

Trademark and Domain Name Disputes in India: A Critical Analysis of UDRP & Legal Strategies

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Abstract:

Domain Names are embodied to play a dual role in today's internet based or driven market place – to map IP addresses & to act as an identifier of a company's trademark. Unlike the trademarks, the protection of domain names under the legal mechanisms (laws) of a country is inappropriate or ineffective. There is a lack of uniformity to ensure the protection of domain names among the legal framework of various nations. With an aim to protect the domain names or ensure the resolution of domain name disputes, Uniform Domain Name Dispute Resolution Policy (UDRP) was founded under an US based organization is Internet Corporation for Assigned Names and Numbers (ICANN). In this research paper various categories of domain name disputes are critically analysed and identified as well. UDRP'S application, procedure to register a domain name & dispute resolution service process are also analysed, examined and intensively discussed in this research paper. Notable cases and their outcomes pertaining to the major domain name disputes resolved under the World Intellectual Property Organization (WIPO) are also critically analysed. It has been explored that the UDRP is applicable to the generic top level domain names (gTLD's), in other words UDRP's applicability extends to the (gTLD's) but, it's relevancy for country code top level domains (ccTLD's) is much lesser as compared to former. The losing party still has an option to file an appeal to the court of a competent authority or jurisdiction in matters related to the (gTLD's) and new (gTLD's). However, this option is not opted for or exercised frequently (seldom exercised). With a view to protect the domain names in an appropriate manner, there is a need to make the domain name laws of various nations uniform. ICANN needs to formulate a model domain names disputes resolution legal mechanisms for the adoption by various nations. UDRP must be strengthened too. As research proceeds, it is made apparent that existing legal instruments are ineffective in handling these disputes appropriately. Here, we will also elaborate into the various kinds of domain name disputes like "Cybersquatting", "Typo Squatting", "Profit Grabbing" & "Domain Names Warehousing" etc. This research paper also explores .IN Domain Name Dispute Resolution Policy (INDRP) in India.

Key Words-Trademark, Domain Names, UDRP, ICANN, INDRP, Dispute Resolution, gTLD'S, ccTLD'S, Cybersquatting, Typo Squatting, Profit Grabbing, Domain Names Warehousing & WIPO.

INTRODUCTION

Current legal landscape witnesses a dispute between 'Trademarks' and 'Domain Names', which is an issue of major concern & intensive discussion across the globe. This research paper is a critical analysis of the conflicts and contributions of the legal mechanisms or instruments (domestic & international) to address and resolve these disputes. Trademark is a sign or a set of signs possesses an ability to distinguish one undertaking's products or services from another one. In today's youth/new age of internet, as E-commerce flourishing, owners would opt their domain names to be distinctive in all of its essential features as that of their trademark. This research paper critically examines the carfax/intersection of trademarks and domain names, paying an attention to the Uniform Domain Name Disputes Resolution Policy (UDRP) as an instrument for addressing and resolving disputes, analyzing number of legal strategies are enshrined to resolve domain name disputes like 'Cybersquatting', 'Typo Squatting', 'Meta Tagging', 'Profit Grabbing', 'Cyber Twin', 'Reverse

Cybersquatting', 'Linking', Framing', and 'Domain Name Warehousing' etc. & bring into the light the complexities & challenges posed by Intellectual Property (IP) protection.

Internet Corporation for Assigned Names and Numbers (ICANN) laid the foundation of Uniform Domain Name Disputes Resolution Policy (UDRP) and UDRP is a crucial body for addressing the conflicts concerning about the domain names registration. The UDRP provides for an economical and simplified replacement for the litigations in matters/cases pertaining to the Cybersquatting, Typo Squatting & so on, and such issues arise when the registrations of domain names infringe upon already existing trademarks. This research paper provides a broad analysis of UDRP, exploring its aims process & procedures and for examining how a complaint is to be made under these procedures & processes. A registrant (trademark owner) of a trademark is embodied with a right to file an UDRP complaint against a registrant of domain name whose registered domain name is confusingly identical or similar to their trademark. A complainant (trademark owner) must satisfy the three criteria to make his/her complaint be successful, following are the key grounds on which an UDRP complaint can be filed: firstly, a complainant must constitute that his registered trademark has been infringed due to a registered domain name being confusingly similar; secondly, the person who has registered a domain name or owing the same is with no rights or genuine interest in it; thirdly, the person who has registered a domain name or using the same in bad faith. Recognized dispute resolution service providers monitor the procedure & ensuring the efficiency and fairness in addressing these disputes. With a view to show that how well UDRP ensures the protection of Digital Sphere's Intellectual Property Rights. This research paper also reviews notable judicial pronouncements, cases and their outcomes under the law.

