

## **DOMAIN NAME DISPUTES - A CYBER WORLD TREND**

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### **Introduction:-**

What a wheel was for the early man so is a computer for a modern man. With the invention of computer, man is striving to reach horizons with the aid and use of computers. In the present day of —e age the boundaries of the countries have shrunk and is now under a single roof. The cyber world is a virtual world where all the boundaries are transcended and whole world has now become a single market place and every occurrence in the real world has its place in the cyber world and more importantly the trade factor. In the complex web of internet called the world wide web, the identity or address (called the IP address) to reach a market place or a specific place to search for a product or service, domain name plays a major role. Therefore IP addresses are the virtual way to a specific web site to search for a product or a service. IP addresses / internet protocol<sup>1</sup>. IP address contains numbers that are too difficult for the human mind to remember and therefore for easy identification and remembering the domain name came into existence.

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<sup>1</sup> An **Internet Protocol address (IP address)** is a numerical label assigned to each device (e.g., computer, printer) participating in a computer network that uses the Internet Protocol for communication. An IP address serves two principal functions: host or network interface identification and location addressing. Its role has been characterized as follows: "A name indicates what we seek. An address indicates where it is. A route indicates how to get there."

## ICANN and DOMAIN NAMES:-

A domain name is a name given to a specific website to identify the website or the person using the website. Domain names<sup>2</sup> are actually a set of strings that helps to identify the IP address or the website address. Since it is very difficult to understand a series of numeric characters, names with a meaning that is easy to remember is used. ICANN<sup>3</sup> administers the world wide internet domain names and any problems connected therewith. The top-level domains (TLDs) such as com, net and org are the highest level of domain names of the Internet. Every domain name ends with a top-level domain label.

When the Domain Name System was devised in the 1980s, the domain name space was divided into two main groups of domains.

- The country code top-level domains (ccTLD) based on the two-character territory codes of country abbreviations.
- generic top-level domains (gTLD) represent a set of categories of names and multi-organizations .government gov, education edu, commerce com, military mil, organization org, network net, business biz.

One of the important tasks of ICANN is to address the issue of Domain Name Disputes for generic top level domains with the co operation of the WIPO-World Intellectual Property Organization and the policy is known as —UNIFORM DISPUTE RESOLUTION POLICY|. This policy attempts to give an an easy and reasonable solution to the problems of domain disputes avoiding the traditional court room system .

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<sup>2</sup> The Internet Network Network Information Centre —INTERNIC| maintains the central database of all internet domain names. In 1993 Internic was established under the sponsorship of the National Foundation as a joint project of AT&T, General Atomics and Network Solutions Inc. —NSII.

<sup>3</sup> ICANN [Internet Corporation for Assigned Names and Numbers] is a non profit organization created on 18<sup>th</sup> September 1998, having head quarters at Los Angeles, California It was formed to regulate internet related tasks which was previously performed by IANA [Internet Assigned numbers Authority]. The **Internet Assigned Numbers Authority (IANA)** is the entity that oversees global IP address allocation, autonomous system number allocation, root zone management in the Domain Name System (DNS), media types, and other Internet Protocol-related symbols and numbers

According to ICANN policy, a domain registrant must agree to be bound by the UDRP — they cannot get a domain name without agreeing to this.<sup>4</sup>

The right to use a domain name is delegated by domain name registrars, recognised by the Internet Corporation for Assigned Names and Numbers (ICANN). In addition to ICANN, each top-level domain (TLD) is maintained and serviced technically by an administrative organization operating a registry. A registry is responsible for maintaining the database of names registered within the TLD it administers. The registry receives registration information from each domain name registrar authorized to assign names in the corresponding TLD and publishes the information using a special service, the whois protocol.

.IN is India's Country Code Top Level domain (ccTLD). The Govt. of India delegated the operations of INRegistry to NIXI<sup>5</sup> in 2004. The INRegistry operates and manages India's .IN ccTLD. The .in domain name creates and builds a distinct Indian identity for brands, companies and individuals in the cyberspace.

Registries and registrars usually charge an annual fee for the service of delegating a domain name to a user and providing a default set of name servers. Often, this transaction is termed a sale or lease of the domain name, and the registrant may sometimes be called an "owner", but no such legal relationship is actually associated with the transaction, only the exclusive right to use the domain name. More correctly, authorized users are known as "registrants" or as "domain holders".

