

LEGAL STATUS OF THE INTERNET: ARE THERE LESSONS TO BE LEARNT FROM DOMAIN NAMES AND TRADE MARKS DISPUTES?*

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Introduction

Until June 2, 1999, Internet was not available in Bhutan. Since then, there has been a significant move towards providing training and information on this new technology. Currently, the number of users is restricted by limited access to computers. However, under a current programme of training schemes backed by the Royal Government in collaboration with the UNDP, Internet training is provided in schools within Thimphu. The programme is being extended across the country. In early June 2001, the first Internet café was officially opened with UNDP support in Jakar, Bumthang. As access and understanding of the Internet increase, it will play an important role in the national economy, as well as in the education of Bhutanese people.

Internet and Television were introduced to commemorate the 25th year of enthronement of His Majesty the King, Jigme

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Singye Wangchuck, only one year after His Majesty devolved full executive power to an elected cabinet ministers for a term of 5 years.¹ It is against this background that the Internet, as well as other forms of media, were introduced.

There were no legislations addressing issues raised by the Internet. Most of the Intellectual property laws are new and passed just recently.² The system of Bhutanese law has always been historically retroactive responding only to the emerging situation or when a demand for new legislation arises to counter changing circumstances within the society.³ Given the country's rapid pace of development, the institutional capacity or the legal instruments that are necessary to deal had to be proactive to accommodate changes and modernization.

The recently created Division of Information Technology (DIT) under the Ministry of Communications reflects such changes and institutional reforms.⁴ The DIT is responsible for the effective application of Information Technology (IT) to harness the perceived benefits that could be derived from the usage of IT revolution in Bhutan. In their ambitious Information and Communication Technology (ICT) master plan, their mission is to embark upon the road of Information Technology with the vision that Bhutan should become one of the world-class user and provider of IT.⁵ They argue that the small and relatively well educated population, widespread knowledge of English language, excellent telecommunications network with added advantage of reliable hydro-power generated electrification system and the existence of dedicated governmental support have created a conducive environment for the success of IT within a short span of time. Through IT, Bhutan can overcome and mitigate the long-standing communication problems caused by inaccessible mountainous terrain. IT is expected to bridge information gap and usher improved living conditions of the people.⁶

While the DIT has also been mandated to come up with IT legislation to be enacted by 2002, Bhutan has been able, as a

latecomer, to learn from the experiences of other developing, as well as developed countries. Internet is a global form of communication. The technical feature, its worldwide extension and unlimited accessibility makes the application and enforcement of existing rules difficult or even impossible to regulate the Internet. New Internet laws may not provide an effective solution either. Therefore, as experienced elsewhere in the world, Bhutan may not be able to effectively regulate Internet related disputes in the most efficient ways but we can definitely learn a lesson from others.

In this paper, the author proposes to discuss the nature of the problem and prospects concerning trademarks and domain names disputes and to consider the existing dispute resolution mechanisms available. This paper is divided into three parts. The first part explains the over all situations in Bhutan concerning the introduction of Internet. It provides the basic concepts of trademark and domain name and focus on the issues that are of concern to the author such as the existence of possible conflicts and problems and specifically the arguments as to why there are disputes between trademarks and domain names. The second part explores and deals with the current situations concerning the dichotomy between trademark and domain name registration system. The third and the final part will be dealing with questions such as how the trademark and domain name disputes could be solved. This part is therefore, sub-divided into two sections such that the first will focus on providing effective remedies in solving the conflict between trademarks and domain names disputes through the careful use of registration system in Bhutan. The second and final part will concentrate on the practice of 'out of court settlement' under the laws of Bhutan.

What is in a 'Domain name'?

Before providing an overview of disputes associated with the domain name and trademark registration system, it is important to understand their concept and definition. A Domain name is basically a database function that works like

telephone directory and number assigned to it. In simple term, it is like an address that guarantees an access to the Internet and guide to a specific location. Every computer that wants to receive and send data on the Internet must have its own identification number, the domain name.⁷

From a purely technological viewpoint, domain names simply identify the host system on the Internet and form part of web site addresses (known as URLs – Uniform/Universal Resource Locators), for example www.Tashitours.com, and they are often used in advertising to point people to information about an organization. Therefore, when an Internet user types in a domain name such as www.Bhutanstudies.com that domain name is translated into the Internet Protocol number, which can be in a numerical form.⁸ To remember lengthy Internet protocol ('IP') addresses is difficult and the domain name approach makes easier access to content on the web. Moreover, in addition to their identification role, domain names have developed secondary characteristics that are very similar to their registered or unregistered trademarks, as they have emerged as critical component of on-line marketing.

There are two types of top-level domain names. They are generic and country code. The generic domain names are created for use by the Internet public as a whole, while country code domains are to be used by each individual country. Therefore, domains such as *.com*, (commerce) *.org*, (organisation) *.net*, (networks) *.mil*, (military) *.edu*, (the educational Institutes) etc. are referred as Top Level Domains.⁹ Recently, the ICANN has proposed and has introduced¹⁰ seven new TLDs: *.pro* (for accountants, lawyers and doctors), *.info* (for anyone), *.biz* (for business), *.name* (for individuals), *.museum* (for museums), *.coop* (for co-operatives) and *.aero* (for the aerospace industry).¹¹ On the other hand, Country Code Top Level Domain (ccTLDs), for example are *.us*, (United States) *.uk*, (United Kingdom) *.jp*, (Japan) *.bt*, (Bhutan), etc.

