

## RESOLVING DOMAIN NAME DISPUTES – A SINGAPORE PERSPECTIVE

### Introduction

1 Internet domain name disputes present interesting legal problems because of the way the Internet works.

2 The facts of *Viacom International Inc v Elitist Technologies Co Ltd*,<sup>1</sup> the first case to be dealt with under the Singapore Domain Name Dispute Resolution Policy, clearly illustrate this.

3 The complainant was an entertainment company incorporated in the State of Delaware, USA, with its principal place of business in New York, USA. One of its divisions, MTV Networks, operated “MTV: Music Television”, a widely distributed television programming service that featured entertainment oriented television programmes. The complainant was also the registered proprietor of various trade marks incorporating the initials “MTV”.

4 The respondent was a company incorporated in Taiwan. It had registered the domain name “mtv.com.sg” with the Singapore ccTLD<sup>2</sup> domain name registration authority, and was using the domain name for a website providing an e-mail service and links to certain entertainment websites. Internet users from around the world were potentially able to access the respondent’s website through their Internet web browsers by typing the URLs<sup>3</sup> “http://mtv.com.sg” or “http://www.mtv.com.sg”.

5 The complainant wished to have the domain name “mtv.com.sg” transferred to it. The respondent did not agree to the transfer.

6 If the complainant was considering litigation, it would have to address the following questions:

- 1 Singapore Domain Name Dispute Resolution Service Case No. SDRP-2002/0001(F). The Singapore Domain Name Dispute Resolution Service was established to manage administrative proceedings under the Singapore Domain Name Dispute Resolution Policy, and is run by a Secretariat jointly operated by the Singapore Mediation Centre and the Singapore International Arbitration Centre. The full text of the decision may be obtained from the Secretariat’s website at “http://www.disputemanager.com.sg”.
- 2 “ccTLD” stands for “country code Top Level Domain”. The term is explained in the section entitled “An Overview of the Domain Name System”.
- 3 “URL” stands for “Universal Resource Locator” or “Uniform Resource Locator”. The term is explained in the section entitled “An Overview of the Domain Name System”.

- (1) In which jurisdiction should proceedings be brought, bearing in mind the different nationalities of the complainant, the respondent and the domain name registration authority, and the fact that the respondent's website was potentially accessible by Internet users from around the world?
- (2) Would the domain name registration authority be bound by the judgment of a court in a different jurisdiction from that in which the domain name registration authority was located?
- (3) Must the domain name registration authority be made a party to the litigation?
- (4) What should the proper law for the determination of the dispute be?
- (5) What cause of action, if any, did the complainant have against the respondent?

7 The complainant would also want to consider whether there were any effective alternatives to litigation.

8 Suppose that the disputed domain name was not "mtv.com.sg" but "mtv.com". ".com" is a gTLD<sup>4</sup> for which the central authoritative database is operated by USA-based VeriSign Global Registry Services. Would those questions be answered in the same way?

9 This paper considers some of these issues. The paper begins with an introduction to the Domain Name System and explains how domain name disputes arise. Next, the paper discusses the different domain name dispute resolution mechanisms that are available. In particular, the paper considers the legal and jurisdictional problems associated with litigation. The paper also discusses two dispute resolution mechanisms that have been developed to try to circumvent these problems, namely, the Uniform Domain Name Dispute Resolution Policy and the Singapore Domain Name Dispute Resolution Policy. The paper discusses the position as at 25 May 2002.

4 "gTLD" stands for "global Top Level Domain" or "generic Top Level Domain". The term is explained in the section entitled "An Overview of the Domain Name System".

## **An Overview of the Domain Name System**

### *The Internet*

10 The Internet refers to the global network of interconnected host computers that communicate using the TCP/IP protocol.

11 A protocol is a set of rules on how to transmit data. IP or “Internet Protocol” provides a mechanism for sending packets of data from one computer to another. TCP or “Transmission Control Protocol” provides the mechanism that ensures that data transmitted from one computer to another is in fact received by the second computer. If a packet of data is lost in the course of transmission, TCP will cause the packet of data to be re-sent. The TCP/IP protocol allows different computers to transmit data to each other reliably.

12 Data on the Internet is provided by host computers that are connected to the Internet throughout the day.

13 Every host computer on the Internet must have a unique IP address to enable it to be contacted. Presently, an IP address consists of four numbers ranging from 0 to 255, separated by periods, e.g. 160.96.179.46.

14 Although IP addresses provide a convenient, compact representation for specifying the source and the destination for packets of data sent across the Internet, Internet users prefer human-friendly and pronounceable names to identify computers on the Internet as these are easier to remember. Domain names serve this function.

### *Domain Names*

15 A domain name is a textual address for a location on the Internet. Domain names correspond to IP addresses. Examples of domain names include: “supcourt.gov.sg” (for the Supreme Court, Singapore), “sal.org.sg” (for the Singapore Academy of Law), “nus.edu.sg” (for the National University of Singapore) and “yahoo.com” (for Yahoo! Inc).

16 A domain name such as “nus.edu.sg” has three components. Moving from right to left:

- (1) the first component (sg) is a Top Level Domain or “TLD”, which, in this case, is the country code Top Level Domain or “ccTLD” for Singapore;
- (2) the second component (edu) is a Second Level Domain, and this reflects the nature of the organisation registering the domain name, which, in this case, suggests that the registrant is an educational institution; and

- (3) the third component (nus) is the Third Level Domain, and this is what the organisation registers with the “.sg” domain name registry.

17 Host computers of organisations affiliated with the National University of Singapore can be named as subdomains of the domain name “nus.edu.sg” to show that these organisations are affiliated with the National University of Singapore. For instance, the Law Faculty’s host computer has the subdomain name “law.nus.edu.sg”.

18 A domain name such as “yahoo.com” has two components. Moving from right to left:

- (1) the first component (com) is a global or generic Top Level Domain or “gTLD” which, in this case, suggests that the registrant is a commercial organisation; and
- (2) the second component (yahoo) is the Second Level Domain that the organisation registers with the “.com” domain name registry.

19 A domain name should be distinguished from a hostname such as “www.nus.edu.sg”. A domain name is the textual address of the location of a set of computers. A hostname is the name of a host computer that resides within the “nus.edu.sg” domain. It is common practice to have Internet web servers running on host computers with hostnames beginning with “www” (for “world wide web”).

20 A domain name should also be distinguished from a URL such as “http://www.nus.edu.sg/”. URL stands for “Universal Resource Locator” or “Uniform Resource Locator”. A URL refers to the location (in textual form) of a particular document (such as a webpage) on the Internet. Since the document resides on a particular computer, both the domain name and the hostname often appear as part of the URL.

### *The Domain Name System*

21 As computers only understand numerical IP addresses while Internet users remember textual domain names, hostnames or URLs, there must be a record that computers can refer to that maps “www.nus.edu.sg” to a specific IP address before Internet users can access that particular webpage.

22 The Internet Domain Name System (“DNS”) is a set of databases that help to establish Internet connections by translating domain names into IP addresses. These databases are located in name servers that are distributed throughout the Internet. Name servers are computers that map domain names into IP addresses. Root name servers provide authoritative information on the identities of other name servers that provide authoritative

information on Top Level Domains or “TLDs”. The authoritative name servers for TLDs in turn identify the name servers that provide information on the lower level domains.

23 When an Internet user types a URL such as “http://www.yahoo.com/” in his web browser, his computer sends a query to the local name server to which his computer is connected. If the local name server has the corresponding IP address, this will be provided to the user’s computer, which will then contact “www.yahoo.com” directly using the IP address provided. If the local name server does not have the corresponding IP address, it will send the query to a root name server. The root name server will direct the local name server to the authoritative “.com” TLD name server. The local name server then sends the same query to the authoritative “.com” TLD name server. The authoritative “.com” TLD server will provide the local name server with the correct IP address, and the local name server will in turn transmit this information to the user’s computer. The user’s computer will then contact “www.yahoo.com” directly using the IP address provided.

24 The Internet Assigned Numbers Authority (“IANA”) is the authority responsible for the day-to-day administration of the DNS. IANA carries out the administrative responsibilities for the assignment of IP addresses, TLDs and other parameters of the DNS and its protocols. These Internet technical management functions of IANA were previously performed by a contractor engaged by the United States government.

25 In 1998, the United States government issued a policy statement to initiate the transfer of the IANA technical management functions from the United States government to the private sector. The Internet Corporation for Assigned Names and Numbers (“ICANN”) was formed as a non-profit, private sector organisation in October 1998 to take over the IANA functions. ICANN also coordinates the operation of the root name server system and is responsible for making policies concerning the DNS. Unlike the previous operators of IANA, ICANN does not receive payment from the United States government for its services in running the IANA functions. Instead, ICANN is funded through payments from domain name registry operators and registrars.

26 The DNS structure adopts a hierarchical naming scheme to provide for the demand for domain names arising from the growth of the Internet. Two naming hierarchies are used for TLDs.

27 The first naming hierarchy is an organisational scheme. TLDs under this scheme are called global or generic Top Level Domains or “gTLDs”. There are currently fourteen gTLDs in use, namely:

- (1) “.aero” for the air-transport industry;
- (2) “.biz” for businesses;

- (3) “.com” for commercial entities;
- (4) “.coop” for cooperatives;
- (5) “.info” which allows registration by any person or organisation for any purpose;
- (6) “.museum” for museums;
- (7) “.name” for individuals;
- (8) “.net” for major network support centres;
- (9) “.org” for organisations other than commercial entities and network support centres;
- (10) “.pro” for accountants, lawyers, physicians and other professionals;
- (11) “.gov” for the United States government;
- (12) “.edu” for educational institutions in the United States that grant four-year degrees;
- (13) “.mil” for the United States military; and
- (14) “.int” for organisations established by international treaties between governments.

28 The “.biz”, “.info” and “.name” gTLDs became operational in 2001 while the “.aero”, “.coop”, “.museum” and “.pro” gTLDs became operational in 2002. These seven new gTLDs were selected by ICANN in November 2000 for inclusion in the DNS.

29 Each gTLD has a registry to handle the registration of Second Level Domains for that particular gTLD. The registry operator maintains the central authoritative name servers for the gTLD. For certain gTLDs, e.g. the “.aero”, “.biz”, “.com”, “.info”, “.name”, “.net” and “.org” gTLDs, registration can also be effected through registrars accredited by ICANN who are not the registry operators.

30 Under the organisational scheme, the Second Level Domains are usually the names, initials or trade marks (in text form) of the registering organisations, or any other words or combinations of alphabets, numbers and hyphens<sup>5</sup> that the registrant wishes to be associated with.

5 The limitations are that the combinations: (a) cannot begin or end with a hyphen; (b) must contain at least one alphabet; and (c) cannot exceed 63 characters in length.

31 The second naming hierarchy is a geographical scheme, under which country code Top Level Domains or “ccTLDs” are assigned based on the ISO 3166-1 standard. There are presently 243 ccTLDs.<sup>6</sup> Examples of ccTLDs include: “.sg” for Singapore, “.my” for Malaysia, “.cn” for China and “.tv” for Tuvalu. IANA delegates the responsibility for the administration of ccTLDs to individual country managers. Generally, the individual country managers assume the role of registry operators and have full control over the operation of the DNS service for their respective ccTLDs. They are also required to maintain name servers for their respective ccTLDs. In the case of Singapore, this responsibility is delegated to the Singapore Network Information Centre (SGNIC) Private Limited (“SGNIC”).

