

TRADEMARK LAW IN CYBERSPACE: PROTECTION TO INTERNET ADDRESS

Abstract

Trademark has been a hot property on the Internet since its inception. Internet, today, has not just provided a great platform to the users for educational purpose but also for business purpose. It has now provided a great economic value to the online business but at the same time it is also exposed to many ways in which it provides these online business holders at a risk. For having a distinct market in the cyberspace, just like trademarks, some alphanumeric characters are given which are 'Internet Domain Names' and the risk associated with these domain names are known as Domain Name Disputes. Through this paper the author has tried to analyze the relation of Internet Domain Names with trademark and how the domain name disputes come into play with it. The main purpose that this paper holds is to analyze the issue of cyber squatting and other similar domain name disputes. The research paper also discusses the legal position under trademark law for protection of trademark in cyberspace. As the trademark laws are territorial in nature, so the paper also discusses the issue of inadequacy of laws for dealing with this matter. It further outlines as to how UDRP (Uniform Dispute Resolution Policy) deals with the same situation at an extra-territorial level according to the mechanism provided by ICANN (The Internet Corporation for Assigned Names and Numbers). The paper concludes by providing some suggestions as to how Indian Trademark Laws can make the working of UDRP better by working on its own laws.

CHAPTER 1: INTRODUCTION TO TRADEMARK LAW W.R.T. DOMAIN NAMES

The history of trademark law to the cyberspace can be associated with the creation of the World Wide Web (www) which certainly created a link of trademark law with Internet domain name disputes. And it has created a buzz amongst users as commercialization of the Internet medium. Thousands of businesses have established storefronts on the Internet to disseminate marketing literature, offer customer service, and sell goods and services online. Not surprisingly, due to this commercialization factor, there is an increasing relation between trademark law and domain names.¹ As a consequence, the following dynamic growth of the World Wide Web has issued new challenges to the intellectual property consultants concerning trademark infringement.

For trademark owners, internet is a profitable platform, but in certain cases, it turns out to be problematic in their business growth. These trademark owners often have to deal with certain domain name disputes inflicted by the third party like cyber squatting etc but in India, we per say do not have any Domain Name Protection Law so the cases relating to cyber squatting are decided under Trade Mark Act, 1999.

Under the current law, section 29² provides for the protection of registered trademark and the protection for unregistered trademark has been provided in section 32³. However, the act is silent on the protection for trademarks infringement in the cyberspace. The majority of domain name disputes seem to involve trademarks as it is submitted that the dispute arises with the registration or use of the domain name which infringes any legally recognized right, such as any trademark right, common law right in passing off, or any other right for that matter.

As trademark laws are territorial in nature but internet in the global domain so the dispute involving bad faith registrations are typically resolved using the UDRP (Uniform Domain Name Dispute Resolution Policy) process which is developed by the ICANN. Under UDRP, WIPO happens to be the leading ICANN accredited domain name dispute resolution service provider which was established as a tool for promoting the protection, dissemination, and the use of intellectual property throughout the world.⁴ Since TRIPS agreement provides for only

¹ Murugendra B. Tubake; US and Indian Trade Marks Law: A Comparison; PL February S-1 Introduction (2012).

² Trademark Act, 1999, Intellectual Property Laws, Universal Law Publishing, (2015).

³ *Ibid.*

⁴ The Uniform Domain Name Dispute Resolution Policy and WIPO; © World Intellectual Property Organization, (2011).

minimum standards so, there exists similarity up to some extent in the domestic IP laws and except these principles there are hardly any laws which are uniform, and as a result of which there exist some advantages and disadvantages of nation over other nations IP laws.⁵

⁵ *Supra* note 1.



