

THE CONTRADICTION BETWEEN INTELLECTUAL PROPERTY RIGHTS AND THE INTERNET: LAWS INVOLVED

Written by Arvind. M

2nd Year BBA LLB Student, Christ (deemed to be University)

ABSTRACT

The invention of internet brought out a whole new scope for law: that being, Cyber law. Other international laws have been enacted to tackle the issues that arise in the virtual world. The purpose of this article is to portray the laws regarding domain dispute cases in India and similar laws on the international board. In the current world, there are about 3.79 billion web users and more than 330.6 million domain names registered. Each time a domain is registered, a problem of having two highly similar sounding or even similar words arises. In such a situation, there will be conflicts over domain names or other such IPR disputes on the internet. Therefore, the ICANN was founded. ICANN - the Internet Corporation for Assigned Names and Numbers, checks and keeps control of these differences arising in the spectrum of domain name and other internet related cases. The spectrum includes not just trademark infringement cases but, also patent and copyright infringement cases too. In India, for domain disputes, bringing an arbitration proceeding under ICANN's rules, or bringing a lawsuit in a court of law is a viable option as per Uniform Domain Name Dispute Resolution Policy. Cybersquatting, inter alia, is a an issue arising out of trademark infringement as such is a major issue for any mega corporate or, basically, a corporate that is popular in the society.

RESEARCH METHODOLOGY:

The Author has employed empirical method for the writing of this article. Information is gathered from primary sources such as books and articles and other sources like original websites of certain institutions.

INTRODUCTION:

The internet was an era-defining invention. It has changed the lives of people significantly, both positively and negatively. Little was known that it had the potential to be a double-edged sword before its creation. But when the issues started coming up, the need for laws rose with it. The article aims to address the issues along with the laws enacted to tackle it and thereby, making the attempt to bring out the issues and its laws to the light.

DOMAIN NAME AND DOMAIN NAME SYSTEM:

A website is a commonly known term in the internet. Technically, it is known as a domain. A domain name is, basically, a business's address on the cyberspace. They are alphanumeric addresses used to locate platforms on the internet. Simply put, a domain name is a name tag that businesses use so that consumers of their product/ services can identify them distinctively. Technically speaking, a domain name serves the purpose of user-friendly identification wherein, the systems consider the IP (Internet Protocol) Address for recognition within the servers. An IP Address is a numerical label assigned to every computer network for communication. The internet uses the domain name system to recognize different websites. Before, knowing what the domain name system is, knowing what a TLD (top-level domain) is required. A TLD is the suffix that comes after a domain name. For example, the google company has its web address as www.google.com. The middle part is the alphanumeric combination which the owner chooses. Which means that, they can not only be names, but also in numbered combinations with words (for e.g: www.movies123.com). The last part of the illustrated website is '.com'. This is known as a gTLD (generic top level domain). Other such gTLDs are .org, .net, .gov and .edu. Sometimes, businesses also use ccTLD (country code top level domain) such as .in (India), .de (Germany), .fr (France) etc. These TLDs identify the purpose for which the website is set up for. For instance, if .com is used, then it means that the website has mostly commercial purposes and if it is '.gov', then it's for government related purposes. In other words, it is for easy network management. The domain name system is the system on which the internet works. That is, it is the traffic routing factor on the internet. DNS routes a computer's search for a website through servers which in turn redirects it towards the registrar of the particular TLD to recognize the domain name. In other words, the DNS maps the route for a computer to access the website. Since the invention of the internet, there have been a rapid increase in the number of domain names registered. Currently, there are about