#### *SGNIC – The .sg Registry*

32 SGNIC, a subsidiary of the Info-communications Development Authority of Singapore, administers the Internet domain space for the “.sg” ccTLD. SGNIC has restricted “.sg” Second Level Domains to six categories, namely:

- (1) “.com.sg” for:
  - (a) commercial entities registered or about to be registered with the Registry of Companies and Businesses, the Trade Development Board or any professional body; or
  - (b) a foreign company with a Singapore representative which is a legal entity that is registered with the Registry of Companies and Businesses, the Trade Development Board or a professional body, and which is duly authorised in writing by the foreign company to apply for the registration of the domain name;
- (2) “.net.sg” for network providers in Singapore with valid licences issued by the Info-communications Development Authority of Singapore;
- (3) “.org.sg” for non-profit organisations such as societies registered with the Registry of Societies, community centres and the People’s Association;

6 An updated list of ccTLDs is available at the URL “<http://www.iana.org/cctld/cctld-whois.htm>”.

- (4) “.gov.sg” for Singapore government entities;
- (5) “.edu.sg” for educational institutions registered with the Ministry of Education, Singapore; and
- (6) “.per.sg” for the registration of personal domain names for use by individuals who are Singapore citizens or permanent residents.<sup>7</sup>

33 SGNIC registers only Third Level Domains for the “.sg” ccTLD. Organisations may register as Third Level Domains their names, initials or trade marks (in text form), or any other words or combinations of alphabets, numbers and hyphens<sup>8</sup> that the registrant wishes to be associated with. An individual cannot register another person’s name as his personal domain name. SGNIC also maintains a list of “.per.sg” domain names that are not available for registration.

34 SGNIC maintains the name servers for the “.sg” ccTLD and Second Level Domains and the database information for all “.sg” domain names. Registration of a domain name with SGNIC gives the registrant the right to use, but not own, the domain name as the registrant’s address on the Internet.

### **Domain Name Disputes and Dispute Resolution Options**

35 As domain names are used to establish a presence on the Internet, many organisations register as their domain names their own names, initials or trade marks (in text form), or words that are descriptive of their products or services or that are otherwise associated with them. It is almost intuitive for a seasoned Internet user seeking to locate the website of a particular organisation to type as URL words or initials that he would associate with that organisation.

36 However, domain names are usually issued on a “first come, first served” basis. Many TLD registries do not require an applicant to prove that he is entitled to a particular domain name before registering the domain name. As domain names are necessarily unique, disputes over who is entitled to a particular domain name may arise where there are two

7 See clause 4 of SGNIC’s generic Domain Name Registration Agreement (Revision 3) and clause 4 of SGNIC’s “.per.sg” Domain Name Registration Agreement (Revision 2).

8 The limitations are that the combinations: (a) cannot begin or end with a hyphen; (b) must contain at least one alphabet; and (c) cannot exceed 63 characters in length.

or more parties interested in using the same domain name. The parties to a typical domain name dispute are the registrant of the domain name (the “registrant”) and the party seeking to take over the domain name (the “complainant”).

- 37 Generally, a domain name dispute may be resolved in four ways:
- (1) by agreement between the parties (for instance, where the domain name is transferred by the registrant to the complainant for an agreed consideration);
  - (2) by using alternative dispute resolution mechanisms such as mediation, med-arb or arbitration;
  - (3) by court proceedings; and
  - (4) by using any administrative procedure for resolving domain name disputes that may be prescribed by the domain name registration agreement entered into between the registrant and the registry/registrar for that domain name.

38 Examples of administrative procedures for resolving domain disputes include:

- (1) ICANN’s Uniform Domain Name Dispute Resolution Policy (“UDRP”), which has been adopted by all ICANN accredited registrars for the “.aero”, “.biz”, “.com”, “.coop”, “.info”, “.museum”, “.name”, “.net” and “.org” gTLDs; and
- (2) the Singapore Domain Name Dispute Resolution Policy (“SDRP”), which has been adopted by SGNIC for the “.sg” ccTLD.

39 It should be noted that not all domain name registration agreements provide for administrative procedures for resolving domain name disputes. For instance, SGNIC’s old domain name registration agreements did not provide for such dispute resolution procedures. This is also the position under certain ccTLDs.

40 Returning to the facts of *Viacom International Inc v Elitist Technologies Co Ltd*, what are the options available to the complainant if an unrelated party registers domain names such as “mtv.com.sg” or “mtv.com”?

41 First, the complainant could choose to do nothing. As of now, there are a total of six gTLDs (“.biz”, “.com”, “.info”, “.name”, “.net” and “.org”) and 243 ccTLDs at which “mtv” can potentially be registered as a second or lower level domain (depending on the registry concerned). It may not be worth the while pursuing the matter.

42 Second, the complainant could try to negotiate with the registrant to reach an agreement for the transfer of the domain name “mtv.com.sg” to the complainant.

43 Third, the complainant could try to persuade the registrant to resolve the dispute by alternative dispute resolution mechanisms such as mediation, med-arb or arbitration. However, this requires the parties to enter an agreement on a dispute resolution process, and the registrant is not obliged to agree.

44 Fourth, the complainant could commence court proceedings in an appropriate jurisdiction. This raises the jurisdictional and legal issues highlighted at the start of this paper. These matters will be dealt with under the section entitled “Litigation”.

45 Fifth, the complainant could initiate proceedings under the administrative procedures for resolving domain name disputes that are prescribed by the domain name registration agreements entered into between the registrant and the registry/registrar. In the case of a “.com” domain name such as “mtv.com”, the relevant procedure would be the UDRP, which is discussed under the section entitled “ICANN’s Uniform Domain Name Dispute Resolution Policy”. In the case of a “.sg” domain name such as “mtv.com.sg”, the relevant procedure would be the SDRP, which is discussed under the section entitled “The Singapore Domain Name Dispute Resolution Policy”.

## **Litigation**

### *Jurisdictional Issues*

46 A website that makes use of a particular domain name may be viewed from anywhere in the world. The registrant, the complainant and the domain name registry/registrar may well reside or be located in different jurisdictions. Given these circumstances, if the complainant wished to determine a domain name dispute by litigation, what should the proper forum and the proper law for determining the dispute be?

47 As there is no contract between the complainant and the registrant, the complainant’s cause of action, if any, must lie in tort. The complainant would have to bear in mind the following practical considerations when choosing the forum in which to commence court proceedings:

- (1) Where was the tort committed?

The location of the tort is significant because it may determine whether a particular cause of action is available to the

complainant. For instance, trade mark legislation does not have extra-territorial effect.<sup>9</sup> As such, if the complainant wished to rely on trade mark infringement, the court proceedings must be brought in the jurisdiction in which the complainant's trade mark was allegedly infringed.

Whether a tort occasioned by the use of a domain name is committed within a particular jurisdiction may well depend on whether the Internet website that adopts the domain name is directed at Internet users within that jurisdiction. The mere fact that an Internet website may be accessible to the world at large does not necessarily mean that the registrant has potentially committed the tort in every country in the world.<sup>10</sup>

(2) Where would the order of court be enforced?

The primary relief sought in a domain name dispute is an injunction to compel the registrant to transfer the domain name to the complainant or cancel the registration of the domain name. Logically, court proceedings should only be commenced in a jurisdiction where such an injunction can be effectively enforced against the registrant.

If the registrant and the registry/registrar are located within the same jurisdiction, the complainant would obviously commence court proceedings in that jurisdiction. However, if the registrant and the registry/registrar are located in different jurisdictions, it may be prudent to commence court proceedings in the jurisdiction in which the registry/registrar is located (as opposed to the jurisdiction in which the registrant is located). It is the registry/registrar that has access to the nameservers that map a domain name to an IP address. As such, the injunction should be sought from a court that can compel or authorise the registry/registrar to effect the transfer or cancellation of the domain name, if the registrant fails to comply with the injunction. One cannot assume that a registry/registrar will give effect to a foreign injunction. A domain

9 In *Parno v SC Marine Pte Ltd* [1999] 4 SLR 579, the Court of Appeal observed that Parliament could not have intended a piece of domestic legislation to apply abroad if enforcement of the legislation would be impossible without infringing on the sovereignty of another state, let alone the practical difficulties associated with such enforcement worldwide.

10 This appears to be the position in England after *Euromarket Designs Incorporated v Peters and Another* [2000] ETMR 1025. A more detailed analysis of the reasoning behind this proposition may be found later in this paper in the discussion on trade mark infringement.

name registry/registrar may, in the domain name registration agreement that it enters with the registrant, identify the courts whose jurisdiction the registrant is required to submit to in the event of a domain name dispute and the courts whose orders the registry/registrar will abide by.<sup>11</sup> The complainant may also commence proceedings against the registrant in the jurisdiction where the registrant is located if the complainant is satisfied that the injunction can be effectively enforced there.

48 Complainants who wish to make use of ICANN's Uniform Domain Name Dispute Resolution Policy are required to agree to submit to the jurisdiction of the court at:

- (1) the principal office of the registrar with whom the registrant has registered the domain name that is the subject of the complaint; or
- (2) the registrant's address as shown in the registration of the domain name in the registrar's "Whois" database<sup>12</sup> at the time the complaint is submitted.

This requirement was introduced to provide a definite judicial forum to which the registrant can turn to if the registrant wished to challenge a decision of an administrative panel ordering the transfer of the domain name to the complainant or the cancellation of the domain name.<sup>13</sup>

49 For the same reason, complainants who wish to make use of the Singapore Domain Name Dispute Resolution Policy are required to submit to the jurisdiction of the courts in Singapore.<sup>14</sup>

50 Aside from the practical considerations regarding the choice of forum, there may also be legal requirements that have to be satisfied before the courts in a particular forum can assume jurisdiction over the matter. The precise requirements may vary from one jurisdiction to another.

11 For instance, see clauses 27 and 30 respectively of SGNIC's generic Domain Name Registration Agreement (Revision 3) and clauses 29 and 32 respectively of SGNIC's ".per.sg" Domain Name Registration Agreement (Revision 2).

12 This is a database maintained by a registrar or registration authority that provides the identity and contact particulars of every registrant registered with it.

13 See paragraph 3(b)(xiii) read with the definition of "Mutual Jurisdiction" in paragraph 1 of the ICANN Rules for Uniform Domain Name Dispute Resolution Policy.

14 See paragraph 3(b)(xiii) of the Rules for the Singapore Domain Name Dispute Resolution Policy.

51 If court proceedings are commenced in Singapore in respect of a “.sg” domain name, Singapore is clearly an appropriate judicial forum for determining the dispute. SGNIC is located in Singapore. The registration of the domain name takes place in Singapore. The authoritative nameservers maintained by SGNIC for “.sg” domain names are located in Singapore. Every registrant of a “.sg” domain name is required to enter a domain name registration agreement with SGNIC. The registration agreement expressly provides for disputes over the registration and use of a “.sg” domain name to be “adjudicated upon by the Singapore Courts”.<sup>15</sup> The registrant is bound by this term and would therefore have submitted to the jurisdiction of the Singapore courts. A complainant who wishes to obtain the transfer of the domain name to himself would also have to abide by the terms of the registration agreement.

