

# Everything's Gone Digital, and So Did Infringers: Domain Name Disputes

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## ARTICLE INFO

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## Abstract

The emergence of E-commerce and an exponential increase in technology led proprietors to expand their activities all over the internet. Before entering cyberspace, a business needs an identity, such an identity was earlier known as an IP address. As time changed, the IP addresses got replaced with the Domain Name system because it was difficult to remember all numeric traditional IP Addresses. Evolution in telecommunication indicates the importance of governing the domain name system.

The first chapter of the research gives a brief exordium about Domain Names and their registration. There is a misconception that Domain Names and Trademarks are similar, which will be clear through the interplay between Domain Names and Trademarks. The essay will unfold various kinds of Domain Name disputes such as cyber-squatting, meta-tagging, name-jacking, and typo-squatting. They are discussed in length together with relevant case laws.

As the article proceeds, it appears that in India, unlike trademarks, there is no statute for the protection of domain names. Through this research, we will examine two sets of forums that protect domain names from abuse. We will discuss the emergence of UDRP and INDRP that protect domain names and bring uniformity. We will further look at different types of disputes that are maintainable under UDRP and INDRP. An in-depth discussion will take place regarding the entire procedure of the dispute between the complainant and the respondent. The study concludes with some suggestions that might help safeguard one's trademark from being disputed by a third party.

## INTRODUCTION

The evolution of social media led producers to promote their brands and carry out E-commerce related activities exuberantly. Social media has yet become another platform for infringement. A company on a virtual platform needs an identity that should be eye catchy with the aim that it will be remembered by users easily. It led to the emergence of the Domain Name System (DNS). DNS came as a substitute for long-established Internet Protocol (IP) addresses. Domain Name is an address that is accessed by the internet users to reach the website. The domain name constitutes letters, numerals, and domain extensions. Domain names are divided into two parts: Second-

Level Domain (SLD) and Top-Level Domain (TLD). Former is distinctive and unique to each brand, for instance, Google, Amazon, etc. Top-Level Domain name whereas, specify the organization's purpose, geographical area and owner, for instance, .net, .com, .in.<sup>1</sup> Each domain name is unique therefore; no two people can own the same domain name.

The procedure of registration of domain names is automated. The domain name is not owned but registered for a fee and for a specific time period and has to be renewed after the expiry. If the domain name is not renewed then it falls into the public domain and anyone else can register it in his name. Through this machine-driven process, one cannot construe if the domain name is registered with bonafide intentions and by the true owner or not, scanning of documents cannot be done by the registrar as done with Intellectual Property.

As the procedure of registering the domain name was automated, it became a setback in the growth of E-commerce because it gave rise to various cyber offences.

## Distinction Between Domain Names & Trademarks

Trademark is a mark that can be represented graphically and can distinguish one's goods and services from that of another. It also includes color combination, packaging, and shape of goods whereas; the domain name is what people types on a web browser to visit the website. Some important distinctions between TM and DN are:

- The trademark is owned by the business to operate in the real world whereas the domain name is used to operate in cyberspace.
- Under domain names, the concept of deceptively similar does not exist. The slightest change in the already existing domain names can also be registered easily.<sup>2</sup>

For instance: The trademark "Sardarbuksh Coffee & Co" is deceptively similar to a well-known trademark

1 What is a Domain Name? Everything you need to know about Domain Names, available at: <https://www.godaddy.com/garage/what-is-a-domain-name/> (Last visited on June 17, 2022)

2 Conflicts between Trademarks and Domain Names: A Critical Analysis, available at: <https://ssrn.com/abstract=2045222> (Last Visited on June 17, 2022)

"Starbucks Coffee" but Sifynet.com and Siffynet.com domain names can be registered smoothly.

- Trademark has territorial boundaries. People across the world can have similar trademarks. Domain name operates globally. Two people cannot have similar registered domain names.
- Trademark is registered for different classes of goods and services while the domain name is owned by the entire company irrespective of the goods and services.

For instance: Mcdonalds.com is the Domain name whereas McAlloo Tikki Burger, Pizza McPuff, and Mc Veggie are the various trademarks that are registered for a particular class of goods.

