston.com`”. The panel however concluded that the name was a playful alteration of the trademark and the risk to confuse the domain name with the trademark was not high enough because an average internet user would notice the parody behind it. The panel also concluded that the name and its outlook on the web page was differentiated enough complaint was denied.¹⁷⁹

Typical for criticism are the additions of “sucks” or “ihate” to the trademark. In these types of cases also the reputation of the trademark may effect on the assessment of the panel. Within

¹⁷⁵ S. Jones. A Childs First Steps: The first six months of operation – The ICANN dispute resolution procedure for bad faith registration of domain names. – 23 European Intellectual Property Review 2001(2), pp. 69–70.

¹⁷⁶ WIPO Arbitration and Mediation Center, Microsoft Corporation v. Amit Mehrotra, D2000-0053.

¹⁷⁷ WIPO Arbitration and Mediation Center, Barneys Inc. V. BNY Bulletin Board, D2000-0059.

¹⁷⁸ WIPO Arbitration and Mediation Center, Digitronics Inventioneering Corporation v. @Six.net, D2000-0008.

¹⁷⁹ WIPO Arbitration and Mediation Center, Harry Winston Inc. and Harry Winston S.A. v. Jennifer Katherman, D2008-1267.

the UDRP the solutions to parody and criticism cases have varied a lot. For example, in a case concerning the United States based supermarket Walmart it was decided that the domain name including “Walmart Canada” joined with the word “sucks” could not be confused with the trademark because they served for totally different purposes.¹⁸⁰ In another Walmart case it was among other things decided that the parties cannot supplement the earlier decisions of different panels i.e. the one including “walmartcanadasucks.com”. In this case it was seen that Walmart is a famous mark and that the fame of the mark still does not mean that all consumers will associate all use of the mark with the mark’s owner. Even though this would have indicated that the respondent could have been entitled to the domain name, in this case, however, the domain name was transferred, because a purpose of cybersquatting was identified.¹⁸¹ Also interestingly, the panel decided that the trademark owners are not required to “create libraries” of domain names to protect their trademarks. For the future of assessing freedom of expression cases, it was also, importantly, decided that the protecting protest sites are important and “the legitimate interest and bad faith factors should insulate the protest sites from vulnerability under the UDRP Policy”. It has also been concluded by a panel that both the wording of the UDRP Policy and common sense indicate that a trademark combined with the word “sucks” cannot be considered confusingly similar with the trademark.¹⁸² Contradictory to that, it was decided in another case that “Guinness-sucks.com was seen confusingly similar with the trademark “Guinness”.¹⁸³ The panel saw it possible that the use of such domain name would disturb the business of the complainant and divert customers from the complainant’s web pages.

It could be proposed that the categories of defamatory and parodying domain names would be divided within the UDRP into an own, whole new category. They could be decided under different Policy and Rules, either together or separately. It must be noticed that in domain name context both parodying and defaming are close to each other and some cases may even involve both. When compared to cybersquatting, in parody the purpose of the domain name registrant hardly is to deceive the consumer or internet user to think that he is advertising or selling the trademark holder’s products or services. It can be questioned if parodying a trademark can cause the risk of confusability in a domain name since the meaning of a parody is to exaggerate the object. The same applies for criticising as in critique the trademark is

¹⁸⁰ WIPO Arbitration and Mediation Center, Wal-Mart Stores, Inc. v. walmartcanadasucks.com and Kenneth J. Harvey, D2000-1104.

¹⁸¹ WIPO Arbitration and Mediation Center, Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale, D2000-0662.

¹⁸² WIPO Arbitration and Mediation Center, Lockheed Martin Corporation v. Dan Parisi, D2000-1015.

WIPO Arbitration and Mediation Center, Diageo plc v. John Zuccarini, Individually and t/a Cupcake Patrol, D2000-0996.

usually supplemented with a defamatory word. It can also be questioned if the UDRP should at all decide cases concerning parody or criticism cases, where a trademark is connected with a defamatory word, and the dispute includes aspects of freedom of expression. In these cases, the assessment of confusability may even seem pointless because the meaning of the domain name registering in these situations is to criticise or to express one's opinion. It can be claimed that it is common sense for a regular customer to realise that the domain name and the web page under it do not belong to the holder of the trademark. Also, the registrant has freedom to express himself. In a case decided in the United States, the Court decided that the defendant would have indeed been free to shout "Taubman sucks!" from the rooftops, and that this he essentially did in the domain name.¹⁸⁴ The court concluded that a domain name is seen as type of public expression and that "rooftops of our past have evolved into the internet domain names of our present". It can be argued that for the protection of freedom of expression, this should be the case with domain names in general.

When an internet user types a domain name into the browser, he is usually trying to reach a certain web page or trying to find a certain web page by trying out different domains. Sometimes it might be, that because of not knowing the right domain name or because of mistyping, the user ends up in a different web page than he first intended to. In these types of situations it can be up to the web page, its layout and its contents what the consumer decides to do. If the web page contains similar kind of objects and contents as the ones the consumer was looking for, he might end up thinking that he is on the right web page. Also, he might realise that he is on a different service provider's page, but ends up browsing the page more and initially ordering stuff from there. Should the web page be totally different from the one he is looking for or advertise totally different products or services, there should be no chance of confusion by common sense. However, the UDRP panel has decided that it makes a difference, if the domain name registrant tries to benefit from this by cybersquatting or is trying to market his products using the reputation of another's trademark in similar type of products or services.¹⁸⁵

It can also be argued that if the domain name is similar to the trademark but the web page under the domain name is different enough, the panel should take the web page into notice in the assessment. This could effect on deciding that the domain name registrant has not been trying to deceive the internet users. It can be questioned if the UDRP should assess the similarity of the web pages or only confusability of the domain name with the trademark. The

¹⁸⁴ Judgement of the United States Court of Appeals, Sixth Circuit in *Taubman Company v. WEBFEATS and Henry Mishkoff*, 07.02.2003, 319 F.3d 770.

¹⁸⁵ WIPO Arbitration and Mediation Center, *Expedia Inc. v. European Travel Network*, D2000-0137.

web pages are an inseparable part of the domain name but still a different platform. The UDRP has decided that they will not look into the webpage when assessing if the domain name is identical or similar with the trademark. Also, it has been concluded by a panel that it depends on if internet user is familiar with the outlook of the web page of the trademark holder he is looking for.¹⁸⁶ In this assessment it is not only about whether the disputed domain name is similar or identical with the trademark, but also about the similarity of the web pages and is the web page constructed in bad faith to disguise the internet users.

3.3.2. Second requirement: Legitimate interest

Under paragraph 4(a)(ii) of the Policy, the complainant has the burden of establishing that the respondent has no rights or legitimate interests in the disputed domain name.

However, there are elements stated in a WIPO case¹⁸⁷ succeeding under this:

1. The Respondent's use must be legitimate non-commercial or fair use
2. The use must be without intent for commercial gain
3. The use must be without intent to misleadingly divert consumers; and
4. The use must be without intent to tarnish the trademark of the complainant.

