

What's in a Name?

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None more so than German automaker BMW, which owns a fleet services company with the same name and critically the domain Alphabet.com.

Despite Google-Alphabet choosing to launch with the domain abc.xyz, and with BMW showing no interest in giving up its prized alphabet.com, the move did raise some critical questions on best practice for companies looking to set up a digital presence.

For the events and MICE industries, this is particularly pertinent. As highly fluid and dynamic sectors, new shows and spin off launches continue to join an already robust calendar. At Dubai World Trade Centre alone in 2014, of the more than 435 trade events staged, an impressive 49 of them were new additions. Across the board in Dubai, figures also show a substantial increase in new businesses setting up. Using the Dubai Chamber of Commerce and Industry as a barometer, the body saw 16,198 new companies take membership – an 18 per cent increase compared to 2013.

As such, making the right decisions when setting up your digital presence is becoming increasingly critical as the market matures and competition increases.

To find out about the dos and don'ts for brands looking to set up online, Read Fiona Robertson's (Senior Associate – Technology, Media & Telecommunications at Al Tamimi & Company) interview with Dubai World Trade Centre.

In your legal opinion, what are the key considerations when protecting yourself digitally, and what should be considered when registering a domain name?

We strongly recommend a contract with the web developer – this must contain not only the services, approval processes, timelines and payment schedules, but must address intellectual property (use of your logo, ownership of the site, third party content) and access to the source code with full capacity to edit.

For the domain name, you will obviously want something that resonates with your intended audience and can be protected in all important jurisdictions as a brand. If you are creating a brand across numerous countries, you should at least do a basic check on the availability of that name in those countries. A country by country trademark search can be very helpful at this stage.

In addition, we do recommend that clients consider whether the event would justify a trademark registration. Remember that an unregistered trademark is very difficult to defend in this market and generally across the Middle East. If you have big plans across the region that would be undermined if someone else registered your event name in another territory in the Middle East, you need to look at regional registration.

It is always wise to include terms on the website that will clearly explain the way you are doing business and the manner in which you wish the public to interact with your website. We also strongly recommend a privacy policy be included as part of the website. If the site is merely providing information, these terms will be quite simple. If you include any e-commerce (tickets, merchandise) or user generated content (forums, comments section) then they will become more complex. Note that terms taken from websites in other jurisdictions (USA in particular) will contain terms that have absolutely no applicability in this region – and you can often end up with terms that are less favourable to you than they need to be.

If you are engaging in e-commerce of any sort, make sure that your web terms line up with the payment gateway terms. The usual area of inconsistency is 'terms of refund' – so at the very least start there!

Whilst most web hosting companies can register a domain for you, do you advise this route as there is no guarantee they give you back the domain should you change web hosting company after handing control of your domain to them?

That is correct; there is no guarantee that they will, although to be fair to the majority of the web hosting companies, most will do so. Another issue is that, without having the domain registered in your name, it becomes slightly more difficult to include it in your inventory of assets and to sell it, should you ever wish to do so. It just means that the agreement for sale has to be slightly more complex as you are, in effect, selling something that you don't own.

What are the main pitfalls of successfully protecting yourself online and how can they be avoided?

Unquestionably the issue we see the most is that people arrange to have a web developer build the site and they pay on a simple purchase order/invoice. These documents do not contain copyright assignments and so the website and all of its content belongs to the web developer, even if you pay them. Remember that, without an assignment in writing for any copyright works, there is no assignment and so the creator continues to own the website and all of its content. A lot of people assume that the American system of 'work for hire' (that is, if you pay for a work, you own it) applies here. It does not actually apply in many countries outside of the USA.

The other reason to have a written web development agreement is to ensure the content your developer adds to the website is original or properly licensed for use. Some developers have scant regard for the copyright of other parties and will use materials that they find on-line without considering whether they are in fact copyright images.

Another often overlooked matter is the legal issues that arise from user generated content. It is easy to forget the fact that, as a website operator, you are in fact a publisher and therefore can be held liable for all content on the site, even if you did not write it. So content that is posted on, for example, a member's forum or a comments section after an article can lead to liability for you as publisher. Given that some content in this region is considered to be extremely contentious, this can cause an issue. We always highly recommend having content moderated before it is posted. And your intern may not be the best person to do this!

Finally, make sure that you get full admin access to your website and, importantly, to all social media created for your event. It is incredible the number of businesses that suddenly find themselves with no access to their Facebook page or their Twitter account because the person who had the admin details left the country and refuses to hand them over unless money is paid!

How many different domains or variations of your domain should you consider registering? Why and how to go about it?

This is really a commercial decision. Internet addresses are just that – addresses. They have value to the extent that you invest in the marketing of those addresses in conjunction with your company and/or your event. Obviously you can buy as many of these as your budget will allow (.com, .ae, .net) in order to stop pretenders but this is not always financially possible.

Is there any legal recourse here in the region/internationally to get back a domain that is registered elsewhere. Or to relevant rogue URLs being set up that could damage your brand?

Domain squatting is still an issue although we have seen a decrease in legal claims across the past 10 years as people find practical ways of dealing with the matter (such as increased marketing of the correct

address).

Domain names are managed by the international agency ICANN. In conjunction with the United Nations copyright agency (World Intellectual Property Organization, known as WIPO), it developed a 'Uniform Dispute Resolution Policy' relating to the resolution of domain name disputes – and this policy can apply to some disputes (but note that it does not apply to all of them).

WIPO has also been permitted by ICANN to establish an arbitration system that allows a person or company to lodge a claim against a domain squatter. It has been active since 1999 and handles thousands of complaints each year.

The ICANN/WIPO processes require that a trademark is registered for the name that is in dispute. So for example, when the estate of Jimi Hendrix took on a serial cyber squatter back in 2000, it had registered trademarks in the name of the deceased singer in various classes in the USA. Cyber squatters have also lost out to Mick Jagger, Jethro Tull and others ... but won over Sting because of the generic nature of his stage name. ICANN does not deal with website content so it is not the forum for disputes about rogue sites that contain content that is damaging to your brand. This becomes a civil matter and the law applicable will depend on factors too complex to address here. For example, in the UAE, you might approach this as a criminal matter if the content is considered to be highly defamatory and in contravention of the Penal Code. Or it may be covered by the Cybercrimes Law 2012 which has a broad scope. You need to address this sort of thing on a case by case basis with your legal representation.

On a social media front, do companies have any legal power to shut down rogue accounts or take ownership of others? If so how and what are the challenges/benefits?

Many companies have seen fake social media accounts spring up in their name – Delta Air Lines and Disney are both currently seeing fake pages circulating in their name and earlier this year, there was numerous fake car giveaways. It appears likely that this is being undertaken in order to sell a popular page to a third party as part of another transaction – the 'likes' you give in order to win a car will become the 'likes' on a rebranded page.

Taking down a fake page can be a difficult process and, as social media grows, we have seen the process change several times.

Similarly, taking ownership of a social media account that is not registered in your name can also take months and involves detailing the reason for the claim, which must be contained within signed statements (currently requiring a notary to witness the signature).

There is no question that you must ensure that that you create own and have full admin powers over all social media from the outset.

This article first appeared in the September 2015 Dubai World Trade Centre Newsletter and is reprinted with their kind permission.

Al Tamimi & Company's TMT team regularly advises clients in respect of web development contracting, social media content take-downs, and related matters. Our Intellectual Property team regularly advises on branding-related issues and domain name disputes. For further information, please contact Omar Obeidat, Partner, Intellectual Property (o.obeidat@tamimi.com) or Fiona Robertson, Senior Associate, TMT (f.robertson@tamimi.com).