## Domain Names Related Disputes

### Cyber squatting

Cyber squatting has been the biggest roadblock in the booming growth of E-commerce. Cyber squatting can be defined as an act where the cyber squatter registers a domain name similar to a registered trademark with mala-fide intention before the real owner of that trademark does. As long as the domain name is registered in the name of the cyber squatter, the real owner of that trademark cannot register it as the domain name in his name. It is found that cyber squatters don't even operate those sites once registered rather they try to sell them at excessively and unreasonably high prices to the real trademark owners.<sup>3</sup>

In India, no statute governs cyber squatting rather courts resolve the cases on the principle of passing off. The domain name registration is completely computerized, due to which it becomes difficult to conclude if the applicant is registering the domain name with bona fide intention or not. The registration of domain names is done on a first-come, first-serve basis which means, only one person can register a particular domain name in the whole world. Cyber squatters take advantage of the same and register the trademark as a domain name and infringe the right of the trademark owner to utilize his trademark.

3 Domain Names and Cybersquatting, available at: [https://www.indialawjournal.org/archives/volume1/issue\\_2/article\\_by\\_ashwin.html](https://www.indialawjournal.org/archives/volume1/issue_2/article_by_ashwin.html) (Last Visited on June 17, 2022)

In *Yahoo Inc. vs. Aakash Arora & Anr*<sup>4</sup> the defendants registered a domain name “Yahoo India!” which was similar and identical to the renowned U.S based company “Yahoo!”. Both the plaintiff and the defendant were dealing in similar services.

Plaintiff contended that the defendant is using a deceptively similar trademark and passing off the services as theirs. They further asserted that it will create confusion among the consumers and make them believe that both trademarks belong to the plaintiff. This case is known as the first case of Cyber squatting.

The court held that, as trademarks and services offered by both the companies are similar, therefore, the defendant was held liable for passing off and was restrained from using it as the domain name.

The researcher believes that the abovementioned judgement gave a new perspective to the people with regard to the bane of advancement in technology. However, the judgement passed by the Hon’ble Court successfully recognized and safeguarded the rights of the registered owner of the domain name.

The *British Telecommunications Plc and Others vs. One in a Million Ltd*<sup>5</sup> case is also known as the “One in a Million” case. In this case, the defendants were the traders in Internet Domain Names. They used to register similar names of well-established brands. Defendants registered domain names of famous Marks & Spencer, Sainsbury’s, Virgin, British Telecommunications, and Ladbroke Group without their consent. They further offered them for sale to none other than the brands whose trademark were used as domain names by them.

The court held that infringers who registered domain names similar to the trademarks of renowned brands in the U.S and used them in the course of trade are liable for infringement of trademark and tort of passing off.

The researcher believes that in the abovementioned case, the Hon’ble Court while passing this judgement set an example that the goodwill and reputation of the well-known trademarks will not be misused and shall be given protection across the nation.

4 Madhavendra Singh, “Typosquatting an Evil in Cyberspace”, Live Law, June 07, 2022  
5 [1998] 4 All E.R. 476

In *HT Media Ltd. & Anr. vs. Brainlink International Inc.*<sup>6</sup> case the plaintiff was the owner of the renowned brand “Hindustan Times” for which they registered a domain name as “HindustanTimes.com”. The defendant based in the U.S registered a similar domain name as “Hindustan.com”. An attempt was made earlier between both the parties to negotiate and transfer the domain name to the plaintiff, but it was unsuccessful.

Later, it was held by the court that, the marks can confuse the general public in India and damage the reputation of the plaintiff. Therefore, a permanent injunction was granted by the court in favor of the plaintiff from using the domain name in question.

The researcher believes that in the abovementioned case, the Hon’ble Court time and again delivers the judgements keeping in mind, the interest of the general public, and how they are affected by such malafide practices.

In *Sbicards.com vs. Domain Active Property Ltd.*<sup>7</sup> case, the complainant was the owner of SBI Cards and Payments Services Pvt. Ltd. for which a domain name was registered as “Sbicard.com”. The mark was in use since the year 1998. Respondent on the other hand was the owner of Domain Active Pty. Ltd. who registered a deceptively similar domain name as “Sbicard.com” for the same services provided by the complainant.

