

The protection of distinctive signs in the Internet - Domain names

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Starting from the first Greek judicial decision relative to domain names, the author presents the issue of protecting distinctive signs in case they are used by third parties as an Internet address. In the first section he makes a brief introduction into the technical and organisational peculiarities of the domain names and in the following sections he examines the legal problems from the aspects of trademark law, unfair competition law, law of tort and protection of the name. By providing examples from other countries' case law, where similar cases have arisen, he displays the potential as well as the limits of the traditional law of distinctive signs in the digital world.

I. The issue

The recent judicial award of the Court of First Instance of Siros [\(1\)](#) has handled for the first time in Greece with a new issue that courts of other countries have been dealing with for a long time: the issue of domain names. During the past four to five years a global battle has started between big enterprises as well as private individuals in relation to their presence in the Internet, and in particular to the address - the domain name - under which their homepage will be hosted. Lately this issue has become popular in Greece, as the globally largest company in the electronic commerce sector, which is operating as a virtual bookstore (amazon.com), has tried to expand in the Greek domain (.gr), but was surprised to find out that the relative domain name (amazon.gr) had already been registered for a company serving Greek interests that had been using it in order to sell books by mail. The Court of First Instance of Siros has given right to the American company in the requested injunction and has decided that the use of a virtual bookstore under the domain name amazon.gr is insulting its right in the name and the company's logo.

The Internet consists of thousands of smaller computer networks that are all wired together. In order to reach the desired computer and read the information, which it offers for downloading, one must know its unique address in the Internet, which resembles to the mailing address or the phone number of individuals and legal entities in the physical world. This address consists of a long combination of numbers (i.e. 206.253.222.65) and forms the identity of the computer in the Internet, known as IP number (2). The difficulty of memorizing such a number, has forced the development of the DNS(3) system, that makes it possible for every IP number to be provided with a free to choose name (i.e. georgiades.com). In this point, that means of the registration of the names, begins the battle for the domain names(4).

Each domain name consists of several levels (domain levels) that are being separated one of the other by full stops. The crucial for our issue levels are the second level domain, which is so to say the name (i.e. «georgiades»), and the top level domain (i.e. «.com» or «.gr»), which indicates the organization which the domain name has been registered with. Competent to register domain names are private companies or organizations that have contracted with the Governments of each country and occasionally also one with the other. The registration under the Greek top level domain (.gr) has been allocated by a contract with the [Greek National Committee for Telecommunication and Mail \(N.C.T.M.\)](#) to the [Foundation for Technology and Research - Institute of Informatics \(IP-ITE\)](#) seated in Irakleon, Crete(5). The said organizations and companies do not effect - due to lack of competency - any kind of preventive control before registering a domain name, but they give them to the applicants based on a first come, first served principle.

Every combination of words can be registered only once under each top level domain, but can also be registered under every single of the 246 top level domains, which are accessible to the public. It is obvious that every corporation is seeking to register its name as domain name (ibm.com, apple.com, antenna.gr etc.) for many obvious considerations, such as marketing policy reasons, image, easiness of finding, but also for protection from unlawful practices. Conscious of that fact the so-called cybersquatters or domain grabbers(6) have urged to register well known names, such as McDonalds, as domain names in order to offer them for sale to their owners for big amounts of money, and some of them have succeeded in it(7). The legal community has in the beginning reacted reluctantly to this new phenomenon called "domain grabbing" as the legal issues that arise are more complex as they may seem at a first glance, especially as the relative controversies have declined from the said, obviously in bad faith examples of registrations of domain names in order to make profit and have changed to hard controversies for the best place in the Internet.

In the international literature and case law many different opinions have been expressed regarding the legal nature of domain names; it cannot be said that one of those has ruled (8). Regardless of what is the legal nature of the domain name itself and as a result what is the protection of a domain name, more

crucial is the contrary - and practically more up to date issue -, whether the registration and use of a domain name may constitute insult of the rights of third parties in immaterial goods⁽⁹⁾. In the following sections we will try to make a brief presentation of a few of the problems that arise in relation to the said issue, as well as of the solutions that the case law of other countries have come up with.