From our example of www.bhutanstudies.com, '*.com*' is the gTLD and the 'bhutanstudies' is the 'Second Level' domains

encompass within the gTLD. Some may have even ‘Third Level’ Domains, especially in case of domain names that are registered under ccTLD, for instance www.druknet.net.bt. The ‘.net, .com, .ac, or .org’ etc that are encompassed in case of ccTLD are also known as sub-level domain to represent entities and also to specify more precisely the sphere of the domain name. But one should not misunderstand that ‘.net, .com, .org, etc and .bt’ are all TLD. In case of Bhutan, it is the 3rd level domain name that is allotted through the registration system.¹² Therefore, the second level domain name in case of generic and third level domain name in case of country code identifies the Internet web site operator, owner and the registrant. Because the second level domain names contain the alphanumeric identifier, they give rise to most legal problems. Such legal issues will be discussed in details in the later part of this essay with particular reference to the allocation of ‘IP’ and its registration of domain names under the assigned .bt, the ccTLD for Bhutan.¹³

Principally, domain names were intended to perform only the technical function of facilitating connectivity between computers through the Internet. Since they are easy to remember and even guess, domain names are now routinely used as an advertising means of indicating the presence of companies or business enterprises on the Internet.¹⁴ For example, if an Internet user wants to seek some information about Microsoft and is not sure about the web site, one may easily guess and type www.microsoft.com, it may as well work. Therefore, most often than in a few cases the domain names are related to registered or unregistered trademark of a business or its product or their activities. This dichotomy of conflict between trademark and domain name and the question as to why there are disputes between them will also be dealt under the subsequent section of this paper.

What is a ‘Trade Mark’?

A trademark is anything that is a distinctive name, symbol, word, or device that is used in commerce to designate the origin or nature of goods that is used for the purpose of

distinguishing the goods of another. This is essentially same in case for the service marks but they are used in designating the source, or origin or otherwise the sponsorship of services.

Trademark is one of the Intellectual Properties. Under the trademark law of Bhutan, it is defined as 'any visible sign capable of distinguishing the goods ('trademark') or services ('service mark') of an enterprise'.¹⁵ Therefore, the law in Bhutan equally protects the trademark and the service mark. In order to get the protection of a trademark, a mark has to be capable of distinguishing the goods and services. Nor may a mark mislead the public or trade circle, or be identical or imitative, nor may it be confusingly similar.¹⁶

Generally speaking, a mark can be registered as a trademark so long as it is distinct from other marks used in commerce. A trademark or service mark also includes the marks that are distinctive words, pictures/symbols or combination of both. Trademarks can exist in both registered and unregistered form and, in addition, even where a registered trademark exists, it is possible for third parties to have concurrent rights with the registered proprietor in cases where the third party had been using the mark in question prior to its registration. However, a registered trademark does not give absolute right provided that the competition is fair on part of the competing trader.¹⁷ Competing trader may not be prohibited from entering the same market with the same goods and services provided that such trader refrain from using identical or similar trade mark or cause some dilution or confusion to an existing registered trade mark.¹⁸ Trade Mark law is territorial. There is nothing to prevent a trader from marketing the same goods or services in a country of different jurisdiction.¹⁹

How Does the Infringement of Registered Trademark Occur?

The infringement of a registered trademark occurs in different ways. The most common infringements of such registered trademarks occurs firstly where a person uses a sign or mark in the course of trade which is identical with the trademark in

relation to goods or services that are identical with those for which it is registered. Secondly, the infringement of a registered trademark occurs in the cases where a person uses, in the course of trade, a sign or mark where:

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

And thirdly, the infringement of registered trademark occurs where a person in the course of trade uses a sign or mark which creates or likely to create confusion on the part of the public that are associated with the trademark.²⁰

Infringement of a registered trademark is actionable by the proprietor of the trademark on proof of infringement. Amongst others, the proprietor is entitled to seek remedies including; damages, an account for profits, injunctive relief, destruction or forfeiture of infringing goods, and delivery up of materials or articles.

Why Are There Conflicts Between Domain Names and Trademarks?

Conflicts between domain name and trademark arise for a number of reasons:

- a) Domain names are often the registered or unregistered trademark. Web site operators often use or desire to use a second level domain name be it registered trademark or not and that refers to their line of business entity.²¹ 'Using a company's name or trademark as a domain name is the easiest way to locate that company's web site'²²
- b) No two-domain names can be identical or same. For example there can be only one Internet address like

www.bhutanstudies.com, and www.rim.edu.bt. This means that the domain name system creates perpetual and exclusive monopolies in cyberspace. Genuine holder of the trademarks registration may be deprived of using their age-old trademark as their domain name. On the other hand, domain names as more specifically defined are addresses over networks of computers. Some IT lawyers argue that they are similar to street names to locate certain buildings or particular place or residence.²³ Indeed, domain names are simply address wherein the complexity of the Internet networking protocols needs separation and identity from the user. In the digital environment or in the cyberspace no two computers can have same domain names unlike the ground realities of trademarks. This invariably results in justifying the need to have a domain name linked with trademarks that have established reputation.²⁴ Moreover, the technical limitation of characters of the domain name to twenty-four letters has made it difficult to coin a new and distinctive name other than to use their own trademark.²⁵

- c) The registrations of domain names are done on the first-come first-served basis. This may deprive the lawful owner of trademarks to use their trade or service name when they decide to go on line. Some one would have already registered and can claim priority. This issue will be discussed in detail under the section on the current analysis of domain name registration system in Bhutan.
- d) The registration of domain names and that of trademarks are managed by different registry system. In case of Bhutan the registration of trademark is done at Registrar's office of the Ministry of Trade and Industry and the domain names registration and the allocation of the 'IP' addresses are maintained with the registry of Bhutan Network Information Centre (BTNIC) under the aegis of the Ministry of Communications. Currently, there is no proper mechanism to cross check between these two registry systems. In most cases, the registrant submits

the application for domain name registration based on information submitted through forms. Therefore, the information, which is submitted through such filing of forms, is based on declaration made by the applicant and the Registry does not cross check whether such declarations are genuine.

