CONFLICT BETWEEN DOMAIN NAMES AND TRADEMARKS IN INDIA : AN ANALYSIS

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ABSTRACT

Today, with the advancement of new technology, every person wants to have access to cyber world. However, we find that much before the development of electronic commerce, India and most of the other countries as well, witnessed problems with regard to registration of domain names. It was often found that some people had already registered the domain names which others legitimately require or which might be related to others' existing trademarks, with a view to sell the same to those others by charging exorbitant prices.

The paper deals with the issue of disputes between trademarks and domain names. It discusses in detail the reason behind the conflicts and kinds of the disputes and what are the remedies available in current legal system for such situation. Conflicts such as cyber squatting, typo squatting, reverse domain name hijacking are discussed in detail with the help of relevant case laws. The proposed solutions such as Internet Corporation for Assigned Names and Numbers (ICANN) and Uniform Domain-Name Dispute-Resolution Policy (UDRP) have been analysed in detail. This piece of research is a bonafide attempt to analyse the dispute scenario and to ponder upon its redressal.

KEYWORDS: Internet Corporation for Assigned Names and Numbers (ICANN), Uniform Domain-Name Dispute-Resolution Policy (UDRP), Cybersquatting, Typosquatting, Domain Name System (DNS), World Intellectual Property Organisation (WIPO), Top Level Domain (TLD), gTLD, ccTLD, Second Level Domain (SLD), .IN Dispute Resolution Policy (INDRP), National Internet Exchange of India (NIXI).

1. Introduction

Ancient Greeks and Romans used various goods as a mark of identification. With the passage of time, new and better techniques of business demanded unique recognition to their products. Trademark made it easy to fulfil the demand. On the need of e-commerce, business entities have started flourishing and expanding their activities on internet. However, no company can directly enter into the cyber space without an identity. DNS(Domain Name System) has emerged as a substitute to the various numeric traditional IP address. Trademark and Domain name sound similar are distinct but both are interconnected. Sometimes, well-known trademarks are used as domain names by hackers so as to deceive the customers. This act is known

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as “cyber squatting”. A domain name consist of two kinds of domain name i.e., Top Level Domain names(TLD) and Second Level Domain names(SLD) which can be registered with ICANN approved registrars such as WIPO. Domain names disputes can be settled through various means like ADR mechanism, agreement and Court proceedings. The Uniform Dispute Resolution Policy (UDRP) was setup by ICANN to settle domain names disputes at an international level. However, the main issue while settling a domain name and trademark dispute is the jurisdictional issue because internet has no boundaries. Issue that in which court the matter should be brought, whether the registrants in two different countries i.e., parties to dispute are bound by the decision of the court or not.[1]

With the rapid growth of the Internet in the world of commerce, domain names have taken on a new significance as business identifiers. When the Internet was in its infancy, domain names were created to serve as useful aid for locating specific computers on the Internet. Domain names are now highly visible in "real space" as well - showing up on television ads, billboards, magazine ads, and even on the public transports.

The essence of the Internet is Internet Protocol (IP) used for inter computer / inter server communication, each computer / server having its own unique numeric IP address. But in fact these addresses are not catchy and are difficult to remember. This had a major role to play in the development of the DNS and the emergence of domain names as corporate assets. Thus, a domain name is a popular substitute for the numeric IP address of a particular server. To make an Internet address more friendly for the users, there must necessarily be a unique numeric address may be matched with a mnemonic domain name (such as ‘mcdonalds.com’). This systematization of recognition of proxy names is termed as the ‘Domain Name System’.[2]

Domain names are simply the addresses on the Internet. E-mails are sent and web pages are accessed through the use of domain names. For example, the web address for the Microsoft web site is www.microsoft.com, while Bill Gates might have an e-mail address such as bill@microsoft.com (both using the "microsoft.com" domain name). Without the domain name, the computer would not have any idea where to look for a web page, and e-mail routers would not be able to send e-mail. Of course, domain names are much more than just addresses, as they can be selected by the "addressee" and are usually closely associated with a specific service or product.[3]

A trademark is used to distinguish goods or services of one trader from those of others. Trademark is a visual symbol in the form of a word, a device, or a label applied to articles of commerce with a view to indicate the purchaser as to the manufacturer or quality of goods. It is a mark to indicate to the purchaser,

1 https://blog.ipleaders.in/trademark-issues-related-to-internet-domain-names/ (Accessed on: 5 February,2019)
2 http://www.legalserviceindia.com/articles/tdms.htm (Accessed on: 6 February, 2019)
3 Ibid

the trade source from which the goods come or trade hand through which they pass on their way to the market.