II. Trademark law

From the combined interpretation of articles 4, 18 (3) and 26 (1) of Law 2239/1994 "regarding trademarks" occurs that the owner of a trademark is empowered to forbid to any third party the use without his consent in the course of trade of any:

- sign, which is similar to the trademark, for goods or services that are similar to those for which the trademark is being used;

- sign, which due to the similarity or the resemblance to the trademark and the similarity or the resemblance to the goods or services, for which the trademark and the sign are being used, provokes risk of confusion of the public that includes the risk of affiliating the sign with the trademark;

- sign, that is similar or resembles to the trademark and is being used for goods or services that do not resemble to the goods and services for which the trademark has been registered, under the condition that the trademark is well-known in Greece and that such a use of the sign would without any reasonable excuse provide it with an unfair advantage deriving from the distinctive character or the reputation of the trademark or would harm the latter's distinctive character or reputation⁽¹⁰⁾.

In case the sign that is colliding with the pre-registered trademark is a domain name, one might be confronted with the following peculiarities, in relation to the application of Law 2239/1994:

1. Use in the course of trade: Law 2239/1994 "regarding trademarks" protects with articles 26 (1) in combination with 18 (3) the owner of a trademark only in case it is being used by third parties in the course of trade. As a result one must exclude from the beginning all cases in which a private individual registers a domain name in order to use it exclusively for private purposes (i.e. to publish his family pictures); in such cases the owner of the trademark will have to seek help in the protection of the name (Art. 58-59 of the Greek Civil Code-GCC), provided that the trademark constitutes his name at the same time, or eventually in the law of torts (Art. 914 f. of the GCC), if it applies, in order to be protected. But should the said private individual offer the domain name for sale or use it for advertising, then one must accept that this does constitute use in the course of trade⁽¹¹⁾. The latter should apply *ad majore* for corporations⁽¹²⁾.

2. Risk of confusion: A first issue that needs to be addressed is which are the goods or the services, in relation to which there must be a risk of confusion. The Appellate Court of Duesseldorf⁽¹³⁾ held that crucial for the acceptance of a risk of confusion are not the goods or services offered by the web site, but the web site as such, which results that a risk of confusion will always be present, regardless of the sector of the market the two challengers of a domain name are engaged in. As an argument for its decision the Court has resembled the case with that of two newspapers that are being published under the same title, for which there is no question to examine their resemblance looking at the contents of the papers. One can be reluctant regarding whether this argument is sound. The widespread use of the Internet and of electronic commerce urge us to go ahead to the contents of the website and to decide according to the goods or services that are being offered by it. Moreover the said judicial decision is an internationally sole example⁽¹⁴⁾, as not even German judicial decisions have followed its arguments⁽¹⁵⁾.

Following the above mentioned conclusion one is confronted with the crucial issue, how to judge the case of non competitive to each other corporations, which have been using for a long time the same or similar trademarks and other distinctive signs and now have to co-exist in the Internet. In contrast to the physical world, where trading in different sectors of the market as well as the geographical distance do allow the harmonic coexistence of similar trademarks and other distinctive signs, the Internet proves to be in relation to this matter quite limited. As already described, every combination of words can be registered only once as a domain name under every top level domain (such as .gr or .com), regardless of the nature of the goods or services or other activity, for which it is going to be used. The problem becomes stronger by the fact that a domain name cannot be accompanied by any other sign, colour or special way of writing and that due to technical reasons it has to be consisting of no more than 24 letters, which results to a narrowing of the possibility of descriptive differentiation of trademarks and distinctive signs in general.

In this cases arises the issue, whether the specific technical principle of time precedence that regulates the appointment of domain names (first come, first served), which means that the domain name will be given to the one who manages to register it first, should apply or whether the owner of a former (older) distinctive sign outside from the Internet will have a somehow stronger right to use it as a domain name⁽¹⁶⁾.

