

Vilau & Mitel

Following the rules

While the Romanian Top-Level Domain Authority oversees the country's domains, brand owners should consider whether to utilise its dispute resolution procedures or utilise other methods

The Romanian Top-Level Domain Authority (ROTLD) (www.rotld.ro), part of the Ministry of Communications and Information Society, manages '.ro' country-code top-level domain (ccTLD) and sub-domain name registration applications (eg, '.ro', '.com.ro', '.org.ro', '.tm.ro', '.nt.ro', '.nom.ro', '.info.ro', '.rec.ro', '.arts.ro', '.firm.ro', and '.store.ro').

The Romanian domain name market is unregulated, except for the standard Internet Corporation for Assigned Names and Numbers (ICANN) rules of use and registration and the Uniform Domain Name Dispute Resolution Policy (UDRP), which applies to all Romanian ccTLD registrations.

Although domain names have become just as important as trademarks, Romanian domain name management and regulation – compared to other jurisdictions – is extremely liberal and imposes no registration requirements (eg, eligibility, link or transfer limitations) to be met in order to obtain registration. This 'hands-off' approach has proved controversial.

In terms of popularity, although recent official statistics have yet to be published, it is estimated that four out of five domain names registered in Romania are in the '.ro' domain, followed in number by '.eu' registrations. The total number of '.ro' top-level domains (TLDs) registered through Romanian registrars is estimated at approximately 700,000.

The registration of a domain name is an exclusive 'first come, first served' process, conducted through either the ROTLD or any of the 92 authorised resellers following payment of a one-off fee of between \$30 and \$60. The registration requirements are minimal. The applicant must follow some simple steps relating to identification and the provision of information in the application form.

According to the ROTLD registration rules, a domain name registration application can be refused if the domain name:

- contains more than 63 characters;
- contains non-permitted characters;
- is identical to an existing registered domain name;
- is trivial; or
- is contrary to public order.

The Romanian domain name market is familiar with two types of infringement:

- registration of a popular name or mark as a domain name with the intent of selling it to its rightful owner (cybersquatting); and
- registration of a slightly altered popular name leading to an alternative website (typosquatting).

Cybersquatting is by far the most common type of infringement. While typosquatting is also used to infringe IP rights through the unauthorised use of a trademark or copyrighted material, it is generally used merely as a preliminary step and in tandem with phishing. Thus, it is just a part of a more serious criminal offence.

To date, when domain names have been registered and used for fraudulent activities, trademark owners have successfully taken rapid action against the infringing domain names (eg, deactivation, content removal or even cancellation), most commonly by sending cease and desist letters to internet service providers (ISPs) or authorised domain name resellers to prove that:

- the trademark owner holds prior rights in the domain name;
- the registered domain name is identical or similar to its mark; and
- the domain is being used or is likely to be used for fraudulent activities (eg, phishing).

Although, according to the registration agreement, the ROTLD can take action when it

is clear that a registrant is in breach of the registration agreement, and according to its dispute resolution policy it may assist the parties to reach a mutually acceptable resolution, it has never acted as a mediator in disputes between domain name holders and third-party complainants.

Therefore, if no fraudulent activity is involved, the available remedies are limited to direct conciliation, independent mediation and eventually court proceedings or arbitration. In other words, trademark owners are alone, as the ROTLD assumes no responsibility or obligation in mediating or resolving any domain name disputes. Instead, while mediation is currently encouraged at all levels in Romania, the ROTLD requires the litigating parties to solve their dispute amicably or to address the dispute to the World Intellectual Property Organisation (WIPO) Arbitration and Mediation Centre or the Romanian courts.

Although in some cases a mutual resolution has been successful (eg, 'amd.ro', 'danone.ro', 'adobe.ro', 'samsungmobile.ro', 'metrogroup.ro', 'cet.ro' and 'pedigree.ro'), this has usually happened only after the complaint was lodged and the respondent made aware of this.

The first case of cybersquatting in a Romanian court concerned the cancellation of the 'airfrance.ro' registration (*Airfrance Romania v Amaltea SRL, Evergreen C&A SRL*, Case 6589/2000) and eventually led to the cancellation of the domain, opening up the path to other similar cases (eg, 'desprecopii.ro', 'michelin.ro', 'chrysler.ro', 'auchan.ro', 'cec.ro', 'quelle.ro', 'harley-davidson.ro' and 'asirom.ro').

