

New rules on .al domain names – and their implications in TM enforcement

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As of November 1, 2018, new rules on the registration and administration of the domain names under .al are applicable in Albania. These rules are adopted by three decisions of the Steering Board of the Albanian Electronic and Postal Communication Authority (AKEP), which brought some changes and amendments to the basic regulation on registration of the (sub) domains under .al of 2008. They are published in the official website www.akep.al

The changes address ranges of issues emerged from the Albanian background and adopt new rules, mainly with restrictive effect, to prevent the abuse in the registration of .al domain names. They are expected to significantly impact trademark enforcement. Some of the key takeaways concern the following:

Limited number of domain names

The new rules set a limitation in respect of the number of the domain names a person can own. According to article 7 of the regulation, the allowed number of domain names is up to 5 for a natural person, and up to 15 for a business entity. This also includes the number of subdomains.

Exceptionally, a person is allowed to register more domains when he proves that his activity is inexorably linked to the names he wants to register, e.g., the applicant is the owner of the registered trademarks whose verbal elements he wants to register as domains.

This restriction was dictated by the need to make the .al domain market more accessible for IP holders. Statistically speaking at the end of December 2017 over 30% (approx. 6,000) of the domains were registered under the accredited registrars' names. It unfairly deprived the trademark holders of registering the domain names that correspond to their trademarks, and for a long time, it has posed a pressing issue. It seemed that AKEP finally took this issue into consideration.

It will be applicable a year later (November 1, 2019) and will also affect the holders of the existing domains. The restriction will stay in force for two years, and AKEP will re-estimate whether it should be extended for an additional time or not.

Domain should be put to use within a year

In order for the domain holders to maintain the ownership of their domains, they should put the domains to use within a year from registration. With the use the regulation implies actions as follows; creating a web page under that domain, the use of emails under that domain, creating open and closed networks, assessing in distance to the system or database, pointing on other web pages but with the content of the same domain holder, technic usage as DNS, FTP, SSH, HTTP/HTTPS, Peer to Peer, etc.

The domain will be free for registration in case its holder fails to meet this condition.

It will also be applicable to the existing domains where their holders are requested to prove such use within September 1, 2019. It should be noted that the rule is adopted by decision No. 41 of 4 June 2018, which has entered into force on September 1, 2018.

This provision along with the one that limits the number of the domain names a person can own is expected to prevent cybersquatting and infringement spaces. As the data shown, over 30% of the domains are registered under the accredited registrars' names. The practice also shows that a considerable number of known trademarks, trade names or extensions of gTLDs domains are abusively bought by speculators who intended to resell the domains to the IP holders for a higher price.

Though these restrictions might create the premise for censure – they are neither common in the IP specialized jurisdictions, the IP professionalises in Albania applause this development. They hope it will contribute to preventing infringing behaviour in the domain name system.

Registered Trademarks now part of reserved names

Article 19.2 of the regulation specifically provides “[verbal elements of] Trademarks, patents and industrial designs registered before the competent authority, which exactly coincide with a domain name under .al are reserved for their holders.”

The regulation also stipulates the obligation of the registrars to have the link of the Albanian IPO database of validated IP right published in their websites, in order to enable would-be domain holders to search for registrability of their domain.

That said, the regulation does not prevent the third party from registering a domain name identical with (the verbal element of) a registered trademark, however, it provides a prerequisite for would-be domain holders. Namely, if the search reveals an identical trademark with the domain name, the applicant should declare in writing that he will withdraw the domain name and any claim for compensation if the IP holder applies for registration of that domain. The regulation set a 30 days term for the applicant to withdraw the domain.

It is not clear enough how this all will be implemented, i.e., it will be done automatically, or the domain holder should go through a set of procedures, etc. However, it is an extraordinary tool at the hands of IP holders, as it avoids court proceedings that trademark holders so far had to follow to have the domain recovered.

It is relevant to note that by first decision No.41 of 4 June 2018, it was excluded the possibility of registering the reserved name as a domains by others, but this provision was heavily contested by the registrars and, by third decision No.67 of October 1, 2018, it came to that moderate solution that allows the applicants to proceed with registration of the reserved name upon their obligation to withdraw the domain if the IP holders applies for that.

AKEP now more involved in domain disputes

Until now all kind of disputes involving domain names has been heard at the court, regardless of the nature of the dispute. Usually, AKEP was called as a third party, either by the plaintiff or the court to attend the court proceedings.

Whereas the situation remains the same when it comes to disputes related to a confusingly similar domain (to a registered mark), the new rules empower AKEP to examine disputes relating to the breaches of the regulation on domain names (articles 11, 27 and 27/1 of the amended regulation). The wording of these provisions leave space for interpretation as to what are the dispute the fall under AKEP's competences, but surely cases involving identical domain with a prior registered mark will be heard before AKEP.

Shorten term for registration/modification/transfer/ deletion procedures

The term for the registration of the domain name under .al, performed by AKEP or Registrars is up to 3 working days following the filing date of the application. In case the application form is not complete, the applicant is requested to remedy the situation within 3 working days; otherwise, the domain will be set free for registration by third parties.

The new rules also shorten the terms with regard to domain names /modification/transfer/deletion procedures to 3 working days.

Registrars subject to further obligations

Whereas the EU General Data Protection Regulation (GDPR) does not seem to affect the changes as AKEP has always regarded the need-to-know data of the domains holders as confidential, which can be disclosed only if the trademark holders shows intention to take action to the court (legitimate interests), the new rules set a range of obligations for the registrars largely related to the information they should provide and some aspects of data protection. Some of these obligations are; they should offer the possibility of a search for the domain names under .al and subdomains, they keep published the regulation on domains, the list of prohibited and reserved names, including the database of the valid IP rights. They should be registered with the Commissioner for the Right of Information and Protection of Personal Data (KDIMDP), which mean they should process the personal data gathering through the registration in accordance with the Law No.99887 of March 10, 2008, On Data Protection (amended).

For more information, please contact:



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