The principle of precedence forms indeed a fundamental principle of the law of distinctive signs, but its implementation requires the existence of the risk of confusion⁽¹⁷⁾. Since there is no such risk of confusion, it would be against the basic virtues of the law of industrial Property, but to the virtue of the economic liberty (Art. 5 (1) of the Greek Constitution) as well, to force the owner of a more recent trademark (beneath the Internet domain) to refrain from using it as a domain name in advantage of the owner of an older trademark (registered for other goods or services)⁽¹⁸⁾. In such cases, where both challengers of a domain name are owners of a trademark or another similar right on the sign

under dispute, there is no other solution due to the technical peculiarity of the internet, than to let the first come, first served principle apply.(19). Thus the less active owner of a trademark, who came second, will have to decline, choosing to add another sign on his trademark, in order to be able to use it as domain name under the same(20) top level domain(21).

A different solution might only apply if one of the colliding signs is a trademark with a reputation, but also then under the prerequisite that its use as a domain name from the other party will constitute illegal exploitation in the meaning of Art. 4 (1C) and 26 (1) of law 2239/1994(22). This means that the use of this trademark as a domain name by the other party should with no reasonable excuse provide it with an unfair gain deriving from the distinctive character or the reputation of the trademark, or cause a damage to the latter's distinctive character or reputation(23).

Finally, following question has been posed by a part of the writers, actually whether the principles that are used in order to assess a risk of confusion in the case of similarity or resemblance to a trademark(24) (of a sign distinguishing similar goods or services) are indeed suitable to be used for the judgement in the case of a conflict between a trademark and a domain name(25). In particular it has been argued that due to the technical peculiarities that revert domain names into a good under insufficiency and due to the accuracy that is demanded while typing a domain name in the computer(26), a deviation should be made from the strictness of these rules, as they have been formed by case law up to now, with the effect that even the addition of a hyphen should be regarded as adequate differentiation, which draws away the risk of confusion between a trademark and a domain name(27).

This argumentation has correctly not been adopted by the case law(28), because the risk of confusion for the consumer remains the same regardless from the fact whether he is on his way in the normal contractual field or the so-called cyberspace(29). An Internet user must indeed be extremely accurate while searching for a WebPage by typing in the domain name under which it is hosted; but one cannot say that this fact has changed (for now) the habits of the average and with medium knowledge and abilities consumer - Internet user(30). Thus the owner of a domain name should be obliged to add such distinctive signs to it, that no risk of confusion can be provoked. Moreover the virtue that the stronger the trademark is, the stronger its protection will be, should fully apply(31).

An exception to the above might only be accepted in case the domain name under dispute has been formed by the natural name of its owner, which is part of the trademark, the distinctive title or his trade name. In that case following interesting phenomenon arises: While the literature and the case law have formed a system of rules for the case of holders of the same name(32), which foresees the addition of differentiating signs in such a manner that the interests in conflict are adequately served, the technical peculiarity of domain names leads towards a re-approach of the colliding signs; it is obvious that both parties

will be interested in using the "crucial"-colliding part of their distinctive sign and not the differentiating addition as a domain name. In that case we must accept that the owner of the more recent distinctive sign will not be totally deprived from using his name as (part of) a domain name(33). If it is technically not possible to add such differentiation signs that the risk of confusion is completely excluded, one should be satisfied by demanding to have it reduced as much as possible(34).

3. The principle of territoriality: Another big issue that arises in relation to trademark legislation evolves the principle of territoriality, which proves insufficient to follow the evolutions in the global information society. As already mentioned, every second level domain (that is every name) can be registered under any of the 246 top level domains. In such cases, where the distinctive sign to be protected is just a trademark and not a trade name or a commercial designation at the same time(35), its owner won't be easily protected from an in bad faith registration and use of it as a domain name under a remote or "exotic" country level domain, as in the case of Amazon.

It is true that the problem of the principle of territoriality is not a new one for the people involved with the trademark protection. The parameter called "internet" though provides this problem with explosive dimensions , in one part due to the speed of its expansion and the circulation of the information contained therein (i.e. Amazon was founded just 4 years ago and is now one of the fastest growing businesses in the world, while it's name has become similar to electronic commerce), on the other part due to its global nature. Internet knows no borders. A web page under the domain name amazon.gr is equal easily accessible to a computer user in the USA or Japan and to one in Greece. The same goes of course also for the domain amazon.com.