TRADEMARK

Trademark refers to a graphical representation that is able to distinguish the products or services of one party or enterprises from those of others, which includes word, logo, picture, design, symbol & a combination thereof. In other words, in case of the registration of the tradename of a company so, such tradename cannot be used by others is also refers to trademark. A trademark may also include a logo, or a picture or a slogan or a sound or a shape or letters or combination of letters. Trademark also refers to an exclusive right that is granted to the registered owners, which makes one undertaking's goods or services able to distinguish from those of another one. Trademarks Act, 1999 regulates the trademark related activities in India. "A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging".¹ A trademark is "a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours".² "A mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours, or any such combinations".³

At international level there are number of conventions dealing with and safeguarding trademark rights and these conventions are: (i) *Paris Convention on Industrial Property (1883)*; (ii) *Madrid Protocol (1891)*; (iii) *Trademark Law Treaty, 1994*; (iv) *Trade Related aspects of Intellectual Property Rights (TRIPS), 1995*. There are four international treaties in trademark law as mention above, out of which first three treaties are administered by *World Intellectual Property Organization (WIPO)* and fourth is Trade Related aspects of Intellectual Property Rights (TRIPS), which is in itself a most comprehensive and landmark treaty safeguarding Intellectual Property (IP) Protection. *Paris Convention, 1883* was one among the very first treaties with an objective to recognize key principles of international trade such as Right of Priority Treatment, National Treatment, Most Favored Nations & Concept of Minimum Standards etc. Madrid Protocol, 1891 was also a landmark treaty facilitating the International Trademark Registration through a single application & payment and make the international filings cheap and easy (India acceded the Madrid Protocol on July 8, 2013). Trademark Law Treaty, 1994 played a pivotal role in harmonizing the administrative measures related to trademarks. TRIPS, 1995 deals with the Trademark Law under its article 15 to 21 (section II of part II) such

¹ The Trade Marks Act, 1994, s. 1(1).

² The Trade Marks Act, 1999 (Act 47 of 1999), s. 2(zb).

³ The Trade Marks Act, 1999 (Act 47 of 1999), s. 2(m).

as Trademark (Article 15), Rights Conferred (Article 16), Term of Protection (Article 17), Licensing (Article 18), Assignment (Article 19), Use of Trademark (Article 20) & Excluded use (Article 21). “Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combination of colours as well as any combination of signs, shall be eligible for registration as trademarks”.⁴

Functions of Trademark

Basically, a trademark performs the functions are as follows-

1. Trademark ensures the identification of one trader's or undertaking's products and making them to be distinctive from products sold by others.
2. Trademark functions to ensure that all products bearing a particular mark come from a single source.
3. Trademark ensures that all products bearing a particular mark are embodied with an equal standard of quality.
4. Trademark performs as a prime instrument in selling and advertising the products or services.

In *Arsenal Football Club v. Mathew Reed*,⁵ the European Court of Justice observed “*the essential function of a trademark is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin*”.

In *Hoffman La Roche & Co. AG v. Centrafarm*,⁶ court stated: “*The Essential function of the Trademark, which is to guarantee the identity of the origin of the Trademarked Product to the consumer or ultimate user, by enabling him without any possibility of confusion to distinguish that product from products which have another origin*”.