- e) E-commerce²⁶ is gaining prominence through on-line advertisement, contracting, and e-mail service using the trade name or service name as prominent domain names on the net. Even though goods and services are not directly available through Internet, the overt increasing trend of such on-line shopping, e-commerce or e-business has become an undisputed advantage in today's on-line world. Therefore, the domain names disputants often relate their claim of domain name linked with trademarks.²⁷ Many companies and business enterprises have also recognised the economic value of on-line business through acquiring the appreciation of unique, distinguishable, of repute, easy, common and memorable domain names.²⁸ A unique and commonly known domain name further enhances the ability to capture the market and popularity on the net. The distinctive mark as domain names and the goodwill associated with it have an advantage and reputation established over new and uncommon marks of business in the market. Thus, the trademark owners have lots of concern and their right to usage of their mark as domain name on the on-line world.²⁹
- f) Trademark laws are national or at the most regional and do not grant universal protection. Waelde points out that dispute between trademark and domain name exists because the application of law and jurisdiction are different in each case. Trademark law is territorial in its application whereas the Internet is global. The infringement of a trademark may therefore, occur only within the territorial jurisdiction or national boundaries and such infringement may be very visible because of its

territorial nature. However, in the case of a domain name, the Internet has unlimited access.

- g) As pointed out elsewhere in this paper, disputes between trademarks and domain names are more likely to arise because a domain name usually points not only to the location of the site in the Internet, but it also identifies the source of information.³⁰ In this sense, the importance of domain name can resemble that of a trademark that identify the origin and perhaps intrusively, the quality of goods that are traded in the e-business³¹. Temptation to consider domains as mutant trademarks has unfortunately resulted in creating interesting legal dilemmas. The preservation of the goodwill of a trademark is central to the protection of the property right vested to the trademark owner. For this concern, the expansion of trademark law is *sine quo non* to ensure that the trademark rights are not usurped in the 'virtual world.'³² But the issues and dichotomy between the two remains much unsolved. Trademark laws are designed to tackle real world situations and the application of its provisions has become difficult when applied to the Internet scenario.

Moreover, trademark law finds infringement when the competitor's names are identical, confusingly similar or imitating. Under trademark disputes the term 'confusingly similar' is very difficult to distinguish with that of the competitor's mark and the protection accorded to trademarks is of much broader application than that of the specific string of character that may attach in the trademark registration itself. However, domain names are limited to a specific string. Registration for domain name 'bhutanstudies.com' does not prevent someone else from registering 'bhutan-studies.com', 'bhutanstudies.com.bt', 'bhutanstudies.org', or 'bhutanstudies.gov'. As a matter fact the author argues that either of the last two TLD could have been much appropriate for the Centre for Bhutan Studies than using '.com' because the Centre of Bhutan

Studies is not a commercial profit making organisation but an autonomous organisation or the agency of the Royal Government. I will not discuss here the possible reasons as to why they have registered firstly under the gTLD of '.com' and in the second case the reasons behind of not having registered with the Bhutan Network Information Centre (BTNIC) under the ccTLD '.bt.'

In these circumstances, many questions arise. Should the tentacles of trademark law be extended to domain names to protect or shove aside such confusingly similar names on the cyberspace? Can the trademark law, which is meant to solve the real world situation, be extended to the virtual world situation? Should domain names be at all allowed to fall within the scope of the trademark law? Should we adopt a distinctive mark in the cyberspace such as 'cybermark' as some would suggest?³³ Does the registration of trademark confer automatic rights to domain name? And what are the best judicial or extra judicial remedies one can provide for effective dispute resolution between trademarks and domain names? All these questions merit separate discussion.

Domain Name: A Current Analysis in Bhutan

The concept of domain names or for that matter, even Internet is new phenomenon in Bhutan even though computers have been used in various government and private sector since 1980's³⁴. Since then, the usage of computers amongst the government ministries and department, educational institute, tourism industry, and other private sectors has drastically increased over the years³⁵.

While both the government and private sectors alike have equally realised the benefits of Internet, for most, the concept of Domain name and its legal significance over the web remains unexplained. However, at present where 79% of the population is farmers and computer illiterate, the Internet as a mode of communication has limited utility and IT will take time to bridge the existing 'digital divide'. At the same time, concerns over unexpected legal dilemmas and issues involved

in regulating Internet and domain name disputes in relation to trademark cannot be ignored.

It may be noted that till date there has not been even a single case concerning the Intellectual Property Rights disputes raised in the Bhutanese Courts.³⁶ However, this may soon change. As Bhutanese interacts and find the Internet as dominating medium and as a sources of valuable information, the Internet related case have potential to find ways through the Courts. One of the such possible disputes which concern is the case that relates to trademark infringement through the 'gold-rush' of domain name registration accompanied by the similar rush for the trademark registration. Currently, (till July 2001) there are about 200 numbers of registered trademarks against 2019 pending application seeking registration with the Ministry of Trade and Industry (MTI).³⁷ The legal dichotomy is currently propounded by the lack of rules concerning the domain name registration. The current practice of name registration on the first-come first-serve basis under the assigned TLD names for Bhutan (i.e., .bt) and the legal significance of its implication in relation to concurrent trademark registration system cannot be ignored. However, these issues will be discussed in detail later.

How does domain name get registered?

Bhutan's gateway to Internet at the moment is through 'DrukNet' the only Internet Service Provider (ISP) in the country. Bhutan Network Information Centre (BTNIC) is an agency, which is presently managed by DrukNet, established under the umbrella of Bhutan Telecom Authority (BTA). BNIC was established in order to administer the country level Internet domain assigned to Bhutan and allocates IP address to customers. BNIC's services include registration of 3rd level domains under .bt and the allocation of IP addresses.

While the registration of the domain through the service of BNIC³⁸ is firstly to check whether there is any domain names under .bt. If there is, the requirements is that you need to file up and give detail information such as your Network

details giving Net name, short description of organization, e-mail address of person filing the forms, date of filing, administrative contact details and technical details etc., with a prescribed fees to get your domain name registered. As of yet, there are no clear-cut rules concerning the allocation of IP addresses, or even, the registration of domain names calling potential disputes. The terms and conditions that are to be associated in filing such registration are just being drafted.