The respondent needs to have no rights or legitimate interests to the domain name in order for the complaint to success.¹⁸⁸ However, the nature of trademark is that the same trademark may be registered in different parts of the world. The UDRP will not handle cases where there are two competing certainly legitimate rights on the domain name. For example, a case where two companies have registered a trademark in different parts of the world could not fall under the UDRP Policy because the UDRP cannot decide which company has stronger rights on the registered mark. The UDRP 4(c) lists situations in which the registrant can have legitimate interests in the domain name. These are for example marketing or advertising products or services under a domain name in good faith before the other has registered rights on the trademark, or if the registrant himself is commonly known by the registered domain even though he would not have registered it as a trademark. Also non-commercial use of domain name without the intent of economically benefitting from the use by deceiving the consumer

¹⁸⁶ WIPO Arbitration and Mediation Center, Bennet Coleman & Co. Ltd. v. Lalwani, D2000-0014.

¹⁸⁷ WIPO Arbitration and Mediation Center, Mission KwaSizabantu v. Benjamin Rost, D2000-0279.

¹⁸⁸ Uniform Domain Name Dispute Resolution Policy, *op. cit.*, para. 4(a)(ii).

or without harming the reputation of the trademark can be seen as legitimate interests. This could be the case if the respondent was using the domain name purely for criticism.

However, different approaches have been taken by the panellists in assessing if the registrant has rights or legitimate interests on the domain name. Good examples are the cases concerning Greenpeace as respondents.¹⁸⁹ In an earlier case the respondent claimed that they had only used the domain names for non-commercial purposes according to UDRP 4(c)(iii) and in theory the complaints should have thus been dismissed. The panel however did not decide according to the wording of the UDRP 4(c) but ordered the domain name to be transferred to the complainants. A different approach was taken more recently in another case concerning Greenpeace as the respondent.¹⁹⁰ In this case the respondent was given the right to maintain the domains as the panel made clear that non-commercial criticism is considered a legitimate use and also guaranteed under freedom of expression. The panel also found that Greenpeace was not trying to harm the complainant, Neste Oil's, reputation. It may be concluded that in these kinds of cases not even harsh critique can be seen as harming the reputation of the complainant since as a public actor it needs to tolerate more criticism. Also, in this case it was seen that the respondent did not mean to deceive the internet users nor gain economic benefit by using Neste Oil's trademark. The panel found that Greenpeace as a respondent was using the web pages for an approved non-commercial purpose.

It remains a question if the nature of the top level domain should play any role in deciding if the use of the domain is non-commercial or not since the decisions in UDRP vary on this issue. Usually the registering of the domain name under the domain ".net" indicates that the use of the web page and the domain name is non-commercial. In one decision the UDRP panel has decided that the use of the domain name was non-commercial and thus allowed because the domain name was not registered under the domain ".com", although it included another's trademark.¹⁹¹ However, other type of decisions has also been made. In the earlier dispute concerning Greenpeace the domain name was registered under the domain ".org" but it did not effect on the panel's decision and the registering was not seen as non-commercial or having legitimate use.

¹⁸⁹ WIPO Arbitration and Mediation Center, *Compagnie Generale des Matieres Nucleaires v. Greenpeace International*, D2001-0376.

¹⁹⁰ WIPO Arbitration and Mediation Center, *Neste Oil Oyj v. Föreningen Greenpeace-Norden*, D2012-089191.

¹⁹¹ WIPO Arbitration and Mediation Center, *Bridgestone-Firestone Inc. v. Myers*, D2000-0190.

3.3.3. Third requirement: Bad faith use

In the UDRP Policy it is stated that the following circumstances shall be evidence of the registration and use of a domain name in bad faith:

- “i) Circumstances indicating that [the Registrant has] registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
- ii) [the Registrant has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Registrant has] engaged in a pattern of such conduct; or
- iii) [the Registrant has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- iv) by using the domain name, [the Registrant has] intentionally attempted to attract, for commercial gain, Internet users to [its] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [its] web site or location or of a product or service on [its] web site or location.”¹⁹²

However, the abovementioned circumstances are non-inclusive and a panel that decides the case can also consider other circumstances as constituting registration and use of a domain name in bad faith.

In order to transfer or cancel the use of a domain name in UDRP process, it is not enough to merely register the domain name but to use it. According to the UDRP 4a the registering of the domain name and the using of it needs to have happened in bad faith.¹⁹³ UDRP 4(b)(i) and (ii) also state the kind of situations where it can be seen that the registrant has acted in bad faith, for example by having the meaning to sell the domain to the trademark holder or by trying to prevent the holder continually to register the mark as domain. It is further stated that by registering the domain in the meaning to hinder the trademark holder’s business or to use the domain in the meaning that the registrant gains economic benefits and deceives the

¹⁹² Uniform Domain Name Dispute Resolution Policy, *op. cit.*, para. 4(b).

¹⁹³ *Ibid.*, para. 4(a)(iii).

internet users to the web page purposefully causing confusion as if the trademark holder would be the host of the webpage.¹⁹⁴

From the vocabulary of the UDRP is quite clear that there needs to occur both the registering and the use of the domain name in bad faith so that the third requirement is fulfilled. However, the problem is that the registering in bad faith may be hard to prove, harder than the use in bad faith. In some cases the panellists have concluded that either the registering or the using of the domain name in bad faith has been enough in order to transfer or cancel the domain name, whereas in others, both requirements need to have been fulfilled. Some of the panels have constituted a way to assess separately if the domain name was registered in bad faith and if it was used in bad faith. In these types of cases the bad faith has been seen rising from the fact that the respondent had offered the domain for sale to the complainant.¹⁹⁵ However, it has also been decided by another panel that just the registering of the domain in bad faith has been enough, even though there was no active web page under the domain name. The respondent had not had the intention of cybersquatting and there were no concurring facts that the respondent had used the domain name in bad faith. However, it was seen to be enough that when all circumstances were assessed and the respondent was passively holding the domain name, the domain name was used in bad faith.¹⁹⁶

In one case the respondent claimed that he had acted as a “domain name speculator”. He had registered a domain name before the complainant had registered the trademark. The trademark holder had not had any business at the time the domain was registered. The panel concluded that under these circumstances the respondent had acted in bad faith, both having registered and used the domain in bad faith.¹⁹⁷ It can be asked if it was reasonable for the respondent as regards of the assessment of bad faith registering of the domain name when there were no rights to the trademark at the moment of registering the domain name. If the registrant was not aware of any trademark rights at the moment of the registering, how could he have acted in bad faith in registering the domain name. It can be concluded that the requirement of bad faith in UDRP has been assessed over the Policy’s wording. There are varying decisions and no coherent way of resolving the requirement of bad faith.

¹⁹⁴ Uniform Domain Name Dispute Resolution Policy, *op. cit.*, para. 4(b).

¹⁹⁵ WIPO Arbitration and Mediation Center, Parfümerie Douglas GmbH v. Khatnani S.A., D2005-0002 and WIPO Arbitration and Mediation Center, World Westling Federatio Entertainment Inc. V. Michael Bosman, D1999-0001

¹⁹⁶ WIPO Arbitration and Mediation Center, Telstra Corporation v. Nuclear Marshmallows, D2000-0003.

¹⁹⁷ WIPO Arbitration and Mediation Center, eResolution v. eResolution.com, D2000-0110.