52 However, if the dispute pertains to a domain name based on any other gTLD or ccTLD, whether a Singapore court may be an appropriate forum for determining the dispute would depend on:

- (1) whether the statutory requirements for the exercise of the court’s jurisdiction over the matter have been met;<sup>16</sup> and
- (2) whether the registrant can succeed in an application to stay the proceedings on the ground of *forum non conveniens* (if the registrant should take out such an application).<sup>17</sup>

53 In Singapore, the likely causes of action in a domain name dispute are the statutorily created tort of trade mark infringement and the common law tort of passing off. As the Trade Marks Act (Cap 332, 1999 Ed) has no extra-territorial application,<sup>18</sup> a Singapore court can entertain such a trade mark infringement claim only if it is alleged that the registration or use of the domain name constituted use of the complainant’s mark in Singapore. However, a Singapore court can entertain a claim for passing off that is alleged to have been committed abroad if the requirements of the “double actionability rule” are satisfied.

15 See clause 27 of SGNIC’s generic Domain Name Registration Agreement (Revision 3) and clause 29 of SGNIC’s “.per.sg” Domain Name Registration Agreement (Revision 2).

16 These are set out at section 16(1) Supreme Court of Judicature Act (Cap 322, 1999 Ed) and section 19(3) Subordinate Courts Act (Cap 321, 1999 Ed).

17 As to the principles governing a stay of proceedings on the ground of *forum non conveniens*, see *Brinkerhoff Maritime Drilling Corp & Anor v PT Airfast Services Indonesia and another appeal* [1992] 2 SLR 776, *Eng Liat Kiang v Eng Bak Hern* [1995] 3 SLR 97, *Oriental Insurance Co Ltd v Bhavani Stores Pte Ltd* [1998] 1 SLR 253 and *PT Hutan Domas Raya v Yue Xiu Enterprises (Holdings) Limited & Anor* [2001] 2 SLR 49.

18 See footnote 9.

54 The double actionability rule provides that in order to found a claim in Singapore for a wrong alleged to have been committed abroad, two conditions must be fulfilled:

- (1) the wrong must be of such a character that it would have been actionable if committed in Singapore; and
- (2) the act must not have been justifiable by the place where it was done.

However, this rule is not immutable and may be departed from in appropriate circumstances, taking into account the varying interests and policy considerations that may arise when one or more foreign elements are present. Indeed, the Singapore courts have affirmed that either of the two limbs of the double actionability rule may be dispensed with in an appropriate case.<sup>19</sup>

55 The proper law for determining a domain name dispute depends on the choice of law rules that are applicable at the forum where the complainant has chosen to commence proceedings. As with jurisdictional requirements, the choice of law rules may vary from one jurisdiction to another.

56 In Singapore, where the parties do not plead foreign law, Singapore law will be applied. Notwithstanding the existence of the double actionability rule, there is no requirement for a plaintiff to plead actionability under a foreign law. If the plaintiff does not allege that the defendant's acts are wrongful under the law of the place of the tort, a tort claim involving foreign elements may be treated as if it was a domestic case. The rationale is this. The double actionability rule is a requirement that has to be satisfied only where a conflict of laws is raised on the pleadings, for instance, where a defendant pleads a defence or a lack of actionability or equivalent liability under the *lex loci delicti* (i.e. the law of the forum where the tort was committed). It is then for the plaintiff to aver for the application of the *lex fori* (i.e. the law of the forum in which the case is tried), if that is his preferred law of choice, as the proper law governing the tort. In the absence of any conflict of laws, the *lex loci delicti* and the *lex fori* are treated as the same, and a judge would in that case apply the law of the forum in which he sits.<sup>20</sup>

19 See *Goh Chok Tong v Tang Liang Hong* [1997] 2 SLR 641 and *Parno v SC Marine Pte Ltd* [1999] 4 SLR 579.

20 See *Goh Chok Tong v Tang Liang Hong* [1997] 2 SLR 641.

*Legal Issues*

57 If a domain name dispute is litigated in Singapore, the causes of action that are potentially available to a complainant are trade mark infringement and passing off.

58 To rely on trade mark infringement, the complainant must be the proprietor of a registered trade mark.

59 The statutory cause of action for trade mark infringement is created by section 27 of the Trade Marks Act (Cap 332, 1999 Ed), which, in so far as it is material, provides as follows:

**“Acts amounting to infringement of registered trade mark**

27. – (1) A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.

(2) A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade a sign where because –

- (a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or
- (b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

there exists a likelihood of confusion on the part of the public.

(3) A person infringes a registered trade mark which is well known in Singapore if –

- (a) without the consent of the proprietor of the trade mark, he uses in the course of trade a sign which is identical with or similar to the trade mark, in relation to goods or services which are not similar to those for which the trade mark is registered;
- (b) the use of the trade mark in relation to those goods or services would indicate a connection between those goods or services and the proprietor;
- (c) there exists a likelihood of confusion on the part of the public because of such use; and
- (d) the interests of the proprietor are likely to be damaged by such use.

(4) For the purposes of this section, ... a person uses a sign if, in particular, he –

- (a) applies it to goods or the packaging thereof;
- (b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;
- (c) imports or exports goods under the sign;
- (d) uses the sign on an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document; or
- (e) uses the sign in advertising.”

60 The plaintiff in an action for infringement of a registered trade mark would have to establish one of the following three scenarios:

- (1) the defendant has used in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical to those for which it is registered;<sup>21</sup>
- (2) the defendant has used in the course of trade a sign which is:
  - (a) identical with the trade mark in relation to goods or services similar to those for which the trade mark is registered; or
  - (b) similar to the trade mark in relation to goods or services identical with or similar to those for which the trade mark is registered,and there exists a likelihood of confusion on the part of the public;<sup>22</sup> or
- (3) if the registered trade mark is well known in Singapore:
  - (a) the defendant has used in the course of trade a sign which is identical with or similar to the trade mark in relation to goods or services which need not be similar to those for which the mark is registered;
  - (b) the use of the trade mark in relation to those goods or services would indicate a connection between those goods or services and the proprietor of the trade mark;

21 Section 27(1) Trade Marks Act.

22 Section 27(2) Trade Marks Act.

- (c) there exists a likelihood of confusion on the part of the public because of such use; and
- (d) the plaintiff's interests are likely to be damaged because of such use.<sup>23</sup>

61 What is common to all three scenarios is that the defendant has used an identical or similar sign in the course of trade in relation to goods or services. This requirement may possibly be satisfied if a registrant has set up a website advertising or offering goods or services using a domain name that is identical with or similar to a registered trade mark in text form.

62 However, the mere fact that the registrant has set up an Internet website that is accessible to the world at large does not necessarily mean that the registrant has used the sign in every country in the world. For there to be trade mark infringement in Singapore, there must be use of the sign in Singapore. Whether the registrant has, by using the domain name, used the sign within a particular jurisdiction may depend on whether the Internet website that adopts the domain name is directed at Internet users within that jurisdiction.

63 This appears to be the position in England after *Euromarket Designs Incorporated v Peters and Another* [2000] ETMR 1025, [2001] FSR 288. In that case, the defendants, who owned a shop in Dublin, Ireland that sold furnishings and accessories under the name "Crate & Barrel", advertised their shop and goods on an Internet website bearing the Internet addresses "crateandbarrel-ie.com" and "crateandbarrel.ie". The claimants, who were the owners of the United Kingdom registered trade mark "CRATE & BARREL", applied for summary judgment for trade mark infringement. In dismissing the claimant's application, Jacob J rejected the suggestion that the defendants were using the words "Crate & Barrel" in the United Kingdom in the course of trade in goods. In particular, he observed that there was "no reason why anyone in this country should regard the site as directed at him". The judge noted that the situation was different from that of Amazon.com, which, though based in USA, had "actively gone out to seek world-wide trade, not just by use of the name on the Internet but by advertising its business here, and offering and operating a real service of supply of books to this country".

64 The same reasoning was applied earlier in *1-800 Flowers Inc v Phonenames Ltd (800-FLOWERS Trade Mark)* [2000] ETMR 369, [2000] FSR 697, where the same judge observed (at [2000] ETMR 378 or [2000] FSR 705):

23 Section 27(3) Trade Marks Act.

“Reliance is also placed on Internet use of 1-800 FLOWERS. This name (with the addition of Inc.) is used for a website. Mr Hobbs submitted that any use of a trade mark on any website, wherever the owner of the site was, was potentially a trade mark infringement anywhere in the world because website use is in an omnipresent cyberspace; that placing a trade mark on a website was “putting a tentacle” into the computer user’s premises. I questioned this with an example: a fishmonger in Bootle who put his wares and prices on his own website, for instance for local delivery, can hardly be said to be trying to sell fish to the whole world or even the whole country. And if any web surfer in some other country happens upon the website he will simply say “this is not for me” and move on. For trade mark laws to intrude where a website owner is not intending to address the world but only a local clientele and where anyone seeing the site would so understand him would be absurd. So I think that the mere fact that websites can be accessed anywhere in the world does not mean, for trade mark purposes, that the law should regard them as being used everywhere in the world. It all depends upon the circumstances, particularly the intention of the website owner and what the reader will understand if he accesses the site.”

65 Leaving aside cases of actual use of a domain name for trade in goods and services, it is less clear whether the plaintiff in an action for trade mark infringement can succeed in the typical “cybersquatting” scenario, where a registrant registers a domain name with a view to making a profit by selling it to the proprietor of the corresponding trade mark, or the owner of the goodwill in the mark (if it is unregistered), or to some other interested person. It would appear from section 27(4) that the mere registration of a domain name does not connote the use of a trade mark. For there to be infringement, there must be use of the sign in the course of trade in relation to goods or services. Further, except in a case where the sign is identical to the trade mark and the goods and services in relation to which the sign is used are identical to those for which the trade mark is registered, there must also exist a likelihood of confusion on the part of the public because of such use of the sign. A registrant who is a cybersquatter deals in domain names. Does such dealing constitute a use of a sign in the course of trade in relation to goods and services such as to create a likelihood of confusion on the part of the public by reason of such use?

66 If a complainant sends a letter of demand that threatens the registrant with proceedings for trade mark infringement on account of the registration or use of the domain name, the complainant may expose himself to an action by the registrant for groundless threat of infringement proceedings under section 35 of the Trade Marks Act, particularly if the complainant and the registrant deal in different goods or services. In *Prince Plc v Prince Sports Group Inc* [1998] FSR 21, the plaintiff (a UK company that provided services in the computer industry) registered the Internet domain

name “prince.com” in 1995. In 1997, the defendant (a US corporation that owned the US and UK registrations of the “Prince” trade mark for sports equipment and clothing) stated in a letter to the plaintiff that the plaintiff’s use and registration of “Prince” as a domain name constituted infringement of the defendant’s “Prince” trade mark. The court found this to be a general threat that fell foul of the English equivalent of section 35. Accordingly, it granted a declaration that the defendant’s threat of proceedings was unjustifiable as well as an injunction restraining the defendant from threatening the plaintiff with proceedings for the infringement of the defendant’s trade marks in respect of the plaintiff’s registration and use of the Internet domain name “prince.com”.