ICANN publishes the complete list of TLD registries and domain name registrars<sup>6</sup>. Registrant information associated with domain names is maintained in an online database

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<sup>4</sup> <https://www.icann.org/resources/pages/welcome-2012-02-25-en>

<sup>5</sup> The **National Internet Exchange of India or NIXI** is a Not-for-Profit Company incorporated under section 25 of the Indian Companies Act, 1956, (now section 8 under Companies Act, 2013) with an objective of facilitating improved internet services in the country.

<sup>6</sup> A **domain name registrar** is an organization or commercial entity that manages the reservation of Internet domain names. A domain name registrar must be recognised by a generic top-level domain (gTLD) registry and/or a country

accessible with the WHOIS service. For most of the 250 country code top-level domains (ccTLDs), the domain registries maintain the information.

## **TRADEMARKS**

A trademark<sup>7</sup> as the name specifies is the name used for trading or for better identification of any product or services coming from a particular person differentiating it from persons producing similar goods and services. A trademark can be any words or combination of letters that gives the public an ability to correlate with the products that they produce leaving behind all other similar existing products in the market. A trademark is used to identify a person's goods in the market.

With the advent of E-Commerce and the increased use of internet and e commerce, where the buying and selling is now happening over the internet there is direct sales of goods over the internet. This makes the correlation between domain names and trademarks.

With the growing E commerce it is now through internet that all sale of goods and services are taking place. We can purchase any product from a recognized purchaser through online and for that we need to know the website they have. So, the online identity of the manufacturer will be the domain names. For example Life Insurance

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code top-level domain (ccTLD) registry. The management is done in accordance with the guidelines of the designated domain name registries and to offer such services to the public.

### **<sup>7</sup> Section 2(1)(zb) of the Trademark Act , 1999**

"trade mark" means 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; and-

- (i) in relation to Chapter XII (other than section 107), a registered trade mark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and
- (ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark;

Corporation may have an online portal for e commerce with the domain name lic.org., dell company may have an online( shop) place of business at www.dell.in ,

Domain Names are thus the trademarks as far as the cyber space in concerned. But not all domain names are trademarks , because an address can be anything not necessarily a brand or a company, it can be individual in nature. Sometimes it so happens that we get carried away by the name of the brand that a particular manufacturer is using believing that it is his own product. Not all domain names are trademarks or vice versa but when they coincide creating confusion in the minds of the users or misleading them then dispute arises known as domain name disputes.<sup>8</sup>

### **CYBER SQUATTING**

Cybersquatting is registering, trafficking in, or using a domain name with a bad faith intent to profit from the goodwill of a trademark belonging to someone else. The cybersquatter then offers to sell the domain to the person or company who owns a trademark contained within the name at an inflated price. Earlier the domain name registration system was not interested in trademark issues and started to give domain names on —first come first served|| basis.

The term is derived from "squatting", which is the act of occupying an abandoned or unoccupied space or building that the squatter does not own, rent, or otherwise have permission to use Cybersquatters usually ask for prices far greater than that at which they purchased it. Some cybersquatters put up derogatory remarks about the person or company the domain is meant to represent in an effort to encourage the subject to buy the domain from them.<sup>9</sup>

The domain name serves dual purpose. It marks the location of the site within cyberspace, much like a postal address in the real world, but it may also indicate to users some information as to the content of the site, and, in instances of well-known trade

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<sup>8</sup> <http://www.wipo.int/amc/en/domains/rpm/>

<sup>9</sup> <http://heinonline.org/HOL/LandingPage?handle=hein.journals/usflr33&div=29&id=&page=>

names or trademarks, may provide information as to the origin of the contents of the site.<sup>10</sup>

Thus cybersquatting is the act of acquiring a domain name which may cause the consumers to associate with the origin of a trademark but which does not have any kind of connection with the purchaser in the first place, with bad faith to profit from re selling it to the original trademark owner for a higher price, profiting from such re selling. Cyber squatters may sometimes use the trait of using the domain name for their purpose, where a unintended consumer may on landing on the domain name, web site might see inappropriate content thereby losing hope and trust on the original trademark of the original producer or manufacturer.