World Intellectual Property Organisation concluded that the respondent registered the domain name with mala-fide intentions and a motive to sell it at a higher price to the complainants. So, WIPO held that the disputed domain name should be transferred to the Indian company.

The researcher believes that there is an increase in domain name disputes, and new settlement procedures come to the rescue. Apart from that traditional litigation, the parties can also opt for such forums that make sure that the interest of the registered proprietor is preserved.

6 The Delhi High Court and an Anti-Suit Injunction- Part-1, available at: <https://spicyip.com/2020/05/the-delhi-high-court-and-anti-suit-injunction-i.html> (Last Visited on June 17, 2022)

7 WIPO Arbitration and Mediation Centre, available at: <https://www.wipo.int/amc/en/domains/decisions/html/2005/d2005-0271.html> (Last Visited on June 17, 2022)

## Typo-Squatting

Typo-squatting is another category of cyber squatting. Typo-squatting happens when the infringer registers a domain name with a slight change in a spelling that is similar to a well-established brand, for instance, goglee.com in place of google.com. When the user, mistakenly types an incorrect spelling and lands on a website created and registered by the infringer instead of the original brand's site, where they are bombarded with advertisements, which makes it difficult for them to leave the site. This hampers the reputation and goodwill earned by the original brand.

For instance, the US and the UK based infringers made two typo-squatted websites in the name of Indian Railways, one was "Indianrailway.com" and other was "Indianrailways.com" when the real websites for Indian Railways were "Indianrail.gov.in" and "Indianrailways.gov.in".<sup>8</sup>

In Rediff Communications Ltd. vs. Cyberbooth<sup>9</sup> case, the plaintiff was the owner of an online media company whose domain name was "Rediff.com". Defendant knowing that such domain name exists, registered another domain name as "Radiff.com" which was deceptively similar to the plaintiff's mark. The plaintiff sent a cease and desist letter to restrain the use of "Radiff" in their domain name.

The plaintiff contended that the defendant registered the domain names with the motive to deceive the public and make them believe that the domain name in question belongs to the plaintiff. The court held that both marks and services provided by the plaintiff and defendant are similar which creates a risk of deception and confusion among the general public. Therefore, the court restrained the defendant from using the mark as the domain name.

The researcher believes that in the abovementioned case, the Hon'ble Court always takes active measures to preserve the rights, hard-earned goodwill and reputation of the proprietor along with protecting the consumers from deception.

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8 Typosquatters Roam Unchecked in India, available at: <https://timesofindia.indiatimes.com/it-services/typosquatters-roam-unchecked-in-india/article-show/5886083.cms> (Last Visited on June 17, 2022)

9 AIR 2000 BOMBAY 27

## Meta-Tagging

Imagine a situation where you search for your trademark and the web shows the website of your competitors on the top rather than yours, it is surprising, right? Now that's called the concept of Meta Tagging. Meta Tagging is when an infringer uses well-established trademarks as their tags to maneuver the search results on the web. Now this will shift traffic to the infringer's website rather than the actual brand. An uninformed consumer will land on the website of the infringer and this will affect the goodwill and result in riding piggyback on the actual brand name.

### *Now, how do these Meta-tags work?*

Meta-tags are just keywords that are mentioned while developing the website in the initial stage. These tags are not perceivable which makes it easier for the infringers to manipulate. Now, when a consumer types a word to search and that particular word is similar to that of meta-tags then the search engine shows the websites accordingly. It leads to confusion in the minds of the consumers.

In Mattel Inc. and Others vs. Jayant Agarwal and Others<sup>10</sup> case, the Plaintiff was the proprietor of toys and games. One of their popular games was "Scrabble". The plaintiff contended that the defendants have launched the online version of their game under a deceptively similar trademark as "Scrabulous". Plaintiff further contended that the defendants are using their trademark and domain name as their meta-tags on their websites which make consumers believe that it is associated with the plaintiffs.