3.79 billion web users and more than 330.6 million domain names registered.¹ Each time a domain is registered, there is a problem of having two very similar sounding or even similar words with typographical errors (typo squatting) for the purpose of use of the website in bad faith use or for abusive registration of the domain by the business (cyber-squatting). In such a situation, there will arise conflicts, conflicts of domain name claims and trade mark cases relating to that of the domain names. The problems arise in the ‘grey area’ which is between the purpose for which the DNS was designed and for which the IPR (Intellectual Property Rights) exist.² In most cases, the victims are usually well-known companies or businesses or upcoming businesses in the market. They become targets as they fall under the scope of vulnerability while growing. Cybersquatting becomes a major issue for well-known companies as they risk the chance of losing their goodwill. A solution for this issue may be exclusion from one or more TLDs.³ That is, a well-known company that possess the requirements for applying for exclusion, can exclude its domain name from the (registrar’s) registries so that no other person can claim a website for a well-known business by creating a domain in a different TLD. This also applies any new gTLDs that may be created in future. In cases regarding the issues stated earlier, the victim usually can sue for remedy for infringement, dilution or passing off the trademark.

AN INDIAN OVERLOOK:

In India, there are no such regulations that would specifically regulate domain name related cases. However, it does not mean that no effort should be made within the scope of the existing laws to provide remedy to best possible extent. Clause (k) of paragraph 4 of the Uniform Domain Name Dispute Resolution Policy states that

“the mandatory administrative proceeding requirements shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded”.⁴

¹ VERISIGN, Domain-name, Verisign blog (Feb. 05, 2018, 5:48 PM), <https://blog.verisign.com/domain-names/verisign-domain-name-industry-brief-internet-grows-to-330-6-million-domain-names-in-q1-2017/>

² Rodney D. Ryder, Intellectual Property and the Internet 97 (Ed. 1 LexisNexis, 2002).

³ Id. At 2

⁴ Satyam Infoway Ltd. v. Siffy solutions Ltd., 2004 Supp(2) SCR 465

In the case of *Satyam Infoway Ltd. v. Siffy solutions Ltd.*, 2004 Supp (2) SCR 465, the Court, inter alia, held 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”. In the Trademarks Act of 1999, Sec. 2 (1) (h) defines ‘deceptively similar’. It defines it as something that looks deceptively like another product or resembles another mark to cause confusion or deceive the consumers of that product or service. This clause defines an infringement of trademark rights with regard to internet. A domain name that is designed to deceptively look like the trademark of another business to deceive the consumers is an infringement of the intellectual property rights of the business. According to Sec. 2 (i) (v), ‘false trade description’ means the use of any false name or initials of a person as a trade description and the fact that a trade description is a trademark or part of a trademark shall not prevent use of such trade description within the meaning of the act. When this is read with the sub clause (c) , it implicitly conveys the definition of tort of dilution. Section 2 (1) (zg) defines what a well-known trademark is. A well-known trademark is a mark that may or may not be registered (as a trademark) but, is a very popular or well-known mark or the use of it by a company, that by natural law, acquired a distinction by itself and has certain, but not all, rights conferred under the concerned legislations. This aspect can be compared to well-known trademarks of a company that already have a distinction in the eyes of the consumers and the owner of such trademark professes some, arguable, rights over its unregistered trademark description (domains) on the internet. Sec. 135 of Chapter XIII of the same Act describes the reliefs that are available for suits filed for infringement or passing off. Clearly, remedy is provided in this section that can be directly related to the violations of intellectual property rights on the internet. So, the Trademarks Act of 1999 provide a substantive support to protect the Intellectual Property Rights with regard to the internet. It is substantive to the international laws that were enacted.