67 The elements which a plaintiff must establish to succeed in a passing off action are as follows:<sup>24</sup>

- (1) The plaintiff must show that he has goodwill in the conduct of his business.
- (2) The plaintiff must show that there was a misrepresentation by the defendant to the public leading or likely to lead a substantial number of persons of the relevant section of the public into believing either that the goods or services of the defendant are those of the plaintiff or that there is a business connection between the plaintiff and the defendant in relation to the goods or services provided by them. It is not necessary that there should be any confusion occasioned by the misrepresentation, although confusion is of great evidential value in determining whether or not there has been any misrepresentation.
- (3) The plaintiff must show that he suffers or, in a *quia timet* action,<sup>25</sup> is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the defendant’s goods or services are the same as those offered by the plaintiff.

68 Again, while these requirements may possibly be satisfied if a registrant has set up a website advertising or offering goods or services using a domain name that is identical with or similar to the name or mark of the complainant, it is less clear whether these requirements are satisfied in a cybersquatting scenario, where the registrant does not offer any goods or services.

24 See *CDL Hotels International Limited v Pontiac Marina Private Limited* [1998] 2 SLR 550.

25 A *quia timet* action is a pre-emptive action for an injunction to restrain a party from doing something before he starts doing it.

69 The English courts have extended the law relating to trade marks and passing off to cover the cybersquatting scenario. In *British Telecommunications Plc v One in a Million Ltd* [1999] FSR 1,<sup>26</sup> the defendant registered as Internet domain names the names or trade marks of the plaintiffs with a view to making a profit by selling them. None of these domain names were used for active websites. The English Court of Appeal affirmed the decision of the English High Court, which had given the plaintiffs summary judgment for injunctions restraining passing off and trade mark infringement as well as mandatory injunctions requiring the defendant to assign the disputed domain names to the plaintiffs. The reasoning of the court may be summarised as follows:

- (1) The court will intervene by way of injunction in a passing off case where passing off is established or threatened, or where a defendant has equipped himself with or intends to equip another with an instrument of fraud. Whether any name is an instrument of fraud will depend on the circumstances, including similarity of the names, the intention of the defendant and the type of trade. If, taking all circumstances into account, the court concludes that the name was produced to enable passing off, is adapted to be used for passing off, and if used, is likely to be used fraudulently, an injunction would be appropriate.
- (2) The placing on the register of a distinctive name makes a representation to persons who consult the register that the registrant is connected or associated with the name registered, and thus the owner of the goodwill in the name. Such persons would not know of the registrant and would believe that the registrant was connected or associated with the owner of the goodwill in the domain name. The registration of the domain name is an erosion of the exclusive goodwill in the name, which damages or is likely to damage the owner of the goodwill in the name.
- (3) The purpose of the registration by the defendant was to extract money from the owners of the goodwill in the names chosen. The ability to do so was dependent on the threat, expressed or implied, that the defendant would exploit the goodwill by either trading under the name or equipping another with the name so the latter could do so. The defendant's activities

26 This is a decision of the English Court of Appeal. The corresponding English High Court decision is reported as *Marks & Spencer Plc v One in a Million Ltd* [1998] FSR 265.

made it clear that it intended to do more than just retain the names. The court was entitled to grant *quia timet* relief to prevent the threat from becoming reality.

- (4) Domain names comprising distinctive trade names can be used as instruments of fraud. Any use of such distinctive trade names as domain names would result in passing off. There was, in this case, ample evidence to justify injunctive relief to prevent them from being used for a fraudulent purpose and to prevent them from being transferred to others.
- (5) Domain names comprising other trade names can also be used as instruments of fraud. The motive of the defendant was to use the goodwill attached to the name, and threaten to sell it to another who might use it for passing off, to obtain money from the plaintiffs. The value of the names lay in the threat that they would be used in a fraudulent way. The registrations were made with the purpose of appropriating the plaintiffs' goodwill and with an intention of threatening dishonest use by them or another. The registrations were instruments of fraud and injunctions were appropriate.
- (6) Threats of trade mark infringement had been established.<sup>27</sup> The defendant sought to sell domain names that were confusingly similar to the registered trade marks. The domain names indicated origin. They were to be used in relation to the services provided by the registrant, who traded in domain names. The domain names were registered to take advantage of the distinctive character and reputation of the trade marks, and that was unfair and detrimental.

70 The decision in *British Telecommunications Plc v One in a Million Ltd* in relation to passing off rested on a threat by the defendant to allow the domain names to be used fraudulently by others for passing off. This represents a significant extension to the law on passing off because there was no evidence that the defendant itself engaged in, or was likely to engage in, any conduct that would amount to passing off. Such reasoning might well be applied in Singapore in a cybersquatting case with similar facts. It is less clear whether a registrant can be compelled to transfer a domain name to the owner of a corresponding trade mark or trade name if all that the registrant seeks to do in registering the domain name is to prevent the owner from using that domain name.

27 It should be noted, however, that the relevant English legislation is worded quite differently from the equivalent Singapore legislation at section 27(3) Trade Marks Act.

71 It is also unclear whether the reasoning in *British Telecommunications Plc v One in a Million Ltd* in relation to trade mark infringement would be applicable in Singapore. The provision considered in that case was section 10(3) of the UK Trade Marks Act 1994, which states:

“(3) A person infringes a registered trade mark if he uses in the course of trade a sign which –

(a) is identical or similar to the trade mark, and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered,

where the trade mark has a reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.”

72 Section 10(3) of the UK Trade Marks Act 1994 does not appear to require the sign to be used as a trade mark. There are English cases that have decided that section 10 of the UK Trade Marks Act does not require an infringing use to be a trade mark use.<sup>28</sup> Indeed, the judge who decided this case in the English High Court held that use “in the course of trade” merely meant use by way of business and not use as a trade mark.<sup>29</sup>

73 In contrast, the Singapore equivalent at section 27(3) of the Singapore Trade Marks Act does seem to require an infringing use to be a trade mark use.<sup>30</sup> The first requirement for there to be infringement under section 27(3) is that the infringer must use the sign “in the course of trade” and “in relation to goods or services”. The second requirement is that the “use of the trade mark in relation to [the infringer’s] goods or services would indicate a connection between [the infringer’s] goods or services and the proprietor”. The third requirement is that “such use” would create “a likelihood of confusion on the part of the public”. The fourth requirement is that “such use” is likely to damage the interests of the proprietor. The repeated reference to “such use” suggests that the infringer’s use of the sign and the “use of the trade mark in relation to [the infringer’s] goods or services” are the same “use”. What “use” could that be other than use as a trade mark? Would there be any “likelihood of confusion on the part of the public” unless such “use” was a trade mark use?

28 See *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281, *Marks & Spencer Plc v One in a Million Ltd* [1998] FSR 265 and *Philips Electronics NV v Remington Consumer Products Ltd* [1998] RPC 809.

29 See *Marks & Spencer Plc v One in a Million Ltd* [1998] FSR 265 at 272.

30 See also *Tan Tee Jim SC*, “Net Effect II: Marked\_Concern.com” (1999) 11 SACLJ 345 at 360 to 363.

74 It is also difficult to contemplate how a cybersquatter can be said to infringe a trade mark merely by registering a domain name and offering it for sale. The “goods” offered by the cybersquatter are the domain names in question. The “services” offered by the cybersquatter are the registration and sale of domain names. The alleged infringing use is the offering of the domain names for sale. How does “such use” create a likelihood of confusion on the part of the public that there is a connection between the cybersquatter’s goods or services and the proprietor?

75 Given the differences between section 10(3) of the UK Trade Marks Act 1994 and section 27(3) of the Singapore Trade Marks Act, the reasoning in *British Telecommunications Plc v One in a Million Ltd* in relation to trade mark infringement may require some extension to be applicable in Singapore.

76 The case is nevertheless significant because it provides the theoretical foundation for dealing with cybersquatting and suggests that:

- (1) The court can grant an injunction to compel a registrant to transfer a domain name to a complainant in a cybersquatting scenario;
- (2) Mere registration of a distinctive trade name as a domain name by a registrant who has no legitimate interests in that trade name may constitute passing off; and
- (3) In other cases, there must be a threat of passing off, or a threat to use the domain name for dishonest purposes, before an injunction can be granted.

77 The later case of *French Connection Limited v Sutton* [2000] ETMR 341 illustrates the limitations of the principles established in *British Telecommunications Plc v One in a Million Ltd*. The claimant ran a chain of fashion stores selling clothes under the name “French Connection”. In February 1997, the claimant used the letters “FCUK” (which it claimed were the initials for “French Connection United Kingdom”) in an extensive advertising campaign, the object of which was to capitalise on the similarity of “FCUK” to a particular obscene expletive. In April 1997, the defendant, a self-employed Internet consultant, registered the domain name “FCUK.com”. He gave two reasons for registering the domain name. First, “FCUK” was used by Internet users to circumvent filters imposed by certain Internet Service Providers to prevent the use of the expletive in material placed on the Internet, and in his field, it was regarded as somewhat clever to register a domain name containing such an obvious reference to the obscene expletive. Second, the defendant planned to set up a website promoting his own business as an Internet consultant, and thought it might improve the level of custom for that business if he attracted to it unsuspecting persons interested in accessing a pornographic site. However, the defendant did not use the domain name until April 1998, when he set up a website

advertising his services as an Internet consultant. Instead, in October 1997, the defendant sent an unsolicited letter inviting the claimant to make an offer for the transfer of the domain name. After an exchange of correspondence between the parties over the domain name, the claimant applied for summary judgment against the defendant on the basis of the reasoning in *British Telecommunications Plc v One in a Million Ltd*. The English High Court dismissed the application as it did not consider this to be an appropriate case for summary judgment. In so far as the claimant based its case on passing off, Rattee J distinguished the *One in a Million Ltd* case on the following grounds:

- (1) The claimant had not satisfactorily established that by virtue of the advertising campaign in 1997, a substantial body of people had come to regard FCUK as synonymous with the claimant. FCUK was not a household name in the same way that the names of the plaintiffs in the *One in a Million Ltd* case were.
- (2) It could not be said that the domain name “FCUK.com” was an instrument of fraud within the meaning given to that term in the *One in a Million Ltd* case. There was evidence that the domain name was registered not with a view to passing off as an alternative to extracting money for sale of the domain name, but for use by the defendant as an Internet and e-mail name. There was unchallenged evidence that “FCUK” had at all material times been used by Internet users as an alternative to the expletive.
- (3) On the evidence, it could not be said that there was no real prospect of the defendant establishing a defence to the passing off claim based on the absence of proof of one or more of the three elements required to be proved by the plaintiff in order to establish a case of passing off.
- (4) There was room for argument whether, as a matter of public policy, having regard to the distasteful nature of the claimant’s advertising campaign, it was right for the court to lend its aid to the claimant to protect any goodwill obtained by it from the use of the FCUK advertising campaign.