CHAPTER 2: DISPUTES RELATING TO TRADEMARK IN INTERNET DOMAIN NAME

Let's start with the question why do domain names need a legal protection? On one hand, domain names provide great economic value to the online business and on the other, these names are exposed to many ways in which it puts domain names at risk. The risk particularly includes;

a) "Cyber squatting"⁶ which is a registration of a domain name by someone who lacks a legitimate claim with the intent to

- (i) sell the name,
- (ii) prevent the trademark holder from gaining access to the name, or
- (iii) to divert traffic

who occupy a name hoping that a trademark owner will make an offer for it"⁷. For instance, in the case of '*Green Products Co. v Independence Corn By-Products Co.*'⁸ (ICBP), here both the companies were competitors to each other in the market of corncob by-product. ICBP got the domain name (greenproducts.com) registered but did not post a website as yet. The court held that the intention of ICBP was to use its confusing domain name to lure potential customers to the site once it was created and wanted to be benefited unjustly from the use of Green Product's name. Court further said that consumers might not get confused after getting to the site but even after it, they may buy the product from ICBP's site only. On these findings, the court found it to be infringement.

b) Reverse Domain Name Hijacking; done by people who register confusingly similar versions of domain names, pointing them to gripe sites that carry some other propaganda⁹;

c) Typo-Squatting; done by people who register the domain names incorporating variations of well-known trademarks terms such as misspellings¹⁰ (micr0soft.com) or adding of prefixes or suffixes to the existing domain name (yahooindia.com) and use them for websites to take advantage of unwary Internet users.

⁶ Sourabh Ghosh; Domain Name Disputes and Evaluation of The ICANN's Uniform Domain Name Dispute Resolution Policy, Journal of Intellectual Property Rights, Volume 9 (2004).

⁷ Mohammad S. Al Ramahi; Internet domain names & Trademark Law: Does the current legal scheme provide an adequate protection to domain names under the US & the UK jurisdictions? (2006).

⁸ No. C-97-177-MJM.

⁹ Chiramel; THE DOMAIN NAME CHAOS- A LEGAL PERSPECTIVE (2011). Also available at: http://www.vaishlaw.com/article/information_technology_laws/the_domain_name_chaos.pdf?articleid=100324

¹⁰ *Supra* note 7.

*Yahoo Inc. Corporation v Akash Arora*¹¹ is the first case in which the Indian Court that discussed the issues revolving services offered through the Internet. The plaintiff, in this case, submitted that they had the registration of the domain name yahoo.com with Network Solutions Inc. and had registrations of the same in more than 69 countries. The defendant contended that he had provided a disclaimer in his website which avoided the confusion, also, that yahoo is a dictionary word and could not be protected but the High Court of Delhi held that the marks were similar and disclaimer does not help as people still would associate it with the original yahoo, administratively or economically. Furthermore the word yahoo was protected as it was a well known trademark used by the Plaintiff and was distinctive.

The main problem regarding this dispute arises with Cyber Twins¹² which occurs when both the domain name holder and the challenger have a legitimate claim to a domain name then they are known as cyber twins.¹³ The cases involving cyber twins are the most difficult to be resolved, because, the law of trademark and unfair competition may otherwise allow both parties to enjoy concurrent use of both. These kinds of disputes also happen at two different levels; firstly, when the same mark owned and used by different persons in respect of different goods or services 'specialty'. Secondly, when the same mark owned and used by different persons in different countries in relation to the same goods or services 'territoriality'.¹⁴

In *Data Concepts, Inc. v Digital Consulting Inc.*,¹⁵ both the entities had a legitimate claim for the domain name of (dci.com) as both of them had trademark rights for DCI. Data Concepts, however, got the trademark dci.com registered in 1993. It would seem that, in the cases where both have claims then the entity first to register would get it but The Sixth Circuit ruled that there still was possibility of infringement. Since trademark infringement is a question of fact as well as question of law, the dispute must go to a full trial for an infringement determination. In this case, due to lack of evidence and the fact that Digital had no knowledge of prior existence of Data dismissed the matter as Data could not establish that dci.com was confusing the users between the two marks.¹⁶

¹¹ 78 (1999) DLT 285.

¹² *Supra* note 6.

¹³ *Ibid.*

¹⁴ *Supra* note 7.

