

CYBERSQUATTING AND TRADEMARK ISSUES:

AN ANALYSIS WITH REFERENCE TO INDIA

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INTRODUCTION

The practise of registering a domain name, which is likely to be desired by an entity, company, or organisation, with the intention of selling it for a profit to another person, company, or organisation is known as cybersquatting. It includes third parties that do not own the Trade Marks or trade names but still register domain in their names. Cybersquatters are the practitioners of cybersquatting who register domain names with the names of Trade Marks or trade names. Cybersquatters register third-party Trade Marks, trade names, company names, and other similar spelled terms with the purpose of profiting from the prestige and reputation of such third parties by either misleading consumers or prospective customers, or by selling the domain name to the rightful owner for a huge fee.

Corporations and Trade Mark holders are required to use their preferred domain name by buying it from cybersquatters for a huge amount of money because there is no way to use two domain names that are pronounced exactly the same. Apart from that, they frequently have to pound on the doors of courts in order to bring cybersquatters before judiciary and to get justice against their unethical and illegal act.

DOMAIN NAME v. TRADE MARK

A domain name is a string of characters, consisting of letters, numbers, and dashes, that is part of a uniform resource locator (URL) which is used to access web pages. Each website has a unique domain name through which it is accessed. They begin with 'www.' followed by the unique name like 'xyz' and ending with domain name extensions like '.com', '.org', '.edu', '.net', '.ac.in', etc. Thus, the domain name appears like 'www.xyz.com'. The function of domain names has developed over time from simply supplying an internet address and a means of communication to a means of conducting commercial business. In the recent case of *Hindustan Unilever Limited v. Endurance Domains Technology LLP & Ors.*¹ the Bombay High Court observed that, "a domain name is simply an easy-to-remember or mnemonic for an internet protocol address. The IP address is a string of numbers in four sets separated by a period."

A Trade Mark is an exclusive identity of the goods or services of the its owner. A Trade Mark is defined as "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 registered Trade Mark distinguishes the goods and services of its owner from the goods and services of his competitors in the business course by empowering the owner with the right to exclusively use the mark for only his goods and services.

Thus, a Trade Mark is always seen in respect of the goods and services provided by its owner. This is how a Trade Mark and a domain name is associated. Both are unique and seen in respect of the goods and services provided by them. So, it will not be wrong if it is said that both, Trade Marks and domain names are "identifiers".

In the landmark case of *Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.*³, the Hon'ble Supreme Court laid down that, "A domain name is easy to remember and use, and is chosen as an instrument of commercial enterprise not only because it facilitates the ability of consumers to navigate the Internet to

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¹ MANU/MH/0765/2020.

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

³ MANU/SC/0462/2004.

find websites they are looking for, but also at the same time, serves to identify and distinguish the business itself, or its goods or services, and to specify its corresponding online Internet location. Consequently, a domain name as an address must, of necessity, be peculiar and unique and where a domain name is used in connection with a business, the value of maintaining an exclusive identity becomes critical.”

A Trade Mark and a domain name differs in the ways they are registered. Registration of a Trade Mark goes through a complex process stretching over a long duration whereas a domain name is registered within less than an hour by spending just a few bucks. The registration process of a domain name is what because of which the issue of cybersquatting is into practice.

PROTECTION OF DOMAIN NAMES AS TRADE MARKS

Domain names can be registered and protected as a Trade Mark provided that it fulfils all the conditions which are required in order to be registered as a Trade Mark. So, a domain name which is unique, distinctive and distinguishes the goods and services offered by its owner from others, can be registered and protected as a Trade Mark. It must fulfil criteria like it should not be misleading, confusing or deceiving to consumers of other corporations engaged in similar business course. With reference to registration of domain names as Trade Marks when the question was raised whether a domain name can be said to be a word or name which is capable of distinguishing the subject of trade or service made available to potential users of the internet, the Supreme Court of India in *Satyam Infoway Ltd. v. Sifynet Solutions*⁴ answered positively and held that “*the domain name not only serves as an address for internet communication but also identifies the specific internet site. In the commercial field, each domain name owner provides information/services which are associated with such domain name. Thus a domain name may pertain to provision of services within the meaning of Section 2(z).*”

As a result, a domain name may be licenced and covered as a Trade Mark if it relates to the provision of services under the scope of Section 2(z) of The Trade Marks Act, 1999. Following registration, the Trade Mark owner will be granted all of the privileges that are normally granted to Trade Mark owners in the Indian subcontinent. These right will also include the right to sue for infringement and rights of action against any person for passing off.