### **ICANN’s Uniform Domain Name Dispute Resolution Policy**

78 The domain name dispute resolution mechanism under ICANN’s Uniform Domain Name Dispute Resolution Policy (“UDRP”)<sup>31</sup> is available as an alternative to court proceedings if the UDRP has been adopted by the

31 The UDRP is available at the URL “<http://www.icann.org/dndr/udrp/policy.htm>”.

registrar or other registration authority with whom the domain name is registered. At the time of writing, the UDRP had been adopted by all ICANN accredited domain name registrars for domain names ending in “.aero”, “.biz”, “.com”, “.coop”, “.info”, “.name”, “.museum”, “.net” and “.org”, as well as certain country managers for ccTLDs (e.g. “.nu”, “.tv” and “.ws”). Thus, any complainant who wishes to challenge the registration of a domain name ending with any of these gTLDs or ccTLDs can avail himself of the ICANN domain name dispute resolution mechanism.

79 SGNIC has not adopted the UDRP. The SGNIC domain name registration agreements that are presently in force specifically provide that “any dispute over the registration and use of the domain name, unless resolved by alternative dispute resolution methods (including, but not limited to the Singapore Domain Name Dispute Resolution Policy and accompanying Rules, ...), should be adjudicated upon by the Singapore Courts”.<sup>32</sup> Thus, a complainant who wishes to challenge the registration of a domain name ending with “.sg” cannot avail himself of the ICANN domain name dispute resolution mechanism unless the registrant also agrees to submit the dispute for determination in accordance with the mechanism.

80 Similarly, the ICANN domain name dispute resolution mechanism would not apply to domain name disputes for ccTLDs whose country managers do not adopt the UDRP. Each country manager has the liberty to determine the dispute resolution policy to be adopted for its ccTLD. Some countries have adopted modified versions of the UDRP that may or may not incorporate the ICANN dispute resolution mechanism, while others have developed their own domain name dispute resolution policies and mechanisms.

81 The UDRP is incorporated by reference into the domain name registration agreements of all registrants who register with registrars and other registration authorities that have adopted the UDRP, and is binding on all such registrants. Under paragraph 4(a) of the UDRP, the registrant is required to submit to a “mandatory administrative proceeding” when a complainant asserts that:

- (1) the registrant’s domain name is identical or confusingly similar to a trade mark or service mark in which the complainant has rights;
- (2) the registrant has no rights or legitimate interests in respect of the domain name; and

32 See clause 27 of SGNIC’s generic Domain Name Registration Agreement (Revision 3) and clause 29 of SGNIC’s “.per.sg” Domain Name Registration Agreement.

- (3) the registrant's domain name has been registered and is being used in bad faith.

82 The complainant must prove each of the three elements he has asserted in the administrative proceeding. The interpretation of these elements is aided by two deeming, but non-exhaustive, provisions in the UDRP.

83 Under paragraph 4(b) of the UDRP, the following circumstances are treated as evidence of the registration and use of a domain name in bad faith:

- (1) circumstances indicating that the registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant, who is the owner of the trade mark or service mark, or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name;
- (2) the registrant has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct;
- (3) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (4) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location.

84 Under paragraph 4(c) of the UDRP, the following circumstances are deemed to demonstrate the registrant's rights to or legitimate interests in the domain name:

- (1) before any notice to the registrant of the dispute, the registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;
- (2) the registrant (as an individual, business or other organisation) has been commonly known by the domain name, even if the registrant has acquired no trade mark or service mark rights; or

- (3) the registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

85 The ICANN domain name dispute resolution mechanism and the law relating to trade marks and passing off adopt different tests for determining whether a registrant should be ordered to transfer a domain name to a complainant. The UDRP is designed to cater for the cybersquatting scenario and other instances of registration of domain names in bad faith. Once the three elements under paragraph 4(a) of the UDRP are established, the administrative panel that is appointed to decide the domain name dispute will decide in the complainant's favour, regardless of whether the complainant would have been able to succeed in an action for trade mark infringement or passing off. Cases decided under the mechanism have established that the reference to "trade mark" under paragraph 4(a) of the UDRP extends beyond registered trade marks to "common law trade mark rights ... under United States trade mark law"<sup>33</sup> and "the common law right to prevent unauthorised use of a name".<sup>34</sup>

86 The complainant initiates the process by submitting a complaint to one of the "administrative-dispute-resolution service providers" (each referred to as a "Provider") listed on the ICANN UDRP website.<sup>35</sup> There are currently four such Providers. The complainant has the right to select the Provider.

87 The Provider will review the complaint for administrative compliance with the UDRP and its subsidiary Rules.<sup>36</sup> The Rules set out the detailed procedure for the dispute resolution mechanism. If the complaint is in order, the Provider would forward the complaint to the registrant. The registrant has 20 days to submit a response to the Provider. This period may be extended by the Provider at the request of the registrant, or by written agreement of the parties with the approval of the Provider. If a registrant fails to submit a response, the dispute will be decided based on the complaint.

33 See *Julia Fiona Roberts v Russell Boyd* WIPO Case No. D2000-0210, which concerns the domain name "juliaroberts.com". The decision is available at the URL "<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0210.html>".

34 See *Jeanette Winterson v Mark Hogarth* WIPO Case No. D2000-0235, which concerns the domain names "jeanettewinterson.com", "jeanettewinterson.net" and "jeanettewinterson.org". The decision is available at the URL "<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0235.html>".

35 See the URL "<http://www.icann.org/udrp/>" for the relevant links.

36 The Rules for Uniform Domain Name Dispute Resolution Policy are available at the URL "<http://www.icann.org/dndr/udrp/uniform-rules.htm>".

88 The dispute will be decided by an administrative panel (referred to as the “Panel”) appointed by the Provider. The Panel may comprise one or three members. Generally, the Provider will appoint a single-member Panel. If either the complainant or the registrant elects to have the dispute decided by a three-member Panel, the Provider will appoint three panellists. The Panel’s fees will be paid in its entirety by the complainant if the Panel comprises only one member or the complainant elects to have the dispute decided by a three-member Panel. The Panel’s fees will be borne equally by the complainant and the registrant if the complainant opts for a one-member Panel but the registrant elects for a three-member Panel. Once the Panel is appointed, the Provider will notify the parties of the panellist or panellists and the date by which the Panel will forward its decision to the Provider. The Provider will also forward the file to the Panel.

89 The communications between the parties and the Panel are made through a case administrator appointed by the Provider. The Panel may conduct the administrative proceeding in such manner as it considers appropriate, so long as it ensures that the parties are treated with equality and each party is given a fair opportunity to present its case. The Panel may request, in its sole discretion, for further statements or documents from either party. There will be no in person hearings (including hearings by teleconference, videoconference or web conference) unless the Panel determines, in its sole discretion and as an exceptional matter, that such a hearing is necessary for deciding the complaint.

90 The Panel decides the dispute in accordance with the UDRP, the Rules for the UDRP and any rules and principles of law that it deems applicable. In the absence of exceptional circumstances, the Panel will forward its decision to the Provider within 14 days of its appointment. The Provider will communicate the full text of the decision to each party within three calendar days after receiving the decision from the Panel.

91 The administrative proceeding does not prevent the complainant or registrant from submitting the dispute to a court of competent jurisdiction before the administrative proceeding is commenced or after the administrative proceeding is concluded. The UDRP requires the parties to submit to the jurisdiction of the courts at either the principal office of the registrar or the registrant’s address as shown in the registrar’s “Whois” database<sup>37</sup> at the time the complaint is submitted to the Provider.

37 This is a database maintained by a registrar or registration authority that provides the identity and contact particulars of every registrant registered with it.

92 The relevant registrar or registration authority will implement the decision of the Panel ten business days after it is notified by the Provider of the Panel's decision, unless the registrar or registration authority receives from the registrant official court documentation<sup>38</sup> that the registrant has commenced court proceedings against the complainant within that ten business day period. If such official court documentation is received within the ten business day period, the Panel's decision will not be implemented, and the registrar or registration authority will take no further action until it receives satisfactory evidence of a resolution between the parties or that the court proceedings have been dismissed or withdrawn, or a copy of the court order dismissing the court proceedings or confirming that the registrant does not have the right to continue using that domain name.

93 According to one commentator, at least two USA federal courts have held that they were not bound by the decisions of UDRP panels. The commentator went on to observe that judicial deference to UDRP panel decisions invited serious substantive and procedural objections. In particular, there were significant differences in the scope and substance of UDRP and court proceedings. The UDRP was intended to cover only a narrow range of domain name disputes involving claims of "abusive registration" of a domain name made with the intention of profiting from another's trade mark. The scope of enquiry in UDRP proceedings was often limited to the three elements under paragraph 4(a) of the UDRP. In contrast, a court would apply the substantive law to decide the dispute, and this took into account many other factors. *De novo* judicial review would also be consistent with the parties' expectations and the intent of the UDRP. Given the constraints of the UDRP process, a court would be in a better position than a UDRP panel to weigh and assess the credibility of the evidence. *De novo* judicial review was also essential to ensure fairness and due process.<sup>39</sup>

94 Subsequently, in *Eric S Bord v Banco de Chile and United States Department of Commerce*,<sup>40</sup> a United States District Court confirmed that the judicial review contemplated under the UDRP was in fact a *de novo* review of the dispute by the court.

38 In the Singapore context, this would probably be a writ of summons or originating summons.

39 See David E Sorkin, "Judicial Review of ICANN Domain Name Dispute Decisions" (2001) 18 Santa Clara Computer & High Technology Law Journal 35.

40 Civil Action 01-1360-A filed in the United States District Court for the Eastern District of Virginia, decision of Chief District Judge Claude M Hilton delivered on 15 May 2002.

95 As at 23 May 2002, a total of 4,894 UDRP proceedings had been decided in respect of 8,414 domain names.<sup>41</sup> 3,921 (about 80%) of the proceedings were decided in favour of the complainant, 942 of the proceedings were decided in favour of the registrant, and there were split decisions in the remaining 31 cases. Some of the proceedings were uncontested.

96 The UDRP-Court Challenge Database<sup>42</sup> at UDRPlaw.net indicates that as at 14 May 2002, more than 40 court challenges had been mounted against decisions by UDRP Panels. The majority of these challenges appear to be made in USA, but there have also been challenges made in Canada, India and South Korea.

### **The Singapore Domain Name Dispute Resolution Policy**

97 When SGNIC registers a domain name, it does not assess the legality of the domain name or whether the registration or use of the domain name infringes the rights of a third party. SGNIC therefore requires an applicant for a “.sg” domain name to represent and warrant that:

- (1) the domain name applied for does not infringe any registered trade mark in Singapore and is not identical to or confusingly similar with either a registered trade mark, company or business name in Singapore;
- (2) he/it intends to use the domain name;
- (3) such use shall be for his/its own benefit and shall be for lawful purposes;
- (4) he/it will not allow another party to use the domain name, whether for profit or otherwise and will not deal with the domain name in any manner whatsoever;
- (5) registration or use of the domain name does not interfere with the legal rights of any party in Singapore; and

41 A complete statistical summary of UDRP proceedings is available at the URL “<http://www.icann.org/udrp/proceedings-stat.htm>”. This webpage is updated periodically.

42 See Patrick L Jones, “The UDRP-Court Challenge Database”, The Uniform Domain Name Dispute Resolution Policy Legal Information Site (UDRPlaw.net) at the URL “<http://www.udrplaw.net/UDRPAppeals.htm>”. The WIPO Arbitration and Mediation Center also maintains a similar list at the URL “<http://arbitrator.wipo.int/domains/challenged/index.html>”.