3.4. Parodying and criticising domain names under the Uniform Dispute Resolution Policy

It can be questioned if the use of domain names for parodying or criticising trademarks can be seen as registering and using the trademark in bad faith. The question is not simple as the public actor needs to tolerate a certain amount of criticism and the threshold for them is usually higher than with private actors. The same applies with celebrities and private persons as celebrities and politicians have put themselves in an arena where they need to tolerate criticism. Parodying is a kind of action where the threshold to tolerance is hard to define. Parodying can certainly happen in good faith but it can also include bad faith indicators or the parody can even unintentionally harm the subject of it because of other factors. For example, the reaction of a certain audience might effect on how the parodied trademark is seen after the parody. Both criticism and parody are important for the freedom of expression and freedom of information. It can be seen from the decisions under UDRP Policy that the decisions are not coherent and the Policy does not as such fit into the cases concerning parody or criticism. The Policy does not tolerate the use of another's trademark for purposefully creating misunderstanding about the owner of the webpage or trying to harm another's business through using his trademark. These factors also fit into the assessment of bad faith in criticism and parodying. However, otherwise the UDRP does not give enough rules for assessing bad faith use in criticism and parodying in domain names and some of the decisions have been decided against freedom of expression. The developing of the UDRP can be seen necessary as regards of cases concerning freedom of expression. Since the UDRP also has decided cases concerning these issues, the Policy itself should be developed to have provisions on freedom of expression cases and not merely cybersquatting.

3.5. Protecting of common law marks and personal names of celebrities in the Uniform Domain Name Dispute Resolution Policy

Although it is stated in the UDRP Policy that it only applies to situations where the trademark is infringed by the domain name¹⁹⁸, other type of issues have also been solved in the UDRP process. Some of these are clearly freedom of expression cases. When the UDRP was developed, it was seen important by the drafters of the Policy to limit the process, and cybersquatting was seen as the biggest issue regarding domain names and trademarks. Thus, for example trade names, geographical indicators and personality rights were left out from the

¹⁹⁸ Uniform Domain Name Dispute Resolution Policy, *op. cit.*, para. 4a (i).

system.¹⁹⁹ However, the UDRP panels have also decided cases including personal names of celebrities such as Julia Roberts, Madonna, Celine Dion, Bruce Springsteen and Sting, as it is common for celebrities or other well-known people to acquire trademark rights to their personal name²⁰⁰, or the celebrities may claim that their name has acquired common law rights meaning the status of a trademark without registering. Even though the complainant needs to prove that he has rights to the trademark, the UDRP does not in practice require him explicitly to have a registered trademark as the panels have also given protection to marks having common law rights.²⁰¹ Common law rights have also been granted in cases where the complainant used to have registered trademarks but had them no more. The panel, however, saw that the very substantial reputation of the complainant constituted rights to the mark.²⁰² Since the UDRP does not preclude protection of common law rights, such decisions may be interpreted not to be against the Policy. However, the complainant needs to prove that he has the substantial right to the mark by showing evidence as it is not enough to state that the mark has been on his use for a certain period of time.

As regards of celebrities' names, in a case concerning Julia Roberts, it was decided that even though the actress had not registered her name as a trademark, she had established common law rights to her name and that the respondent had no rights to the domain name identical to the actress's name. The respondent had also acted in bad faith by registering several domain names including names of celebrities.²⁰³

In the cases concerning Celine Dion²⁰⁴, Madonna²⁰⁵ and Bruce Springsteen²⁰⁶ the well-known names of the singers corresponding to registered domain names were protected and the domain names was ordered to be transferred in the cases concerning Celine Dion and Madonna. However, only in case of Celine Dion and Madonna, the singers had registered trademark rights no their names. Although, in case of Madonna also common law rights were appealed to. In the case concerning Bruce Springsteen, the complaint was denied even though the complainant was seen to have established common law trademark on his name. The

¹⁹⁹ Final Report of the WIPO Internet Domain Name Process, *op.cit.*, para. 167.

²⁰⁰ J. D. Lipton. Celebrity in Cyberspace. *Cyberspace: A Personality Rights Paradigm for Personal Domain Name Disputes.* – 65 Washington & Lee Law Review 2008, p. 1449.

²⁰¹ WIPO Arbitration and Mediation Center, Freedom of Information Foundation of Texas v. Steve Lisson, D2001-0256.

²⁰² WIPO Arbitration and Mediation Center, Bennet Coleman & Co. Ltd. v. Lalwani, D2000-0014 and WIPO Arbitration and Mediation Center, Bennet Coleman & Co. Ltd. v. Long Distance Telephone Company, D2000-0015.

²⁰³ WIPO Arbitration and Mediation Center, Julia Fiona Robers v. Russel Boyd, D2000-0210.

²⁰⁴ WIPO Arbitration and Mediation Center, Celine Dion v. Jeff Burgar, D2000-1838.

²⁰⁵ WIPO Arbitration and Mediation Center, Madonna Ciccone p/k/a Madonna v. Dan Parisi and "Madonna.com", D2000-0847.

²⁰⁶ WIPO Arbitration and Mediation Center, Bruce Springsteen v. Jeff Burgar and Bruce Bringsteen Club, D2000-1532.

denying of the complaint was made on the basis that the complainant could not show the bad faith use of the domain name and that the respondent had at least some rights or legitimate interests for the use of the domain name. Also, in the case concerning Sting²⁰⁷ the complaint was denied but for different reasons. In this case the panel took a different view and referred to the UDRP Policy stating that personal rights are not covered by the Policy. Also, the word “sting” is a generic word in English why it was decided that no common law trademark could be established on it and thus protection could not be awarded.

3.5.1. Using personal names of politicians in domain names

There is a complex balance between freedom of expression and IPRs, as well as public interest, especially in regards of well-known people such as politicians or celebrities. It has been stated that there are inconsistencies in domain name policies as there are no effective tools to protect personal names in domain names and, for example, the use of politicians’ names as domain names. In these situations, political cybersquatting can occur and it can lead to a situation where there is a conflict between trademarks and politicians’ names. There have been three categories suggested for the use of domain names in political context. They are 1. political cybersquatting that is socially and economically wasteful, 2. political cyberfraud that means spreading misleading information about the politician under the registered politician’s name as a domain name. 3. competing interests of trademarks and politicians’ names as domain names.²⁰⁸

Domain names can be seen to be important in disseminating valuable information about the politician and his ideology.²⁰⁹ However, the current dispute resolution system and rules are based on preventing cybersquatting and protecting commercial trademark interests. It can be claimed that there are no effective tools to protect other socially important interests such as political interests or personal interests.²¹⁰ On the other hand, the public should be able to find relevant and right and non-misleading information about the politician but on the other hand however, some may register the politician’s name as a domain name and provide misleading information on the webpage. At the moment no clear rules have been established on how domain names corresponding to politicians’ names can be legitimately used in political context.²¹¹

²⁰⁷ WIPO Arbitration and Mediation Center, Gordon Sumner, p/k/a Sting v. Michael Urvan, D2000-0596.

²⁰⁸ J. D. Lipton 2008, Who Owns “hillary.com”?, *op. cit.*, p. 55.

²⁰⁹ *Ibid.*, p. 55.

²¹⁰ J. D. Lipton 2005, *op. cit.*, p. 1363.

²¹¹ J. D. Lipton 2008, Who Owns “hillary.com”?, *op. cit.*, p. 57.

