Intellectual property rights uk

Law

Intellectual Property Dissertation Guide on Trade Marks and Domain Names Under the Dilution Perspective

The following guide could be used by a PhD or Master Level Law student looking to write a dissertation or thesis on intellectual property, particularly trade marks and domain names under the dilution perspective. The guide has been written by a our site writer and is a detailed overview of how the work should be structured.

1. 0 My understanding of the topic

The " dilution" perspective, as you rightly point out, is a concept which has been neglected and particularly so in the UK where, in comparison with the USA at least where the first dilution statute was enacted in Massachusetts in 1947, this concept has only recently found its way into the Trade Mark Act 1994[1] and then only by the confined path of implementing the trade mark directive[2]. The Trade Mark Act 1994 is now, by all accounts, dated and it is obvious that it is not sufficient to provide the kind of advanced protection which the USA offers. The tort of passing off has been traditionally used for dilution procedures and this is clearly inadequate, leading to, in the words of Colston & Middleton, " strained interpretation designed to accommodate remedies for domain name disputes"[3]. Any discussion of the dilution perspective must begin naturally with Frank Schechter's arguments from 1927 who wanted a greater scope of protection for trade marks[4]. Schechter pointed out:

"…the real injury in all such cases…is the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name

by its use upon non-competing goods. The more distinctive or unique the mark, the deeper its impress upon the public consciousness, and the greater its need for its protection against vitiation or dissociation from the particular product in connection with which it has been used”.[5]

Schechter’s views are acknowledged as a talisman for those who advocate greater expansion and protection for trade marks and are the theoretical base of the dilution perspective. Consequently his views must be the theoretical underpinning for this PHD study – you are arguing though for an extension of the protection past that which currently prevails. The hypothesis which I would propose is that the current response to domain names is woefully inadequate: there either needs to be a new trademark and domain names Act complete with duties, rights and remedies or a dispute resolution process in theUKto catch up with the rapidly changing world oftechnologyand domain names. The ECJ considered dilution for the first time very recently but disappointed those who advocated a move beyond even dilution:

“ Some have gone further to argue that such protection should be not just against a dilution of the distinctiveness of such a mark, but also against any appropriation of the mark’s value by a third party, even if it does not damage the mark itself. From this point of view, the ECJ judgement in Intel will be disappointing” [6]

Thus with a theoretical underpinning and a hypothesis established what are the problems with the current national and international setup and what causes the conflict between domain names and trade mark lawFirstly the

demand for domain names exceeds the supply and this will inevitably cause friction between those who want to muscle in on established territory. Secondly trade marks confer only national, or at most, regional, protection while a domain name has global application. Thirdly the registration system does not confer a trade mark as such immediately and the rules for registration of a domain name are a matter of contract between the applicant and the registry. It should also be noted that registries do not undertake trade mark searches which increase the likelihood of abuse and conflict[7]. The problems with the systems are also well documented and it has, for example, been argued that the UDRP is too biased in favour of trade mark owners as well as allegations of the stifling of freedom of expression[8].

The next part will deal with the proposed structure of the PHD based on the observations above and also the aims and objectives which were set out originally. The final part will be some comments upon the research and recommendations I propose.

2. 0 Proposed structure of the PHD

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Title page

Abstract

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3. 0 Additional Comments

It is of course vital to note that this structure above is only a draft one and subject to changes. As you will note having a look at the proposed structure there are a few things which I have included which deserve to be commented upon.

Firstly the research section: for a dissertation I wrote on the WTO I did something very similar where simple research is conducted, empirically, on all Dispute resolution cases involving African countries within a certain period. My idea is to conduct research on all WIPO panel cases involving UKbrands from the period 2000 – 2011 to attempt to identify any trends or patterns[9]. This would, in my opinion, make the study even more original which is only a good thing.

My other idea was to attempt to put some kind of economic value upon certain trade marks: can this be quantified in some mannerIt would be a highly sophisticated study which is able to, say, put an economic value on brands such as google. co. uk or apple. com. Related to this I thought about a case study on google. co. uk and to attempt to contemplate their business from the perspective of the IP lawyer: how much is their trade mark worthAre they victims of cyber squattingHow many cases have they been involved in at the international and national arbitration?

Finally my recommendations are based both upon systems and remedies. Perhaps as the centrepiece of this study an Act can be created from scratch

(!!) which I have tentatively called the UK Trademark and Domain Names Act 2015[10]. The full “ Act” could be recreated in an appendix and could be an attempt by the author to advocate a solution which is tangible and bold. A complete abolition of the Trade Mark Act 1994 is what I would actually propose – and in a PHD fortune favours the brave.

[1] Directive 89/104 on trade marks art. 4

[2] Colson, Catherine & Middleton, Kirsty (2005 2nd ed) Modern Intellectual Property Law Cavendish: London

[3] Colson, Catherine & Middleton, Kirsty (2005 2nd ed) Modern Intellectual Property Law Cavendish: London p. 421

[4] Schechter, Frank (1927) ‘ The Rational Basis of Trade Mark Protection’HarvardLaw Review 40 p. 813

[5] Quoted in Bently, Lionel & Sherman, Brad (2009 3rd) Intellectual Property Law Oxford Uni Press: worldwide p. 715

[6] Davis, Jennifer (2009) ‘ The European Court of Justice Considers Trade Mark Dilution’ Cambridge Law Journal 68(2) pp290-292

[7] Colson, Catherine & Middleton, Kirsty (2005 2nd ed) Modern Intellectual Property Law Cavendish: London p. 421

[8] Schiavetta, S and Komaitis, K (2003) ‘ ICANN’s Role in Controlling Information on the Internet International Review of Law Computers & Technology 17(3)

[9] http://arbiter. wipo. int/domains/search/overview/index. html

[10] So called to allow it’s undoubtedly tortuous passage through White Papers, Green Papers and then both Houses of Parliament!