

Information Technology and Intellectual Property Rights: Online Use of Trademarks and Domain Name

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Abstract

A trade mark is a sign which can be represented graphically and is capable of distinguishing the goods or services of one undertaking from those of other undertakings. An application for registration of trade mark shall be made to the Trade Marks Registry of the Intellectual Property Department, and the application shall be determined by the Registrar of Trade Marks. The owner of a registered trade mark has the exclusive right to use the trade mark in relation to the goods and service. Whereas, a domain name is a website address on the Internet which gives you an online identity. Subject to the terms of the agreement as entered into between the registrant and the accredited registrar, the registrant shall have the right to use the domain name as its address on the Internet. This paper explains the relevant domain name disputes and the dispute resolution mechanisms for such disputes. Different types of domain name disputes include cyber squatting, typo squatting, framing and linking which has been explained briefly. The Uniform Domain Name Dispute Resolution Policy (UDRP) is a process established by the Internet Corporation for Assigned Names and Numbers (ICANN) for resolution of disputes regarding the registration of internet domain names. ICANN resolves disputes relating to generic top level domain and .IN Domain Name Dispute Resolution Policy (INDRP) resolves the disputes related to CCTLD in India. INDRP operates through its own provisions read with Arbitration and Conciliation Act of 1996 while UDRP operates through its own rules appointing 1 or 3 arbitrator.

Introduction

The invention of computer is one of the cherished gifts of science and technology. Widespread use of computer led to the further development in the field of communication through the media of Internet. While the merits of Internet usage are undisputable, it is not

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free from the demerits. Internet has always been found as major problem creator for law.³ Cyberspace has been prone to a number of misuses because of its inherent nature of being without any boundary. The biggest challenge of cyber law is its integration with the legacy system of law applicable to the physical world. Since cyber space has no geographical boundaries, nor do the citizens have physical characteristics. The internet is independent of any geographical location. Trademarks in the cyber space are represented by domain names. Domain names are many a time equated with trademarks. Domain name is a tool of identification which identifies a trade source in a virtual world. Both domain names and trademarks rest on the same idea i.e. identification of source and both have a similar kind of ownership and proprietorship.

In *Yahoo v. Akash Arora*⁴ it was held that domain names should be treated as a trademark in cyber space as they serve the same purpose and function and that domain name is as same as trademark.

Meaning of Domain Name

A domain name is a website name which is the address where Internet users can access a particular website. A domain names an identification tool to a trade source on the Internet. A domain name is the user-friendly form of an Internet Protocol (IP) address that points an Internet user's computer to the website the user wants to view. However, it is difficult for humans to remember strings of numbers. As the popularity of the Internet increased so the difficulty to remember these numerical addresses became obvious.⁵ Because of this, domain names were developed and used to identify entities on the Internet rather than using IP addresses.

A domain name can be any combination of letters and numbers, and it can be used in combination of the various domain name extensions, such as .com, .net and more. The domain name must be registered before one can use it. Every domain name is unique. No two websites can have the same domain name.

³ David Kitchin, et al., *Kerly's Law of Trademarks and Trade names*, Thirteenth edition, (London: Sweet & Maxwell, 2001) 737.

⁴ *Yahoo v. Akash Arora*, 1999 (19) P.T.C. 201 (Del) (India).

⁵ Paul Sugden, „Trademarks and Domain Names“ in Jay Forder and Patrick Quirk (eds.), *Electronic Commerce and the Law*, (Australia: John Wiley & Sons, 2001) 202.

Domain names are formed by the rules and procedures of the Domain Name System (DNS). A Domain Name System is a global addressing system which allows users to go to a specific website by entering its corresponding domain name and locates and translates domain names into IP addresses. A domain name has to be registered under the domain name system.

Categories of Domain Names

There are two components in a domain name. The first one is the Middle Level Domain which represents the source of the business, education, charity etc. It follows “www.” and precedes the top level domain name. It is chosen by registrant and it must be a unique term which is not previously used as a middle level domain name, and it should be registered. The business entities usually prefer to have their trademark as their middle level domain, in order to establish their identity over the Internet.