Although, there are only about 34 Registered domain names with two pending,³⁹ most seems to have applied and registered on the basis of genuine requirements keeping their domain names strictly related to trademarks or service names. To date, the applications for the registration of domain names both by the government under *.gov.bt*, by private companies or enterprises under *.com.bt* or by organisations under *.org.bt* have been increasing on a daily basis. Most government departments and ministries are waiting to launch their own web site. The High Court too will soon have it's own web site with it's domain name registered with the BTNIC. However, most of the major and reputed companies or enterprises have either no domain names at all, or they simply have not bothered to register with the BTNIC. For example, a large and reputed commercial corporation like Tashi Commercial Corporation has lists of registered or unregistered product marks and service marks. Their product such as 'Drukjam' is not only well known in Bhutan, but they have established a good reputation in our neighbouring countries like in India, Nepal, Bangladesh and even other South Eastern Asian countries notably in Thailand. However, when checking the availability of domain under the registered product mark of 'Tashi' such as www.drukjam.com.bt, it became apparent that they have not registered as yet. As from the experiences of other countries, keeping an open registration system - such that as long as there is domain name available under '*.bt*,' there could be sudden up load or the possibility of passing off and even cybersquatting in the registration system. The concept and the legal significance of

passing off and cybersquatting are discussed in the following sections.

New Trademarks Law and the 'Passing Off'

Until 1997, Bhutan had no trademark law. It was so far governed by the 1997 Industrial Property Regulation. This rule was formulated to regularise, protect and provide uniform trademark registry system in Bhutan under the patronage of the Ministry of Trade and Industry. However, with the rapid pace of the private sector development over recent years and especially with Bhutan having joined the World Intellectual Property Organisation (WIPO) from 16 March, 1994 and accession to WTO membership underway, Bhutan had to accommodate the obligations as provided under the Paris Convention in the registration of the trade mark in Bhutan.⁴⁰ This twin factors has necessitated the old rule to be replaced by the most recent Act passed by the National Assembly called the 'The Industrial Property Act, 2001.' This new Act has provisions encompassing the Patent and the Trademark law of Bhutan.

Since the trademark law is fairly new, accompanied by the lack of awareness in the value that are involved in trademark amongst the companies and business enterprises, there is currently a significant number of unregistered trademarks in Bhutan.⁴¹ Many companies or private enterprises have a number of trademarks or services marks, which merit protection because of their established goodwill and reputation. As discussed in the earlier section, trademarks and service marks designate the source or origin of the goods and services. Trademark and service mark are primarily intended to protect the consumers from being misled or confused as to the source of the goods or services rendered by the trademarks and the service marks owners. When the consumers trade or purchase a particular brand of commodities, trademarks and service marks allow them to expect the particular degree of quality or the satisfaction that they would have derived from using such goods or services. Therefore, trademark protects the originality of goods and

services. As argued, trademarks can be protected either by way of registered trademark or through the 'common law' practice of passing off.⁴²

Passing off is a means of protecting names that are not registered under the trademark law but have gained enough reputation and goodwill. Therefore, for one to succeed in a passing off action, it must be shown that one had built up goodwill in business and that someone else had by using such a trademark benefited from that goodwill. Since the trademark law itself is new in case of Bhutan, the protection of trademark through passing off action will be most suitable solution available and relevant.⁴³

Cybersquatting and the related disputes

Another similar trademark infringement but not equivalent to passing off is 'cybersquatting'.⁴⁴ Cybersquatting or domain name 'hijacking' is the act of registering a trademark or registering others domain name in bad faith with the intent to profit from such action. The factors that constitute bad faith though not exhaustive includes the registration of domain name with an intention to divert consumers from the mark owner's on-line location and an offer to sell, transfer or otherwise assign the domain name to another person.

Cybersquatting is condemned worldwide. Recently, the World Intellectual Property Right Organisation (WIPO), which mediates in intellectual property disputes, has ordered India-based cybersquatter Devinder Pal Singh Bhatia to transfer the domain names *Sapmaster.com* and *Sapwizard.com* to German multinational e-business concern, SAP AG. According to SAP India officials, the said domain names *Sapmaster.com* and *Sapwizard.com* were identical or confusingly similar to the trademarks of SAP. WIPO held that Bhatia has no rights or legitimate interest in the names and found that the domain names were registered and were being used in bad faith.⁴⁵ Similarly, a WIPO Panel has also awarded 31 of 32 domain names to the Canadian government after it has held that, the

dot-com domain names had been registered in bad faith by a Vancouver, British Columbia-based cybersquatter.⁴⁶

In case of Bhutan, as there is no case law at the moment it is not possible to assess the true picture of the case. There could be lots of potential disputes arising from cybersquatting as the domain name registration in Bhutan, is based on the first-come, first served. From our previous example of Tashi Commercial Corporation case, it won't be surprising to find that most of their famous names would already have been taken by someone else be it on bad faith or on whatsoever basis. In other words, when Tashi decides to go on on-line, it may not be surprising if they discover that they can not register domain names under their product mark because some one would have already registered.⁴⁷ The only option that may be available is to claim back their name either through litigation or find appropriate settlements like settling out of court. But that will cost money and time for the company.

How Could These be Solved in Bhutan?

Bhutan can adopt two-prong strategy in solving the legal dichotomy between trademark and domain names: firstly by adopting a carefully crafted rules that are applicable pertaining to trademark and domain name registration system, and secondly, by the adoption of simple disputes resolution policy. This policy has to be within the framework of Bhutanese legal system. This strategy is discussed subsequently.

Through careful use of trademark and domain name registration system

Currently the BTNIC maintains the details of the data that is submitted along with the forms for the purpose of registration, cancellation, renewal and reversion, and transfer of domain names. Even though it is responsible for maintaining the details of the database, the absence of clear cut rules may cause the DrukNet or the BTNIC to face legal

responsibility that may arise from the infringement of intellectual property rights in the names used as domain names.⁴⁸ Therefore, it is very important to have such a rule whereby the DrukNet should specify that any liability for infringement of rights by registering a domain name rest solely with the registrant.⁴⁹ BTNIC must not burden itself with such potential legal challenges. For ensuring consistency and fairness, the registration process has to be guided by well-spelt rules concerning subsequent transfer, surrender, suspension and cancellation of domain names rather than just depending on the details filled up in the forms. Once the domain name is registered under the established process of rules, certificate validating the domain names may be issued as an evidence of proof to the registrant.