¹⁵ 150 F.3d 620, 625 (6th Cir.1998).

¹⁶ *Ibid.*

CHAPTER 3: RELATION OF DISPUTE RESOLVING BETWEEN UDRP AND THE COURTS

The UDRP is applicable to second-level domain name registrations in 14 following gTLDs naming: .aero, .asia, .biz, .cat, .com, .coop, .info, .jobs, .mobi, .museum, .name, .net, .org, .pro, .tel and travel.¹⁷ But policies and procedures other than the UDRP are only applicable to some of the above-mentioned gTLDs. For example, there are two dispute resolution policies potentially applicable to second-level domain name registrations within the .name space, one being the UDRP and the other the Eligibility Requirements Dispute Resolution Policy (ERDRP)¹⁸ which is rarely used by the Indian registrants. To succeed under the UDRP, a complainant must establish the following three elements:

- (i) “That the domain name is identical or confusingly similar to a trademark or service mark of the complainant;
- (ii) That the registrant has no rights or legitimate interests in the domain name; and
- (iii) That the registrant has registered and used the name in bad faith”¹⁹

The process of getting redressed under UDRP is conducted online with a single electronic and hard copy document submission of facts and legal arguments which makes the process simple and easily accessible. Service of process can be achieved by email to the address in the registrar’s record.²⁰ Under the rules of UDRP, the panelists take their decisions on whichever law they think as fit in a particular case.

But despite its obvious achievement, lack of oral testimony and rules of evidence in these paper proceeding makes it difficult to evaluate the disputed facts and ascertain the credibility of the evidence produced. Panelists deliver the judgment only on the evidences produced in front of them, so they have to regard that as reliable where there is lack of documentary evidence even in the cases of legitimate interest. So is it not necessary that same or right conclusion is reached in this type of Resolution Policy as the decision in UDRP or courts would differ according to where better evidences are put forth.²¹ Moreover the decision of the UDRP is not binding on the courts of land which sometimes turn to be defeating the very initiation of decision by UDRP and the trademark owners are the victims of such thing. As also seen, in the case of *Referee*

¹⁷ © World Intellectual Property Organization (August) 2011.

¹⁸ *Ibid.*

¹⁹ Rule 4, UDRP Rules World Intellectual Property Organization (August) 2011.

²⁰ Levy, J., “Precedent and other problems with ICANN’s UDRP Process”, April 2001 Domain Name Law Reports (2001).

²¹ Penguin Books Limited v The Katz family and Anthony Katz, WIPO D 2000 – 0204 (2000).

*Enterprises Inc. v Planet Ref. Inc.*²², where the dispute was between the magazine publisher and another publisher on online medium, the plaintiff initiate the UDRP proceedings in the basis of his ownership on the term referee as hid magazine title, challenging his rivals mark “ereferree” on domain name, the panel negated the complaint on the ground that the word used by the plaintiff is the word which is generic in nature the publisher subsequently filed the case against the inferior alleging him violating the federal trademark law, the court in response granted the preliminary injunction which was broad to the extent that it prohibited the defendant to use all the domain names having the word in dispute court did not take the notice of UDRP proceedings and did not mention the decision in its ruling. Furthermore in a case where the applicant brought the subsequent suit in the court after being defeated in the UDRP proceedings, the trademark owner moved to dismiss the action on the grounds that it do not have sufficient grounds to vacate arbitral award of UDRP, the court denied this argument by saying that Federal Arbitration Act do not applies to the UDRP proceedings.²³

One of many examples of failure of the mechanism is the case *Maruti.com et al. v. Maruti Udyog Ltd. et al*²⁴, where Maruti Udyog, an Indian Company which has its reputation with its name in India had also registered its domain name in the United States with marutiudyog.com. the respondent got the domain name as “maruti.com”. When the plaintiff made a complaint before WIPO panel, the decision was made in favour of Udyog. Also, the respondent had got stamped as a cyber squatter 3 times by the WIPO panel in WIPO arbitration cases filed by Onida, Hero Honda and Maruti. Yet when the case approached the United States courts, the WIPO panel decisions were considered non binding. Even the United States Anti Cybersquatting Consumer Protection Act was said not to have applied. The court held that, as Maruti did not manufacture or sell its cars in the United States and so were not entitled to protection under their land law of trademark i.e. Lanham Act, 1946.²⁵