However, most of the domain name disputes were submitted directly to the WIPO Arbitration and Mediation Centre and led to interesting panel decisions ordering, in most cases, the cancellation or transfer of the infringing domain names.

Out of the 108 cases settled by the WIPO Arbitration and Mediation Centre between 2001 and 2012 in connection with '.ro' domain names, close to 75% of these complaints were filed and resolved between 2007 and 2011. Romania currently ranks 26th in terms of the number of respondent country filings, according to statistics published by WIPO.

The first two complaints regarding '.ro' domain names were addressed to the WIPO Arbitration and Mediation Centre in 2001 and led to successful transfer decisions in both cases (*Koninklijke Philips Electronics NV v Catalin Mogoseanu*, for 'philips.ro' (Case DRO2001-0001) and *Sairgroup v Amalteea SRL*, for 'swissair.ro' (Case DRO 2001-0002)).

When dealing with complaints regarding '.ro' domain names, the WIPO panel usually establishes that all three conditions required by the ICANN UDRP rules and supplemental rules be met:

- The domain name must be identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- The respondent must have no rights or legitimate interests in respect of the domain name; and
- The domain name must have been registered and be used in bad faith.

In *Sairgroup v Amalteea SRL* WIPO found that all three conditions had been met. The panel held that the circumstances of the case indicated clearly that Amalteea SRL had registered 'swissair.ro' primarily for the purpose of selling it to the complainant for substantial consideration; the same respondent had also registered other well-known marks belonging to airlines, such as 'sabena.ro' and 'airfrance.ro' (see *Airfrance Romania v Amalteea SRL*), which proved that it had displayed "typical behaviour of hijacking domain names".

However, in two milestone decisions involving the '.ro' TLD, WIPO denied the complaints. In one it found that the respondent had a legitimate interest in using the domain name as an authorised reseller of SUBARU (*Fuji Jukogyo Kabushiki Kaisha v Radacini Autotrading SRL*, regarding 'subaru.ro' (Case DRO2007-0009)). In the other, it held that the domain name had not been registered in bad faith even though the respondent had no further rights or legitimate interest and started to use the domain name in bad faith (*Christyane Leister v Vitess Industrial SRL*, regarding 'leister.ro' (Case DRO2009-0005)).

A trademark owner should take effective measures in order to prevent infringement of its mark. Domain name management deals



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with the elements that must be considered in order to protect a mark. Accordingly, the trademark owner should:

- identify all keywords relating to the trade name, trademark, business or goods or services, and register these as domain names before they become known to the public;
- consider for registrations of several variations and slightly misspelled keywords;
- check WHOIS databases;
- seek specialist legal advice, preferably before taking any steps in connection with domain name registrations or transfers; and
- follow the exact procedure and use the model documents adopted by the ROTLD when dealing with voluntary domain name transfers.

Following its 41st international public meeting, ICANN decided to expand the number of generic top-level domain names (gTLDs) from the current 22, which include '.com', '.org', '.net', '.info' and '.asia'.

ICANN's decision caused concern among trademark owners and practitioners regarding how trademark protection could be secured in this new environment. Despite this, ICANN announced a formal plan to begin accepting applications for new gTLDs from January 12 2012.

ICANN will disclose both the gTLDs that have been applied for and the applicants' names on May 1 2012, after which an opposition period will follow. The entire registration process will take applicants for new gTLDs on "a journey that will most likely carry them into 2013".

As the entire process for the first wave of new gTLDs applications will not be finalised during 2012, and the registration fees will be a financial barrier for most organisations - particularly in light of current economic conditions - it is expected that ICANN's decision will not become effective in 2012 or 2013. Therefore, the traditional domain name management measures should remain in place for trademark owners over the next couple of years.

Even so, it may be surprising that the ROTLD has hitherto assumed less responsibility than similar authorities in other jurisdictions, both when it comes to the registration of domain names and in regard to potential disputes. Trademark owners should identify the most efficient legal instruments against infringing domain name registrations by using the WIPO arbitration procedures or taking action in the Romanian courts. [WTR](#)