As a means of preventive measures and before a domain name is allowed to get registered it is vital that all steps are taken to establish that no other companies, business entities and organisations use an identical or similar mark on their goods and services in the on-line market. This can be done in two ways: Unregistered & New Marks.

Unregistered Mark

In the case of unregistered mark the BTNIC has to consider the prevailing knowledge as to the existence of marks that are with reputation or goodwill. This in specific term can be achieved by using the appropriate knowledge and contacts in the market, it can be ascertained if an identical or similar mark exists to the one that is to be launched. The following pre-conditions are proposed to minimise the conflicts between domain name registration and unregistered or new marks before the domain names are actually registered in Bhutan under '.bt':-

- (a) A written notice pending the application for registering of domain name(s) may be issued through media publication (Kuensel) and announcement through Bhutan Broadcasting Service (BBS). Such notice should

specify calling objection to the proposed domain name registration within specific statutory time limit.⁵⁰

- (b) A copy of such notice may be sent to the Bhutan Chamber of Commerce and Industry (BCCI) and to the Registrar's office of the Ministry of Trade and Industry calling objection thereto or certificate issued to that effect.
- (c) In case of new companies or those who wants to establish new business enterprises, the registrant has to declare that the domain name sought is new and does not infringe the existing names or mark. In such cases, the principle of first-come first-serve will be the criteria for the allocation of domain name. Similarly, if there are more than two entities having equally valid claims for the registration of domain names, there should be a clause in the rules allowing the disputing parties to mediate their claims or the disputes referred to the court to determine the competing claims.
- (d) In case of the establishment of foreign companies and the registration of domain name by such companies, it has to be guided by the Companies Act of the Kingdom of Bhutan, 2000.⁵¹
- (e) A procedure may be established whereby, the terms of an undertaking by the registrant in writing may be submitted with the application forms to declare and establish that the domain name registration sought is in good faith.
- (f) The registry could also require applicants to certify that it knows of no entity with any rights in the domain name it seeks to register.
- (g) The rules should also specify that when the entities such as the government, business, educational institutions, military etc., file for the registration of the domain names under *.bt* they have to comply in strict sense of their activities. For example, no government or its agency may

allow to be registered as business entities under '.com.bt' or vice-versa.⁵²

- (h) The current practice of the DrukNet such as the charging of fees that are required to be paid along with the application forms for the domain name registration is encouraging to prevent cybersquatters for registering the domain names in bad faith.⁵³

Registered Marks

Although registered marks are protected, it is very important that the BTNIC directs the applicant for domain name to acquire a certificate from the Registrar's office of the Trade and Industry claiming the validity of such marks.

A domain name databases which is readily searchable through a common interface to determine what names are registered, who holds those domain names etc, may be established to make the job of policing easier and the chance of domain names piracy reduced.⁵⁴ The domain name database will also identify the availability of a particular name in which someone is interested and determine if there are similar names already in use, verify online merchants, online infringers for enforcement of intellectual property rights, locate and identify source in the investigation of illegal activity including consumer fraud etc.

Through existing ADR under Bhutanese law, Nominet and ICAAN Policies

This section analyses the dispute resolution mechanism under the Bhutanese law and provide a comparative study with that of rather more formalistic method of ADR⁵⁵ under Nominet and that of ICANN policies which are specifically provided to solve trademark and domain name disputes. Therefore, this section is divided into two sub-sections. The first sub-section provides the general background of most preferred form of practice of mediation under the Bhutanese legal system. The second sub-section enumerates as to how the Nominet and the Uniform Domain Name Dispute Resolution Policy (UDRP) of the ICANN

deals with the disputes. It shows that Bhutan could draw an interesting experience and lessons from them to address the domain name and trademark issues.

Mediation under Bhutanese Legal System

While disputes relating to trademark or domain names under Bhutanese jurisprudence may be new, one possible remedy may exist in the current provisions for out of court mediation of disputes. In Bhutanese jurisprudence, reflecting provisions in Buddhist text, settling the case out of court has deep-rooted foundation. With the society that is small, simple and close-knit, the ideal situation for such communities was to prefer out of court settlement.⁵⁶ In such a situation, the age old and time-tested concept of mediation and reconciliation between conflicting parties outside the purview of the formal legal process has played a vital role since time immemorial. Historically, the Bhutanese have preferred to resolve their disagreements through compromise⁵⁷. In an alternative form of dispute resolution there may not be a winner or loser. Moreover, such mutual settlement deviates from emotional, psychological and economical cost. Therefore, out of court settlement has always been valued higher than retribution and the need for sanctions.⁵⁸

The basic governing law, which confers legal status to out of court settlement, is the *Thrimzhung Chhenmo* or the Supreme Law.⁵⁹ Under Section DA 3-2, all type of cases can be negotiated and settled out of court except those cases that are prohibited under the law or as specified under the preceding Section DA 3-1⁶⁰. In principle, settlements of only a few cases fall foul of prohibition. Therefore, formal litigation is generally a last resort.

For the Bhutanese, mediation is one way of finding resolution and compromise without litigating in the courts. The mediator(s) are normally the person or group of persons who defy definition or qualification other than the experience. Mediation or out of court settlement is reached with the help of mediators who are commonly known as *barmi*. They are the

gup (elected village headman), *chimi* (elected people representative to the National Assembly), *mangi ap* or *tshogkpa* (village elders), retired officials or a monk in-charge of the village monastery who use their acquired experience and social standing in dealing with such settlements. Buddhism and its ways of life also influence the longstanding success of mediation in Bhutan.⁶¹

Mediation is generally sought in two ways. One is before filing the case to the court and the other is after having filed the case but before the court hands down the written judgement. These two stages of mediation are discussed in detail below.

