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Intellectual Property Issues on the Internet

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Overview

- Copyright - What you can and cannot do
- Trademarks and Unfair Competition
- Domain Names
- Jurisdiction - Where do you sue
- Patenting E-commerce Business Plans

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Copyright

- Browsing - Host Sends
- Caching - Downloading
- US Copyright Law Amendments
 - Digital Millennium Copyright Act

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Digital Millennium Copyright Act

- Illegal to Circumvent Digital Copying Protection Measures
- Illegal to Create or Distribute Circumvention Tools
- Limits liability of ISP's

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Copyright

- Implied License
 - To view, copy for personal use, print
 - But not to retransmit, modify, store
- Implied License Can Be Restricted on Notice
- Content clearance

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Trade-marks

- Trade-mark use
- Infringement
- Passing Off - Misrepresentation
- Problem of finding infringement where no use

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Unfair Competition

- linking and “deep linking”
- framing
- metatags

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Domain names

- an address on the Internet
- .com most popular; all common English words are taken
- estimated over 10,000 current conflicts over domain names
- As eCommerce proliferates problems will grow

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Acquiring Domain Names

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- No trade-mark screening
- Applicant statement that domain name doesn't infringe third party rights is taken on its word
- Nominal registration fee

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ICANN Dispute Resolution Policy

- Applicants must adhere to policy to obtain a domain name
- Mandatory arbitration with approved arbitrators; but can go to Court
- Conducted by e-mail
- Complainant chooses the arbitration panel
- Quick and relatively inexpensive

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ICANN Dispute Resolution Policy

- Service of Complaint by e-mail
- 20 days from service to respond
- If no response proceedings are conducted *ex parte*
- Court action by squatter must be filed within 10 days of adverse decision
- Sole remedy is cancellation or transfer of domain name

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ICANN Dispute Resolution Policy

- Complainant must show:
 - domain identical or confusingly similar to complainant’s trademark
 - domain holder has no legitimate interest in domain name
 - domain has been registered and is being used in bad faith

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ICANN Dispute Resolution Policy

- Bad Faith:
 - acquired primarily to sell to complainant or competitor
 - registered domain to prevent trade-mark owner from using it; if there is a pattern of conduct
 - purpose is to disrupt competitor’s business
 - using domain to intentionally attract web users to your site by causing confusion

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US Anti-Cybersquatting Legislation

- Court proceeding with remedies:
 - Injunction
 - General Damages
 - Attorney’s fees and costs
 - Statutory Damages (\$1000 - \$10,000 per domain)
- Damages only if activity after enactment

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US Anti-Cybersquatting Legislation

- Based on trade-mark right of complainant
- *in rem* action permitted
- .com domain name registry is domiciled in the US
- Canadians will effectively be “governed” by the Act and can take its benefit

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US Anti-Cybersquatting Legislation

- Decisions:
 - Tennis Australia preliminary injunction
 - Bell Atlantic Corporation *in rem* action
- Threat of Court appearance may “encourage” squatter to capitulate

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Domain Disputes

- US Anti-Dilution Statutes
 - Requires “commercial use”
 - Mark must be “famous”
 - Requires jurisdiction
- Unfair competition / Passing Off
 - One In a Million Case (U.K.)

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Domain Disputes

- Goliath wins
 - Umbro vs. 3263851 Canada, Inc.
 - Panavision vs. panavision.com
 - TOYS “R” US vs. toysareus.com
- “Initial Interest Confusion”

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Domain Disputes

- David wins
 - TOYS “R” US vs. gunsareus.com
 - Porsche “in Rem” Action
 - Avery/Dennison vs. avery.com/dennison.com
 - Hasbro vs. clue.com
 - veronica.com; pokey.net; eToys.com

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Jurisdiction - Where to Sue

- No Commercial Activity
 - Passive Web site
 - Posting on Bulletin Board
 - *Braintec Inc. v. Kostiuk*

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Jurisdiction - Where to Sue

- Commercial Activity
 - Taking Orders
 - Targeting a Jurisdiction Commercially

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Patenting E-Commerce Business Plans

- *State Street Bank* US Decision
- Priceline.com vs. Microsoft
- Amazon.com “I click”
- Situation in Canada

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Links of Interest

- <http://www.perkinscoie.com/resource/ecomm/netcase/index.htm>
- <http://www.icann.org/udrp/proceedings-list-name.htm>
- <http://cyber.law.harvard.edu/icann/search/udrp.asp>
- <http://www.networksolutions.com/cgi-bin/whois/whois>

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