The court held that using deceptively and confusingly similar names will lead to the case of infringement and passing off. Thus, defendants are restrained from using "Scrabulous" as their domain name and "scrabble" in their meta-tags.

The researcher believes that in the abovementioned case, the Hon'ble Court always acts as a shield for the registered proprietor against the fraudsters and upon analyzing the facts and circumstances of the case, punishes the wrongdoer.

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10 The Fabulous Tale of Scrabulous, available at: <https://spicyip.com/2008/10/fabulous-tale-of-scrabulous.html> (Last Visited on June 17, 2022)

In *People Interactive Pvt. Ltd. vs. Gaurav Jerry & Ors.*<sup>11</sup> the Plaintiff was the owner of the very famous trademarks “Shaadi.com” and “Shadi.com”. The defendant was the competitor who owned the domain name “ShaadihiShaadi.com”. Plaintiff contended that the defendant is using a similar trademark and creating confusion in the minds of consumers.

They further contended that the defendant is using their trademark and domain name “Shaadi.com” as meta-tags in his website [www.ShaadiHiShaadi.com](http://www.ShaadiHiShaadi.com) which is shifting traffic from the plaintiff’s website to his own.

The Court defined meta-tags for the first time in this case. The court granted Ad-interim injunction in the favor of the plaintiff and held this as a case of infringement and passing off the plaintiff’s trademark and domain name.

The abovementioned case was the very first case where the dishonest and deceitful practice of Meta-tagging came to light before the courts and the public. The researcher believes that the Hon’ble Court set the case as a precedent which is cited every now and then while adjudicating the meta-tagging disputes.

## Name-Jacking

Name-Jacking is another category of squatting. The offender exploits the celebrity’s name as the top-level domain name. Many false websites are being owned by a person other than a celebrity. There have been many such cases and most of them are decided in the favor of the celebrity. The burden of proof lies on the celebrity. Firstly, they must prove that the domain name is deceptively similar to their trademark.

Secondly, the domain name is registered by mala-fide intentions. Thirdly, the owner has no legal right over the domain name.

The prominent actress Jennifer Lopez was the victim of Name-jacking. Two domain names “[Jenniferlopez.net](http://Jenniferlopez.net)” and “[Jenniferlopez.org](http://Jenniferlopez.org)” were registered by a U.S based user.

<sup>11</sup> Does Use of Trademark as Meta Tag Amount to Trademark Infringement, available at: <https://www.algindia.com/article-does-use-of-trademark-as-meta-tag-amount-to-trademark-infringement/> (Last Visited on June 17, 2022)

It was found that the websites were used with mala-fide intentions to gain commercial benefits. It was found that the defendant did not have a legitimate interest and right over the domain name.

The researcher believes that the advancement in technology led to the rise in digital fraud. The Hon’ble Court is proactively passing landmark judgements to combat such fraudulent practices.

In *Arun Jaitley vs. Network Solutions Private Ltd. & Ors.*<sup>12</sup> case, the Plaintiff “Arun Jaitley” is a well-known politician. He wanted to register a domain name but found that it is already registered as [www.arunjaitley.com](http://www.arunjaitley.com). The plaintiff contended that it’s a rare combination of two words and considering the fame and achievements thus, it does not remain as a personal name. So, the right to use the name “Arun Jaitley” is vested with them only.

The Court held that the name is distinctive and popular and therefore deserves trademark protection.

Many other famous personalities have been a victim of name-jacking such as Salman Khan, Amitabh Bacchan, Madonna, Tom Cruise, Celine Dion and Scarlett Johansson.

The researcher believes that as a large number of people have gone digital, the imposters have found new ways to trick the innocent public. We are witnessing a surge in the abovementioned types of cases, however, in order to resolve them, the Hon’ble Court has been delivering judgements to set an example in society and various new settlement procedures have also been introduced.

## Settlement Procedure of Domain Name Dispute

Domain Names are not just referred to as addresses anymore but are regarded as an essential element in businesses. There has been an increase in disputes related to domain names. UDRP by ICANN came to the rescue of proprietors from miscreants.

Aggrieved parties may assert their rights over the Domain names in any one of the two sets of forums which are:

- Traditional Litigation: Approaching courts and resolving the matter with the help of a judge or jury.

