

UK and EU Administrative Enforcement Options

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Domain Dispute Resolution



Overview: Domain dispute resolution

- Generic top level domains
- .eu-domains
- .de domains



Generic top-level domains, e.g.: .com, .net, .org, .biz, .info

- The *Internet Corporation for Assigned Names and Numbers* (ICANN) manages various top-level domains, such as for example *.com*.
- ICANN has established in cooperation with WIPO an Uniform Dispute Resolution Policy (UDRP) to provide a mechanism for resolution of domain name conflicts.
- An UDRP complaint is not brought before courts but rather before a specialized WIPO body that arbitrates domain name disputes.
- Once a complaint is filed, the Center requests the concerned registrar to “lock” the disputed domain name so that the domain name will not be transferred to another registrant during the UDRP proceeding

Generic top-level domains, e.g.: .com, .net, .org, .biz, .info

- The Complainant can seek as remedy the transfer or the deletion of the domain in question.
- In that respect, the Complainant needs to demonstrate that
 - the domain name in question is identical or confusingly similar to a trademark in which the Complainant has rights; and either
 - the respondent has no rights or legitimate interests in respect of the domain name; or
 - the domain name was registered and is being used in bad faith.
- The procedure normally should be completed within 60 days of the date the WIPO receives the complaint.
- For a case involving between one and five domain names that is to be decided by a single Panelist, the fee is USD 1,500.

.eu-domain

- The European Registry for Internet Domains (“EURid”) is a non-profit organization appointed by the European Commission as the domain name registry that operates the .eu top-level domain.
- Outside of court proceedings, an .eu-domain can be challenged via the established Alternative Dispute Resolution (ADR) through two providers:
 - The Czech Arbitration Court (“CAC”) attached to the Czech Chamber of Commerce and Agricultural Chamber of the Czech Republic has been operating as the dispute resolution provider for .eu domain names since 2006.
 - WIPO Arbitration and Mediation Center (Domain Name Dispute Resolution Service for .EU)



.eu-domain

- The proceeding and requirements before EURid are very similar to the one before the WIPO.
- An ADR procedure takes an average of four months to resolve.
- From January 1, 2021 to December 31, 2021 the standard filing fee for an .EU domain name dispute has been discounted (EUR 100 for a single member panel involving one to five domain names).



.de-domains

- The German legislature has not established an arbitral dispute resolution procedure regarding .de-domains.
- Therefore, action against .de-domains need to be taken before the competent German courts.
- The plaintiff can seek injunctive relief against the use of the .de-domain (usually based on prior trademark rights).
- Under certain and limited circumstances it is also possible to request the deletion of the domain (based on older name rights, including company names but not trademark rights).
- Under German law it is not possible to claim transfer of the internet domain.



.de-domains

- However, it is possible to file a so called dispute before DENIC (the organization that manages .de-domains) in order to prevent the domain owner of transferring its domain to a third party.
- Furthermore, the dispute ensure that - in case of the domain in question being deleted - the domain will be automatically be transferred to the applicant.



Company Names Tribunal & Trading Standards



Company Names Tribunal Actions

- Tribunal hearing officers are the same as the Trade Mark Registry's
- The majority of Tribunal actions are not defended and so there is a high success rate
- If the Tribunal finds in your favour, then they will issue an order for the company to change its name to one which is not an offending name.



Basis

- Relies on Goodwill in a 'name' – trade mark registration not required
- Goodwill - Generated through use of a mark in the UK
- If the name is not identical then need to show that the name is likely to **mislead** by suggesting a connection between the company and the applicant
- Need to set out the basis of your claim of goodwill in the compliant
- Evidence of the goodwill is not needed upfront but may be required if the company decides to defend against the complaint

Defenses - s.69(4) Companies Act 2006

- (a) that the name was registered before the commencement of the activities on which the applicant relies to show goodwill; or
- (b) that the company—
 - (i) is **operating under the name**, or
 - (ii) is proposing to do so and has incurred substantial start-up costs in preparation, or
 - (iii) was **formerly operating** under the name and is now dormant; or
- (c) that the name was registered in the ordinary course of a company formation business and the company is available for sale to the applicant on the standard terms of that business; or
- (d) that the name was adopted in good faith; or
- (e) that the interests of the applicant are not adversely affected to any significant extent.

Contacting the other side

- Tribunal prefers that you contact the other side before filing the complaint (will ask for the date of contact in the complaint)
- BUT no grace period for this (unlike there is for revocation actions)
- If you contact the other side before filing the complaint may put them on notice (raises the risk of them relying on a defence)
- Often contact them on the same day as the complaint is filed to avoid this

Co-respondents

- Can join members of the company or its directors as co-respondents to the complaint
- Particularly useful when you are dealing with a sole director
- Co-respondents can be jointly liable for any costs awarded by the Tribunal



Take-aways

- Is the company in use?
- If yes, then CNT action not appropriate - would then need to consider if trade mark infringement or passing-off
- Effective against young company names
- Recommend company name watch – low cost option



Trading Standards

- Network of local government authorities in the UK that enforce consumer protection legislation
- Conduct independent investigations and take independent action on all types of consumer protection matters including counterfeit goods
- Actions range from educating companies to conducting raids and prosecuting them
- Primarily for consumer protection (rather than trade mark owners) but can be useful in certain circumstances