- (6) all information contained in the application form and furnished to SGNIC is to the best of the applicant's knowledge true and accurate in every detail.<sup>43</sup>

98 SGNIC's domain name registration agreements allow SGNIC to remove a domain name if, in SGNIC's determination, the continued entry of the domain name on the database would be wrongful or where fraud has been committed in the registration process for the domain name.<sup>44</sup>

99 SGNIC's domain name registration agreements also provide that:

- (1) SGNIC does not wish to be a part of any dispute between a registrant and any third parties in connection with the registrant's registration or use of a domain name;<sup>45</sup>
- (2) If SGNIC is named as a party to any legal proceedings commenced by either the Registrant or Complainant, SGNIC may suspend the operational status of the domain name until the conclusion of the legal proceedings;<sup>46</sup>
- (3) Whether or not SGNIC is named as a party, SGNIC will abide by all temporary or final orders made by Singapore courts that are directed at SGNIC;<sup>47</sup> and
- (4) Where a registrant desires to avoid litigation regarding the registration and use of a domain name and therefore requires a new domain name to be registered, SGNIC may assist the registrant with the assignment of a new domain name and allow the registrant to maintain both names simultaneously for up to 60 days to allow an orderly transition to the new domain name.<sup>48</sup>

43 See clause 6 of SGNIC's generic Domain Name Registration Agreement (Revision 3) and clause 6 of SGNIC's ".per.sg" Domain Name Registration Agreement (Revision 2).

44 See clause 21(c)(iii) of SGNIC's generic Domain Name Registration Agreement (Revision 3) and clause 20(c)(iii) of SGNIC's ".per.sg" Domain Name Registration Agreement (Revision 2).

45 See clause 25 of SGNIC's generic Domain Name Registration Agreement (Revision 3) and clause 27 of SGNIC's ".per.sg" Domain Name Registration Agreement (Revision 2).

46 See clause 29 of SGNIC's generic Domain Name Registration Agreement (Revision 3) and clause 31 of SGNIC's ".per.sg" Domain Name Registration Agreement (Revision 2).

47 See clause 30 of SGNIC's generic Domain Name Registration Agreement (Revision 3) and clause 32 of SGNIC's ".per.sg" Domain Name Registration Agreement (Revision 2).

48 See clause 32 of SGNIC's generic Domain Name Registration Agreement (Revision 3) and clause 34 of SGNIC's ".per.sg" Domain Name Registration Agreement (Revision 2).

100 In November 2001, SGNIC launched the Singapore Domain Name Dispute Resolution Policy (“SDRP”). In line with the launch, SGNIC revised the terms of its domain name registration agreements. The revised domain name registration agreements, which provide for “.sg” domain name disputes to be resolved in accordance with the SDRP, apply to new domain name registrations approved by SGNIC on or after 15 November 2001. With effect from 1 January 2002, the revised domain name registration agreements also apply to domain name registrations approved by SGNIC before 15 November 2001.

101 The SDRP and its accompanying Rules are modelled after the UDRP and its corresponding Rules, but with modifications to suit the Singapore context. The dispute resolution service provider under the SDRP is a joint secretariat of the Singapore Mediation Centre and the Singapore International Arbitration Centre (the “Secretariat”).

102 The SDRP and its accompanying Rules and Supplementary Rules may be downloaded from the SGNIC websites at “<http://www.nic.net.sg/>” and “<http://www.sgnic.com.sg/>” and the Secretariat’s website at “<http://www.disputemanager.com.sg/>”.

103 The SDRP makes one significant departure from the UDRP, namely, the formal incorporation of a mediation option as part of the dispute resolution mechanism.

104 Other important deviations from the UDRP are as follows:

- (1) To take into account the fact that personal domain names can be registered by individuals in Singapore, paragraph 4(a)(i) of the SDRP extends the scope of applicable disputes to situations where the registrant’s domain name is identical or confusingly similar to a “name, trade mark or service mark” in which the complainant has rights.
- (2) To cover the situation where a domain name originally registered in good faith is subsequently used in bad faith, paragraph 4(a)(iii) of the SDRP extends the jurisdiction of the Panel to cases where the registrant’s domain name “has been registered or is being used in bad faith”.<sup>49</sup>

49 This course of action is recommended by the “WIPO ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes”. See page 10 of this document, which is available at the URL “<http://ecommerce.wipo.int/domains/cctlds/bestpractices/bestpractices.pdf>”.

- (3) Paragraph 4(k) of the SDRP precludes the registrant and the complainant from commencing court proceedings in respect of a domain name while an administrative proceeding is pending in respect of that domain name. This reduces the potential for concurrent administrative proceedings and court proceedings.
- (4) Paragraph 4(1) of the SDRP makes it clear that an administrative proceeding is not an arbitration. Thus, the Arbitration Act (Cap 10, 1985 Ed), the Arbitration Act 2001 (Act No. 37 of 2001) and the International Arbitration Act (Cap 143A, 1995 Ed) do not and will not apply to administrative proceedings under the SDRP.

105 Under paragraph 4(a) of the SDRP, the registrant is required to submit to a “mandatory administrative proceeding” when a complainant asserts that:

- (1) the registrant’s domain name is identical or confusingly similar to a name, trade mark or service mark in which the complainant has rights;
- (2) the registrant has no rights or legitimate interests in respect of the domain name; and
- (3) the registrant’s domain name has been registered or is being used in bad faith.

106 The complainant must prove each of the three elements he has asserted in the administrative proceeding. The interpretation of these elements is aided by two deeming, but non-exhaustive, provisions in the SDRP.

107 Under paragraph 4(b) of the SDRP, the following circumstances are treated as evidence of the registration and use of a domain name in bad faith:

- (1) circumstances indicating that the registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant, who bears the name or is the owner of the trade mark or service mark, or to a competitor of that complainant, for valuable consideration in excess of the registrant’s documented out-of-pocket costs directly related to the domain name;
- (2) the registrant has registered the domain name in order to prevent the owner of the trade mark or service mark from

- reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct;
- (3) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
  - (4) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other on-line location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location.

108 Under paragraph 4(c) of the SDRP, the following circumstances are deemed to demonstrate the registrant's rights to or legitimate interests in the domain name:

- (1) before any notice to the registrant of the dispute, the registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;
- (2) the registrant (as an individual, business or other organisation) has been commonly known by the domain name, even if the registrant has acquired no trade mark or service mark rights; or
- (3) the registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

109 The complainant initiates the dispute resolution process by submitting a complaint to the Secretariat. The Secretariat will review the complaint for administrative compliance with the SDRP and its subsidiary Rules. If the complaint is in order, the Secretariat would forward the complaint to the registrant. The registrant has 15 working days to submit a response to the Secretariat. This period may be extended by the Secretariat at the request of the registrant, or by written agreement of the parties with the approval of the Secretariat. If a registrant fails to submit a response, the dispute will be decided based on the complaint.

110 The dispute will be dealt with by an administrative panel (referred to as the "Panel") appointed by the Secretariat. The Panel may comprise one or three members. Generally, the Secretariat will appoint a single-member Panel. If either the complainant or the registrant elects to have the dispute decided by a three-member Panel, the Secretariat will appoint three

panellists. The Panel's fees will be paid in its entirety by the complainant if the Panel comprises only one member or the complainant elects to have the dispute decided by a three-member Panel. The Panel's fees will be borne equally by the complainant and the registrant if the complainant opts for a one-member Panel but the registrant elects for a three-member Panel.

111 The complainant and the registrant are invited to consider whether they wish to have the dispute mediated by the Panel before the Panel is called upon to decide the dispute. If both parties agree to have the dispute mediated first, the Panel will facilitate discussions between them to help them resolve the dispute amicably. The terms of a mediated settlement are not restricted to the usual remedies of transferring or cancelling the domain name registration. Possible settlement options include:

- (1) an agreement that the domain name be transferred to the complainant not immediately but at an agreed time in the future;
- (2) the retention of the domain name by the registrant, but with clear and visible links on the registrant's homepage to the complainant's website; or
- (3) the transfer of the domain name to the complainant, but with clear and visible links on the complainant's home page to the registrant's website.

112 The complainant and the registrant will elect, in the complaint and response respectively, whether to let the same Panel decide the dispute if the parties fail to reach a settlement after mediation. If either party wishes to have the dispute decided by a different Panel, the complainant will have to commence a new administrative proceeding before a different Panel. As such, the complainant is asked to indicate whether the complainant would still wish to have the dispute mediated if the respondent does not agree to the same Panel deciding the dispute should the parties fail to reach an agreement after mediation.

113 Once the Panel is appointed, the Secretariat will notify the parties of the panellist or panellists and the dates by which mediation should be concluded and/or the Panel will forward its decision on the complaint to the Secretariat. The Secretariat will also forward the file to the Panel.

114 Generally, the communications between the parties and the Panel are made through the Secretariat. The Panel may conduct the administrative proceeding in such manner as it considers appropriate, so long as it ensures that the parties are treated with equality and each party is given a fair opportunity to present its case. The Panel may request, in its sole discretion,

for further statements or documents from either party. There will be no in person hearings (including hearings by teleconference, videoconference or web conference) unless the Panel determines, in its sole discretion and as an exceptional matter, that such a hearing is necessary for deciding the complaint.

115 The Panel decides the dispute in accordance with the SDRP, the Rules for the SDRP and any rules and principles of Singapore law that it deems applicable. In the absence of exceptional circumstances, the Panel will forward its decision to the Secretariat within ten working days after the date of its appointment. The Secretariat will communicate the full text of the decision to each party within three working days after receiving the decision from the Panel.

116 The administrative proceeding does not prevent the complainant or registrant from submitting the dispute to a Singapore court before the administrative proceeding is commenced or after the administrative proceeding is concluded. However, neither party shall initiate any legal proceedings in respect of a domain name dispute that is the subject of a pending administrative proceeding.

117 SGNIC will implement the decision of the Panel ten working days after it is notified by the Secretariat of the Panel's decision, unless SGNIC receives from the registrant during that ten working day period a sealed copy of a writ of summons or an originating summons showing that the registrant has commenced a lawsuit against the complainant in respect of the domain name. If SGNIC receives such documentation within the ten working day period, SGNIC will not implement the Panel's decision, and SGNIC will take no further action until it receives satisfactory evidence of a resolution between the parties or that the court proceedings have been dismissed or withdrawn, or a copy of the Singapore court order dismissing the registrant's lawsuit or ordering that the registrant does not have the right to continue using that domain name.

118 Under the SDRP, an administrative proceeding may be concluded in as short as 30 working days from the date the complainant submits a complaint to the Secretariat. The service may cost as little as \$2,750 (for a single-member Panel to decide disputes pertaining to up to five different domain names). The SDRP administrative proceeding therefore offers a quicker and cheaper way of resolving ".sg" domain name disputes compared to litigation in the courts.

119 As at 25 May 2002, two SDRP proceedings had been commenced in respect of two domain names. The first case was decided on 15 April 2002 and is discussed in the next section. The second case underwent mediation, and the parties were still in negotiations at the time of writing.

*Viacom International Inc v Elitist Technologies Co Ltd*

120 The facts of *Viacom International Inc v Elitist Technologies Co Ltd*<sup>50</sup> were summarised at the start of this paper. However, to fully appreciate the decision of the Panel, it is necessary to go into the facts in greater detail.