The registered domain name of “hillary.com” has been under discussion since it has an interesting and rather rare connection between commercial trademark interests that corresponds to politician’s name. In this situation both parties have interests and legitimate claims for the corresponding domain name. “Hillary.com” is a rather generic domain name and much more generic than for example “hillaryclinton.com.” As regards of “hillary.com”, a company named Hillary Software, Inc. has legitimate interests on the domain name as its business name. Seemingly, the web page under the domain name is not for example an attempt to provide misleading information about Hillary Clinton. The company assumingly has legitimately registered the domain name solely for its own commercial purposes in the industry of software solutions and the name is corresponding to its business and trademark. Under trademark rights they have a legitimate right to protect their trademark in the corresponding domain name which they have used for purely business purposes and in good faith. It has no difference that Hillary Clinton has trademark rights on her personal name. This has been decided in a NAF case where the registrant of a domain name “hillaryclinton.com” was ordered to transfer the domain name to Hillary Clinton on the basis that Hillary Clinton had a common law trademark on her name.²¹²

Also, in the case of “hillary.com” it would be hard to claim that consumers would be confused in the case of trademark infringement of Clinton’s name. “Initial interest confusion” is a rising problem in the internet. It can be explained to mean that consumers that are seeking a certain website and then reach a different website are thus diverted from pursuing the original object of their search. Internet users may not be initially confused when reaching the website that they were not searching but the likelihood of confusion can be assessed by “initial interest confusion” doctrine.²¹³ The doctrine has arisen in commercial trademark context and the domain name registrant can try to confuse the search engines rather than the internet user in the relationship between the domain name and the trademark. However, it must be stated that the case of “hillary.com” might not succeed under the UDRP criteria because there assumingly is legitimate use of the domain by the company. In domain names the guiding principle to be obeyed is ‘first come, first served principle’, but in elections it is not likely or realistic that the candidate would register all possible domain names in advance, even not the most obvious ones. It is clear that the politicians cannot know beforehand the nature of their political careers and when they will enter campaigns.²¹⁴

²¹² The National Arbitration Forum, Hillary Rodham Clinton v. Michele Dinoia a/k/a SZK.com, File No. FA0502000414641, 18.03.2005.

²¹³ J. D. Lipton 2008, Who Owns “hillary.com”?, *op. cit.*, pp. 111–113.

²¹⁴ *Ibid.*, p. 115.

3.5.2. Domain name sharing as a solution

Currently, Hillary Clinton and Hillary Software Inc. are sharing the domain name in such a way that the domain name leads to a page which contains hyperlinks both to the commercial trademark holder's website and to the politician's website.²¹⁵ This can be seen as a fair and efficient way of distributing information and of hindering misleading information from spreading, even if it would be unintentional. In this kind of situation there can be seen to be balance between political and commercial speech. It also prevents political cybersquatting where a domain name holder seeks to gain money from the politician by registering his personal name and later offering it to the politician on high price.²¹⁶ Other ways of solving the use of personal names as domain names could be licencing the name to the one that wants to register it. Also, it could be possible that the domain names corresponding to politician's names would be preserved or transferred to politicians automatically but this would require for discussions at international level and by governing internet bodies as well as deciding on which level of politicians should gain this right.

3.6. Creating coherence within the Uniform Domain Name Dispute Resolution System

Even though the UDRP was not specifically created for freedom of expression cases to be handled in domain name disputes, and as the text gives margins to interpretation, some of the panels have widened the scope of the policy in applying it to cases including freedom of expression in domain names. When drafting the UDRP it was made clear that the issues relating to use of domain names for criticism purposes would fall outside the scope of the policy. It can be questioned if the panels should decide the cases that involve fundamental rights, such as freedom of expression. It can be noticed from the decisions of the panels that the interpretation varies. Some panels have clearly decided that the UDRP cannot be applied in cases where freedom of expression is at hand because the limiting of the application of the Policy should be on the cases that have focus on clear cybersquatting and have the purpose of economic and commercial use of the trademark.²¹⁷

In the observations of WIPO's Final Report on the internet domain name process, it is stated that the scope of the application of the policy should be narrow and include merely clear cases of cybersquatting having bad faith in registering and intent to profit commercially from

²¹⁵ www.hillary.com. Accessible at: www.hillary.com (30.04.2019).

²¹⁶ J. D. Lipton 2008, Who Owns "hillary.com"?, *op. cit.*, pp. 118–119.

²¹⁷ WIPO Arbitration and Mediation Center, *Aspis Liv Forsakrings AB v. Neon Network, LLC*, D2008-0387, Dissenting Opinion.

others' trademarks. Other type of disputes relating to domain names should be left for courts to decide or for arbitrators agreed by the parties to the dispute.²¹⁸ According to a strict interpretation of the UDRP and its text the cases involving fundamental rights such as freedom of expression should be dismissed in the UDRP system and left for courts to decide. However, in practice the panels have taken the approach to widen the scope of the application of the UDRP and decided also cases involving fundamental rights.²¹⁹

It can be assessed if this is possible under UDRP rules and if the panels are given discretion on what type of cases to decide. In UDRP 4(c)(iii) it is stated that in the legitimate non-commercial purpose of the domain name use, the registrant can be deemed to have a right or interest in registering the domain name. Therefore, the defendant has to show both non-commercial and legitimate use of the disputed domain name. It seems that under the UDRP Policy it might be suitable to consider cases and decide on transferring the domain name in cases where there is illegitimate but still non-commercial use of the domain name. In turn, when assessing the registration and use of bad faith under 4(b) criteria, the non-commercial or commercial use of the domain name is not separated under this criterion. It can be noted that under the UDRP it is not specifically required that the commercial use of the domain name should be involved for the justification of transferring of the domain name or for cancelling it. The text of the policy is constructed in a way that it presents the cases where domain name registering violates the rights of the trademark holder.²²⁰

In the policy it is specifically stated that "a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark," can establish legitimate rights and interests in a domain name.²²¹ The UDRP panel may assess the commercial use of the domain name including another's trademark but the commercial use may not be easy to prove. Generally, the cases relating to cybersquatting where the registrant tries to benefit from the domain name by selling it can be deemed to be commercial use. However, it can be assessed that the use of a trademark in a domain name that leads to a web page where one expresses his opinion or criticises a brand is quite clearly not commercial use. In non-commercial use the registrant may try to harm the trademark and its holder or their reputation and it can lead to economic losses from the point of view of the trademark holder, but the actual intent of the domain

²¹⁸ Final Report of the WIPO Internet Domain Name Process, *op.cit.*, para. 135(i).

²¹⁹ WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition 2017, para. 2.6. Accessible at: <https://www.wipo.int/amc/en/domains/search/overview3.0/> (30.4.2019)

²²⁰ Uniform Domain Name Dispute Resolution Policy, *op. cit.*, para. 2.

²²¹ *Ibid.*, para. 4(c)(iii).

name registrant may have been merely to hurt the trademark without economically benefiting from such act himself.