It is very doubtful whether the few exceptions to the principle of territoriality that have been acknowledged by the International Paris Convention are capable of regulating in the future the commercial transactions in the global village named the Internet. Furthermore the use of internationally uniform rules as well as the obligatory international mediation (administrative panels) in the level of the registration authorities regarding domain names disputes, as it has been pursued by international organizations(36), do not seem to be in position to totally solve the problem. Those rules and these mediation proceedings do not have in the present phase a legislative and a judicial status, with result that there is always the possibility of taking those mediation awards to the national courts, which will decide taking into consideration the applicable law.

III. Unfair Competition

Apart from the protection of the trademark legislation, but also in cases where such protection will not be applicable due to the aforementioned reasons, one should investigate whether the use of a domain name could be prevented on the basis of unfair competition law and in particular by the clause of Art. 1 of law 146/1914. That will mainly be the case when a domain name is being used

for transactions, but no risk of confusion arises or it is not being used as a trademark(37). Herein fall the cases in which companies are either using the distinctive signs of a well known competitor of theirs as a domain name, in order to gain clients at the competitor's expense (unfair expropriation of foreign reputation), or are just registering them as domain names without using them, in order to block them (unlawful obstruction)(38).

The German case law, interpreting broadly the requirement of "acting for the purpose of competition(39)" is solving according to the respective general clause of Art. 1 UWG (German Act Against Unfair Competition), also the cases of registration of a trademark by the so-called domain traders with the sole intention to "resale" it to the owner of the respective distinctive sign(40). Respectively the English case law solves the cases of domain grabbing by the use of the tort of passing off(41).

Moreover Art. 13 of Law 146/1914 regarding distinctive signs according to the non typical system and the trade name might be applicable, provided that the requirements that it sets are met. As far the requirements of the use in the course of trade and the risk of confusion are concerned, what has already been handled above should apply accordingly. In cases where the same sign or part of it is used as a trademark, tradename and distinctive title at the same time(42), its owner might find himself better protected against the use of his sign as a domain name by a third party, by the means of Article 13, rather than by the trademark legislation, .

IV. Tort law

In cases where no use in the course of trade is made or no risk of confusion exists, protection could be granted on the basis of the provisions of the Greek Civil Code for torts and in particular of Art. 914 and 919 of the Greek Civil Code. Registering intentionally a foreign trademark or name as a domain name in order to prevent his owner from using it as a web-address or to hold it to ransom, is an illegal interference in his professional activity in the sense of Art. 914 of Greek Civil Code or alternatively an opposed to the honest practices action in the sense of Art. 919 of Greek Civil Code(43). The requirements of the illegality and the opposition to the honest practices will be harder to prove in cases where the names are identical and the cybersquatter will be setting forth his right in name.

V. Protection of name

The protection of name (as well as of the company and the trade name) against it's use as a domain name should also be examined on the basis of Art. 58 of the Greek Civil Code(44). Critical will be the answer to the question, whether the owner of the domain name makes illegal use of the name of the claimant (Art. 58, 2nd var.)

The use will most probably not be illegal in cases where the owner of the domain name has a right to use the particular name (i.e. holder of an identical name). This will be almost absolutely the case when the private owner of the domain name will be setting forth his right on his name, with the result that no exception would be permitted from the first come, first served principle.

In relation to the trade name in particular, to the extent that the critical requirements for the assessment of the illegal insult are the same as the requirements of Art. 13 of Law 146/1914⁽⁴⁵⁾, what has already been mentioned above should be cited here as well. The same applies for the principle that no one can be deprived from his right to use his name, even in transactions in the course of trade.

Moreover with the provisions for the protection of name (and eventually with the ones for the protection of personality as well as of torts) one could deal with cases where private individuals or non profit organizations are using the distinctive signs or the trade name of a famous brand as a domain name, in order to practice from the relative web-page a propaganda campaign against it⁽⁴⁶⁾.