DOMAIN NAME

*Hon'ble Bombay High Court in People interactive (India) Pvt. Ltd. v. Vivek Pahwa and ors.*⁷ provided a proper definition of term Domain Name. Basically, Domain Names can be called as an organization's internet address. As all of us are aware of the Internet is widely associated with a long chain/network of computers and each device linked with this chain/network is embodied with an unique electronic address and same is known by the name of “Internet Protocol” (IP) addresses. A domain name is also known as an asset, which is crucial to an organization. As all of us know well there are computers in millions, which are connected with the Internet but when we need to identify a one particular computer out of millions, then we primarily use domain names to identify one particular computer out of millions. Domain Names plays a key role in enabling the users in ensuring their access to web pages or in making them enable to transfer the files or to send an e-mail. We are familiar with a phrase that two persons cannot be with a same mobile number and in the same way two organizations cannot carry on their activities/operations with similar or identical domain names. The registration of domain names is usually based upon the first-come-first-serve mechanism and it endows an organization with an unique presence on internet from others. A domain name is regarded as the most suitable and easiest path in ensuring access any material that is available on cyber space/exists on cyber space and domain names can have a global application and always associated with a same page of internet. *A domain name plays a pivotal role in making computers available with an internet address, but throughout the period of times, internet from being a medium of communication shifted to being a medium of multiple commercial activities. This indicates that a domain name has become an identity of business or in others words, it classifies*

⁴ Trade Related Aspects of Intellectual Property Rights, 1995, art. 15.

⁵ (2003) RPC 39.

⁶ 493 US 165 (1989).

⁷ 2016 (68) PTC 225 (Bom).

a domain name to be a business identifier, which means a domain name also falls under the category of service under the **Section 2(z) of the Trade Marks Act, 1999**.⁸

Examples of Domain Names

Some of the popular domain names examples are as follows-

1. **.edu**: This is a subject to be used by Educational Institutions.
2. **.gov**: This a subject to be used by Organizations of Government.
3. **.org**: This is a subject to be used by Non-Profit Organizations.
4. **.mil**: This is a subject to be used by the Agencies of Military.
5. **.com**: This is a subject to be used by Personal & Commercial Sites.

PARTS OF DOMAIN NAMES

Basically, there are three main parts of a domain name, when someone uses to select a domain name from among the three parts of domain names then one needs to choose a domain name with an idea in mind that one domain which he has chosen is suitable to your business/industry, can describe your business properly & will be a key factor in the enhancement of your brand. These three types of domain names are explained in brief as follows:

1. Top- Level Domains (TLDs): A **Top Level Domain** is popularly known by a name of ending of domain or an extension, this basically signifies to the last part or suffix of an internet address and TLD exists on right side of last dot (places after primary domain name). For an example if a domain is www.google.com then here **“.com”** is TLD. A TLD with non-representation of a nation or a particular territory is called as a generic TLD (gTLD). A division body of **ICANN**, which is known as **The Internet Assigned Numbers Authority (IANA)** deals with TLDs allocation. By the year 1988, seven TLDs were released by this division body of **ICANN** and same were made to play their role as main generic **Top Level Domains (gTLDs)**. These seven Top Level Domains are as follows:

- (a) **.com**: Most popular TLD and deals with business/personal sites.
- (b) **.org**: Deals with the non-profit organizations.
- (c) **.net**: This is a subject to be used by companies associated with infrastructure of internet.
- (d) **.gov**: It is a subject to be used by government organizations or we can say government agencies.
- (e) **.mil**: It is to be used by organizations of military.
- (f) **.int**: It is a subject, which deals with or to be used by international organisations or intergovernmental organizations.
- (g) **.edu**: Deals with educational institutions.

A. Country-code TLDs (ccTLDs): Basically, a **country code TLD** refers to a two-letter extension of domain that helps in representation of a particular country, a sovereign nation, an autonomous territory, a specific geographic location and an autonomous territory etc. Following are some examples of **Country Code TLD** in correspondence of their geographical locations:

- (a) **.us**: Refers to the United States
- (b) **.ca**: Refers to the Canada
- (c) **.fr**: Refers to the France
- (d) **.au**: Refers to the Australia
- (e) **.ie**: Refers to the Ireland
- (f) **.sg**: Refers to the Singapore
- (g) **.eu**: Refers to the European Union
- (h) **.uk**: Refers to the United Kingdom

⁸ Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd., (2004) 6 SCC 145.