It can be seen from the practice of the UDRP decisions that the panels have also assessed the nature of the registered domain names, especially in criticism and parody purposes. In a case where the respondent had registered two domain names, “dellorussoinfo.com” and “dellorussosucks.com” the assessment of the nature of the domain name was at hand. The web page under domain “dellorussoinfo.com” contained criticising opinions about a surgeon, Joseph Dello Russo. The web page under domain “dellorussosucks.com” was inactive and led to a standard registrar’s page. The first domain name was seen by the panel to be identical with the trademark DELLORUSSO, whereas the latter domain name, including the defamatory word “sucks”, was seen to be confusingly similar with the trademark. In the case of the first domain, the complaint was granted whereas in the case of the latter domain the complaint was denied. This indicates that domain names including derogatory term and not identical to complainant’s trademark can be found to have legitimate interest to use the trademark by the the respondent. Generally, the panels have also demanded that the use is non-commercial and not misleading the internet users.²²² An average person can be assumed to understand that a domain name where trademark is connected with a word “sucks” as in “trademarksucks.com” is most probably not owned by the trademark holder. In these type of cases the internet user is not confused with the domain name being owned by the trademark holder as it is apparent from the domain name that the web page is created for criticism or parody purposes. Usually, the web page also contains content that implies the nature of the page being to criticise the trademark.

The UDRP is created to be an efficient tool for protecting the trademark holder against others registering their trademark in the form “trademark.com” as a domain name. By registering a domain name confusingly similar to another’s trademark, the exercising of freedom of expression may not be as acceptable as in the case of clearly stating the indication in the domain name with combining it with the descriptive or defamatory word. If a domain name registrant has registered a domain name identical or confusingly similar to another’s trademark but the web page itself contains clearly criticising content that can be identified as criticism by an average interne user, it can be questioned if the panel should take the contents of the website into account in their assessment. The UDRP was created to assess the domain name, not the content of the web site. It is clear that the registrant of the certain domain may benefit from the customer flow to the website due to people, who try to look for the website

²²² WIPO Overview of WIPO Panel Views on Selected UDRP Questions, *op. cit.*, para. 2.6.3.

of the actual trademark holder. It may be seen as unfair practice by the domain name registrant to take advantage from the visits of deceived people originally looking for another web page.

When establishing if there is a fair use of the domain name, the panels can assess the commercial use of it even though it is not required by the UDRP policy. It should be noted that in the kind of cases where the domain name registrant is trying to gain revenue on taking advantage from another's trademark but by deceiving the web page under the condition of criticism, the panel can decide that there is no fair use. In assessing the bad faith use of domain name, the web page content can be looked upon. The trademark criticising page can support a third parties' products and services and contain advertisements for them as they may belong to the same category as the infringed trademark. The UDRP panels have indeed assessed the similarity of the outlook of the website under the domain name.²²³ The web page may be similar to that of the actual trademark holder's web page. If the domain name registrant does not state on the page that he does not own or have rights on the protected trademark, the trademark holder's rights may prevail in the decision for the similarity.

In the traditional case of cybersquatting, the domain name registrant may have tried to register as many domain names as possible similar to the trademark owned by third party, and then benefit from selling these domain names to the trademark holder for profit. As has been stated in one UDRP panel, the trademark holders cannot be required to create "libraries of domain names" to register all the possible domain names that could be used for taking advantage of them. The same may apply in situations where the domain name registrant has registered several domain names for criticism as this in practice may hinder the trademark holder from using the trademark in such domain.

The primary concern of the UDRP system according to its Policy is still cybersquatting. Thus, the UDRP process is meant to cover only a narrow part of disputes rising among domain names. It can be noticed that even though the UDRP was created and initially meant for solving disputes concerning cybersquatting, the scope of the application has since been clearly widened. The panellists have solved issues concerning common law rights of trademarks and also trademarked personal names of celebrities. This has effected on that there is no coherent decision base as regards of how UDRP 4(a) has been interpreted in different decisions and by different panels. It can be questioned if UDRP should at all be widened to issues that the panels have now decided, and if the panels continue to do so, how does it affect the efficiency

²²³ WIPO Arbitration and Mediation Center, Bernardelli Cesarina vs. Paola Ferrario, Ferrario Photography, D2017-0091.

of the UDRP as a dispute resolution system. Also, it can be questioned, if the policy is not developed to attain issues beyond cybersquatting, does it anymore serve the purposes it was created for as the scope of it is constantly widened. However, the widening of the scope of the policy has already happened so the actual questions are how UDRP should be developed to create more coherent decision base. It could also be assessed, if the questions relating to freedom of expression should be moved from the UDRP to a new Policy that could be adopted similarly to the UDRP and accredited for use of dispute resolution centers by ICANN. One suggestion is also, if the UDRP should be totally moved from ICANN and implemented wholly into WIPO and thus under the UN. The problems of this, however, are the facts that states like Russia and China with own interests in the internet would possibly like to regulate common issues differently.

Another question is if the UDRP decisions should act as precedencies. Even though they are meant not to act as ones, many panels refer to earlier decisions in their reasoning. It can also be questioned if this is a suitable way, because when the UDRP decisions currently have no status of precedence but are still used as such, the panellists can cherry pick from the contradictory earlier decisions the most suitable ones into their reasoning's. Developing an appellate system within the UDRP might be a way to solve the issue of the decision base not being coherent. Of course, this would mean possible longer waiting times for the parties and would be against the initial means of the UDRP to be a fast and efficient dispute resolution body.

CONCLUSION

The internet and its constant growth is global and inevitable. The fundamental right to freedom of expression and imparting and receiving information should also be self-evident also in the internet. Although the freedom of expression is protected by several international instruments recognised in every part of the world, there is not common consensus on what is protected in the internet as regards of freedom of expression. Internet can be said to be a platform for the free flow of information and ideas, which fulfils the main purpose of freedom of expression. But internet is also not internationally or centrally governed which makes regional and cultural differences in the fulfilment of these freedoms. Also, when taking into consideration the aspects of trademark law and their use in the internet world, the freedom of expression may get hindered by the exercise of other rights, such as intellectual property rights.

As the e-commerce and the use of internet for commercial purposes has increased tremendously during the past years, the use of domain names for purposes of advertising and commercial use has simultaneously increased. The use of trademarks as domain names is common for business. Also, it is rather easy to register a domain name so the possibility that someone else registers another's registered trademark as a domain name is possible. The problems of abusing someone's trademark in domain names has been tackled with anti-cybersquatting laws but other types of possible infringements of trademarks in domain names are not as clear and unambiguous.

The cases where freedom of expression is in conflict with a trademark holder's right are more frequent due to the non-commercial use of internet and non-commercial use of domain names for criticising, parodying and other types of opinion statements. The problem of criticism and parody pages is that the holder of a trademark may claim his intellectual property rights infringed in a situation where the other, namely the domain name registrant, is practicing his freedom of expression.

Generally, the too wide protection of trademarks in the UDRP process endangers the protection of freedom of expression. The issue is that the UDRP was indeed developed for protecting trademarks from cybersquatters, the abusive use of another's trademark by the domain name registrant and the intention of economically benefit from selling it to the trademark holder. The creation of the UDRP can be assessed to be great for cybersquatting and the need for global dispute resolution process was needed because of the territorial nature of trademarks. The UDRP is also mandatory process for every domain name registrant and

they are subjected to it by an agreement by registering a domain name with a registrar providing the registration services which makes it a necessary international dispute resolution system.