VI. Conclusion

With the above presented remarks we have tried to show part only of the issues that arise in relation to domain names and constitute in a way the top only of an iceberg. The larger the number of the users of the internet is becoming and in particular the more the electronic commerce business is expanding, the more issues will arise concerning domain names. To the issues already addressed one should also add the general issues that relate to law and the internet, such as the issue of the applicable law, but also that of the international jurisdiction and the implementation of judicial awards⁽⁴⁷⁾. The number of the relative cases that are pending before the courts of all the countries of the world is increasing on a geometrical basis over the last years. Initiatives for the resolution of the issue of domain names have been undertaken by many country governments (with leader the Government of the USA) as well as by the European Union and the World Intellectual Property Organization (WIPO)⁽⁴⁸⁾. The latter has also issued on April 1999 a long relative report, where among others the establishment of specific mediation panels and quick procedures for the cancellation of obviously in bad faith registered domain names, are foreseen, with doubtful outcome though⁽⁴⁹⁾.

The short overview above shows from one side the new legal issues that arise from the expansion of this new communication and information medium called the Internet; it also shows on the other side the welfare in protection mechanisms that the legal science is developing, especially in the countries of the roman legal tradition, a fact that is of great significance and importance in view of the globalization that is under process⁽⁵⁰⁾.

FOOTNOTES

(1) Court of First Instance of Siros Nr. 637/1999 Business and Corporate Law (DEE) 1999, 1276. [\(return\)](#)

(2) Internet Protocol number. [\(return\)](#)

(3) Domain Name Server. [\(return\)](#)

(4) For the translation of the term into Greek see the efforts of *Anthimos*, Introduction to the issue of Domain Names, Business and Corporate Law (DEE) 1999, 815, 817. [\(return\)](#)

(5) The administration of the three general (also called "international") top level domains (.com, .net, .org) was up to now exclusively allocated to Internic by virtue of a contract with the U.S. Government, while for the rest 243 regional (country code) top level domains (i.e. .uk for the United Kingdom, .de for Germany, .fr for France a.s.o.) there are special companies or organisations in every country. [\(return\)](#)

(6) Translated into greek as "kivernosfeteristes" by *Anthimos*, passim (Footn. 4), p. 818, footn. 22. [\(return\)](#)

(7) In order to view the activities of Greek cybersquatters it is worth visiting the following websites: mega.gr, net.gr, iaso.com, latsis.com, vardinoyannis.com, athina2004.com, greece2004.com, athina2004.net, olympiada.com, lawyer.gr, doctors.gr, medical.gr which are expressively offered for sale; continent.gr, visa.gr, mastercard.gr, 2004.com which have an ambiguous content; greece2004.org which hosts the web pages of a religious organisation; finally aspis.com which contrary to the address aspis.gr, where the same named company is being promoted, hosts the complaints of one of its clients-investors (the site contains the full story and correspondence between the two parties!). Moreover many domains that today are hosting the web pages of well known companies, were being offered in the near past for sale or rent (i.e. dromeas.gr). [\(return\)](#)

(8) In Greece see *Anthimos*, passim (footn. 4), who cites the international literature, as well as *Perakis*, General Part of Commercial Law, 1999, p. 301. [\(return\)](#)

(9) *Kur*, Namens- und Kennzeichenschutz im Cyberspace, CR 1996, 590, 591. [\(return\)](#)

(10) *Liakopoulos*, Industrial Property II, 4th edition, 1995, p. 130. [\(return\)](#)

(11) *Kur*, passim (footn. 9), p. 591· *Nordemann*, Internet-Domains und zeichenrechtliche Kollisionen, NJW 1997, 1891, 1893. Accordingly in the

U.S.A. Panavision International, L.P. v. Toeppen, 945 F.Supp. 1296,
U.S..P.Q.2d (BNA) 1908 (C.D. Cal. 1996). [\(return\)](#)