PARADIGM SHIFT TO THE INTERNATIONAL PERSPECTIVE:

Overtime, the number of domains that were registered increased rapidly. And along with it, the chance of identical domain names being registered as intellectual property also increased tremendously. A regulatory body was thus established on the international arena on November

16th, 2000. It was known as ICANN (Internet Corporation for Assigned Names and Numbers). The home page of ICANN mentions its purpose as follows:

‘In more technical terms, the Internet Corporation for Assigned Names and Numbers (ICANN) helps coordinate the Internet Assigned Numbers Authority (IANA) functions, which are key technical services critical to the continued operations of the Internet's underlying address book, the Domain Name System (DNS). The IANA functions include: (1) the coordination of the assignment of technical protocol parameters including the management of the address and routing parameter area (ARPA) top-level domain; (2) the administration of certain responsibilities associated with Internet DNS root zone management such as generic (gTLD) and country code (ccTLD) Top-Level Domains; (3) the allocation of Internet numbering resources; and (4) other services.’⁵

In other words, the ICANN is a coordinating factor for the, previously mentioned, traffic routing mechanism, the Domain Name System. Another authority known as the IANA (Internet Assigned Numbers Authority) is mentioned in the purpose of ICANN stated above. The IANA is responsible for the coordination of key elements required for the internet to run smoothly, the DNS. Conclusively, the ICANN founded the IANA to coordinate the key component (DNS) of the internet. So, if any domain name conflicts arise within the domain name system, then that issue is flagged by the IANA and such disputes may be addressed in the dispute resolution board created by the ICANN known as WIPO. WIPO is the abbreviation of the World Intellectual Property Organization. The WIPO serves as a dispute resolution agent in any cases wherein the dispute arises when Intellectual Property Rights contradict with the internet. It provides mediation and arbitration for such issues. But, that is not the only purpose of it. The WIPO is also an international forum for discussions regarding any policy formation in the intellectual property field. Moreover, it is also a registrar listed under the ICANN for registering domains. For instance, instead of filing an application for the other kinds of intellectual properties with other registrars (assigned registering authorities), the WIPO serves as a substitute platform wherein a unified application for other such intellectual properties can be filed at a single source which uniformly applies for other such intellectual properties with other registrars. That is, a universal registration can be made through WIPO. As mentioned

⁵ The purpose for which the ICANN was established is mentioned in its home page. For more information regarding the same, visit <https://www.icann.org>.

earlier, the ICANN maintains and updates the list of registrars of domains over due course of time. For its dispute redressal guidelines, the WIPO relies on a policy created by ICANN for this purpose. It is known as the Uniform Domain Name Dispute Resolution Policy (UDRP).

The UDRP was adopted on August 26th, 1999. The main purpose for creating this policy was to be a guideline for the dispute resolution boards such as WIPO. The UDRP was established for resolving any disputes that might arise from the domain name conflicts. Paragraph 1 of the policy, in fact, states the purpose. It is: ‘to set forth terms and conditions in connection with a dispute between you and any party other than us (registrar) over the registration and use of an internet domain name registered by you’.⁶ The same paragraph also mentions that paragraph 4, contains the procedures by which the disputes will be resolved. One of the steps that the policy takes to make sure to avoid obvious violations of the laws established is through the paragraph 2 of the policy. This para states the conditions to be agreed upon by the applicant before registering a domain name or asking to maintain a domain name or renew a domain name registration. Clause (a) states that the statements made by the applicant in the registration agreement are complete and accurate. Clause (b) is to make sure that to the extent of the knowledge of the applicant, the registration doesn’t infringe upon the trademark of another or even violate such rights of a third party. Clause (c) mentions a confirmation that is to be made stating that the domain name is not being registered for an unlawful purpose, and clause (d) states that the applicant must not use the domain name in violation with any other applicable laws or regulations and also that the responsibility of determining for what use the domain name is put into depends upon the applicant - whether he infringes or violates a third party’s rights anyhow. However, a point to be noted is that the registration of a domain name is not untethered from any objections from the side of the registrar. Paragraph 3 states the circumstances under which the registrar can ‘cancel, transfer, or otherwise make changes to the domain name registrations’⁷ authorized under the UDRP. As mentioned while stating the contents of paragraph 1 of the policy, paragraph 4 states the procedure by which the domain name cases are to be dealt. Clause (a) of the paragraph states the conditions by which a domain case or such cases like intellectual property rights in relation to the internet is applicable in a Court of law. The clause states: ‘You are required to submit to a mandatory administrative