The UDRP Policy puts the registrant into the obligation of checking the availability of a trademark registered into domain name before the registering. However, the UDRP process itself is initiated by the complainant i.e. usually the trademark holder when he has found out about his trademark infringed in the internet. Thus, the UDRP has been very effective and popular tool in tackling cybersquatting. However, the scope of it is rather narrow and not all cases regarding domain name and trademark conflicts fit under it. There are no clear frames as to if the UDRP should at all consider cases where clear connection to freedom of expression is at hand. Even though the UDRP was indeed developed for clear abuses of trademarks and the trademark infringements that fit into the narrow area of cybersquatting, different UDRP panels have also decided issues that are not clearly cybersquatting and thus widened the scope in the application of the UDRP.

The function of the UDRP is to be an administrative procedure and the panel decisions do not serve as precedencies to later cases nor do they bind domestic courts. There is not a problem of enforcement after the decision is given, as the decisions are binding on the registrars who are obliged to enforce the transferring or cancelling of the domain name according to the decision. However, the UDRP procedure does not preclude the chance of judicial proceedings at national court level before the enforcement of the decision.

The UDRP has developed useful criteria in assessing if trademark rights are infringed in domain names but the question is, if these criteria fit to other type of cases than just clear cybersquatting. The use of another's trademark in the UDRP must be assessed through three cumulative criteria that are prerequisites for a complaint to succeed in the UDRP process according to the UDRP 4(a):

- a) the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights,
- b) the respondent has no rights or legitimate interests in respect of the domain name, and
- c) the domain name has been registered and used in bad faith.

The problem of the UDRP is that it does not fit as such to the cases that are not clearly cybersquatting since that is the only issue it was developed for. However, the UDRP panels have by themselves widened the application of the policy also to other type of cases,

including cases of criticism and parody. The panellists have assessed, using the UDRP criteria, for example the use of trademarks in domain names with the meaning to criticise or parody the trademark. These situations are problematic since the UDRP was developed for protecting trademark rights whereas these situations include usually freedom of expression of the domain name registrant which can get prevented in UDRP process.

One of the problems of the process is that in assessing the bad faith registration and use of the domain name both of them must be found for the complaint to succeed. However, the decisions of the panellists in this frame vary a lot. Some find it enough to have the domain registered in bad faith though there would be no use on the web page under it. Some panels strictly require both, as was the meaning when developing the UDRP. Also, the assessing of legitimate interest lacks coherency. This results in that the solutions and reasoning vary in very similar cases and there is no coherent way to solve the disputes.

What is also problematic in the nature of the UDRP is that it is binding only on the registrars who have to enforce the decision given by the panel. In turn, the decisions are not legally binding on domestic judicial proceedings and the decisions do not have the nature of precedencies, not even in the UDRP system. This means that the later panels are not required to refer to the earlier decisions, though they tend to refer to them a lot and on a different basis, which also effects on the non-coherency of the decision base. Currently, the panellists may refer to cases they feel are adequate to the problem at hand as they do not have to follow the earlier decisions. Thus there is no clear development within the policy. It should be considered if the UDRP decisions should be given the status of precedencies so that the former decisions would bind the panellists of later cases.

Currently, there is also no appellate system within the UDRP. Although the nature of the UDRP is administrative and arbitral-like, and the given decision is binding on the registrars for prompt enforcement, it should be considered if the UDRP should have its own appellate system developed. However, it would require for further research as the decisions of arbitral-like systems are traditionally binding. Also, developing such system would be a matter of resources and require for international consensus.

Since the cases regarding freedom of expression in the domain names do not fit to the UDRP process, new rules and categories within it should be developed. Possible solutions to the conflict could be that the UDRP Policy and Rules should be developed to have own rules and policies for freedom of expression in domain names. These disputes could be categorised to include possible infringements of trademarks in domain names, i.e. parody and criticism

cases, trademarked personal names, i.e. names of celebrities, and geographical names. Another suggestion would be to develop a totally new policy as regards of criticism and parody sites, as well as for cases including personal rights such as in cases of celebrities' names. As the UDRP panels have already decided such parody and criticism cases that are not the initial purpose of the process, it would not be effective or reasonable use of resources to establish a totally new instrument or body for these types of cases. Rather, the UDRP should be developed to include naturally other cases than cybersquatting, too. It could also be discussed at international level, if it would be reasonable to move the UDRP from the administration of ICANN to WIPO and possibly make WIPO the only possible international domain name dispute resolution center. In this scenario, the UDRP would not be under the private organisation, ICANN, and would have more international sphere to it. However, moving the process and its administration solely under WIPO and thus under the UN is not without problems as powerful states such Russia and China have their own interests in the internet. In this situation the development of common international policies, rules and decision base might be difficult.

It can be claimed that the registrations in parody and criticism cases are merely about expressing one's opinion and the freedom of expression should not be hindered by protecting the trademark holder. Since the UDRP does not as such fit to the resolving of problems where two different rights, trademark rights and freedom of expression, are in conflict, the developing of it should be a common international concern for the global nature of the internet and domain name disputes. For the further protection of freedom of expression in the internet, it would be important for international organisations to incorporate the protecting of freedom of expression of into international instruments. This would also include the freedom of expression in domain names, or it could even be specifically mentioned in the texts of the instruments for clarifying the importance of it even more.

ABBREVIATIONS

ADNDRC – The Asian Domain Name Dispute Resolution Centre

ccTLD – Country Code Top Level Domain

CRP – The CRP Institute for Dispute Resolution

DNS – Domain Name System

ECHR – European Convention on Human Rights

ECtHR – European Court of Human Rights

gTLD – General Top Level Domain

HRC – The United Nations Human Rights Council

IANA – The Internet Assigned Numbers Authority

ICANN – The Internet Corporation for Assigned Names and Numbers

ICCPR – International Covenant on Civil and Political Rights

IP – Internet Protocol

NAF – The National Arbitration Forum

Paris Convention – Paris Convention for the Protection of Industrial Property

TLD – Top Level Domain

TRIPS – The Agreement on Trade-related Aspects of Intellectual Property Rights

UDHR – The Universal Declaration of Human Rights

UDRP – The Uniform Domain Name Dispute Resolution Policy

UN – The United Nations

WIPO – The World Intellectual Property Organisation

REFERENCES

INTERNATIONAL LEGAL INSTRUMENTS

1. Agreement on Trade-Related Aspects of Intellectual Property Rights. Marrakesh. 15.4.1994, e.i.f. 1.1.1995.
2. Convention Establishing the World Intellectual Property Organization. Stockholm. 14.07.1967, e.i.f. 26.4.1970.
3. European Convention on Human Rights. Rome. 4.11.1950, e.i.f. 3.9.1951.
4. International Covenant on Civil and Political Rights. New York. 16.12.1966, e.i.f. 23.03.1976.
5. Paris Convention for the Protection of Industrial Property. Paris. 20.03.1883, e.i.f. 07.07.1884.
6. Universal Declaration of Human Rights. Paris. 10.12.1948, e.i.f. 3.1.1976.

REGIONAL LEGAL INSTRUMENTS

7. Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, adopted 20.12.1993.
8. Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, adopted 16.12.2015.

LITERATURE

9. Aplin, Tanya and Davis, Jennifer. Intellectual Property Law: Text, Cases, and Materials. Oxford: Oxford University Press 2013.
10. Bygrave, Lee A. and Michaelsen Terje. Governors of Internet. – Bygrave, Lee A. and Bing, Jon. Internet Governance. Infrastructure and Institutions. Oxford: Oxford University Press 2009.