(12) The German theory and case law handle the cases where a domain name has only been registered without being used by granting provisional protection towards the upcoming danger of using the domain name in the course of trade (OLG Duesseldorf CR 1998, 165, 166 - epon.de (= NJW-RR 1998, 979)· LG Frankfurt a.M. NJW-RR 1998, 974, 975 - lit.de). More recent decisions moreover rule that the mere registration of a domain name constitutes use in the course of trade, due to its prohibiting function in relation to having the same sign registered as a domain name by another Internet user. (See OLG Dresden CR 1999, 589, 590 (=NJW-CoR 1999, 302) - cyberspace.de· OLG Braunschweig CR 1998 364, 365 - deta.com). [\(return\)](#)

(12) The German literature and case law are dealing with the cases in which a domain name has only been registered without being actually used by accepting a provisional claim towards the upcoming danger of using the domain name in the course of trade (OLG Duesseldorf CR 1998, 165, 166 - epon.de (= NJW-RR 1998, 979)· LG Frankfurt a.M. NJW-RR 1998, 974, 975 - lit.de). Some latest awards also rule that the sole registration already constitutes a use in the course of trade, due it's hindering function for another user of the internet to register the same sign as a domain name (see OLG Dresden CR 1999, 589, 590 (=NJW-CoR 1999, 302) - cyberspace.de· OLG Braunschweig CR 1998 364, 365 - deta.com). [\(return\)](#)

(13) OLG Duesseldorf passim (footn. 12), p. 168. [\(return\)](#)

(14) For France see TGI Bordeaux, ord. ref., 22 juill. 1996, *Sapeso et Atlantel c/ Icare*, PIBD, n° 632, III, p. 274· TGI Versailles, 14 avr. 1998, *Champagne cereales c/ GJ*, Rev. Lamy dr. aff. 1998, n° 7, p. 31, with comment by *L. Costes*. For the U.S.A. see *Maritz, Inc. v. Cybergold, Inc.* 947 F.Supp. 1338 (U.S. District Court, E.D. Missouri). [\(return\)](#)

(15) See LG Muenchen I CR 1997, 540, 541 - freundin.de with comment by *Cloos* (= MMR 1998, 556 =NJW-RR 1998, 984)· LG Hamburg, KuR 1998, 365 - eltern.de· LG Braunschweig passim (footn. 12).For the same issue see also *Wiebe*, Zur Kennzeichnungsfunktion von Domain Names, CR 1998, 157. [\(return\)](#)

(16) In that sense TGI Paris, ord. ref., 12 mars 1998, *Alice c/ Alice*, D. 1999, Jur. p. 316, with comment by *M. Viala*, which has been revoked by the Appellate Court CA Paris, 4 dec. 1998 at http://www.legalis.net/inet/decisions/marques/arret_ca-paris_0411298.htm . [\(return\)](#)

(17) In relation to the risk of confusion in the law of distinctive rights see *N. Rokas*, Unfair Competition, 1975, p. 139 f. [\(return\)](#)

(18) See *Liakopoulos*, Issues of Commercial Law II, 1997, p. 145. [\(return\)](#)

(19) A limit to the above remark will set Art. 281 of the Greek Civil Code, i.e. in cases where the registration of a younger trademark is used in order to "legalise" the registration of the domain name that follows. [\(return\)](#)

(20) It might be possible of course to register the trademark as it is, without any additions under another top level domain, i.e. under .com instead of .gr. [\(return\)](#)

(21) Accordingly for the French law see *Loiesau*, Nom de domaine et Internet: turbulences autour d' un nouveau signe distinctif, D. 1999, Chr. p. 245, 249. *M. Viala*, comment on TGI Paris, passim (footn. 16), p. 318. [\(return\)](#)

(22) See *Liakopoulos*, passim (footn. 18), p. 144. [\(return\)](#)