- **Right to sue for infringement:** The owner of a Trade Mark would have the exclusive right to use the Trade Mark in relation to the products or services for which the Trade Mark has been licenced, as well as the ability to seek redress in the event of infringement.⁵ If an individual other than the Trade Mark owner uses a domain name that is licenced as a Trade Mark without permission, he will be held responsible for Trade Mark infringement under Section 29 of the Trade Marks Act, 1999.
- **Rights of action against any person for passing off:** If certain requirements are met, an owner whose mark is not licenced as a Trade Mark may also get benefit of protection of his mark. First and foremost, the Trade Mark owner should develop goodwill or a reputation for his product. Second, the owner of Trade Mark has to show that someone else has misrepresented his products and it is either misleading or will be misleading the relevant public, and third, the Trade Mark owner is needed to show that a loss has been caused to his own goods and services as a result of the defendant’s goods and services being mistaken for the plaintiff’s.⁶

UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP)

When we look for the policies which can be followed to resolve the disputes or cases of domain name, the UDRP is the answer. This policy has been adopted to resolve the disputes over domain names between the registrants of domain name and the complainant on the ground of foul use or owning of domain name or registration harming the enterprises or corporation in a way or other. Under this policy,

⁴ See *id.*

⁵ *Supra* note 2, § 2(m).

⁶ *Reckitt and Colman Products Ltd. v. Borden Inc. and Ors.*, MANU/UKHL/0012/1990.

the domain name disputes which can be resolved both, generic top level domains such as '.com', '.org', etc.; and country code top level domains such as '.au', '.eu', etc. with the condition that the concerned nation is a follower of the policy on a voluntary basis.⁷ This policy provides for the arbitration of disputes relating to domain names. It is important to know that India is not a follower of this policy. So, disputes of domain name with extension '.in', can't be resolved through this policy.

If a Trade Mark owner believes that registration of any domain name is infringing his Trade Mark, he, under the UDRP, may bring a complaint and initiate a proceeding.⁸ To resolve a dispute, a suit needs to be filed before a service provider of dispute resolution giving all the required details.⁹ For the gTLDs, a dispute resolution service providers (e.g., WIPO) are officially recognized by ICANN, the body which established this policy. Unlike gTLDs, a dispute resolution service provider for ccTLDs is officially recognized by the administrating body of the concerned ccTLD.¹⁰ The grounds on which a complain can be brought are:¹¹

- i) the complainant considers that his registered Trade Mark or service mark is getting infringed due to a domain name being identical or confusing similar.
- ii) the person who has registered and is owning the domain name is having no rights or genuine interest in it; and
- iii) the person who has registered and is using the domain name in bad faith.

When the proceedings will start, the third party which has brought the suit will have to prove that each of the above mentioned three required grounds and reasons are present and form the basis of his complaint.¹² The panel of arbitrators is not allowed to deliver any monetary verdict of the dispute.¹³ So, as the remedy available under this policy, the domain name will either be transferred or the registration will be cancelled, or the case will be dismissed on the lack of appropriate reasons or grounds.

When we look into the service providers of dispute resolution under this policy which are recognized by the establishing body of the policy, i.e., ICANN, then WIPO comes out as one of the key service providers. Disputes are resolved on fast track basis under this organisation. It can be understood by their rule itself that it usually takes not more than two months to resolve a dispute. The organisation does not go for physical proceedings except in certain cases and conducts it online and thus, the disputes get resolved at very low fees.¹⁴

LAWS ON CYBERSQUATTING IN INDIA

In India, unlike many developed countries, there is no law which can provide protection for domain names. So, cases of cybersquatting are settled under the Trade Marks Act, 1999. Acknowledging the gap in such specific issues due the absence of specific law, courts in India extend the domain of the Trade Marks Act, 1999 to such conflicts. The Court in case of *Satyam Infoway Ltd. v. Sifynet Solutions Pvt Ltd.*¹⁵ observed that “As far as India is concerned, there is no legislation which explicitly refers to dispute resolution in connection with domain names. But although the operation of the Trade Marks Act, 1999 itself is not extra territorial and may not allow for adequate protection of domain names, this does not mean that domain names are not to be legally protected to the extent possible under the laws relating to passing off.”

⁷ WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP), WORLD INTELLECTUAL PROPERTY ORGANISATION, <https://www.wipo.int/amc/en/domains/guide/#a>. (last visited Apr. 16, 2021).

⁸ How does the UDRP work?, WORLD INTELLECTUAL PROPERTY ORGANISATION, <https://www.wipo.int/amc/en/center/faq/domains.html#8>. (last visited Apr. 15, 2021).

⁹ See *id.*

¹⁰ WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP), WORLD INTELLECTUAL PROPERTY ORGANISATION, <https://www.wipo.int/amc/en/domains/guide/#c1>. (last visited Apr. 15, 2021).

¹¹ Uniform Domain Name Dispute Resolution Policy, INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS, <https://www.icann.org/resources/pages/policy-2012-02-25-en>. (last visited Apr. 15, 2021).

¹² See *id.*

¹³ Can damages be awarded?, WORLD INTELLECTUAL PROPERTY ORGANISATION, <https://www.wipo.int/amc/en/center/faq/domains.html#21>. (last visited Apr. 15, 2021).

¹⁴ See *id.*

¹⁵ *Supra* note 3.