B. New gTLDs: New gTLDs are known as the general extensions of domains. Based on the many requests were made from among the businesses/individuals, ICANN began the delegation and approval of New gTLDs in October of Year 2013. As per the ICANN, more than 1300 New gTLDs are presumed to available in next few years. Some popular examples of New gTLDs are .app, .earth, .health, .co, .cloud and .bank etc.

2. Second Level Domains: Second-Level Domains are known as the crucial/main part of any domain name and another name for this type of domain is the domain title. The Second Level Domains refers to the mixture of words through which a website/business can be described. For an example www.google.com and if we want to identify in this a Second Level Domain in this then same will be word “google” (SLD). At the time of choosing SLD’s, we can use any blend of hyphens, numbers and letters.

3. Third Level Domains or Subdomains: Third Level Domains are also called by the name of Subdomain. And Third Level Domains are the part of an URL and exists before Second Level Domain and the most common and popular example of this kind of domain name is the www., refers to the World Wide Web. There are some chances that business owners use to create subdomains that indicate categories/sections of their websites. Some examples of the Third Level Domains or Subdomains are as follows-

- (a). In **shop.website.com** (here, shop. is Third Level Domain)
- (b). In **blog.website.com** (here, blog. is Third Level Domain)
- (c). In **support.website.com** (here support. is Third Level Domain)
- (d). In **app.website.com** (here, app. is Third Level Domain)

APPLICABILITY OF TRADEMARK REGULATIONS TO THE DOMAIN NAMES

This is a very big question to address when we aim to describe the domain names its protection under trademark law. Are domain names protected under trademark law? Then we can answer this question in the form yes response because it had made clear through the various landmark judgments of Hon’ble Apex Court of India and Hon’ble High Court of Delhi. Prior to these Judgements domain names in India were not treated as equivalent to the trademarks but since 1999 through a judgment of Delhi High Court in Yahoo! INC v. Akash Arora (1999) and through a Judgment of Supreme Court in Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd. (2004), this trend has been changed and same also extended the extent of legal landscape to be governed by Indian Trademark Regime. This research paper explores this applicability of trademark law to the domain names are as follows with the help of different kinds of Domain Name Disputes in India. In both of above-mentioned cases Hon’ble High Court of Delhi and Hon’ble Apex Court respectively declared that Passing Off remedies available in trademark law will be applicable to the protection of domain names as well. Sometimes there may be some exception against the plaintiff in domain names case. In case of *I Plus Inc. v. Consim Info Pvt Ltd.*,⁹ here hon’ble court declared that plaintiff’s domain name “indiaproperties.com” consists not jus a generic but also a descriptive term namely, “india” & “properties and same could not have the protection of trademark.

KINDS OF DOMAIN NAME DISPUTES IN INDIA

There are many types of domain name disputes incidences do occur in India, but here we will discuss here only four major types of disputes out of all kinds. Following are these four types-

Cybersquatting Case Law: Acqua Minerals Ltd. v. Pramod Borse (2001)	Profit Grabbing Case Law: Satyam Infoway LTD v. Sifynet Solutions Pvt. Ltd. (2004)	Misspelling and Identical Domain Names Case Law: Yahoo! INC v. Akash Arora (1999)	Concurrent Claims Case Law: Nissan Motors Co. Ltd. v. Nissan Computer Corporation (2004)
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⁹ 2010 (42) PTC 50 (Bom).

Detailed explanation of these four major types of domain names substantiated with landmark case laws are as follows-

1. Cybersquatting: This is considered to be the most common and popular dispute related to the domain name. This is an illegal act through which a person registers another's business name/domain name as his own. In other words, cybersquatting refers to an unethical act or cybercrime where criminal or offender purchases or uses a domain name that closely resembles to an existing domain or business name with an aim to make his profit by passing off the another's well known domains and by using another's name too.

