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HOW TO PROTECT YOUR DOMAIN NAME IN NIGERIA

by Davidson Oturu

(Partner, ÆLEX Intellectual Property/Corporate Commercial Practice Groups)

What is a domain name?

Simply put, a domain name can be considered as the name that a person or business chooses for his/its website. It is used to identify a registered Internet Protocol (IP) address which online visitors can use to access a website. Examples of some domain names are “google.com”, “facebook.com” and “linkedin.com”.

A domain name can be regarded as a company’s unique identity and most individuals and businesses usually invest in registering a domain name. A domain name can comprise of a combination of letters and numbers. It is however advisable to choose a name that is distinctive so users can easily identify it. If a common domain name is selected by a company, it may be difficult building a reputation with the name and impossible to prevent other competitors from using it.

Every domain name is required to have a word (Second-Level Name) and a suffix (Top Level Domain Name). For example, with the domain name linkedin.com, “linkedin” is the Second-Level Name and the suffix, “.com”, is the Top Level Domain (TLD). TLDs can be classified as generic Top Level Domains (gTLDs) and Country-Code Top Level Domain (ccTLDs). Companies can register their domain names in any number of TLDs. The company may choose from gTLDs (such as “.com”, “.net”), or ccTLDs (such as “.ng” for Nigeria and “.za” for South Africa).

Importance of protecting a domain name

It is important that you protect your domain name by registering it with a Second Level Name that is closely related to your brand. Examples of some relatively popular domain name disputes highlighted below may help to put this in perspective.

IKEA

IKEA is a company that designs and sells ready to assemble furniture and is the world's largest furniture retailer¹[\[1\]](#). In 2001, IKEA won a high-profile domain name regarding the domain name “ikea.com.cn.” The matter was instituted in China against a Chinese company as IKEA, which had registered its well-known trademark, was able to show that the Chinese company (CINet) had registered multiple domain names for financial gain and was potentially misleading consumers about the relationship between IKEA and CINet.

Bruce Springsteen

In 2001, Bruce Springsteen commenced an action when he discovered that a domain name, “BruceSpringsteen.com”, had been registered to a cybersquatter, Jeff Burgar. He however lost the domain name dispute when the World Intellectual Property Organization (WIPO) panel ruled 2-1 in favour of Burgar as there was no evidence to show that Bruce Springsteen’s name was trademarked².

Google

Google is reported to have lost a dispute over the domain name, “Oogle.com”. They have also lost other domain name disputes involving “Groovle.com” and “Goggle.com³.”

¹IKEA Is a World-Wide Wonder (Forbes) <https://www.forbes.com/sites/walterloeb/2012/12/05/ikea-is-a-world-wide-wonder/#5a188a5427b9>

²Landmark Domain Name Dispute Cases (Hutcherson Law LLC) <<https://hutchersonlaw.com/landmark-domain-name-dispute-cases/>>

³Google Loses Oogle.Com Domain Name Dispute (DN ATTORNEY.COM) <<https://dnattorney.com/google-loses-oogle-com-domain-name-dispute/>>

Apple

In 2012, long before the iPhone5 had been manufactured, Apple filed and won a domain dispute claim against the domain name owners of iPhone5.com⁴. Apple has also secured ownership of other sites such as iPhone4.com and WhiteiPhone.com.

Can a domain name be protected as a trademark?

In several instances, it can be argued that a domain name performs similar functions as a trademark. While the trademark is a mark that customers can use to identify a brand or a product, the domain name serves as an identifier and draws visitors from any part of the world to the company's website.

In considering the protection of a domain name, one needs to be aware that in most jurisdictions, it is possible to register domain names as trademarks, provided that the domain names satisfy all conditions for it to be registered like the trademark and service marks. Thus, if the domain name is distinctive and is capable of distinguishing the goods or services of a company from that of other companies, it may be registered and protected as trademark or a service mark.

Furthermore, in order to qualify for registration as a trademark or service mark, it must be distinct from other domain names and well-known trademarks so that it does not mislead or deceive customers or violate public order or morality.

Trademark Protection vs. Domain Name Protection

Generally, trademarks are only protected in jurisdictions where they are registered. In other words, where trademarks are registered with a trademarks registry in a particular country, they may not enjoy worldwide protection as the protection they enjoy is limited to the country where they are registered.

Due to this limitation, it may not be advisable to register a domain name only as a trademark as this would limit its protection. Due to this limitation and other factors, the Internet Corporation for Assigned Names and Numbers (ICANN) was established to oversee and regulate the domain name industry. The tasks of ICANN includes the

⁴Apple wins WIPO dispute, secures ownership of iPhone5.com domain <http://www.idownloadblog.com/2012/05/17/apple-wins-iphone5-com-dispute>

responsibility for IP address allocation, protocol identifier assignment, TLDs system management and root server system management functions.