121 To recapitulate, the Complainant, a global entertainment company incorporated in Delaware, USA, operated an advertiser-supported television programming service known as “MTV: Music Television” through its division, MTV Networks. The MTV programming service featured entertainment oriented television programmes ranging from music videos to music and general lifestyle information, news, animations and documentaries. Since 1995, the MTV programming service has been broadcast to various parts of Asia, including Hong Kong, Macau, Taiwan, Malaysia, South Korea, India, Philippines, and Singapore.

122 The Respondent was a company incorporated under the laws of Taiwan. It was not the original registrant of the disputed domain name. ROTA Corporation Pte Ltd (“ROTA”) applied to register the disputed domain name with SGNIC on 23 February 2000. The registration was approved on 23 March 2000. On 22 June 2000, the disputed domain name was transferred from ROTA to another Singapore company, Presslink Automation Pte Ltd (“Presslink”). On 11 July 2000, Presslink transferred the disputed domain name to the Respondent.

123 Since May 2000, the Complainant’s solicitors and the Respondent and its predecessors had exchanged correspondence concerning the disputed domain name and the website set up by the Respondent and its predecessors addressed under the disputed domain name. The website was a developed website that provided a free email service with the suffix “@mtv.com.sg” and served principally as an Internet portal for supplying Chinese entertainment products and services. Hyperlinks on the website linked the surfer to various Macromedia Flash files hosted on third party websites and various items of entertainment news about the production and recording of music videos by various Chinese artistes.

124 The words “This site, mtv.com.sg, is NOT endorsed by, affiliated to or somehow associated with MTV Networks” (the “Disclaimer”) were included and prominently displayed at the foot of the home page of the website and some of its second level pages. According to the Complainant, the Respondent’s predecessors put up the Disclaimer in May 2000 in response to a cease and desist letter sent by the Complainant’s solicitors.

50 See footnote 1.

125 The Complainant brought administrative proceedings against the Respondent under the SDRP, seeking a transfer of the domain name from the Respondent to the Complainant. In accordance with paragraph 4(a) of the SDRP, the Complainant contended that:

- (1) the disputed domain name was identical or confusingly similar to the “MTV” mark in which the Complainant had rights;
- (2) the Respondent had no rights or legitimate interests in respect of the disputed domain name; and
- (3) the Respondent’s domain name had been registered or was being used in bad faith.

126 In relation to the requirements of paragraph 4(a)(i) of the SDRP, the Complainant submitted that it had rights to the “MTV” name as the registered proprietor of eleven “MTV”-related trade marks in Singapore. Of these eleven trade marks, eight were for the stylised graphical representation of the MTV Music Television logo and the others were word marks comprising the word “MTV” with some other expression such as “Select”, “Asia Hit List” and “In Control”. Most of these registered trade marks were for television programming and broadcasting and entertainment services (Classes 38 and 41), and other entertainment and broadcasting related goods and services (Class 9).

127 The Complainant also submitted that it had significant goodwill and reputation in the “MTV” marks by reason of its extensive exposure through the wide distribution of its television programming services in Asia and the publicity and merchandising of the MTV trade marks. It referred to the fact that it had spent in excess of US\$7 million in advertising its services under the MTV trade marks in South East Asia, and had sales in excess of US\$3 million for MTV trade marked merchandise in Singapore.

128 In relation to the requirements of paragraph 4(a)(ii) of the SDRP, the Complainant contended that the Respondent had no rights or legitimate interests in respect of the disputed domain name because “[t]he name ‘MTV’ is not a common noun universally used all over society”, the disputed domain name bore no resemblance to the name and/or business of the Respondent, the only conspicuous business activity carried out by the Respondent on the website was that of a free e-mail service provider, and the Respondent was not licensed to provide television programming services in Singapore.

129 In relation to the requirements of paragraph 4(a)(iii) of the SDRP, the Complainant contended that the Respondent had registered or used the Domain Name in bad faith, because the principal business activities of ROTA, the first registrant, were the retailing of calculators, typewriters and other office equipment and these were in no way associated with the

online business of providing a free e-mail service or an Internet portal service.

130 As further evidence of bad faith, the Complainant urged the Administrative Panel to infer that the various registrants of the disputed domain name were seeking to avoid liability through the device of transferring the domain name from the initial registrant, ROTA, a Singapore company, to Presslink, another Singapore company, and then to the Respondent, a Taiwanese company. The Complainant presented printouts from the Singapore Registry of Companies and Businesses to show that both ROTA and Presslink were related companies with common directors and shareholders.

131 The Complainant also contended that the Respondent had used the domain name in bad faith by having website banner advertisements and banner referrals. Since the website was frequented by, in the Respondent's own words, a "large number of subscribers, visitors, e-mail users and website visitors in Singapore and other countries around the world", this would result in "substantial commercial gain" for the Respondent.

132 Finally, the Complainant noted that the Respondent was prepared to sell the disputed domain name for US\$200,000 to the Complainant, a sum the Complainant asserted was well in excess of the Respondent's developmental, operational and maintenance costs for the website. This, the Complainant contended, was indication that the Respondent had acquired the domain name primarily for the purpose of selling to the Complainant, and therefore bad faith on the part of the Respondent.

133 The Respondent submitted that the word "MTV" was generic or was used in a generic way in the Chinese language. In support of its submission, the Respondent adduced numerous items of evidence to show that the word "MTV" was widely used in a generic fashion by the Chinese community to describe Chinese music videos. Among the items adduced were:

- (1) Video CDs and Karaoke VCDs in Chinese of various popular Chinese artistes which were published and/or distributed in Singapore, Taiwan and Hong Kong by reputable producers, recording houses and publishers such as Polydor/Polygram Music, What's Music International Incorporated, EMI, Warner Music and Sony, and which were described and marketed as "MTV" VCDs.
- (2) Articles from several Chinese local newspapers and entertainment magazines and from the Singapore Press Holdings' Zaobao.com website, discussing various music videos of Hong Kong and Taiwanese music artistes, and describing the same as "MTVs".

- (3) TV programming guides from SPH Mediaworks and Media Corporation of Singapore for Chinese programmes such as “You Weekly” and “I-Weekly”, wherein certain music programmes were described as “MTVs”.
- (4) Printouts from various Chinese website searches which highlighted the use of the word “MTV” as a substitute for “music videos” or “music programmes”. Most of these websites were Chinese websites, and some of these were reasonably reputable websites with reasonably reputable operators such as tom.com, sohu.com, and even warnermusic.com.tw (operated by Warner Music).

134 The Respondent also contended that the Complainant was seeking to embark on an exercise of Reverse Domain Name Hijacking (i.e. using the SDRP in bad faith to attempt to deprive the Respondent of the disputed domain name).

#### *The Decision*

135 The sole panellist, Mr Daniel Seng Kiat Boon, denied the relief sought by the Complainant for the transfer of the disputed domain name. His reasoning may be summarised as follows:

- (1) To be entitled to the remedy sought, the Complainant must prove, on a balance of probabilities, that all three elements in paragraph 4(a) of the SDRP are present. Where the Complainant fails to prove, on a balance of probabilities, that any one of the three elements is present, the Panel will find for the Respondent.
- (2) While the Respondent’s domain name was identical to the word “MTV” that featured on all the Complainant’s “MTV” marks, that did not conclude the analysis. The Complainant must still show that it has exclusive rights to the use of the word “MTV” to displace the Respondent’s rights to its registered domain name. Even if the domain name is identical to the word elements in the complainant’s registered trade mark, if the word elements are generic or descriptive, the registrant will still be able to keep the registered domain name. Graphic elements in marks need not be considered when comparing the domain name and the marks for identity or confusing similarity.
- (3) The Complainant cited the fact that it owned trade mark registrations in the “MTV” marks in 35 other jurisdictions ranging from Argentina to Uruguay. However, the Complainant provided no further particulars as to these marks.

The Complainant also cited in support of its rights to the “MTV” marks, statements from other UDRP panels to the effect that “MTV” was not a common term for media products and services, but instead identified the products and services of the Complainant, and that “MTV” was a “famous” or “well-known” mark. The Panel did not find the evidence of foreign trade mark applications or the blanket statements from other panels to be conclusive. First, many of these statements were made by panels in undefended proceedings or in proceedings with unrepresented respondents. Statements from undefended proceedings were less authoritative and much less persuasive than defended proceedings. Second, the cited panel decisions concerned gTLDs, and centred primarily around the jurisdiction of the United States and some other countries with some nexus to the respondent. The disputed domain name here involved a ccTLD. Therefore, the Panel was required to make its own examination as to the Complainant’s rights to the mark “MTV” in the context of a consumer of broadcasting and entertainment services in Singapore. None of the panel decisions cited by the Complainant pertained to the status of the “MTV” mark in Singapore.

- (4) The Complainant had to offer numerous disclaimers for the registration of the “MTV” marks that it relied on. In particular, the Complainant had disclaimed rights to the use of the letters “M”, “TV” and the words “Music Television”. The legal effect of the disclaimers was that the Complainant had disclaimed any rights to the exclusive use of these specified elements of the trade mark.<sup>51</sup> The words “Music Television” were descriptive of the business of the Complainant, as well as its products and services to which the “MTV” marks were attached. In view of the disclaimers, the Complainant would not have been able to register, as a trade mark, the word mark “Music Television”, as such a mark would clearly “consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose ... of goods or of rendering of services, or other characteristics of goods or services”, and would constitute an absolute ground

51 See section 30(1) of the Trade Marks Act read with paragraph 3(3) of the Third Schedule (Transitional Provisions) to the Trade Marks Act.

for refusal of registration of this mark under section 7(1)(c) of the Trade Marks Act (Cap 332, 1999 Ed). The word “MTV” was a clear abbreviation for “Music Television”. Even though the Complainant did not disclaim away, in its trade mark registrations, the right to the word “MTV” as an element in its marks, a trade mark registrant cannot rely upon an abbreviation of a descriptive word to found registrability of the mark. Thus, while the Complainant had exclusive rights to its “MTV” marks as a whole, it did not follow that the word “MTV” was necessarily associated with the Complainant’s “MTV” marks. The Complainant had, at best, very weak legal rights over the exclusive use of the word “MTV” in television programming and broadcasting and entertainment products and services. The Complainant’s registered “MTV” marks did not advance its legal rights to the word “MTV” significantly. If at all, the disclaimers in these “MTV” marks and the class of goods for which they had been registered considerably weakened the Complainant’s rights to use the words “Music Television” and “MTV”. If the Complainant wished to assert an exclusive right to the word “MTV”, the onus was on the Complainant to maintain and preserve the distinctiveness of the word “MTV”, as applied to these products and services.