"A mark capable of being presented graphically and which is capable of distinguishing the goods or services of one person from those of another's and may include various shapes of goods, their packaging and their combination of colours…"[4]

2. Arise of Dispute

Due to the well-established link between the domain names and trademarks, every entrepreneur is keen to get his trademark registered as domain name. For this purpose, huge amount of money and time is invested by them in the modern era of electronic commerce. The involvement of large sum of money has paved the way for taking undue advantage by third parties, and resultantly, conflicts over the registration of domain names. The tremendous increase in the domain name disputes currently poses serious challenge to the ICANN and national legal systems.

The most common form of domain name dispute is the conflict between the rights of domain name holder and the trademark holder. Conflict between the two arises because of several reasons-

1. Change in the role of the domain names can be a fundamental reason. As the original role of domain name is to provide an address for different sites on the Internet, today in the modern era electronic commerce, it has evolved from being a mere means of communication to a mode wherein commercial activities take place. Thus domain names have become part of corporate and individual identities over the Internet. This somewhat independent status of domain name often comes in conflict with trademarks.
2. The trademarks and domain names operate in two different fields and two different levels. While the trademarks operate in the real world, domain names are confined to virtual world. Furthermore, trademarks are confined to national level / multinational level and domain names are international in nature. Due to this reason, there can be more than one holder of same trademark but there can't be more than one holder of same domain name. This difference in the fields and levels of operation has resulted in lot of conflicts, since at some point of time they overlap with each other in determining the interests of stakeholders.
3. The principle of first-come first-served used in domain name registration has served as the hub of conflict. The first-come first-served makes it mandatory for the trademark holder to go for the registration of his trademark as domain name at the earliest point of time, so as to prevent others from registering it. In this competition for registration, there is a possibility of a genuine right holder to lose the domain name to a third party, and thereby resulting in the conflict. The first-come first served is not

[4] Section 2(zb) of THE TRADEMARK ACT, 1999

only fatal to the trademark owners but also bad to the online consumers of product or services, since they might end up in landing to a website that they never intended.

These are three major situations in which domain names come in conflict with trademarks. There are existence of same trademarks, cybersquatting, registration of domain name similar to well-known trademark or domain name (typosquatting) and reverse domain name hijacking.

3. Trademark and Domain Name at International Level

Trademarks are generally recognised and protected in only those national and international jurisdictions, where these are adequately registered; these may not acquire trademark protection worldwide. whereas the domain names as trademarks or service marks are registered and thereby protected at the entire global level mainly by only one organization which is ICANN [Internet Corporation for Assigned Names and Numbers], along with the national and international protection given under the directly concerned national Trademark Law and diverse International Trademark Treaties of the world. Any national or international trademark law is not completely capable of protecting a domain name in any county of the world. Thus due to this the disputes arises.

In order to beat the problems of settling disputes, ICANN has introduced the Uniform Dispute Resolution Policy (UDRP) as a mechanism to settle domain name disputes. This policy empowers a trademark owner to challenge the legitimacy of a domain name. The case of worldwrestlingfederation.com was the first case for UDRP which was filed in December 1999. This dispute came before Mediation and Arbitration Centre of World Intellectual Property Organization (WIPO) which was also the first dispute resolution provider approved by ICANN[5]. After WIPO, ICANN widened the application of UDRP to other organizations like Asian Domain Name Dispute Resolution Centre, National Arbitration Forum, Arab Centre for Domain Name Dispute Resolution (ACDR) etc. Organizations approved by ICANN for settlement of domain name disputes having powers which are as follows-

a. Cancellation of domain names created by cyber squatters.
b. Changing the registration of domain names
c. Transferring the domain name to the complainant.