11. Bently, Lionel and Sherman, Brad. *Intellectual Property Law*, 3rd ed. Oxford: Oxford University Press 2009.
12. Bettinger, Torsten. *Domain Name Law and Practice: An International Handbook*. Oxford: Oxford University Press 2005.
13. Chia, Ken. *E-World*. York, Stephen and Chia, Ken. – *E-Commerce: A Guide to the Law of Electronic Business*. London: Butterworths 1999.
14. Chissick, Michael and Kelman, Alistair. *Electronic Commerce: Law and Practice*. London: Sweet & Maxwell 1999.
15. Cook, Trevor and Garcia, Alejandro I. *International Intellectual Property Arbitration*. Great Britain: Kluwer Law International B.V. 2010.
16. Cornish, William and Llewelyn, David. *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, 6th ed. London: Sweet & Maxwell 2007.
17. Cucereanu, Dragoş. *Aspects of Regulating Freedom of Expression on the Internet*. School of Human Rights Research Series, Vol. 27. Intersentia 2008.
18. Froomkin, Michael. *ICANN's Uniform Dispute Resolution Policy – Causes and (Partial) Cures*. – 67 *Brooklyn Law Review* 2002(3).
19. Ghosh, Sourabh. *Domain Name Disputes and Evaluation of the ICANN's Uniform Domain Name Dispute Resolution Policy*. – 9 *Journal of Intellectual Property Rights* 2004.
20. Grabenwater, Christoph. *European Convention on Human Rights: Commentary*. Germany: Verlag C. H. Beck 2014.
21. Helfer, Laurence R. *International Dispute Settlement at the Trademark – Domain Name Interface*. – 29 *Pepperdine Law Review* 2001.
22. Jain, Pankaj and Rai, Pandey Sangeet. *Copyright and Trademarks Laws Relating to Computers*, 1st ed. Eastern Book Company 2005.
23. Jolly, Adam and Philpott, Jeremy. *The Handbook of European Intellectual Property Management*, 2nd ed. London: Kogan Page 2009.
24. Jones, Stephen. *A Childs First Steps: The first six months of operation – The ICANN dispute resolution procedure for bad faith registration of domain names*. – 23 *European Intellectual Property Review* 2001(2).

25. Kortteinen, Juhani et. al. Article 19. – Alfredsson, Gudmundur and Eide, Asbjørn. The Universal Declaration of Human Rights. A Common Standard of Achievement. The Netherlands: Kluwer Law International 1999.
26. Kur, Annette. UDRP. A Study by the Max-Planck-Institute for Foreign and International Patent, Copyright and Competition Law. Munich 2001. Accessible at: http://www.zar.kit.edu/DATA/projekte/udrp_705937a.pdf (30.04.2019).
27. Lipton, Jacqueline. Beyond Cybersquatting: Taking Domain Name Disputes Past Trademark Policy. – 40 Wake Forest Law Review 2005.
28. Lipton, Jacqueline. Commerce versus commentary: Gripe Sites, Parody, and the First Amendment in Cyberspace. 84 Washington Law Review 2006(6).
29. Lipton, Jacqueline. Internet Domain Names, Trademarks and Free Speech. Edward Elgar 2010.
30. Lipton, Jacqueline D. Celebrity in Cyberspace. Cyberspace: A Personality Rights Paradigm for Personal Domain Name Disputes. – 65 Washington & Lee Law Review 2008.
31. Lipton, Jacqueline D. Who Owns “hillary.com”? Political speech and the First Amendment in Cyberspace. – 49 Boston College Law Review 2008(55).
32. Lipton, Jacqueline and Wong, Mary. Trademarks and Freedom of Expression in ICANN’s New gTLD Process. – 38 Monash University Law Review 2012(1).
33. Maggs, Peter B. et al. Internet and Computer Law: Cases – Comments – Questions. West Group 2001.
34. Maniatis, Spyros. Trade Mark Use on the Internet. – Phillips, Jeremy and Simon, Illanah. Trade Mark Use. New York: Oxford University Press 2005.
35. Michaels, Amanda and Norris, Andrew. A Practical Guide to Trade Mark Law, 5th ed. Oxford: Oxford University Press 2014.
36. Nilsen, Jonathan. Mixing Oil with Water: Resolving the Differences between Domain Names and Trademark Law. – 1 Journal of High Technology Law 2002(47).
37. Norton, Ben. Constitutional Internationalization of ICANN's UDRP. – 29 Arizona Journal of International & Comparative Law 2012(1).
38. Pellonpää, Matti, et. al. Euroopan Ihmisoikeussopimus. Helsinki: Talentum. 2012.

39. Sakulin, Wolfgang. Trademark Protection and Freedom of Expression. An Inquiry Into the Conflict Between Trademark Rights and Freedom of Expression Under European Law. Great Britain: Kluwer Law International B.V. 2011.
40. Soong-Hoon Chay, Justin and Beckham, Brian. Keeping track of domain name jurisprudence. WIPO Arbitration and Mediation Center, WIPO Magazine 10/2017. Accessible at: https://www.wipo.int/wipo_magazine/en/2017/05/article_0008.html (30.04.2019).
41. Stim, Richard. Trademark Law. Canada: West Legal Studies 2000.
42. Sugden, Paul. Trademarks and Domain Names. – Forder, Jay and Quirk, Patrick. Electronic Commerce and the Law. Australia: John Wiley & Sons 2003.
43. Zalnieriute, Monika and Schneider, Thomas. A Council of Europe Analysis on ICANN’s Procedures and Policies in the Light of Human Rights, Fundamental Freedoms and Democratic Values. Strasbourg: Council of Europe 2014. Accessible at: <https://rm.coe.int/icann-s-procedures-and-policies-in-the-light-of-human-rights-fundament/168073e0eb> (30.04.2019).
44. Zalnieriute, Monika et. al. ICANN’s Corporate Responsibility to Respect Human Rights. ARTICLE 19: Global Campaign for Free Expression, 2/2015, p. 6. Accessible at: <https://www.article19.org/data/files/medialibrary/37845/ICANN-PAPER-WEB.pdf> (30.04.2019).

DOCUMENTS OF INTERNATIONAL ORGANISATIONS

45. Guiding Principles on Business and Human Rights – Implementing the United Nations “Protect, Respect and Remedy” Framework. The Office of the UN High Commissioner for Human Rights. United Nations 2011, p. 1. Accessible at: https://www.ohchr.org/documents/publications/GuidingprinciplesBusinesshr_eN.pdf (30.04.2019).
46. United Nations Human Rights Council. Resolution 20/8. The promotion, protection and enjoyment of human rights on the Internet. 18 July 18.07.2016, A/HRC/RES/32/13. Accessible at: https://digitallibrary.un.org/record/731540/files/A_HRC_RES_20_8-EN.pdf (30.4.2019).

47. United Nations Human Rights Council. Resolution 38/7. The promotion, protection and enjoyment of human rights on the Internet. 4.7.2018, A/HRC/38/L.10/Rev.1. Accessible at: <https://documents-dds-ny.un.org/doc/UNDOC/LTD/G18/203/73/PDF/G1820373.pdf?OpenElement> (30.4.2019).

UNIFORM DOMAIN NAME DISPUTE RESOLUTION RULES AND POLICY

48. Rules for Uniform Domain Name Dispute Resolution Policy. Accessible at: <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en> (30.4.2019). Uniform Domain Name Dispute Resolution Policy. Accessible at: <https://www.icann.org/resources/pages/policy-2012-02-25-en> (30.4.2019).

