

Domains & Domain Names

Contributing editor
Flip Petillion



2018

GETTING THE
DEAL THROUGH

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Preface

Domains & Domain Names 2018

Fifth edition

Getting the Deal Through is delighted to publish the fifth edition of *Domains & Domain Names*, which is available in print, as an e-book and online at www.gettingthedealthrough.com.

Getting the Deal Through provides international expert analysis in key areas of law, practice and regulation for corporate counsel, cross-border legal practitioners, and company directors and officers.

Throughout this edition, and following the unique **Getting the Deal Through** format, the same key questions are answered by leading practitioners in each of the jurisdictions featured. Our coverage this year includes new chapters on Armenia and Australia.

Getting the Deal Through titles are published annually in print. Please ensure you are referring to the latest edition or to the online version at www.gettingthedealthrough.com.

Every effort has been made to cover all matters of concern to readers. However, specific legal advice should always be sought from experienced local advisers.

Getting the Deal Through gratefully acknowledges the efforts of all the contributors to this volume, who were chosen for their recognised expertise. We also extend special thanks to the contributing editor, Flip Petillion of Petillion, for his continued assistance with this volume.

GETTING THE 
DEAL THROUGH 

London
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Argentina

Pablo T Armando

Noetinger & Armando

Registration and use of domain names at ccTLD registry

1 Which entity is responsible for registration of domain names in the country code top-level domain (ccTLD)?

In Argentina the entity responsible for the registration of ccTLDs is NIC Argentina (National Directorate of Domain Names Registration), an entity that falls under the executive power of the federal government, except for the edu.ar domain, which is handled by the Network of University Interconnection Association.

In addition, NIC Argentina is responsible for the only generic top-level domain available in Argentina, which is .ar. The gTLD is reserved for official organisations.

2 How are domain names registered?

During the past few years NIC Argentina has been introducing changes to the way that domain names are registered, handled and renewed. On 19 July 2016 a new Regulation for the Administration of Domain Names in Argentina (Resolution 110/2016) was published in the Official Gazette. By virtue of this new regulation, the older ones (issued in 2014 and 2015) have been replaced or modified.

Article 13, Chapter 1 (Registration) of the above-mentioned regulation establishes that the registration of a domain name will be granted to the person or entity that applies for its registration first, once a validation procedure has been completed.

The validation procedure consists of providing NIC Argentina with some information (name, address, country, email address, date of birth, tax ID) and creating a user account. Real persons are required to submit a copy of their ID or passport so as to allow the registry to confirm whether the information provided in the form is accurate. In the case of entities, their representative must submit documents showing that he or she has sufficient powers to represent said company.

Once completed, the applicant will have an account created at NIC Argentina through which domain names can be registered, renewed, delegated and transferred.

As in many other domain name registries, before registering a domain name the registry confirms whether it is available. If so, the procedure is very simple: confirmation of the owner's information; choosing the payment method (credit card is provided as one of the means of payment); and receiving confirmation of registration.

Although the domain name is registered a few hours after the payment has been approved, it should be noted that registrations and assignments of domain names are published in the Official Gazette (article 15, Chapter 1, Resolution 110/2016). This publication takes place a few days after the registration has been confirmed.

Besides this general procedure, NIC Argentina has established some additional requirements for special ccTLDs such as tur.ar, musica.ar, gob.ar and org.ar. To be able to register these domain names the applicant must provide evidence that it is registered as an authorised tourist agency (for tur.ar), registered at the Registry of the Musical Activity of the National Institute of Music or Registry of National Musicians (for musica.ar), government entities (for gob.ar) or as a non-profit organisation (for org.ar).

3 For how long is registration effective?

NIC Argentina has established the effectiveness of registration of all types of ccTLD for one year. Domain names may be renewed repeatedly for the same period of time.

4 What is the cost of registration?

The cost of registration, renewal and assignment is 270 pesos.

5 Are registered domain names transferable? If so, how? Can the use of a domain name be licensed?

Domain names are transferable. The procedure requires entering the owner's user account, choosing the domain name to be assigned and entering the ID number of the assignee. The assignee must have already completed the validation procedure. Once finished, the assignee will receive a request to confirm the assignment and to pay the official fees.

NIC Argentina's regulation does not contain any provisions related to the licensing of domain names. However, as with any other IP asset, their licensing is permitted (Civil and Commercial Code, international treaties).

6 What are the differences, if any, with registration in the ccTLD as compared with a generic top-level domain (gTLD)?

As described above, the registration procedure established in Argentina is similar for the registration of gTLDs. The only significant difference, compared for example with .com, is that registration is centralised with a single federal government entity.

Additionally, it should be noted that NIC Argentina is responsible for the only gTLD available in Argentina (.ar), which is reserved for official organisations.