²² No. 00-C-1391 (E.D. Wis. Jan. 24, 2001)

²³ Shreya Chaddha; IP Valuation and Management Project On "A Critical analysis of domain names dispute resolution policy, with special emphasis on Uniform domain name resolution policy".

²⁴ U.S. Dist. Ct. No. L- 03-1478.

²⁵ *Supra* note 9.

CHAPTER 4: POSITION IN INDIA

Another issue that needs to be addressed is ‘Are the trademark law in the country adequate to resolve the matter?’

According to the court in the case of *Satyam Infoway Ltd v. Sifynet Solutions (P) Ltd*²⁶ case nailed the Indian domain name scenario way back in 2004 stating 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.”*²⁷

In India, since, there exists no direct law to wrestle the threat of such disputes; hence courts have largely used the principle of passing-off.²⁸

It is interesting to note that despite the fact that the national court framework is not bound by the decision of WIPO Arbitration Panel, they still have made various findings and judicial decisions based on the ICANN’s UDRP Policy which shows that the courts find the policies and decisions of the UDRP to be of sound authority on the matter in hand. One of the examples demonstrating the same is *Manish Vij v. Indra Chugh*²⁹, in this case, the plaintiff was dealing with second hand good on the internet with the trademark and domain name “www.kabadibazaar.com”. Within the same month when plaintiff had started operating, defendant came up with “www.kabarribazaar.com” and claimed wider reputation amongst the public than that of plaintiff’s. The plaintiff approached the WIPO Uniform Dispute Resolution Policy, 1999, and argued that the registration of the domain name “www.kabaribazaar.com” by the defendants was done with a malafide intention. The panel held that it was not possible to prove that the registration of the domain name was in a bad faith as “Kabadi- bazaar” is a common term in the hindi language and so the plaintiffs domain name had not acquired a

²⁶ AIR 2004 SC 3540.

²⁷ *Ibid.*

²⁸ Rediff Communication Limited v Cyberbooth (1999 (4) BomCR 278).