- (5) The evidence led by the Respondent showed that the Chinese music production industry and the Chinese entertainment industry had used the word “MTV” as an abbreviation for “music videos”. The word “MTV” had also entered the mainstream Chinese language, in Singapore, Taiwan and Hong Kong, as a substitute for the Chinese expression for “music videos”. As such, the Complainant would be unable to assert exclusive rights to the word “MTV” since this word has become “customary in the current language or in the bona fide and established practices of the trade” under section 7(1)(d) of the Trade Marks Act.
- (6) Various English-Chinese dictionaries had dictionary entries for “MTV”. An entry in a dictionary published in Shanghai in 1993 and used in Singapore since 1994 confirmed that as far back as 1993, “MTV” had become an accepted abbreviation for “Music Television” in the Chinese language and had entered the Chinese vocabulary. The dictionary affirmed beyond doubt the Respondent’s assertion that the word “MTV” had become customary or generic. This would also go towards supporting a refusal of registration of the “MTV” word mark under section 7(1)(c) of the Trade Marks Act. If the local Chinese entertainment and entertainment news industries had

honestly and in good faith deployed the word “MTV” to refer to Chinese music videos that were not produced by the Complainant, the law required that the word remain available for general use, since competitors had a legitimate interest in employing such indications without hindrance.

- (7) As the distinctiveness of the word “MTV” was in issue, by registering what would arguably appear to be a generic word or term, it could not be said that the Respondent had made a representation to persons who consult the register that the registrant was connected or associated with the name registered and thus the owner of the goodwill in the name. On the evidence, the Complainant would not be able to substantiate the assertion that the word “MTV” denoted in its ordinary usage the Complainant, because the word “MTV” also meant “music videos”, which were not necessarily related to the Complainant. Thus it was doubtful if the Complainant could prove sufficient goodwill arising from the use of the word “MTV” to support a passing off action.
- (8) There was no credible evidence that the disputed domain name was registered by the Respondent with a view to passing off as an alternative to extracting money for sale of the name. The Panel did not find that the domain name was used by the Respondent as an “instrument of fraud”.
- (9) There was no evidence as to the extent to which the Internet traffic arriving at the Respondent’s website represented traffic actually intended for the Complainant (or its affiliates) but erroneously channelled to the Respondent’s website. The Respondent’s case was that all the Internet traffic was intended for its website, and was built up through its efforts. On the limited evidence, the Panel was unable to find that there was clear and unequivocal evidence of misrepresentation or that the Complainant had suffered or was likely to suffer harm.
- (10) Where a registrant offered cogent evidence to suggest the continued development of an established website with an established physical business for the registrant’s business, the registrant would on the face of the record have successfully rebutted the complainant’s assertion that the registrant had no rights or legitimate interests in the domain name. The Respondent afforded some evidence to suggest an established website. On the premise that the Complainant’s exclusive rights in the word “MTV” are weak, or alternatively that “MTV” had become customary or generic in its use, there was no clear or unequivocal evidence to show that the

Respondent had no rights or legitimate interests in the disputed domain name. The fact that third parties had used the word “MTV” itself or as an abbreviation for “music videos” to describe their broadcast and entertainment products and services, such as music videos, and in particular Chinese music videos, was so indicative. The Complainant had failed to discharge the burden of establishing the second element in paragraph 4(a) of the SDRP.

- (11) The unexplained circumstances of the transfer of the disputed domain name from ROTA to Presslink and then to the Respondent did not assist the Respondent in its case that it (or its predecessors) had registered the disputed domain name in good faith. However, on its own, the Respondent’s offer to sell the disputed domain name to the Complainant for US\$200,000 cannot establish that “the Registrant has registered or acquired the domain name primarily for the purpose of selling ... the domain name registration to the Complainant.” The Respondent’s written position was that the disputed domain name was an integral part of the Respondent’s business, that significant time and resources had been expended in developing the website, and that the disputed domain name would not be sold. There was no clear or unequivocal evidence that the Respondent had acquired the domain name primarily for the purpose of selling it to the Complainant.
- (12) Evidence of the presence or absence of good faith on the part of the Respondent’s conduct is the key to determining whether registration or use was bona fide under the SDRP. Where the disputed domain name is generic, or weakly distinctive, administrative panels are more prepared to find that the registrant either has a legitimate interest in respect of the domain name, or that the registrant has acted in good faith in registering and using the domain name.
- (13) There was no clear or unequivocal evidence to show that the Respondent had, by using the domain name which it claimed was generic, intentionally attempted to attract, for commercial gain, Internet users to the Respondent’s website by creating a likelihood of confusion. The Respondent had adduced some evidence to suggest a plausible and certainly not illegitimate interest, in seeking to establish its own Internet portal to supply Chinese entertainment products, news and information. A Panel is not required to blindly accept the Respondent’s assertions, and is required to test the Respondent’s assertions for evidentiary support and credibility. However, the Panel did not find the Respondent’s evidence in this regard to be

inherently incredible. There was no clear or unequivocal evidence to show that the Respondent had registered or used the domain name in bad faith.

- (14) The Panel did not find this to be a case of reverse domain name hijacking. The Complainant had brought the complaint in good faith, in reliance on its “MTV” trade marks, but ultimately failed in these proceedings because the word “MTV” had become descriptive or generic in the local context.

### *Commentary*

136 This decision makes several significant points. In particular, it contains observations on the inter-relationship between the SDRP, the UDRP and the law in Singapore on trade marks and passing off. It also offers an insight into the nature and quality of the evidence that a complainant must adduce in order to succeed under the SDRP.

137 First, the burden of proof is on a complainant to establish all three elements under paragraph 4(a) of the SDRP on a balance of probabilities. Further, as the SDRP administrative proceedings adopt a summary procedure for dealing with domain name disputes, there must be clear and unequivocal evidence to enable a panel to make a finding in favour of the complainant.

138 Second, the decision emphasises the special care that a complainant must take to show his rights to a domain name, particularly if the domain name concerned is a generic or descriptive word. In a case where a complainant’s registered trade mark comprises both graphic and word elements, and the word elements are generic or descriptive, while the trade mark registration gives the complainant the exclusive rights to use and authorise the use of the trade mark as a whole in relation to the goods and services for which the trade mark is registered,<sup>52</sup> it does not follow that the complainant has a corresponding exclusive right to use the word elements of the trade mark.

139 While the Panel did say that the Complainant must show that it has exclusive rights to the use of the word “MTV” to displace the Respondent’s rights to the domain name, this statement must be read in the context in which it was made. The Complainant had relied on various trade marks registered in Singapore that incorporated both graphic elements and the word “MTV” to show that it had “rights” to the use of the word “MTV”

52 See section 26(1) of the Trade Marks Act.

under paragraph 4(a)(i) of the SDRP. As the graphic elements could not be reproduced in a domain name, the Panel proceeded to consider whether the word “MTV” could have been registered as a word mark. The Complainant had in fact applied to register the word “MTV” as a trade mark, but this application was still pending when the Panel made its decision. An important feature of this case was the fact that the Complainant had repeatedly disclaimed, in its registered trade marks, rights to the use of the letters “M” and “TV” and the words “Music Television”. The significance of these disclaimers was that the Complainant had disclaimed any right to the exclusive use of these elements of its trade marks.<sup>53</sup> The Panel cited *Re “Staph Guard” Trade Mark* [1967] RPC 165, a decision of the English High Court, for the proposition that the use of an abbreviation of a descriptive word in a trade mark did not save the mark from being considered descriptive of the use of the item bearing the mark. While the Complainant did not disclaim the right to the use of the expression “MTV”, as “MTV” was clearly an abbreviation for “Music Television”, it suffered the same flaw. Further, there was evidence before the Panel that the expression “MTV” had entered mainstream Chinese language as a substitute for the Chinese expressions for “music videos” and “music television”, and therefore had become customary or generic. On these facts, the Panel took the view that the Complainant would be unable to assert any monopoly rights to the use of the word “MTV” since the word “MTV” no longer distinguished entertainment products to which it was applied as the Complainant’s products.

140 As this case was decided on its peculiar circumstances, in an appropriate case, a panel may yet find for a complainant who relies on a trade mark in which the word elements are generic or descriptive of the goods and services to which the trade mark is applied. A trade mark that has acquired a distinctive character as a result of its prior use as a trade mark in relation to certain goods or services may be registered as a trade mark in relation to those goods or services.<sup>54</sup> Such a trade mark might well comprise or incorporate a generic word or expression or be descriptive of the goods or services in question.

141 Similarly, in an appropriate case, a panel may decide in favour of a complainant who fails to establish that he has exclusive rights to the use of the word or expression used by the registrant as a domain name. In this regard, it is important to appreciate that a registered trade mark merely

53 See section 30(1) of the Trade Marks Act.

54 See section 7(2) of the Trade Marks Act.

gives the proprietor the exclusive rights to use and authorise the use of the trade mark “in relation to the goods or services for which the trade mark is registered”.<sup>55</sup> It is not inconceivable for a word mark to have honest concurrent users who use the same word mark in relation to different unrelated classes of goods or services or in different jurisdictions. Paragraph 4(a)(i) of the SDRP does not expressly require a complainant to possess exclusive rights to the name, trade mark or service mark that the registrant’s domain name is identical or confusingly similar to. In fact, paragraphs 4(a)(i) and 4(a)(ii) of the SDRP, when read together, contemplate a situation where both the complainant and the registrant may have “rights” to the domain name. In that event, as the registrant was the first in time, his “rights” to the domain name will prevail.

142 What is crucial in every case is that the complainant must be able to show that he has “rights” to the name, trade mark or service mark that he alleges the registrant’s domain name is identical or confusingly similar to. The Complainant failed to establish this in relation to the expression “MTV”.

143 Third, the Panel discusses the weight to be given to other panel decisions concerning the same word mark. Panel decisions in favour of a complainant in undefended proceedings are less authoritative and less persuasive as compared to defended proceedings. Decisions under the UDRP that focus on the circumstances in the United States and other foreign jurisdictions were also less persuasive as, under the SDRP, a panel must examine the dispute from a Singapore context.

144 Fourth, the Panel affirmed that for the purposes of paragraph 4(a)(i) of the SDRP, a complainant has “rights” in a name, trade mark or service mark if the complainant can succeed in asserting a claim against the registrant in passing off. However, the decision also illustrates the types of difficulties a complainant may encounter in trying to establish the elements needed to support a passing off action where the registrant has used the disputed domain name. In particular, it demonstrates that if a complainant wished to show that there was a misrepresentation by the registrant in using the disputed domain name or that the complainant had suffered or was likely to suffer loss as a result, it was insufficient to merely rely on the fact that significant Internet traffic flowed through the registrant’s website bearing the disputed domain name. This arises from the difficulty in gauging whether the Internet traffic was actually intended for the complainant to begin with.

55 See section 26(1) of the Trade Marks Act.

145 All things said, the decision in *Viacom International Inc v Elitist Technologies Co Ltd* is an important milestone in Singapore's jurisprudence relating to the resolution of domain name disputes. In particular, it provides useful insight on the approach that a panel may adopt in resolving a domain name dispute under the SDRP.

### Some Closing Thoughts

146 The UDRP and the SDRP recognise that domain name registrations can be made in bad faith and may be open to abuse. They have therefore attempted to define the circumstances in which a registrant should be ordered to transfer a domain name to a complainant. However, both the UDRP and the SDRP also recognise that domain name disputes are closely related to issues of trade mark infringement and passing off, and therefore allow the decisions of Panels to be reconsidered by the courts. It is possible that the courts may decide the same domain name disputes according to the different principles applicable under the law of trade marks and passing off and come to different conclusions from the Panels.

147 Only time will tell whether, and if so how, the provisions of the UDRP and the SDRP may influence the development of the law relating to trade marks and passing off, in so far as these pertain to domain name disputes.

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