7 Can the registrant use a privacy service to hide its contact information?

There is no such privacy service to hide contact information. Part of the contact information is mandatory such as the name, tax ID and personal ID numbers. Other information, such as telephone or email address, may be hidden at the request of the registrant.

Pre-litigation actions

8 Under what circumstances will a registrant's privacy-protected contact information be disclosed? What processes are available to lift a registrant's privacy shield?

There is no provision regarding the circumstances in which NIC Argentina will disclose hidden contact information. In general, at the request of a competent authority (ie, a court order), NIC Argentina would have to reveal such information.

9 Are third parties (such as trademark holders) notified of a domain name registration or attempt to register a domain name? If so, how? If not, how can third parties receive notice?

Every registration or assignment of domain names is published in the Official Gazette for two days. This publication allows third parties to be aware of new registrations.

As usually happens with trademark applications in Argentina and many other countries, companies and law firms can monitor the domain names that appear on a weekly basis and compare them with trademark registrations that might be infringed.

10 Is there a need to notify the domain name registrant before launching a complaint or initiating court proceedings?

It is not mandatory to notify the registrant before initiating a complaint before NIC Argentina or filing a court action before the federal courts. Once the complaint is initiated, either NIC Argentina or the court will order service of the complaint to the registrant.

Transfer or cancellation

11 What is the typical format for a cancellation or transfer action in court litigation (domains registered in either a ccTLD or a gTLD) and through ADR (ccTLD only)?

In Argentina there are two ways of pursuing the cancellation or transfer of a domain name. One is provided by NIC Argentina, which is based on the ICANN rules, and the other consists of a lawsuit before the federal courts.

With respect to the cancellation procedure ruled by NIC Argentina, it is not strictly ADR; rather, it is an administrative procedure where both parties will be heard and NIC Argentina will issue a decision. The administrative decision may be appealed before the courts.

If the complainant chooses to file a lawsuit before the federal courts, some jurisdictions require a mandatory mediation procedure that should be completed before being able to initiate the lawsuit.

The judicial procedure consists of three stages: lawsuit and response; initial hearing and evidence stage; and final arguments and decision. The decision may be appealed to the Chamber of Appeals.

In both cases (administrative and judicial procedure), the complaint is generally based on the ownership of trademark rights over the domain name.

Additionally, the federal procedural law and many local laws contain provisions that allow parties to submit the conflict to arbitration or voluntary mediation. However, the parties rarely choose ADR.

12 What are the pros and cons of litigation and ADR in domain name disputes? What are the pros and cons of choosing a local forum to litigate a gTLD dispute compared with the ICANN ADR format for the gTLD?

The procedure before NIC Argentina provides a fairly quick decision from the authority, and it is more cost-effective. However, it is advisable only for those cases where the domain name and trademark in conflict are practically identical, and where the trademark owner has a valid trademark registration in Argentina.

In those cases where the factual situation is more complex, the possibility of discussing various issues and obtaining a wide range of evidence, or the need to obtain a preliminary injunction, could make it advisable to resort to a court of law.

13 What avenues of appeal are available?

As stated, both in the case of the administrative procedure before NIC Argentina and in the case of litigation before a court, appeals are available to the Chamber of Appeals.

It should be noted that on an appeal against an administrative decision (issued by NIC Argentina or any other administrative organisation) the parties at court are the complainant and NIC Argentina. The registrant is not the defendant, although it may be cited by any of the parties as a third party connected with the case.

14 Who is entitled to seek a remedy and under what conditions?

Rights holders, such as a trademark owners, are definitely entitled to pursue a cancellation or transfer of a domain name. Licensees may also be entitled to seek remedies if their licence agreement allows them to defend the licensed rights in Argentinian territory.

The first and most important condition to be 'entitled' is to have a legitimate interest in the domain name. In fact, article 24, Chapter III (Disputes) of Resolution 110/2016 states that 'any user who considers that it owns a better right or has a legitimate interest with respect to the ownership of the domain name' may file a complaint.

15 Who may act as defendant in an action to cancel or transfer a gTLD in local courts?

The defendants in an action to cancel or to recover a domain name are always the registrants. Since NIC Argentina does not allow any privacy shield, the name and tax ID of the owners are always published in WHOIS, so there is no need to specify any respondent other than the real registrant.

16 What is the burden of proof to establish infringement and obtain a remedy?

In Argentina there is a general rule that determines that whoever files the complaint has the burden of proving the factual and legal issues in the case. If there is an infringement, the complainant must prove that it has legitimate rights and legitimate interests and that certain actions or behaviour by the defendants are infringing its rights.

17 What remedies are available to a successful party in an infringement action?

In the case of the procedure before NIC Argentina, the only remedy available is the transfer of the domain name.

In the case of a court action, a petition to recover litigation costs is usually added to the transfer of the domain name. In addition, if the complainant can prove that the behaviour of the registrant has caused him or her damage, he or she may also claim monetary relief. No punitive damages are available.