49. Uniform Domain Name Dispute Resolution Policy. Accessible at: <https://www.icann.org/resources/pages/policy-2012-02-25-en> (30.4.2019).

JUDICIAL PRACTICE

50. C-39/97, Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer, EU:C:1998:442, 29.09.1998.

51. Ahmet Yıldırım v. Turkey, App no 3111/10, ECtHR 18.12.2012.

52. Handyside v. United Kingdom, App no 5439/72, ECtHR 07.12.1976.

53. Jacubowski v. Germany, App no 15088/89, ECtHR 23.06.1994.

54. Lingens v. Austria, App. no 9815/82, ECtHR 08.07.1986.

55. Tuslap v. Turkey, App no 32131/08 and 41617/08, ECtHR 21.02.2012.

56. Judgement of the United Kingdom High Court in French Connection Ltd. v. Sutton, 2000 E.T.M.R. 341, Ch D.

57. Judgement of the United States Court of Appeals, Sixth Circuit in Taubman Company v. WEBFEATS and Henry Mishkoff, 07.02.2003, 319 F.3d 770.

UNIFORM DOMAIN NAME DISPUTE RESOLUTION DECISIONS

58. The National Arbitration Forum, Hillary Rodham Clinton v. Michele Dinoia a/k/a SZK.com, File No. FA0502000414641, 18.03.2005.
59. WIPO Arbitration and Mediation Center, Aspis Liv Forsakrings AB v. Neon Network, LLC, D2008-0387, Dissenting Opinion.
60. WIPO Arbitration and Mediation Center, Bakers Delight Holdings Ltd v. Andrew Austin, D2008-0006.
61. WIPO Arbitration and Mediation Center, Barneys Inc. V. BNY Bulletin Board, D2000-0059.
62. WIPO Arbitration and Mediation Center, Bennet Coleman & Co. Ltd. v. Lalwani, D2000-0014.
63. WIPO Arbitration and Mediation Center, Bennet Coleman & Co. Ltd. v. Long Distance Telephone Company, D2000-0015.
64. WIPO Arbitration and Mediation Center, Bernardelli Cesarina vs. Paola Ferrario, Ferrario Photography, D2017-0091.
65. WIPO Arbitration and Mediation Center, Bridgestone-Firestone Inc. v. Myers, D2000-0190.
66. WIPO Arbitration and Mediation Center, British Nuclear Fuels plc v. Greenpeace International, D2001-1318.
67. WIPO Arbitration and Mediation Center, Bruce Springsteen v. Jeff Bugar and Bruce Bringsteen Club, D2000-1532.
68. WIPO Arbitration and Mediation Center, Celine Dion v. Jeff Bugar, D2000-1838.
69. WIPO Arbitration and Mediation Center, Compagnie Generale des Matieres Nucleaires v. Greenpeace International, D2001-0376.
70. WIPO Arbitration and Mediation Center, Diageo plc v. John Zuccarini, Individually and t/a Cupcake Patrol, D2000-0996.
71. WIPO Arbitration and Mediation Center, Digitronics Inventioneering Corporation v. @Six.net, D2000-0008.

72. WIPO Arbitration and Mediation Center, eResolution v. eResolution.com, D2000-0110.
73. WIPO Arbitration and Mediation Center, Excelentísimo Ayuntamiento de Barcelona v. "Barcelona.com Inc", D2000-0505.
74. WIPO Arbitration and Mediation Center, Expedia Inc. v. European Travel Network, D2000-0137.
75. WIPO Arbitration and Mediation Center, Freedom of Information Foundation of Texas v. Steve Lisson, D2001-0256.
76. WIPO Arbitration and Mediation Center, Gordon Sumner, p/k/a Sting v. Michael Urvan, D2000-0596.
77. WIPO Arbitration and Mediation Center, Harry Winston Inc. and Harry Winston S.A. v. Jennifer Katherman, D2008-1267.
78. WIPO Arbitration and Mediation Center, Julia Fiona Robers v. Russel Boyd, D2000-0210.
79. WIPO Arbitration and Mediation Center, Lockheed Martin Corporation v. Dan Parisi, D2000-1015.
80. WIPO Arbitration and Mediation Center, Madonna Ciccone p/k/a Madonna v. Dan Parisi and "Madonna.com", D2000-0847.
81. WIPO Arbitration and Mediation Center, Microsoft Corporation v. Amit Mehrotra, D2000-0053.
82. WIPO Arbitration and Mediation Center, Mission KwaSizabantu v. Benjamin Rost, D2000-0279.
83. WIPO Arbitration and Mediation Center, Neste Oil Oyj v. Föreningen Greenpeace-Norden, D2012-0891.
84. WIPO Arbitration and Mediation Center, Parfümerie Douglas GmbH v. Khatnani S.A., D2005-0002.
85. WIPO Arbitration and Mediation Center, Scania CV AB v. Leif Westlye, D2000-0169.
86. WIPO Arbitration and Mediation Center, Telstra Corporation v. Nuclear Marshmallows, D2000-0003.

87. WIPO Arbitration and Mediation Center, Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale, D2000-0662.

88. WIPO Arbitration and Mediation Center, Wal-Mart Stores, Inc. v. walmartcanadasucks.com and Kenneth J. Harvey, D2000-1104.

89. WIPO Arbitration and Mediation Center, World Westling Federatio Entertainment Inc. V. Michael Bosman, D1999-0001.

OTHER SOURCES

90. Domain Name Dispute Resolution Service for Country Code Top Level Domains (ccTLDs). World Intellectual Property Organisation. Accessible at: <https://www.wipo.int/amc/en/domains/cctld/index.html> (30.04.2019).

91. European IPR Helpdesk. Fact Sheet. Domain names and cybersquatting. European Union, 11/2017. Accessible at: <https://www.iprhelphdesk.eu/sites/default/files/newsdocuments/Fact-Sheet-Domain-Names.pdf> (30.04.2019).

92. List of Approved Dispute Resolution Service Providers, ICANN. Accessible at: <https://www.icann.org/resources/pages/providers-6d-2012-02-25-en> (30.04.2019).

93. Madrid – The International Trademark System. World Intellectual Property Organisation. Accessible at: <https://www.wipo.int/madrid/en/> (30.04.2019).

94. Summary of the Convention Establishing the World Intellectual Property Organization (WIPO Convention) (1967), World Intellectual Property Organisation. Accessible at: https://www.wipo.int/treaties/en/convention/summary_wipo_convention.html (30.04.2019).

95. Wipo Caseload Summary. World Intellectual Property Organisation. Accessible at: <https://www.wipo.int/amc/en/center/caseload.html> (30.4.2019).

96. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition 2017, para. 2.6. Accessible at: <https://www.wipo.int/amc/en/domains/search/overview3.0/> (30.4.2019)

97. Working Group on Internet Governance. Report of the Working Group on Internet Governance. Château de Bossey 6/2005.

98. World Intellectual Property Organization. The Management of Internet Names and Addresses: Intellectual Property Issues. Final Report of the WIPO Internet Domain Name Process. Accessible at:
<https://www.wipo.int/amc/en/processes/process1/report/finalreport.html> (30.04.2019).

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