A. Uniform Domain Name Dispute Resolution Policy – ICANN has adopted the Uniform Domain Name Dispute Resolution Policy (UDRP), the policy for resolution of domain name disputes. This policy ascertains for arbitration of the dispute instead of litigation in respect of domain name disputes. According to this policy, any person (complainant) can bring an action on the grounds that:

[5] https://blog.ipleaders.in/trademark-issues-related-to-internet-domain-names/ (Accessed on: 8 February, 2019)

- A domain name is similar or confusingly similar to a trademark or service mark in respect of which the complainant has rights.
- The domain name owner has no specific rights or legitimate interests in the domain name.
- The domain name has been registered and is brought used into bad faith.

But the complainant is required to prove all these elements if he wants his action to succeed. If the abusive registration is proved, the domain name registration is cancelled or shifted to the complainant but there are no financial remedies provided to him.

B. WIPO Arbitration and Mediation Centre Decisions on Domain Names – World Intellectual Property Organization is the principal domain name dispute resolution service provider under the UDRP and is accredited with ICANN. WIPO provided qualified panellist and expeditious administrative procedures, and overall impartiality and credibility. A domain name case filed with WIPO is generally concluded within two months, using on-line procedures, and a very nominal fee is charged. Only extra-ordinary cases are heard in person.

- **INDIAN SCENERIO**- In India, National Centre for Software Technology (NCST) is the body that governs country level domain name registration. On September 26, 2000 NCST added two more domain names which are named as "ind.in" (for individuals) and "gen.in" (for organizations) to facilitate registration of individuals and organizations under the .in category. The two new classifications of domain name do not require the applicant's presence in the country as an essential requirement for registration. Earlier, the applicant had to mandatorily have their offices in India to register domain name under "co.in" & "org.in" category. On October 26, 2004, the Government of India stated National Internet Exchange of India (NIXI) as the registrar of .in domain. NIXI was rendered with the function of collaborating with companies who are adept registrars and fulfils the international criteria of domain name registration.[6]

4. Methods to Resolve the Domain Name Disputes

Cybersquatters and typosquatters in the whole world are getting domain names registered in bulk, a easy way to ensure a quick profit. Rights holders are, therefore, increasingly approaching to dispute resolution mechanisms to recover domain names.

Domain name disputes relating to a generic Top-Level Domain (gTLD) name are governed by the Uniform Domain-Name Dispute-Resolution Policy (UDRP). These disputes are entertained by a dispute resolution

[6] http://www.thehindubusinessline.com/2004/10/27/stories/2004102701720700.htm (Accessed on: 8 February, 2019)

service provider approved by the Internet Corporation for Assigned Names and Numbers (ICANN), such as the World Intellectual Property Organization (WIPO) and National Arbitration Forum (NAF).[7]

On the other hand domain name disputes relating to the country code TLD (ccTLD) name for India (.in) is governed by the .IN Dispute Resolution Policy (INDRP) and is overseen by the National Internet Exchange of India (NIXI).[8]

Domain name disputes became out of control just because of the jurisdictional issues within the cyber space. In the year 2016 cyber squatting cases hit the record. US is the first country to introduce a legislation which is specifically for trademark infringement in cyberspace known as Anti-cybersquatting Infringement Act, 1999. In general, domain name disputes can be resolved by the following methods-

i. By ADR mechanism such as Arbitration and Mediation.
ii. By Court Proceedings
iii. By agreement between the parties (Example- The parties may arrive at a mutual conclusion for some consideration).
iv. By adopting the procedure for settlement of disputes as entered in the domain name registration agreement entered between registrar and registrant.[9]

5. Judicial Approach

In India, there is no legislation which can be used for dispute resolution in relation to Cybersquatting or other domain name disputes. There is no provision in the present Information Technology Act to punish cyber-squatters that's why in India the issues of cybersquatting are mainly governed by principles of passing off. However, it has also adopted policy, called .INDRP, in the line with the UDRP. So following are the cases decided by the court to resolve the dispute between trademarks and domain names:

Yahoo!, Inc. v. Akash Arora & Anr, this was the first case relating to the domain law protection in India. The trademark YAHOO! was owned by the plaintiff. He filed suit against the defendants, with the remedy of permanent injunction, in order to restrain the defendants, from carrying any business relating to services or goods, under the domain name "yahooindia.com", on the ground that the name incorporated was deceptively similar to the plaintiff's trademark. The domain name "yahoo.com" was registered on the application of plaintiff with the Network Solutions Inc. and was registered in 69 countries. So it was held by the Delhi High Court that the marks were confusingly similar with the well-known trademark of the Plaintiff.

[7] https://www.trademarksandbrandsonline.com/article/domain-name-dispute-resolution-an-indian-perspective (Accessed on: 8 February, 2019)
[8] Ibid
[9] https://blog.ipleaders.in/trademark-issues-related-to-internet-domain-names/ (Accessed on: 9 February, 2019)

Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd . In this case the Respondent had registered domain names www.siffynet.com and www.siffynet.net which were similar to the Plaintiff's domain name www.sifynet.com. Satyam (Plaintiff) had goodwill in the market and had registered the name Sifynet and various other names with ICANN and WIPO. The word Sify was first taken by the plaintiff using elements from its corporate name Satyam Infoway and had a very wide reputation and goodwill in the market. Thus Supreme Court observed that "domain names are business identifiers, serving to identify and distinguish the business itself or the goods and services and to mention its corresponding online location." The supreme court observed that domain name has the same characteristics as of a trademark and an action of Passing off can be taken where domain names are involved. The decision of the case was given in favour of the plaintiff.

In the case of *Starbucks corporation v. Mohanraj* (Decided on 26th Nov, 2009) the respondent's domain name www.starbucks.co.in was confusingly similar to the complainant's domain name www.starbucks.in., it was contended that the domain name of the respondent is confusingly similar to the complainant's domain name. It was also contended that the respondent has no legitimate interest in the domain name. Further it was again contended that the mark used by the respondent was used in bad faith. The arbitrator held that the disputed domain name was confusing, similar and identical to the complainant and that they had right in the trademark. The respondent had registered his domain name in bad faith and therefore the domain name should be transferred to the complainant.[10]

Bennett Coleman & Co. Ltd v. Long Distance Telephone Company D-2000-0015 was the first on its kind case where an Indian Company got relief under ICANN's URDP mechanism. The complainant company was dealing with the business of publication of Articles in Daily newspapers like "The Economic Times" and "The Times of India". The complainant also deals with online publication of their respective newspapers under the domain name "economicstimes.com" and "timesofindia.com". The respondent's registered domain name was "theeconomictimes.com" and "thetimesofindia.com". The complainant contended that the second level domain name(SLD) of the respondent company was same as theirs and that it was meant to attract customers using complainant's goodwill.

The matter came before the panel of Mediation and Arbitration Centre of WIPO and the panel decided that the two domain names of respondent should stand transferred to the complainant. It must be noted that this case was decided in a span of just 45 days by the help of E-magistrate mechanism and the whole procedure took place online.

In the case of *Morgan Stanley v. Bharat Jain* (Decided on 28th October 2010) the conflicting domain name www.morganstanleybank.co.in was registered by the respondent on June 20, 2010. The complainant

[10] https://www.ssrana.in/Intellectual%20Property/Domain%20Names/DomainName_CaseLaw.aspx (Accessed on: 10 February, 2019)

contended that the addition of ccTDL ".co.in." was insufficient to make the disputed domain name dissimilar to the complainant's mark MORGAN STANLEY. Hence the disputed domain name was confusingly similar to the above notified mark.

Further it was contended that as the respondent was not commonly known by the mark MORGANSTANLEY he had no right or legitimate interest in respect of the disputed domain name. Regarding the element of bad faith, it was contended that the respondent had registered the above stated domain name with the intention of earning profit and mislead the customers of the complainant's domain name.