(23) See LG Muenchen I passim (footn. 15), p. 542. OLG Karlsruhe, MMR 1999, 171, 172 -zwingling.de (unfair gain). In relation to damaging the reputation see in the American case law *Hasbro, Inc. v. Internet Entertainment Group*, 40 U.S.P.Q. 2d 1479 (W.D.Wash.1996). Also OLG Hamm CR 1998, 241, 242 with comments by *Bettinger* - krupp.de (=MMR 1998, 214 with comments by *Berlit*) and OLG Muenchen EwIR 1999, 543 (*Hoeren*) - shell.de with partially ambiguous reasoning, as they accept the existence of a danger of damaging the reputation, but they use as a basis of the relative omission claim the right in the name according to Art. 12 of the German Civil Code. [\(return\)](#)

(24) According to German case law crucial for assessing the use is only the second level domain. As a result the use of a sign under any top level domain (i.e. .com or .gr) constitutes use of a sign that is identical to the trademark. In any case the addition of the top level domain does not constitute an adequate differentiation, in order to exclude the risk of confusion with a previously registered trademark (the same applies of course for the communication protocol <http://www.>, which inevitably accompanies every domain name) See LG Frankfurt a.M. passim (footn. 12), p. 976. OLG Dresden, passim (footn. 12), p. 591 and LG Hamburg of 30.9.1998 (315-0-278/98) – *xtra.net* at <http://www.onlinerecht.de/vorent.html?LGHamburg980930>. The latter correctly rules that the top level domain might become crucial in case it is being used as well in the sense of a trademark. As a result the domain name *xtra.net* does collide with the trademark *xtranet*. [\(return\)](#)

(25) *Kur*, Internet Domain names, CR 1996, 328. *the same*, CR 1996, 593. *the same*, Kennzeichenkonflikte im Internet, in Festschrift fuer Beier, 1996, p. 276. *Hoeren*, Rechtsfragen des Internets, 1996, p. 98 f. *Graefe*, Marken und Internet, MA 1996, 100, 102. *Bettinger*, Kennzeichenrecht im Cyberspace: Der Kampf um die Domain-Namen, GRUR Int. 1997, 402, 412. [\(return\)](#)

(26) Every little deviation while typing a web address (even omitting a full stop) might lead the internet user to a completely different web page than the one he is seeking for. [\(return\)](#)

(27) See *Hoeren*, passim (footn. 25), p. 99. [\(return\)](#)

(28) As it can be indirectly concluded from the case law in relation to adding the top level domain (see above footn. 23). See also OLG Hamm passim (footn. 23), p. 243 that leaves the matter pending. [\(return\)](#)

(29) *Nordemann*, passim (footn. 11), p. 1894. [\(return\)](#)

(30) *Nordemann*, passim, p. 1894. [\(return\)](#)

(31) *Poeck*, in Schwartz, *Recht im Internet*, Stadtbergen, 1996, 4-2.2, p. 16. In relation to the doctrine see *Rokas*, *Trademark law*, 1978, p. 106 and 107 f. [\(return\)](#)

(32) See in depth *Liakopoulos*, *Identical corporate names*, *Epitheorisi Emporikou Dikaiou* 1995, 324 f.. and *N. Rokas*, *Identical trademarks*, *Epitheorisi Emporikou Dikaiou* 1996, 208 f. [\(return\)](#)

(33) In relation to this doctrine in general see *Liakopoulos*, *Industrial Property II*, 4th edition, 1995, p. 185. According to *Kur*, CR 1996, 594 this doctrine meets its limits in the technical peculiarities of the Internet. [\(return\)](#)

(34) In this sense *Viefhues* in *Hoeren/Sieber/Decker* kap. 6, Nr. 84. [\(return\)](#)

(35) According to Art. 8 of the International Convention of Paris the trade name (and the distinctive title) is being protected despite the principle territoriality "in every country of the Union without any obligation of registration, regardless of the fact whether it constitutes part of a trademark or not". [\(return\)](#)

(36) See supra under IV. [\(return\)](#)