⁶ [Uniform Domain Name Dispute Resolution policy, ICANN \(Feb. 06, 2018, 4:12 PM\),
https://www.icann.org/resources/pages/policy-2012-02-25-en#3](https://www.icann.org/resources/pages/policy-2012-02-25-en#3)

⁷ Id. At 6

proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure'. Meaning, whenever there is a dispute between a two parties with regard to a domain dispute (for example), can file a suit under the paragraph 4. Clause (b) of the paragraph 4 states the requirement of the evidence of registration for a domain name dispute case in the court. It also mentions some of the examples of bad faith registration of domain names such as abusive registration of domain name (Cybersquatting) and for the purpose of paragraph 4 (a)(iii) the following is stated, exactly as it is in the policy:

‘(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location’.⁸

Any cases that may come to fall under the above stated situations will be considered as cases of bad faith. Such cases shall be decided, either, by way of mediation or by arbitration, under the supervision of a dispute resolution agent (such as WIPO itself). Clause (c) states that the respondent, when a domain name dispute case filed against him by the complainant, should demonstrate his legitimate interest in the disputed domain name. Lack of proving such interest will tip the judgment in favor of the complainant slightly. And if any such legitimate interest is present, the respondent should file his statement as per paragraph 5 of the rules of procedure.

⁸ Id. At 6

This is to determine how the response should be prepared. Clauses (d) to (g) contain the procedures regarding the dispute redressal by the dispute resolution agent. And to various cases that are filed for more reasons other than bad faith use of domain name, the court or the resolution agent shall provide the complainant with the remedies that are stated in clause (i) of the paragraph 4. The most important of all clauses in this paragraph, is clause (k). This clause says that in case the parties that do not file a case under paragraph 4, it can file a case in front of another competent court of law or any other such independent resolution board either before the commencement of hearing of the case or after the hearing of the said case, if either of the parties are not satisfied with the judgment of the board. After paragraph 4, it can be understood that the mandatory administrative proceedings which was undertaken, is usually done with a dispute resolution agent sauce as WIPO itself. However, paragraph 5 states that other such litigations that wasn't brought under the mandatory administrative proceeding of paragraph 4, can be resolved in any other court of law or personally by settlement if the issue between the parties involved itself. The paragraphs and its clauses stated above, clearly, deal with the issues wherein it rises from the contradiction of the intellectual property rights of a person and the internet, effectively. The rules mentioned in the UDRP were enacted especially for the purpose of tackling these issues. With the overshadowing evidence of past cases heard using the UDRP as a tool, it can be said that the purpose is being fulfilled.

CONCLUSION:

The trademarks Act of 1999, a domestic law of India, did prove to provide a substantive protection to the intellectual property rights of a person on the cyber space. The protection of intellectual property rights such as trademarks, patents, copyrights etc., on the internet is a difficult task because, the internet evolves by the minute. And, so does the opportunity for a cyber predator to cause troubles. Issues will not stop coming and when they arise, laws like the UDRP have to be enacted to tackle the problems. At the end of this article, an apparent question may be asked, if the issues that arise are in relation to the internet, why were the cyber-crime related laws not mentioned in this essay? It is true that the issues that arise are in relation to the internet. But that is not the only area the issues can be classified under. The point to be considered is that the issues pose a threat to the protection of intellectual property rights in the internet and not just 'crimes on the internet'. It can be said that the issues mainly lie in the vicinity of intellectual property rights. The cyber laws can be evoked in certain circumstances

such as deciding upon the punishment for the crime committed but the procedure and other aspects of the suit filed should be in based on the intellectual property laws. Thus, the article mentions the domestic laws that aid in the protection of IPR along with the international counterpart to effectively portray the laws that deal with the issues that would arise when there would be a contradiction of intellectual property rights with the internet.