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*Patent & TradeMark Agents*

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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

- 
- 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. Kostjuk*

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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 “1 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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