### **DOMAIN NAME DISPUTES IN INDIA:-**

The first ever case that India faced in respect of domain name disputes was that of *Satyam Infoway Ltd<sup>11</sup>. v. Sifynet Solutions Pvt. Ltd<sup>12</sup>*. The principal question raised in this appeal was whether internet domain names are subject to the legal norms applicable to other intellectual properties such as trade marks? The city civil court judge decided in favour of appellants and allowed the application for temporary injunction on the following grounds:

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<sup>10</sup> Peter Brown, *New Issues in Internet Litigation, in 17TH ANNUAL INSTITUTE ON COMPUTER LAW: THE EVOLVING LAW OF THE INTERNET-COMMERCE, FREE SPEECH, SECURITY, OBSEINITY AND ENTERTAINMENT*, at 151, 156 (PLI Pats., Copyrights, Trademarks, and Literary Prop. Course, Handbook Series No. 471, 1997), *quoted in* Panavision Int'l L.P. v. Toeppen, 141 F.3d 1316, 1327 n.8 (9th Cir. 1998).

<sup>11</sup> AIR 2004 SC 3540

<sup>12</sup> The appellant which was incorporated in 1995 registered several domain names like www.sifynet, www.sifymall.com, www.sifyrealestate.com etc. in June 1999 with the internationally recognised Registrars, viz the internet Corporation for Assigned Names and Numbers (ICANN) and the World Intellectual Property Organisation (WIPO). The word 'Sify' is a coined word which the appellant claims to have invented by using elements of its corporate name, Satyam Infoway. The appellant claims a wide reputation and goodwill in the name 'Sify'. The respondent started carrying on business of internet marketing under the domain names, www.siffynet.net and www.sijfynet.com from 5th June 2001. The respondent claims to have obtained registration of its two domain names with ICANN on 5th June, 2001 and 16th March, 2002 respectively. Coming to know of the use of the word 'Siffy' as part of the respondent's corporate and domain name, the appellant served notice on the respondent to cease and desist from either carrying on business in the name of Siffynet Solutions (P) Ltd. or Siffynet Corporation and to transfer the domain names to the appellant. The respondent refused. The appellant filed a suit in the City Civil Court against the respondent on the basis that the respondent was passing off its business and services by using the appellant's business name and domain name.

- Appellant was the prior user of the trade name ‘Sify’;
- Appellant had earned good reputation in connection with the internet and computer services under the name ‘Sify’, and
- Respondent’s domain names were similar to the domain name of the appellant and that confusion would have been caused in the mind of the general public by use of such deceptive similarity.

Aggrieved by the decision of the City Civil Court, the Respondent approached, the High Court, which reversed the order of the City Civil Court. The matter was taken up to the Supreme court by way of a special leave application and the the hon‘ble supreme Court held that:

- The use of similar domain name may lead to diversion of users as ordinary customers seeking to locate the functions available under one domain name may be confused with another domain name which may offer dissimilar services. Thus, the customers may conclude misrepresentation, which will result in loss of customers.
- Further, a use of similar domain name has all the ingredients of a passing off action, such as preservation of reputation and goodwill, safeguarding the public, misrepresentation by the defendant, loss or likelihood of loss. Thus, the Hon‘ble Supreme Court held that that a domain name may have all the characteristics of a trade mark and one can also file an action for passing for the same.

Thus the domain names were treated as trademark and its contemporary on the virtual world. The issues relating to domain name disputes were treated as disutes under the trademarks law under the common law remedy of passing off<sup>13</sup>

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<sup>13</sup>The action against passing off is based on the principle that —a man may not sell his own goods under the pretence that they are the goods of another man. (N. R. Dongre v. Whirlpool Corporation, (1996) 5 SCC 714) Passing off is a species of unfair trade competition by which one person seeks to profit from the reputation of another in a particular trade or business. A passing off action is a direct subject matter of the law of tort or common law of right, i.e. case law.

## ICANN AND UDRP

ICANN first commissioned the UN organ WIPO to produce a report on the conflict between domain names and trademarks. On 30 April, 1999, WIPO published a report recommending the establishment of a mandatory administrative procedure concerning the abusive registrations of domain names.