(37) According to the almost unanimous opinion of the courts and the literature in Germany (see instead of many others OLG Dresden passim (footn. 12), p. 590 and *Wiebe*, *Zur Kennzeichnungsfunktion von Domain Names*, CR 1998, 157) but in the United Kingdom as well (see. *British Telecommunications plc. and others. v. One in a Million Ltd. and others*, 1998 4 AllER 476) the use of a trademark as a domain name is capable of insulting the function of origin of a trademark, that means it can be constituting a use as a trademark. Indeed taking into consideration the practices of Internet users in relation to locating the web pages of a commercial enterprise as well as the fact that the web address (which is free to choose and is not being allocated following a strictly technical method, the way a usual phone number is) will usually be printed on the commercial correspondence stationary, the advertisements and sometimes even on the products, the use of a domain

name not as trademark will form the exception, at least in the context of e-commerce. [\(return\)](#)

(38) OLG Dresden passim (footn. 12), p. 592. [\(return\)](#)

(39) See the well-known award of BGH GRUR 1985, 550 - Dimple. [\(return\)](#)

(40) LG Duesseldorf passim (footn. 12), p. 171· LG Braunschweig passim (footn. 12), p. 366· LG Braunschweig CR 1997, 414 - braunschweig.de. due of lack of a competition relationship *Wilmer*, Offene Fragen der rechtlichen Einordnung von Internetdomains, CR 1997, 562, 565 partially also *Bettinger*, passim (footn. 25), p. 412 f. [\(return\)](#)

(41) See *British Telecommunications plc. and others. v. One in a Million Ltd. and others*, passim (footn. 37), as well as *R. Meyer-Rochow*, The application of passing off as remedy against domain name piracy, 20 European Intellectual Property Review, Nov. 1998, p. 405. [\(return\)](#)

(42) See *N. Rokas*, Unfair Competition, 1975, p. 133 f. [\(return\)](#)

(43) For German law see *Bettinger*, passim (footn. 25), s. 414· *Bucking*, Internet-Domains - Neue Wege und Grenzen des buergerlich-rechtlichen Namensschutzes, NJW 1997, 1887, 1890. See also the distinction made by *Wilmer*, passim (footn. 40), p. 566. [\(return\)](#)

(44) The first judicial award globally devoted to the issue of domain grabbing (LG Mannheim, CR 1996, 353 with comment by *Hoeren*) has prevented a company providing computer and internet services from publishing information on the city of Heidelberg under the domain name heidelberg.de. The court has [\(return\)](#)

(45) See *Liakopoulos*, Industrial Property II, 4th edition, 1995, p. 185. [\(return\)](#)

(46) *Kur*, Festschrift fuer Beier, 1996, p. 274 with reference to BGH GRUR 1984, 684 - Mordoro. In such a case in order to assess the conflicting interests (being among others the freedom of speech from the side of the holder of the domain name) the court will inevitably have to take under consideration also the fact that the use of the domain name for that purpose deprives the owner of the trademark from the chance of using it in the Internet market. [\(return\)](#)

(47) See *Karakostas*, Law of the Internet, Nomiko Vima 46, 1172, 1181 f.· *Marinos*, The Internet and its consequences mainly in the field of law, Elliniki Dikaiosini 1998, 1 f. · *Mouzoulas*, Transactions via the Internet, Elliniki Dikaiosini 1998, 15 f. (also at <http://www.lawnet.gr/congress1/mouzoulas.html>). For the jurisdiction in particular see *Kalow*, From the Internet to Court: Exercising Jurisdiction over World Wide Web Communications, 65 Fordham Law Review 2241. [\(return\)](#)

(48) It is worth noting that the WIPO itself is a victim of domain grabbing (wipo.com), but being an international organization it is being hosted under the top level domain .int. [\(return\)](#)

(49) The application of the report-proposal (at <http://wipo2.wipo.int/process/eng/processhome.html>), provided that it will be adopted by the competent authority, the organization which will be regulating and managing the naming system in the Internet ([ICANN](#)), will be limited to the three generic top level domains (.com, .net., .org) and therefore will not automatically apply to the greek domain (.gr). For a brief summarized description of the report see *Anthimos*, passim (footn. 4), p. 824. [\(return\)](#)

(50) See also *Lehmann*, Cyberlaw: Rechtsevolution durch Globalisierung, in *Festschrift fuer Fikentscher*, 1997, p. 944, 952. [\(return\)](#)