ANTI CYBERSQUATTING CONSUMER PROTECTION ACT

With a vision to address the problem of cybersquatting, the government of our nation passed **Anti Cybersquatting Consumer Protection Act, 1999** and this regulation makes legitimate owner of trademark entitled to initiate a course of action against a person who attempted the crime of cybersquatting.

- **Acqua Minerals Ltd. v. Pramod Borse,**¹⁰ in this case the plaintiff was a registrant of a well-known bottling water brand BISLERI whereas, on the other hand defendants in this case was alleged to use the word Bisleri/Bisleri.com as a part of their domain name and plaintiff sued defendant for same and sought a decree of permanent injunction. After observing all issues hon'ble court issued a decree of permanent injunction that prohibited the defendant along with his partners from using Bisleri/Bislari.com as a part of their corporate name or domain name. In this case Hon'ble Court stated "*If any domain name is registered under the Trademarks Act, such domain name is entitled to equal protection for an action of infringement of tradename*".

2. Profit Grabbing: Profit Grabbing is an-another major category of Domain Name Conflicts in which a person registers his domain name with an identical tradename with an aim to grab the profit from concerned business.

- **Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.,**¹¹ this case was the first case related to the domain name disputes to be decided by the hon'ble Supreme Court of India in which hon'ble court declared that Provisions of Trademarks Act, 1999 has also an extent to the protection and registration of domain names. Actually, in this case Satyam Infoway was the appellant and Sifnet Solutions was the respondent. Appellant in this case was the registered proprietor of domain name such as Sifynet.com, sifyrealestate.com and sifymall.com to carry out their trade of online marketing, registered by them in 1999. On the other hand, respondent used to start word siffy as a part of their domain name (Siffynet.net and siffynet.com) and same were registered in 2001 to carry out the business of internet marketing. After these activities of respondent, appellant sued and sought an injunction against respondent. In this case hon'ble Supreme Court of India held that the Satyam Infoway was the prior adapter of word "Sify" and through which Satyam Infoway earned an immense goodwill and reputation in relation to the internet and computer related services. Hon'ble Court issued an injunction to restrain the respondent from using the word siffy as a part of their domain names to carry any of their business transactions. In this case hon'ble apex court held that laws relating to the passing off in trademark act 1999 are also applicable to the domain names disputes. Provisions invoked in this matter were **Section 2(1)(zb), 2(1)(m), 2(1)(z), 2(1)(j) of Trade Marks Act, 1999 and Rule 4 of ICANN.**

3. Misspelling and Identical Domain Names: As the trend of E-transactions are on an exceptional height and with this rise in E-transactions, peoples register domain names, which seems/appear to be deceptively similar or identical to existing domain names, especially in same field of trade and these activities are likely to confuse the general public regarding the ownership of these domain names.

¹⁰ AIR 2001, DELHI 463.

¹¹ AIR 2004 SC 3540.

- **Yahoo! INC v. Akash Arora**,¹² in this case *Yahoo! INC* was plaintiff and owner of domain name “*Yahoo.com*” for the internet services and yahoo was registered company since 1995 and acquired domain names in 69 countries but except India. Basically, in this case defendant Akash Arora registered a domain name “*YahooIndia.com*” for providing the same internet services as plaintiff and from this activity of defendant this was clear that ordinary consumer might be confused. Plaintiff noticed these activities and sued defendant for using domain name which is identical to that plaintiff. In this case Hon’ble Delhi High Court agreed with plaintiff’s contentions and concluded that through these activities of defendant consumers are likely to be deceived into believing that services provided by Akash Arora belong to the Yahoo! INC. Hence court ruled favour of plaintiff Yahoo! INC and restrained the defendant from utilizing word yahoo as a part of its domain name. In this case **Section 27(2) of Trademarks Act, 1999 and Section 106 of Trade and Merchandise Act, 1958 were invoked**. This was the first case where Delhi High Court declared Domain Names as equivalent to Trademark and this was also a landmark ruling on “Cybersquatting” in India.