<sup>12</sup> *Arunjaitley.com* – A case of Cybersquatting, available at: <https://spicyip.com/2011/07/arunjaitleycom-case-of-cybersquatting.html> (Last Visited on June 17, 2022)

### Satyam Infoway Ltd. vs. Sifynet Solutions<sup>13</sup>

Plaintiff registered a domain name with ICANN and WIPO as “Sifynet.com” whereas; the respondent registered a deceptively similar domain name as “siffynet.com” and “siffynet.net”. The plaintiff has a reputation and goodwill associated with his company named Satyam Infoway Ltd.

The court found that using a similar or same domain name can lead to confusion in the minds of consumers and they might access the wrong domain name instead of another. The court concluded that the domain name constitutes the characteristics that are associated with the Trademark and Tort of Passing off can be found.

- Private Arbitration: Procedure as prescribed by Internet Corporation for Assigned Names and Numbers.

A dispute related to generic top-level domains, for instance, .com, .org, .net, etc can be resolved through arbitration under Uniform Domain Name Dispute Resolution Policy (UDRP).<sup>14</sup>

On the other hand, if the dispute is regarding .in domains then the aggrieved person can approach arbitration under .IN Domain Name Dispute Resolution Policy (INDRP).<sup>15</sup>

Remedies available to the aggrieved party under the two mechanisms are:

- Cancellation of the domain name registration.
- Transfer of domain name to the complainant.

It should be noted that under this no provision provides compensation to the aggrieved party.

#### **The Procedure Under UDRP:**

UDRP was implemented by ICANN in the year 2009. The procedure undergone by the aggrieved party is faster and cheaper than the traditional legal system.

- A complaint has to be made by the trademark holder to any ICANN approved dispute resolution service providers. There are five providers namely, World Intellectual Property Organisation (WIPO), the National Arbitration Forum, Asian

Domain Name Dispute Resolution Centre, Czech Arbitration centre for Internet Disputes, and Arab Centre for Domain Name Dispute Resolution (ACDR) regarding the misuse of one's.<sup>16</sup>

- A copy of the complaint will be sent to the respondent. The details of the respondent can be taken from the WHOIS database.
- The complaint has to be reviewed according to the rules of UDRP and the provider. If the complaint had defects then 5 days will be given to the complainant to resolve them. If the faultless complaint is not submitted within the time then it will be deemed to be withdrawn from the side of the complainant.
- The complaint will be sent to the registrar, and a copy of it will be sent to the respondent.
- The response has to be submitted by the respondent within 20 days.
- The panel is appointed within 5 days.
- The decision of the panel is given within 14 days and the same will be notified to the respective parties.

The burden of proof lies on the complainant:

- The respondent is using a domain name that is similar to the complainant's trademark.
- The respondent has no legitimate interest in the domain name in question.
- The respondent has mala-fide intentions behind using the domain name in question.

#### **The Procedure Under INDRP:**

In India .IN Domain Name Dispute Resolution Policy (INDRP) was implemented in the year 2006 and is managed by the National Internet Exchange of India (NIXI) to resolve the disputes related to Country-Code Top Level Domains (ccTLDs). INDRP is emulating the provisions of the Indian IT Act, 2000 and the rules of UDRP.

- A complaint is filed to INDRP as per the rules of INDRP and rules of procedure.
- The complaint will forward to the respondent provided by the prescribed fee.
- The review of the complaint is done according to the rules of INDRP. If the complaint has

<sup>13</sup> (2004) 6 SCC 145

<sup>14</sup> Aprajita Nigam, “What to do in a case of a website or domain name dispute”, The Economic Times, Dec 31, 2021

<sup>15</sup> .IN Domain Name Dispute Resolution Policy (INDRP), available at: <https://www.registry.in/domaindisputeresolution> (Last Visited on June 17, 2022)

<sup>16</sup> List of Approved Dispute Resolution Service Providers, available at: <https://www.icann.org/resources/pages/providers-6d-2012-02-25-en> (Last Visited on June 17, 2022)

defects then 5 days is given to the complainant to resolve them. If the faultless complaint is not submitted within the time then, it will be deemed as withdrawn from the side of the complainant.