The learned arbitrator held that the complainant's mark and domain name MORGAN STANLEY was a coined word and highly distinctive in nature and as such the consumers looking for MORGAN STANLEY may instead reach the respondent's website and hence the disputed domain name was confusingly similar to the complainant's trademark. Regarding legitimate interest, the learned Arbitrator upheld the complainant's contention that the respondent was in no way known with the said trademark and further held that as the complainant had not licensed or permitted the respondent to use the trademark the respondent did not have any legitimate interest in the disputed domain name. The respondent through one of its customers had tried to sell the disputed domain name to the complainant then a cease & desist letter was sent to the respondent which reflected that the domain name was registered and used in bad faith and with the intent to offer the disputed domain for sale to the complainant or to a competitor for a valuable consideration.

The concept of cybersquatting can be better understood by a famous case – *Intermatic Incorporated v. Dennis Toeppen* in which the company Intermatic was the exclusive owner of the trademark "Intermatic" after registering it with US Patent and Trademark Office. The company had taken an action against "Dennis Toeppen" alleging that the use of domain name "intermatic.com" by the respondent company violates section 32(1) of Federal Trademark Infringement Act, Section 43 of Federal Trademark dilution Act, 1995 etc. On the other respondent company's contention was that they were the first ones to register with the said domain name and hence, they had priority rights over the same following the "first come first serve" principle in domain name registration.

Though the court decided in the complainant's favour mentioning that Intermatic was a famous company operating at a global level. The trademark was used by the company for almost a period of 50 years which definitely meant that the use of the same by the respondent would lead to dilution of their trademark. Also, the respondent company does not have sufficient evidence to prove their contention. Hence, the case was decided in favour of complainant.

In the case of *GOOGLE Inc. v. Gulshan Khatri* (Decided on 6th May, 2011). The complainant filed the instant complaint alleging the registration of the domain name <googlee.in> in favour of the respondent, the

grievance of the complainant was regarding the latter's act of adopting similar and identical domain name and that also in respect of similar services of the respondent.

The learned arbitrator held that the impugned domain name <googlee.in> was identical and confusingly to the other prior registered domain name and registered trademark of the complainant and directed the registry to cancel the said domain name forthwith and transfer the said domain name in favour of the complainant.[11]

There are lot of cases related to cybersquatting in the past few years in India. The courts generally deals with the matters related to domain name dispute and cybersquatting. The Bombay High Court has given one of the earliest judgments on cybersquatting in case of *Rediff Communication v. Cyberbooth*[12]. In this case the court was of the opinion that the value and significance of a domain name is like a corporate asset of a company. The defendant had registered the domain name radiff.com which was similar to rediff.com. And the Court was of the opinion that internet domain names are of utmost importance and can be a valuable corporate asset and such domain name is more than an Internet address and is entitled to protection same as of a trade mark. The court gave the decision in favour of the plaintiff.

6. Conclusion

With the expanding activities within the cyber world, various thought provoking issues are being raised now and then. The jurisdictional issue is one of the most commonly discussed issues. Trademarks and Domain names have become a wide part of the ever increasing e-commerce business activities. Domain names indentify a company's presence on internet and presently considered as valuable corporate assets. Domain names are usually given on "first come first served basis" and registrars like NSI who are merged with National Science Foundation have got veto power towards assignment of domain name. However, these agencies can exercise the same powers only if the domain name given for registration is exactly similar to the other one and that the registration of this one would infringe the rights of other.

In India, due to the absence of relevant cyber laws, cases are settled within the ambit of trademark laws by interpreting the principle of Passing off with regard to domain names in the court and by the .IN dispute resolution policy of India. On account of the issues Indian jurisdiction is facing and the various jurisdictions looked into, there is an urgent need to frame a new legislation in India which would expressly deal with cybersquatting and domain name disputes.

[11] https://www.ssrana.in/Intellectual%20Property/Domain%20Names/DomainName_CaseLaw.aspx (Accessed on: 12 February, 2019)
[12] AIR 2000 Bom 27