Furthermore, ICANN exercises such regulatory powers as accrediting domain name registrars, setting base prices for domain names, protecting domain name trademarks, and punishing wrong-doers. It is also the responsibility of ICANN to address the issue of domain name ownership resolution for gTLDs and it has, in conjunction with WIPO, developed the Uniform Dispute Resolution Policy (“UDRP”) and UDRP Rules.

Through the UDRP, ICANN and WIPO have provided a mechanism for rapid, cheap and reasonable resolution of domain name conflicts by avoiding the traditional court system for disputes and allowing cases to be brought to a set of bodies that determine domain name disputes.

Registration of a domain name

The technical management of the domain name system is handled by ICANN. However, the registration of the TLDs are managed by ICANN accredited Internet registrars. A company can also confirm the availability of a domain name by searching a registrar's site or by using a 'WHOIS' search. WHOIS is an internet database that contains information on domain names, the domain registrars, registrants and the domain's Administrative and Technical contacts. By performing a WHOIS search, one can also confirm who registered a domain name and its expiration date.

For registrations of a domain name in the ccTLDs, a company will need to contact the registration authority designated for each ccTLD. WIPO has set up a ccTLD database that provides useful guidance on how to register a cTLD. WIPO has established a Trademark Database Portal (<http://ecommerce.wipo.int/databases/trademark/index.html>) to assist in the domain name search.

Domain Name Conflicts

The UDRP (<<https://www.icann.org/udrp/udrp-policy24oct99.htm>>) sets out the legal framework for the resolution of disputes between a domain name registrant and a third party (i.e., a party other than the registrar) over the abusive registration and use of an Internet domain name.

The essence of the UDRP is to enable anyone in the world file a domain name complaint concerning a gTLD or ccTLD using the UDRP Administrative Procedure. The complaint

may be submitted to any accredited dispute resolution service provider accredited by ICANN.

All ICANN accredited registrars that are authorized to register names in the gTLDs and the ccTLDs that have adopted the Policy have agreed to abide by and implement the UDRP Rules for those domains. Any person or entity wishing to register a domain name in the gTLDs in question is required to consent to the terms and conditions of the UDRP.

According to the ICANN policy, a domain registrant must agree to be bound by the UDRP — they cannot get a domain name without agreeing to this. To effect this, a Dispute Resolution Policy clause is usually inserted in the domain name registration agreement stating that if the registration of the domain name is challenged by a third party, the registrant shall be subject to the provisions specified in the UDRP.

Resolution of disputes and the UDRP

Paragraph 4(a) of the UDRP provides that it is mandatory for a registrant to submit to administrative proceedings in the event that a third party brings a complaint before any of the approved dispute resolution provider concerning an alleged abusive registration of a domain name under the following circumstances:

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

Consequently, where a domain name offends the provisions of the UDRP Policy, such a domain name registration must be cancelled and the name transferred in favour of the person who possesses the registered trademark.

ICANN approved providers

Paragraph 3 (a) of the UDRP Rules states that any person or entity may initiate an administrative proceeding by submitting a complaint to any provider approved by ICANN.

The implication of this provision is that the Complainant can institute administrative proceedings before any of ICANN's approved providers. The approved providers as listed on the ICANN website are:

- a) Asian Domain Name Dispute Resolution Centre
- b) The National Arbitration Forum
- c) World Intellectual Property Organization
- d) The Czech Arbitration Court

Procedure for commencing transfer of a domain name

The procedure for commencing the transfer of the domain name is as follows:

- The filing of a Complaint with an ICANN-accredited dispute resolution service provider chosen by the Complainant;
- The filing of a Response by the person or entity against whom the Complaint was made;
- The appointment by the chosen dispute resolution service provider of an Administrative Panel of one or three persons who will decide the dispute;
- The issuance of the Administrative Panel's decision and the notification of all relevant parties; and
- The implementation of the Administrative Panel's decision by the registrar(s) concerned where there is a decision that the domain name(s) in question be cancelled or transferred.

Conclusion

The importance of domain names cannot be emphasized enough in this era of e-commerce. A protected domain name is indispensable for prominence, and profitability of a business like an internationally protected trademark or service mark. It is therefore necessary to protect ones domain name as a trademark and under the ICANN and WIPO procedure.

Some points to note on this include the following:

- 1) Registered trademarks/service marks protect a brand name while a registered domain name protects against any unauthorized use of the domain name;
- 2) Trademark supports the value of a business while a domain name draws traffic to the business from any part of the world where there is access to the internet and the World Wide Web.

If you would like to get more information on this and other areas tax related matters, you may contact the Intellectual Property Practice Group of the firm through its email address: iplagos@aelex.com.

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Contact us at:

4th Floor, Marble House,
1 Kingsway Road, Falomo Ikoyi,
Lagos, Nigeria

Telephone: (+234-1) 4617321-3, 2793367-8, 7406533,

E-mail: lagos@aelex.com

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