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Two important developments in the field of domain names

Over the last ten months, the Belgian law of June 26, 2003 relating to the improper registration of domain names (in force since September 19, 2003) same convinced several right holders.

In December 2004, the first "reservations" of ".eu" domain names will be possible.

Further details hereafter.

Aim of the new Belgian legislation :

Domain names are generally delivered according to the rule "*first come, first served*" without further checking. It is the case in particular for ".be", ".com", ".net". Consequently, the owner of prior rights on the name, for example the one who holds a trademark right or copyright on the name or whose patronymic name or trade name is identical, will have to go and see a judge or an arbitrator to have the domain name usurped by a third party cancelled or to "recover" it.

The Belgian legislator considered that courses of action previously available to the "victims" of such a behaviour sometimes called "cyber squatting" were not sufficient. Belgium passed this new legislation, which specifically allows to fight against certain improper registrations of domain names.

Content of the New Belgian legislation:

The law opens a specific procedure ("action en cessation") to be brought before the president of the court (of trade or first instance, depending on the case) and allowing to quickly obtain a decision on the merits (in several months) ordering the domain name cancellation or its transfer to the "natural" owner.

The law defines the improper registration as follows: 1) the registered domain name is identical or similar (to such an extent that it leads to confusion) to a name on which the plaintiff has a prior right (copyright, trademark, company name, patronymic name, trade name, indication of origin or appellation of origin), 2) the owner of the domain name has no right to or legitimate interest in the name, 3) the owner of the domain name has acted with the intention of prejudicing the plaintiff or of unduly taking advantage from him (e.g. extorting money).

The action can be brought if 1) the cyber squatter is domiciled or established in Belgium (be the domain name registered under ".be", ".com" or any other domain), or 2) if the cyber squatter has registered the domain name under ".be" (whatever his domicile is). There must thus be a link with Belgium.

Alternative procedures :

Other available procedures are not specific to domain names, except the one before Cepani (Belgian Centre for Arbitration and Mediation, www.cepani.be). Beside this Cepani procedure, the actions based on trademark infringement, on unfair trade practices (in case of a prior trade name in particular) and on the liability can be particularly mentioned.

The Cepani procedure consists in a very fast arbitration procedure (2-3 months), which occurs online without – in principle - appearance of the parties in court. One can only require this procedure if the plaintiff shows not only that the domain name is identical or similar (with a risk of confusion) to a name on which he has a prior right (e.g. a trademark) and that the owner of the domain name has no right to or legitimate interest in this name, but also that he has registered *and* used the domain name in *bad faith*.

Contact

Antonietta Arcuri
manager of trademark dept.
a.arcuri@office-kirkpatrick.com

Dominique Kaesmacher
chief IP counsel
d.kaesmacher@office-kirkpatrick.com

Avenue Wolfers, 32
B 1310 La Hulpe (Brussels)
Belgium
Tel: +32 2 652 1600
Fax: +32 2 652 1900
www.office-kirkpatrick.com

Our recommendations :

Even more than before, it is useful to protect the distinctive signs used by your company with trademark rights. The registration of your mark indeed grants you an increased protection and reinforces your possibilities of actions in case of use of your mark by a third party without your consent, in particular within the context of an improper registration of domain name.



« .eu » Top Level Domain name

It will soon be possible (early 2005) to register a domain name ".eu" with EURid based on the rule "*first come, first served*".

To favor the owners of trademarks, an initial phase ("*sunrise period*") has been foreseen, which should start from December 2004 onwards. During this period, the companies established in Europe, already owners of a registered trademark

at the Community level or in one of the countries of the European Union (or in the Benelux), as well as the owners of geographical indications and the public law agencies will be able to take an option on a domain name under the extension ".eu" corresponding to their mark or to their other prior right.

More details soon.

Our recommendations :

If you contemplate registering a ".eu" domain name, the protection of your sign as a trademark will enable you to "save" your domain name during the "sunrise period" ... provided that you are the first in line and that the registration certificates are conform to the reality. It is therefore essential to have your trademark portfolios perfectly up-to-date, in particular with respect to the legal form, the name and the coordinates of the trademark owner. Be careful and precise.

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Contact

Antonietta Arcuri
manager of trademark dept.
a.arcuri@office-kirkpatrick.com

Dominique Kaesmacher
chief IP counsel
d.kaesmacher@office-
kirkpatrick.com

Avenue Wolfers, 32
B 1310 La Hulpe (Brussels)
Belgium
Tel: +32 2 652 1600
Fax: +32 2 652 1900
www.office-kirkpatrick.com

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