Impact of Infringement and Customs procedures



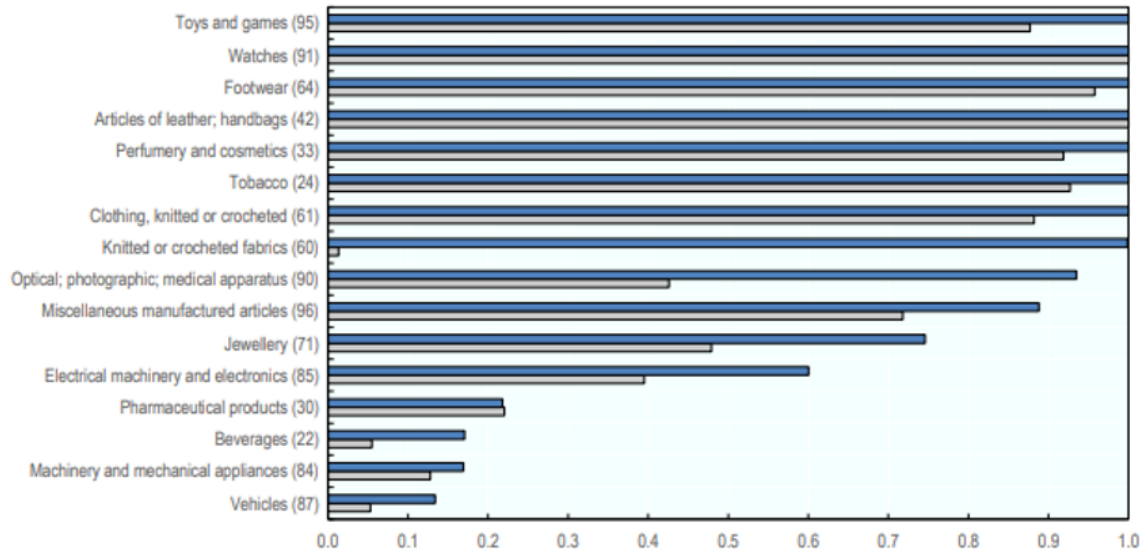
Impact of the IP Rights Infringement

- The volume of fake items detained in the EU amounts to approximately 438 million items. About 30-40 % of these were detained at the EU borders, and 60-70 % in the internal market.
- The estimated value of fake items detained in the EU amounts to some EUR 12 billion. About 15- 30 % of the total value of detained items reported is accounted for by detentions at the EU borders and 70-85 % by detentions in the internal market.
- The distribution of IP rights allegedly infringed at the moment of detention shows that trade marks predominate. Such products account for almost 70 % by volume and 54 % by estimated value of detentions at the EU borders and in the internal market.

(1) Available at:

https://euipo.europa.eu/tunnelweb/secure/webdav/guest/document_library/observatory/documents/reports/2020_Status_Report_on_IPR_infringement/2020_Status_Report_on_IPR_infringement_en.pdf

Impact of the IP Rights Infringement



Impact of the IP Rights Infringement

Sector	Direct Lost Sales (EUR billion)	% of Sales	Total Lost Sales (EUR billion)	Direct Employment Loss	Total Employment Loss	Government Revenue Loss (EUR billion)
Smartphones*	4.2	8.3%	4.2	Not calculated	Not calculated	Not calculated
Pesticides & Agrochemicals	0.5	4.2%	1.0	767	3 854	0.1
Pharmaceuticals	6.0	2.4%	10.0	20 040	48 253	1.0
Spirits & Wine	2.3	5.3%	5.2	5 681	31 858	2.1
Recorded Music	0.1	1.6%	0.1	280	644	0.0
Jewellery & Watches	1.6	11.5%	3.0	12 146	22 908	0.5
Handbags & Luggage	0.9	6.4%	1.9	6 715	13 691	0.3
Toys & Games	1.0	7.8%	1.7	3 930	8 380	0.3
Sports Goods	0.6	7.7%	1.1	3 286	6 579	0.2
Clothing, Footwear and Accessories	23.3	7.8%	37.0	263 196	373 476	7.0
Cosmetics & Personal care	9.6	14.0%	17.9	99 963	161 792	3.5
Total all sectors	50.0	6.4% (avg.)	83.2	416 004	671 435	15.0

Customs Actions – EDB (Enforcement Database)

IP right holders

- file a customs application for action (AFA) electronically to protect your products,
- stay informed about suspicious cases detected by enforcement authorities,
- alert enforcement authorities,
- ensure that enforcement authorities will be able to search for your products quickly and easily and access your contact details.

Enforcement authorities

- for rights holders' products and contact details in just one system,
- exchange information about suspicious cases,
- (for customs) receive AFAs translated into your own language, and in a structured manner.

Customs Actions – EDB (Enforcement Database)

Representatives

- manage all your EDB clients using a single password,
- send a customs application for action (AFA) to protect your clients' products,
- stay informed about suspicious cases detected by enforcement authorities,
- alert enforcement authorities on behalf of your clients,
- be sure that enforcement authorities will be able to search for your products quickly and easily, and access your contact details

Thank you

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