4. Concurrent Claims: This is also an important pillar that constitutes into occurring domain name disputes in India. This pillar basically comes into play when two lawful entities engage in a conflict pertaining to a domain name and each of them claims to be a real and lawful owner of a domain name over which disputes arise.

- **Nissan Motors Co. Ltd. v. Nissan Computer Corporation**,¹³ there was a defendant in this case whose surname was Nissan and he used his surname as a tradename for number of trades continuously since 1980 and he established Nissan Computer Corporation in 1991 and acquired a domain name “*nissan.com*” and “*nissan.net*” in 1994 & 1996 respectively and both were for providing services related to the computer. Plaintiff raised an objection against defendant 1995 for using this word “Nissan” as a part of its domain name but plaintiff did not initiate any further legal proceeding. Defendant had further made a modification in its website to add “*Nissan Computer*” logo was identical to that of plaintiff. As a result, plaintiff sued defendant for infringing upon plaintiff’s trademark and sought a preliminary injunction. Ultimately, in this case hon’ble court considered it to be an infringement on the part of defendant.

UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP)

The Uniform Domain Name Dispute Resolution Policy (UDRP) refers to a key instrument in resolving and addressing disputes concerning Domain Name protection. It is a framework that was established to resolve the conflicts arising as a result of registering a domain name/internet domain and infringing upon the rights of a legal domain name holder. **UDRP was established on October 24, 1999 by ICANN**, an US based corporation as highlighted above in abstract. This was created as a vision to deal with the matters relating to the registration of internet domain. The WIPO Arbitration and Mediation Center (also known as WIPO center) refers to a service provider for dispute resolution and has developed as a vital pillar in offering a well-structured, effective and efficient mechanism for tackling and resolving disputes pertaining to the domain names through UDRP.

PURPOSE OF UDRP

First and essential motive behind this instrument is to ensure an appropriate and cost-effective mode of addressing domain name conflicts. UDRP works with a vision to safeguard the interests of legitimate domain holders and to provide an efficient and transparent dispute resolution process. Currently, the scope of UDRP extends to all **gTLD’s** such as .com, .org and .net etc.

PROCEDURE OF UDRP

- **Filing of Complaint:** Under the UDRP’s procedure a lawful owner of trademark institutes a complaint with an appropriate dispute resolution service provider like WIPO and legitimate owner contends that registration of domain name was done in bad faith by respondent.

¹² 78 (1999) DLT 285, 1999 IAD Delhi 229.

¹³ 378 F.3d 1002 (2004).

- **Response by Respondent:** UDRP provides the respondent with an opportunity to file a counter statement to respond the complaint made by appellant and also to avert the evidences to prove respondent's lawful interest in disputed domain name.
- **Decision by Panel:** Upon examining and analysing the contention and evidences from both sides, experts in panel decide either to transfer the ownership of conflicted domain name to appellant, if proves bad faith registration on the part of respondent or to let it to rest with respondent if proved legitimate interest in it.

CONCLUSION:

After observing all above available factors, we conclude this research paper that it is clear that Domain Names have achieved an exceptional height for treating as equivalent to the trademark through the various judgments such as *Yahoo! INC v. Akash Arora (1999)* and *Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd. (2004)*. Domain Names refer to act as a reputation of brand in this digital or online world and there is a high probability of a legitimate owner's domain name being misrepresented to significantly damage the goodwill and reputation earned by lawful owner and its brand. Hence, Domain Names must have same characteristics and same level of safeguard as available to trademark. On the other hand, UDRP have also been a milestone in keeping the rights and interests of lawful domain owners protect and it serves as an important tool for addressing domain disputes transparently, efficiently and fairly.

SUGGESTION:

In the end of this research paper, I would like to suggest that however rule of passing off in Indian Trademark Act of 1999 proves protection to the Domain Names in India but Indian Government needs to formulate separate laws to address the matters of domain names.

REFERENCES:

1. The Trademarks Act, 1994
2. The Trademarks Act, 1999
3. The Trade and Merchandise Act, 1958
4. Trade Related Aspects of Intellectual Property Rights, 1995