Mediation prior to registration of a case

Where a conflict arises in the community, the *barmi* try to solve such disputes at its origin. The disputing parties may choose and agree with any suitable person for the purposes of mediation. The *barmi* attempt to resolve the conflict involving all the parties concerned in a cordial environment that is conducive and amicable. In such a settlement the victim is compensated for the damage caused by the offender; the offender is made to realize his wrong doing and encouraged to apologize to the victim, which often leads to a reconciliation of the two parties. If such a process leads to an amicable settlement, then in such circumstances, a mutually reached agreement is set down in writing, which is known as a *goenja* or written agreement counter signed by the agreed parties in presence of two independent witnesses. The judicial stamp has to be affixed for the validity of such agreement. The agreement like any other contractual documents is enforceable in the court of law from any consequences that may arise out of the breach of such agreement.

Mediation after the case has been registered in a court of law

Under the law, any civil cases and compoundable offenses could be settled at any time of the proceeding but before the written judgement is handed down by the court. When there is resolution through mediation the court pass a consent judgement. The litigants have the statutory right to settle out

of court. Even if the litigating parties are not aware of their right to settle out of court, an obligation is imposed upon the judges to inform the parties in the Preliminary Hearing⁶² that they have the right to settle out of court at any time of the proceeding of the case. Efforts to resolve cases by mutual agreement may also proceed with or without the assistance of mediators, thus it is evident that the mode of such reconciliation is at the discretion of the parties concerned.

The procedure for such settlements is simple. All that the parties are required to do is to submit a joint petition to the court requesting for an adjournment in order to pursue such a settlement. Once a settlement has been reached by mutual consent it must be set down in writing stating the modalities of the mutual consensus. The agreement reached thereto has to be countersigned by the conflicting parties with two independent witnesses and a judicial stamp affixed. The witnesses may be the mediators themselves. After having drawn up the mutual agreement, it must be submitted to the court for its judicial sanction. It is at this stage that the court draws up a consent judgement.

However, it is very important to note that the settlement of the case has to be voluntary without coercion, undue influence, and false promise or otherwise. In order to safeguard from such malpractice, any party to the agreement who may wish to object to the validity of the agreement has ten working days from the date of the judicial sanction to contest the agreement. An agreement, once sanctioned by the court and not objected to by either party within this statutory period is enforceable under court order and supervision or *suo moto*. Therefore, the disputes that may arise between trademarks or domain names falls under the category of the cases that could be solved through mediation or any other forms of available dispute resolution mechanism in Bhutan.

Conclusion

The access to Internet web sites in Bhutan, as experienced elsewhere in other countries,⁶³ is growing rapidly. As the usage of the Internet further expands it is expected to promote education, information sharing, facilitate e-commerce and e-governance and usher benefits through such IT revolution. However, it is necessary to understand that the Internet and its unlimited access also pose difficulty and gray areas in providing effective regulation and challenge legal certainty and predictability. As we enter the Internet world most of us will face, as it has been in other parts of the world, the common problem of Internet like the often talked about 'digital gap', the difficulty in finding effective regulatory mechanism to curb Internet related crimes of all ranges - child pornography, libel and defamation, spamming, hate and racial speech, privacy, etc.

The evolution of disputes concerning domain name usage in the Internet will find ever-increasing trend in the years to come. Unless there is a proper mechanism established to address an applicable solution, the controversies of the registration of famous trademarks, service marks and trade names as domain names by someone other than the owner of such famous mark will have potential to create avenues of dispute.

Notes

¹ Election of Cabinet Ministers' Act, 1999. It should be noted that the period from 1952 to 1998 saw many important social, economic and political changes. However, the kasho issued by His Majesty in 1998 was perhaps the most far-reaching political change in the last thirty years.

² The 79th session of National Assembly which was held from 28th June, 2001 to 3rd August, 2001 had passed several commercial acts. The new legislation includes the Industrial Property Act, Copyright Act, Commercial Sales of Goods Act, Cooperatives Act, Income Tax Act, Civil and Criminal Procedure Code, Livestock Act, and the Bhutan Electricity Act.

³ Bhutan 2020 'A Vision for peace, prosperity and happiness' Planning Commission, RGOB, 1999, p.81.

⁴ A new ministry as the Ministry of Communication and Information Technology will be created by the year 2002 as part of the programme of institutional and capacity enhancement of IT in Bhutan. See Information and Communication Technology (ICT) Master Plan for Bhutan, compiled and published by the Division of Information Technology, Ministry of Communication in March 2001, Thimphu, p.21.

⁵ See for details in Information and Communication Technology (ICT) Master Plan for Bhutan, compiled and published by the Division of Information Technology, Ministry of Communication in March 2001, Thimphu, pp.5-6.

⁶ The Intranet and Internet network will enable district officers in Bhutan to collect, share, retrieve and analyse data and information, narrowing the information gap between the officers in the Ministries of Thimphu, Bhutan's capital, and the country's 20 districts headquarters and remote villages. For further details see, 'IT Access, Income Generation Needed in Bhutan's Districts' and 'Bhutan network will aid local decision-making', available at www.undp.org.bt

⁷ For an excellent source of the history and technical background of domain names, see R Shaw, 'Internet Domain Names: Whose Domain Is This?' at 'What is the Internet Domain Name System?' <http://www.itu.ch/intreg/dns.html>

⁸ For example a typical Internet address might appear as '44.56.0.48' where '44' is the net work, '56' and '0' refers to sub-networks, and '48' refers to the computer itself. See Dueker 'Trademark Lost in Cyberspace: Trademark Protection for Internet Address' (1996) 9 Harv. J.L. & Tech. 483, p.491.

⁹ It is referred in its abbreviated form as generic Top Level Domains (gTLD) or (iTLD). <<http://www.icannwatch.org/article.php?sid=224>>

¹⁰ This proposal was made in 14th November, 2000. Two of the seven registries have already commenced registration activities. The ICANN anticipates that the others will do so later in 2001. See <<http://www.icann.org/committees/ntepptf/>>. The information about the schedule for their implementation is available at web sites operated by their registry operators <<http://www.nic.biz>> and <<http://www.nic.info>>. In case of '.biz' the deadline for the application for the domain name is 17 September, 2001.