Following adoption by ICANN, the UDRP<sup>14</sup> was launched on 1 December 1999, and the first case determined under it by WIPO was World Wrestling Federation Entertainment, Inc v. Michael Bosman, involving the domain name —worldwrestlingfederation.com

Under this policy a trademark holder can initiate a proceeding against a domain name registrant, if he considers that a domain name registration infringes its trademark.

Under the UDRP complainant has to file the complaint giving the details of the domain name in question, the registrant of the domain name (respondent), the registrar with whom the domain name was registered and the grounds for the complaint. The grounds should qualify the central criteria i.e. the way in which the domain name is identical or similar to a trademark to which the complainant has rights; why the respondent should be considered as having no rights or legitimate interests in respect of

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<sup>14</sup>The **Uniform Domain Name Dispute Resolution Policy** (UDRP), which was proposed by WIPO in 1999 and has become accepted as an international standard for resolving domain name disputes outside the courts, is designed specifically to discourage and resolve the abusive registration of trademarks as domain names, commonly known as cybersquatting. Under the UDRP, a complainant must demonstrate that the disputed domain name is identical or confusingly similar to its trademark, that the respondent does not have a right or legitimate interest in the domain name and that the respondent registered and uses the domain name in bad faith.

Disputes are decided by independent panelists drawn from the WIPO Center's global list of trademark specialists.

The domain name registration in question is frozen (suspended) during the proceedings. After reviewing a case, panelists submit their decision within a period of 14 days. If a panelist's decision to transfer a domain name is not challenged in a competent court within a period of ten business days, the registrar is legally bound to implement the panelist's decision. The entire case normally takes no more than about two months.

In the process of arbitration the person does not need to follow US law because ICANN does not follow US law and in case of cc TLDs the dispute resolution policies of each country has to be followed

the domain name that is the subject of the complaint; and why the domain name should be considered as having been registered and used in bad faith<sup>15</sup>

**UDRP** arbitration is a much easier option for the person and one person has to prove 3 things -the domain name is similar or confusingly similar - it is used by the infringer in bad faith -the person/ infringer has no legitimate interest in the domain name<sup>16</sup>.

### **INDRP POLICY**

The Arbitrator<sup>17</sup> shall conduct the Arbitration Proceedings in accordance with the Arbitration & Conciliation Act 1996 as amended from time to time and also in accordance with this Policy and rules provided for the same

The circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name ; the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or

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15 <http://www.mondaq.com/india/x/519662/Trademark/Domain+Name+Laws>

16 In late 2004, the Indian legislature introduced a significant change in the administration of the .INRegistry. The INRegistry is now the official .IN domain name Registry. '.in' is India's top-level domain on the internet. The INRegistry is operated under the aegis of the [National Internet Exchange of India](#) (NIXI). The Registry has issued the .IN Dispute Resolution Policy (INDRP), pertaining to resolution of domain name disputes between the registrants of NIXI

17 The .IN Registry appoints an Arbitrator out of the list of arbitrators maintained by the Registry. The List of the Arbitrators shall be published on line by the .IN Registry on its website at [www.registry.in](http://www.registry.in).

mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location are verified for determining the domain name disputes.

## **CONCLUSION :**

Driven by the pressures of globalization and the borderless nature of cyberspace, governments and private parties will expand their efforts to transcend the limits of existing dispute settlement paradigms. Therefore, the UDRP must be evaluated not only as a vehicle for the resolution of conflicts between domain names and trademark rights—important though that issue is in a digital economy—but also as the likely default mechanism for more broad-based non-national lawmaking and dispute settlement. Of necessity, the nature of disputes in the digital era required the formation of a hybrid decision-making structure..

UDRP though having advantages of speed and global reach must also see that the checking mechanisms are up to date with the technology and the connection with the non – national governors governing them. The guardians of the UDRP, and the drafters of any non-national structures that follow it, must embrace the challenge of constructing new forms of control. If they do not, the potential for new models that match our increasingly non-national world will be diminished by competing assertions of national sovereignty, allegations of institutional capture, and justified complaints of illegitimately expansive lawmaking.<sup>18</sup>

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<sup>18</sup>[https://www.bc.edu/dam/files/schools/law/lawreviews/journals/bclawr/43\\_5/06\\_TXT.htm](https://www.bc.edu/dam/files/schools/law/lawreviews/journals/bclawr/43_5/06_TXT.htm)