- The arbitrator is appointed according to the provisions of the Arbitration and Conciliation Act 1996 and the rules of INDRP.
- The arbitrator has to render the decision in writing within 60 days and a copy of it is sent to both the parties.
- The .IN registry will communicate the order given by the arbitrator to both the parties and inform them about the implementation of the said order.

## CONCLUSION

As it is evident from the above discussion that a domain name is not just considered the identity of the company but is also an essential intangible asset of the company. The goodwill and reputation are attached to the domain name which makes it of paramount importance to protect. The Domain names are different from trademarks as discussed above but have a similarity of a “first-come, first-serve” basis. Due to the expansion in business activities, numerous issues have been raised now and then.

To safeguard the brand from infringement, one must follow certain steps: firstly, the brand should register its work mark to stop third parties from including it in their domain names. Another way to keep a check on infringers is to switch ‘ON’ Google alerts with your registered trademark; you will get notified once anyone uses it without your consent also when you brainstorm your brand, make sure the domain name is available or if the same is available for trademark registration.

In case a brand owner caught an online infringement then the first step one should follow is to scrutinize the source. For instance, some fans create a community by sharing blogs, news, and tips on social media platforms which sometimes infringe the brand’s trademark rights. So, before issuing a cease and desist letter for such infringement one must take into account the context of infringement and should respond accordingly else it will create buzz around the brand which will heavily affect

the goodwill and reputation of the brand.<sup>17</sup> On one hand, cyber crimes are set to rise whereas, on the other hand, the internet has also proven to be a powerful tool for brand owners to track down the infringement. However, in some cases, it becomes hard to identify the whereabouts of the infringers and make them a party to the lawsuit or even send them to cease and desist notice, in such circumstances; brands have a remedy commonly known as “John Doe orders”.

Another remedy left with the brand is an “Injunctive relief” against the infringers only if the brand owner knows how and where the infringers are operating unlawful activities then the brand owner can ask to freeze the accounts of the infringers.

The Brand owners to ensure speedy enforcement efforts must avoid traditional litigation methods and opt for easy and cost-effective private arbitration. There are some website support systems available such as on Amazon, eBay, and Alibaba.

Amazon launched the “Amazon Brand Registry” back in 2017 to safeguard the brand owners who have a registered trademark. The motive behind coming up with this new initiative was to eliminate all the fake and counterfeit products that are being sold<sup>18</sup>.

eBay came up with “The Verified Rights Owner Program (VeRO) to safeguard the Intellectual Property Rights of brand owners concerning the trademarks, copyrights, design, and patents. After registering, the brand owner has to fill out a form called “Notice of Claimed Infringement (NOCI)”. The system removes listings that infringe the intellectual property rights of the brand owner<sup>19</sup>.

Alibaba established the “Intellectual Property Protection Platform” to provide a healthy and safe E-commerce platform. The system after receiving notices carries out investigations and if proven in favor of the complainant, takes down the listings

<sup>17</sup> Erica D. Klein and Anna K. Robinson, “Combating Online Infringement: Real-World Solutions for an Evolving Digital World”, American Bar Association, April 01, 2020

<sup>18</sup> Amazon Brand Registry, available at: <https://brand-services.amazon.in/> (Last Visited on June 17, 2022)

<sup>19</sup> The Verified Rights Owners Programme (VeRO), available at: <https://www.ebaymainstreet.com/issues/verified-rights-owners-programme-vero> (Last Visited on June 17, 2022)

which allegedly infringe the IP rights.<sup>20</sup>  
The research concludes that though in India there is no direct law for the protection of domain names

Indian judicial mechanism has been adopting and giving justice time and again. Domain names are well secured and protected by the law in India.

<sup>20</sup> Alibaba Intellectual Property Protection Platform Instructions, available at: [https://ipp.alibabagroup.com/policy/en.htm?\\_localeChangeRedirectToken=1](https://ipp.alibabagroup.com/policy/en.htm?_localeChangeRedirectToken=1) (Last Visited on June 17, 2022)