¹¹ The rights to operate and sell domain within this TLDs have been granted to seven separate bodies, with a joint venture between a Delaware spin-off from Lockheed Martin and a spin-off of the University of Melbourne (NeuLevel), based in the USA. Such authorised domain name registrars, includes four in the UK. The '.biz' gTLD has been introduced apparently to cure to the problems of 'gold rush' and ease registration under '.com'. But in seeking diversity in the Internet it opens up yet another new problems for those trying to protect and enhance their registered trademarks on the Internet.

<<http://www.siliconvalley.com/docs/news/tech/024423.htm>> See also 'Confusing problems with .biz domain names' 19/06/2001 available at

<http://www.out-law.com/php/page.php3?page_id=confusingproblemsw992950724>

¹² In Bhutan one often come across domain names that are registered with the outside registry system. This web site like <http://www.bootan.com>, <http://www.bhutanstudies.com>, etc are either registered before the Internet was introduced in Bhutan or it is done as an option to have a place of registering their domain name beyond the jurisdiction of Bhutan.

¹³ The Internet assigned numbers authority (IANA) is the overall authority for day-to-day administration of the Internet Domain Name System (DNS). IANA staff carries out administrative responsibilities for the assignment of IP Addresses, Autonomous System Numbers, Top Level Domains (TLDs), and other unique parameters of the DNS and its protocols. Bhutan has acquired the country level domain as '.bt' in 16th July, 1997. See <<http://www.iana.com>>

¹⁴ In a recent study by the Scottish Internet Society, it was shown that out of all the UK companies, which currently have web presence, 6% use the Internet as trading medium and that one year from now this figure will have risen to 36%. This means that by year

2002 more than one third of the UK companies will be using the Internet for buying and selling products and services. www.scotlandis.com

¹⁵ Section 24 (i) of the Trade Mark Act, 2001. The terms 'trademark' and 'service mark' can be used interchangeably because they are both protected in the same manner under the Act.

¹⁶ See Section 25(3) (i), (ii), (iii), (iv), (v) and (vi) of the said Act.

¹⁷ See Section 36 of the said Act, 'Unfair Competition'.

¹⁸ C Waelde's article on 'Trade Marks and Domain Names' in L Edwards & C Waelde 'Law & the Internet: a framework for electronic commerce' Hart Publishing, Oxford, (2nd edn.) 2000, pp.135.

¹⁹ Ibid.

²⁰ See Trademark infringement under the Bhutanese law s.25 read with s.33 in comparison with the United Kingdom's Trade Mark Act, 1994, s.10 for the infringement of registered trademark.

²¹ For further reading see T Jim, 'Trade Mark Use on the Internet', Supreme Court, Singapore, Paper: MC/2.1b (1999).

²² *Panavision v. Toepfen*, 141 F.3d 1326, 1327 (9th Cir. 1998)

²³ D J Loundy, 'A Primer on Trademark Law and Internet Addresses' 15 John Marshall J. of Computer and Info.law 465 (1997).

²⁴ For details on 'Reputation, Well-known or Famous Mark', please see, C Waelde's article on 'Trade Marks and Domain Names' in L Edwards & C Waelde 'Law & the Internet: a framework for electronic commerce' Hart Publishing, Oxford, (2nd edn.) 2000, pp.144-145.

²⁵ For details see K S Dueker 'Trademark Law Lost in Cyberspace: Trade Protection for Internet Address' 9 Harv.J.L.& Tech. 483(1996).

²⁶ Some writes prefers to refer by different names such as e-business, e-shopping, on-line shopping etc.

²⁷ See A Orange, 'Development in the Domain System: For Better or for Worse?', Commentary (3), The Journal of Information, Law and Technology (JILT). <http://elj.warwick.ac.uk/jilt/99-3/orange.html>

²⁸ M Geist 'Internet Law in Canada' Captus Press Inc. (2000) p.328.

²⁹ A Brunel 'Trademark Protection For Internet Domain Names' Computer Law Association Inc, the USA, 1996, p.1-10.

³⁰ I J Kaufman, 'Resolution of Domain Name Disputes in the Context of the New Internet Governance'. <http://www.ladas.com>

³¹ See Hale 'Trademarks ride into the Wild West of the Internet: A Landmark Ruling of Cyber Infringement in the Comp Examiner Agency, Inc. v Juris, Inc.' (1997) 4 J. Intell. Prop. L. 399.

³² In order to provide an effective protection of mark in the cyberspace and to solve the problems of existing conflict between trademark and domain names some Intellectual Property law experts

even advocates the proposal for adopting an alternative form of the protection in case of the Internet. Such proposal includes the adoption of a new name 'cybermark' to be in place. See D Flint 'Proposal for a Cybermark, January 1997' MacRoberts, Solicitors Intellectual Property & Technology Law Group. <<http://macroberts.co.uk>>

³³ David Fint, 'Proposal For a Cybermark', MacRoberts, Solicitors Intellectual Property & Technology Law Group, January 1997.

<http://www.macroberts.co.uk>

³⁴ The introduction of computer for the first time in Bhutan was in 1984. Currently there are more than 4,000 computers in Bhutan. For detail see Information and Communication Technology (ICT) Master Plan for Bhutan, compiled and published by the Division of Information Technology, Ministry of Communication in March 2001, Thimphu, pp.9-15.

³⁵ For example, the computers have been in use especially in the case of Judiciary of Bhutan from early 1990's. The Judiciary with a three level of appeal system, the High Court in the apex, the District and Sub-District Courts as subordinate is well equipped with computers made available both through RGOB funding and support from UNDP and DANIDA projects. The Judiciary retains the objectives that the Information technology is a powerful resource, for the court system to function as being accessible, fair, accountable, transparent, effective and timely (the concept of due process) in the administration of justice. For detail reports see 'Royal Court of Justice, Strategic IT Plan', Prepared and submitted by Drew Jackson, Umesh Pradhan and Bob Mortgenthaler, 5 May, 2000, High Court of Bhutan, Thimphu.