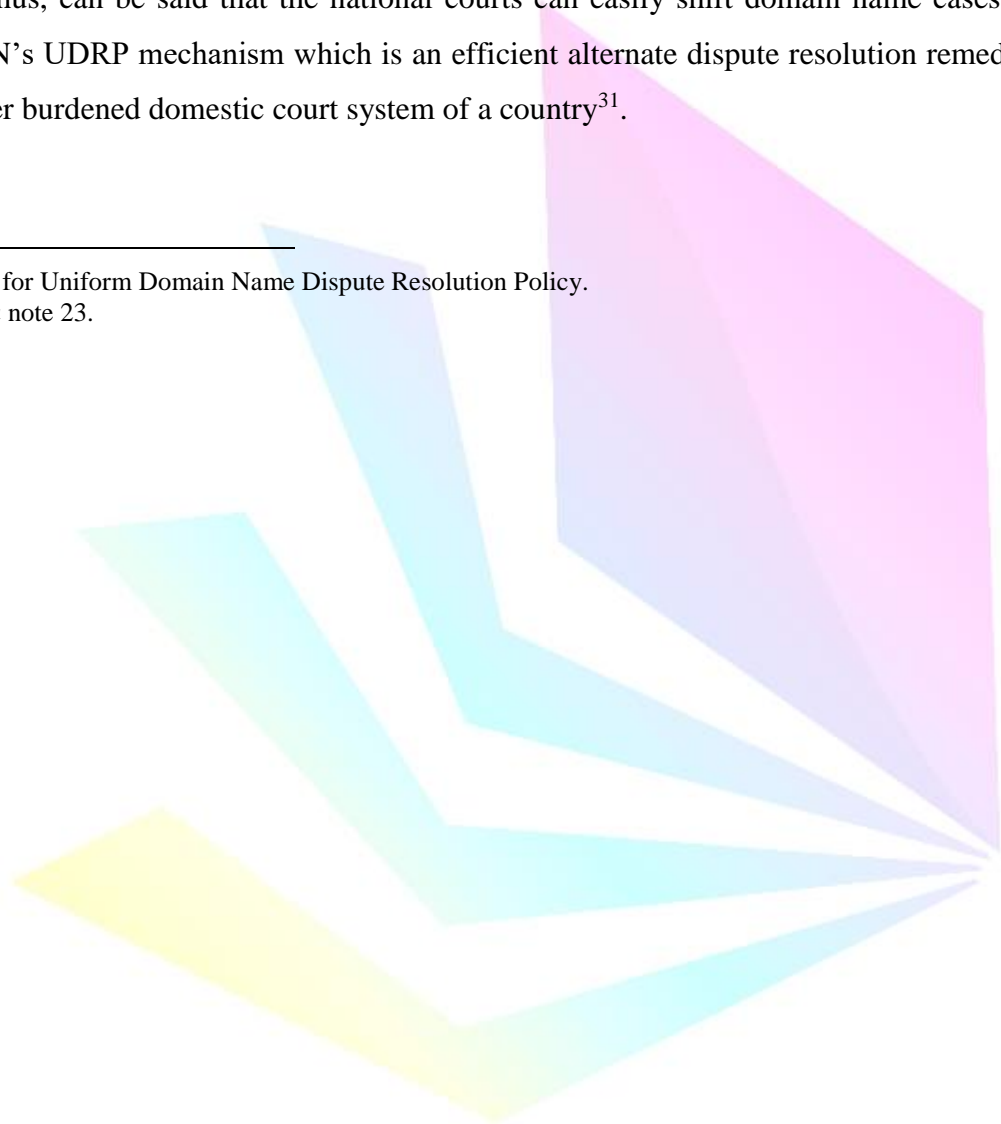
²⁹ AIR 2002 Del 243.

secondary meaning. It also referred to the Rules 4 (a) and 4 (b)³⁰, found that both parties had operated their websites within a month and while the plaintiff was unable to show the quantum of business carried out, it can't be said that the defendant had not incurred advertisement costs. Therefore, it dismissed the plaintiff's application and vacated the interim injunction order against the defendant.

This, thus, can be said that the national courts can easily shift domain name cases towards ICANN's UDRP mechanism which is an efficient alternate dispute resolution remedy easing the over burdened domestic court system of a country³¹.

³⁰ Rules for Uniform Domain Name Dispute Resolution Policy.

³¹ *Supra* note 23.



CHAPTER 5: CONCLUSION & SUGGESTIONS

It is of no argument that UDRP has been proved to be the simplified and cost friendly way of getting justice over the issue of domain name disputes to tackle the online disputes affecting the landmark owners in an era of online world but a lot is still to be done to make it a better working at the territorial level. The global experience has shown that many other countries have even tried to plug the legal lacuna by passing separate law for dealing with the problem like US has passed Trademark Cyber Piracy Prevention Act, 1999. Likewise, India also needs a law regarding the same since bringing the passing law principle does not provide for an entire solution to the issue in question. There should be a provision for easier and supplemental method of register for each State under the Indian trade mark law so that the owner who wants a territorial registration only does not have to be tortured with 'n' number of procedural formalities due to which a lot of time can also be saved. The period of non-use of a trade mark for five years as a ground for revocation should be reduced to three years under the Indian law so that one does not take advantage of getting a name registered from stopping some other squatter to use the same as they know how tedious and lengthy the process of litigation is. Another suggestion is that there should be a provision regulation of cyber crimes especially cyber squatting, not only under trade mark law but also in Information and Technology law in order to protect the rights of the legitimate claimers at territorial as well as extra-territorial level.