18 Is injunctive relief available, preliminarily or permanently, and in what circumstances and under what conditions?

Preliminary injunctions are only available if the complainant chooses court action.

The Procedural Law, the Trademark Law Act, the Paris Convention and TRIPS govern preliminary injunctions in these conflicts. Jurisprudence and doctrine determine that there are three main requirements for obtaining an injunction: danger in delay (irreparable damage); plausibility of rights (eg, likelihood of confusion); and security bond.

The usual time frame for obtaining a preliminary injunction is about one month. The judge makes the decision without hearing the defendant.

If the judge grants a preliminary injunction then he or she will order NIC Argentina to preliminarily transfer the ownership of the domain name to the complainant and will notify, at the same time, the decision to the defendant. The decision can be appealed by any of the parties.

It should be noted that the Federal Procedural Law determines that in order to maintain the effectiveness of the preliminary injunction, the complainant must file a lawsuit in federal court within a short period of time, in order to obtain a final decision.

19 How is monetary relief calculated?

Monetary compensation is usually related to an infringement and can only be requested in a court action. The basis of this general claim is article 1716 of the National Civil and Commercial Code, which establishes that 'the violation of the duty of not damaging a third person, or the breach of an obligation, gives rise to compensation for the damage caused'.

The person who infringes an intellectual property right and causes damage to its rights holder should repair the damage caused. The damages sought should be estimated by the one who suffered the consequences of the damage and are granted by a judge.

However, in the great majority of cases related to intellectual property rights it is very difficult for the rights owner (eg, trademark owner) to prove the damage provoked by the infringer, and therefore there are some general rules that the courts usually apply:

- how the trademark goodwill has been affected;
- loss of profits; and
- the infringer's profits.

20 What criminal remedies exist, if any?

There are no specific regulations in connection with domain names and criminal remedies. Inasmuch as the use of a registered trademark belonging to a third party may be considered included within the rule of article 31(b) of the Trademark Law ('whoever uses a counterfeit

trademark or tradename, or one fraudulently imitated or belonging to a third party without their authorisation') then such conduct could be considered a crime under the Trademark Law.

However, the civil remedies described above (lawsuit or administrative proceedings) are much more straightforward and effective. In addition, criminal courts are more reluctant to condemn trademark infringers (or even cybersquatters).

21 Is there a time frame within which an action must be initiated?

There is no time frame within which an action must be initiated. NIC Argentina's regulations do not contain any provision that determines that after a certain period of time the rights holder loses the opportunity to file a lawsuit or a complaint.

22 Can a registrant's rights in a domain name expire because of non-use. Can a registrant be estopped from bringing an infringement action? In what circumstances?

Unlike trademark registrations in Argentina, domain names are not vulnerable to cancellation based on non-use. Of course, the registrant must renew it every year and pay the official fees. If this does not happen, then the registration would expire and any third party (and also the former registrant) may apply for its registration.

23 What is the typical time frame for an infringement action at first instance and on appeal?

The usual time frame for an infringement action (or domain name cancellation or transfer) before the federal courts is three years. An appeal may take another two years.

If the case is decided by NIC Argentina, it is common to obtain a decision within three months. If the complainant or defendant appeals, the final administrative decision takes approximately two more months. The administrative decision may be appealed before the courts (although is quite unusual), which may take between three and four years.

24 Is a case law overview available on procedural or substantive issues? Does the case law have a precedential value?

As in most civil law jurisdictions, jurisprudence is considered an important source when deciding a case, although it is only mandatory when it comes from a decision issued by the Chamber of Appeals en banc, and only for those first-instance judgments under the Chamber of Appeals' jurisdiction.

25 Can parties choose a panellist in an ADR procedure involving a ccTLD? Can they oppose an appointment?

As stated previously, arbitration – although it is ruled by the Federal Procedural Law – is not a popular form of ADR.

However, if the parties involved in a conflict related to domain names decide to take the case to arbitration, the rules that govern the proceedings will depend on the entity chosen to hold the arbitration. Most of the arbitration centres already created include provisions that allow the parties to choose one panellist each, and the third is chosen by the other two arbitrators.

26 What is the typical range of costs associated with an infringement action, including pre-litigation procedures, trial or ADR, and appeal? Can these costs be recovered?

Court fees in connection with an infringement action are around US\$100 to US\$200. However, if the complainant requests monetary compensation based on damage caused by the infringer, court fees will be higher, since they are calculated as a percentage of the amount claimed in the complaint.

When the judge issues his or her decision on the merits of the case, he or she may order the losing party to pay litigation costs to the other party. The litigation costs vary dramatically depending on the case, but in a typical infringement action based on a trademark right they might be estimated to be between US\$6,000 and US\$8,000.



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