³⁶ Refer the data of registered case compilation Report of Bhutan from (1990-June 2001), unpublished, High Court of Bhutan.

³⁷ Source: e-mail enquiry from the MTI (9 July 2001).

³⁸ <www.btnic.com.bt>

³⁹ (22 July 2001) e-mail correspondence with DrukNet .

⁴⁰ See Section 26; it provides that the applicant for the registration of the trademark has to declare the priority of claiming such registration. This declaration should be made and as provided for in the Paris Convention.

⁴¹ The current 2019 pending applications for trademark registration with the MTI itself demonstrate the existence of the numbers of unregistered mark in Bhutan.

⁴² For detail on passing off see A Michaels 'A Practical Guide to Trade Mark Law' (2nd edn) London; Sweet & Maxwell, 1996, pp.112 to 126.

⁴³ It may be noted here that Section 25(2) of the Trade Mark Act of Bhutan, provides that 'Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods or services as the goods of another person or as services provided by another person, or the remedies in respect thereof'.

⁴⁴ For brief reading see Ladas & Parry, 'Improper Use of Trademark in Domain Name and Cybersquatting'.
<http://www.ladas.com/index.html>

⁴⁵ See 'SAP Evicts Cybersquatter', by CT Mahabharat, Newsbytes, New Delhi, India, 09 July 2001.
<http://www.newsbytes.com/news/01/167712.html>

⁴⁶ See R MacMillan 'Canada Wins 31 Domain Names In WIPO Decision' Newsbytes, Wanshington, D.C., U.S.A., 10 Jul. 2001.
<http://www.newsbytes.com/news/01/167770.html>

⁴⁷ C Oppedahl 'Internet Domain Names that Infringe Trademarks' New York Law Journal, Feb. 14, 1995, pp.1-5.

⁴⁸ In the UK, Nominet does not take the legal responsibility for the intellectual property rights in the names used as domain names. For brief reading see William Black's article on 'The Domain Name System' in L Edwards & C Waelde 'Law & the Internet: a framework for electronic commerce' Hart Publishing, Oxford, (2nd edn.) 2000, pp.125-130.

⁴⁹ It may be noted here that the DrukNet has come up with 'Service Agreement for Dial Up Access' wherein, it is stipulated that the DrukNet through their Disclaimer Clause makes the customers to be solely liable for any legal consequences in entering into agreements for securing Dial up access through the DrukNet.

⁵⁰ Such statutory time limit may be prescribed in the rules thereto.

⁵¹ Under the Act, no foreign company may directly operate in Bhutan except through the Bhutanese Subsidiary Companies registered under the Companies Act of Bhutan, 2000. Therefore, the author propose that any foreign subsidiary companies in Bhutan who may want to register their domain name has to be filed through such subsidiary companies without prejudice to the parent companies' existing domain name abroad. However, such foreign subsidiary companies shall have to comply with the rules thereto under the Companies Act and be consistent with the rules of domain name registration that may similarly apply to any Bhutanese companies or enterprises.

⁵² The aim of such proposal is to minimise confusion and to ease the possible overloading of registration under '.com.bt' as experienced in other countries. Furthermore, the entity and activities based

segregation of domain name registration in Bhutan will provide sound management for the DrukNet and promote easier accessibility for the Internet public.

⁵³ For the allocation of 'IP' address the applicant is charged a fees of Nu.2000 and Nu.5000 for the actual allocation of domain name with annual fees of Nu.300. (Nu. is an abbreviation of the Bhutanese currency the 'Nugtrum')

⁵⁴ See 'A Proposal to Improve Technical Management of Internet Names and Addresses Discussion Draft 1/30/98' pp. 1-17. <http://www.ntia.doc.gov/ntiahome/domainname/dnsdrft.htm>

⁵⁵ Alternative Dispute Resolution or some prefer to call an Alternate Dispute Resolution.

⁵⁶ Although there were records that the laws and law officials were in existence from 1652 the emphasis has traditionally been on local resolution of differences. This reflected a deeply held belief that social disputes caused disharmony in the village and its surrounding areas which in turn could lead to local deities being displeased and causing crops to fail and illness (see F. Pommaret 1998, Schicklgruber 1997, R Whitecross 1999).

⁵⁷ Though as Dr M Aris has pointed out violence was historically often relied on by the more powerful figures, and reaching compromise between villagers was not always easy (M Aris 1994).

⁵⁸ see T Wangchik '(Alternative Dispute Resolution) out of Court Settlement/mediation-(Nangkha Nangdig) in Bhutan' a SAARC Law Paper presentation Unpublished paper., Thimphu, 1999.

⁵⁹ Thrimzhung Chhenmo, 1959.

⁶⁰ Thrimzhung Chhenmo, 1959, DA 3-1 states, 'Cases regarding theft, armed robbery and treason are non-compoundable offences and must be brought before a duly appointed court of law. Such cases cannot be negotiated and settled out of court'.

⁶¹ Although there are no official data available at the moment to support by what extent mediation is successful in Bhutan, it can be mentioned here that the case compilation (unpublished) report of the High Court of Bhutan (since 1990-1999) shows that the majority of the case that comes to the court are those that relate to property disputes, followed by matrimonial or couples seeking divorce from the court. It may be noted here that under s. Kha 9-3 of the Marriage Act, 1980 only the court has power to grant divorce and it cannot be settled out of court.

⁶² Civil and Criminal Court Procedure of the Kingdom of Bhutan, 2001.

⁶³ It is mentioned that the Internet has taken only 4 years to reach 50M people in the world whereas television took 13 years and radio 38 years. There are between 150M-200M users now. In 1999, users increased by 55%. The global online population is predicted to reach 300-500M by year 2005. The fastest growth rate as forecast will be in Asia and Latin America. For detail see P Brennan, 'Enforcing Software IP Rights-Moving with the Times' Federation Against Software Theft (FAST), EF Legal, London, (2001). www.fast.org

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