- ❖ **.IN Domain Name Dispute Resolution Policy (.INDRP):** There is no such thing as an exclusive rule for the protection of domain names in India. Disputes concerned to country code top level domain, which is also identified with domain name extension '.in' can be settled by this India-specific policy, which has been introduced by National Internet Exchange of India, in addition to enforcement under the Trade Marks Act.¹⁶ Since India has not voluntarily accepted the UDRP, complaint of disputes involving domain names with the extension '.in' can be filed under this policy. The grounds of filing a complaint are the same as those outlined in the UDRP. The settlement procedure is identical to that of the UDRP. The registrant's domain name may be transferred or cancelled as a result of the remedies available.¹⁷ Unlike the UDRP, the arbitrator can award costs as considered appropriate under the .INDRP.¹⁸

LANDMARK JUDGEMENTS ON CYBERSQUATTING

1. *Yahoo Inc. v. Aakash Arora & Anr.*¹⁹

Earlier to this case, Indian judiciary has never dealt with cases of cybersquatting. In this case, the plaintiff which was an MNC was the Trade Mark holder of 'Yahoo!' and was owning a domain name 'Yahoo.com' whereas 'Yahooindia.com' was another domain name which was owned by the defendants and the later was providing similar services as like the former. The MNC brought a suit against Aakash Arora and other defendants and was seeking a permanent injunction for passing off along with an ad interim temporary injunction against Aakash Arora and other defendants which would stop them from carrying on any commercial activity on the web or otherwise under the referred domain name which was claimed to be similar by the plaintiff, the MNC or any term which is analogous to the MNC's Trade Mark.

The Court barred the defendants from using Yahoo as a Trade Mark or domain name on the web platform, as well as from using the same code as Yahoo. The Court observed that the defendants were trying to take advantage and encash the recognition of the MNC's Trade Mark and declared that registration of a domain name on the web platform should be understood as grants of lawful rights to use the registered domain name just because of the reason of its registration, the registrant can still be held guilty of infringement of claimant's owned Trade Mark.

2. *Aqua Minerals Limited v. Mr Pramod Borse & Anr.*²⁰

It is one of the landmark judgements on the cybersquatting cases in India. In this case, the Trade Mark 'BISLERI' was registered and owned by the plaintiff, Aqua Minerals Limited and it also had copyright of uniquely written word 'BISLERI'. After applying for registration of 'bisleri.com' as a domain name, it came to their knowledge that the defendants had already illegally registered the referred domain name.

The Court observed that the defendants had registered the referred domain name in bad faith and held it amounting to an act of cybersquatting. The defendants had replied to the plaintiff that they can cancel the registration of their registered domain name if plaintiff would pay them the amount which they had spent in developing the website. The Court took it as an attack on the goodwill and reputation of Aqua Minerals Limited. Thus, the plaintiff was permitted to approach the concerned service provider to seek a transfer of the domain name.

3. *Ms. Barkha Dutt v. Easyticket, Kapavarapu, Vas*²¹

In this case, the respondent obtained the registration of a domain with the name 'www.barkahdutt.com' on internet. The case was filed under UDRP before WIPO's Arbitration and Mediation Centre by Ms.

¹⁶ *.IN Domain Name Dispute Resolution Policy*, .IN REGISTRY, <https://www.registry.in/IN%20Domain%20Name%20Dispute%20Resolution%20Policy%20%28INDRP%29>. (last visited Apr. 15, 2021).

¹⁷ *See id.*

¹⁸ *See id.*

¹⁹ 1999 PTC (19) 201 Delhi.

²⁰ MANU/DE/0642/2001.

²¹ Case No. D2009-1247.

Barkha Dutt, a known figure in the media and particularly recognised for her news reporting, seeking transfer of the above mentioned domain name to her which was registered in her name but by a third party, the respondent.

The complainant was successful during the administrative proceeding in proving that each of the three elements²² required to be present in a complaint were existing in her case. Hence, the panellists gave their decision and ordered the defendant for transferring the referred disputed domain name to the plaintiff.

CONCLUSION

The domain of Cyber Law in India is yet to expand as compared to western countries. So, in India it is a fact is that there is no exclusive law which makes the cybersquatting illegal and prevents the unethical practice of obtaining the registration of domain names and their owning by the cybersquatters in greed of money. The only way by which domain names can be protected in India is through their registration as Trade Marks. But obtaining the registration of a Trade Mark is not an easy task. They are certain complex conditions as explained in earlier sections which require to be fulfilled in order to obtain the registration of Trade Marks. Sometimes unregistered marks too can be protected can be protected by way of passing off but it all depends upon the fulfilment of specific conditions as explained.

The other ways by which disputes and conflicts of domain names is resolved are by following UDRP which has been adopted by ICANN. Here, the disputes and conflicts of domain names are resolved and judgement is given through practice of arbitration facilitated by service providers of dispute resolution, like WIPO. Since India is not a follower of UDRP, so the disputes of domain names having extension '.in' are resolved only through the .IN Domain Name Dispute Resolution Policy (.INDRP) which has been adopted by National Internet Exchange of India (NIXI). The grounds of complain, process of resolution and the remedies available, all are almost same as that of under UDRP.

²² *Supra* note 11.