The second one is the Top Level domain (TLD). They can be seen after the middle level domain name. They are further divided into two categories. The generic top level domains (gTLDs) (for example: .com, .net, .org.) and the country code top level domains (ccTLDs) (for example: .au for Australia, .mx for Mexico). While the gTLDs are intended to provide information about the type or nature of the organizations, ccTLDs generally give information about the location of organizations identifying the country of the domain name holder.

Traditionally, there were seven gTLDs, namely .com, .org, .net, .edu, .int, .gov and .mil.⁶ After 2000, some new gTLDs are operated due to the efforts of the Internet Corporation for Assigned Names and Numbers (ICANN). These new gTLDs include .biz, .info, .pro, (name), .museum, .coop, and .aero.⁷ They are also based by brand (.amazon, .dunlop), music and arts community (.theater, .band), cause (.eco, .charity), geographic/cultural area (.nyc, .irish), etc. Companies and organizations will be able to create and operate a registry business for the new gTLD. The use of non-Latin characters such as Cyrillic, Arabic, Chinese, etc. will also be allowed in gTLDs. The initial application process closed on May 30, 2012. The time period

⁶ „.com“ refers to commercial organizations, „.org“ refers to non-profit organization, „.net“ refers to network service providers, „.edu“ refers to educational institutions, „.int“ refers to international organizations, „.gov“ refers to government entities, and „.mil“ refers to military and defence entities. Supra note 3, 202.

⁷ „.biz“ refers to businesses, „.info“ refers to unrestricted general use, „.pro“ refers to professionals, „(name)“ is for individuals, „.museum“ refers to museums, „.coop“ refers to cooperatives and „.aero“ refers to air transport industries. Ibid 203.

for a second round of applications has not yet been established, but it will likely be at least a couple of years after the close of the initial round of applications. Individuals are free to register any kind of gTLD and ccTLD as it is open to everyone and no one can have a right over them.

Internationalized Domain Names (IDNs) contain local language characters such as accents and may include non-Latin scripts for example: 香港(Hong Kong), рф (Russian Federation).

For registering a ccTLD, each country has an allocating office.⁸ In India, .IN Registry, which operates under the authority of National Internet Exchange of India (NIXI) performs the function of allocation.

The domain name system is currently managed and administered by Internet Corporation for Assigned Names and Numbers (ICANN).⁹ The ICANN is a non-profit public-benefit nongovernmental organization with an international board of directors, working from 1999.¹⁰ Each of these registries is certified by and subject to the direct supervision of ICANN. The ICANN sets standards for the performance of registration functions, vetting applicants in relation to those standards and for managing accreditation agreements. While gTLDs are governed directly under ICANN and subject to the terms and conditions defined by ICANN with the cooperation of gTLD registries, ccTLDs are governed by the terms and conditions of respective state governments. For the purpose of ccTLD allocation, each country has established a registry.

Domain names can be registered online. Nowadays there are many online websites like godaddy.com, hostgator.com etc. which provide for the registration of domain names. One can also freely check what domain names are available for registration on their website. WHOIS directory is a prominent directory where one can obtain details of the registered domain names. A domain name once registered takes upto 72 hours to be accessible by public. The domain registration is for a particular time period as decided by the domain

⁸ These registries have got authority from ICANN. They also operate on the first-come first-serve basis. Anjan Sen, „Intellectual Property Rights in Internet Environment“, Indian Juridical Review, Vol. 1, 2005 11.

⁹ Alan Davidson, The Law of Electronic Commerce, (Australia: Cambridge University Press, 2009) p. 127.

¹⁰ The Network Solutions Inc (NSI) was performing the function of registration and administration of domain names from 1992 to 1999, until ICANN assumed its functions. GERALD R. FERRERA, et al., Cyber Law - Text and Cases, Second edition, (Ohio: West Legal Studies in Business, 2004) 52-53.

provider and needs to be renewed according to the time period it has been registered for. If a domain fails to be renewed the domain provider will cancel the domain registration and it will be blocked for usage until the registrant has completed the renewal process.

Domain Name Disputes

As it is an established fact that domain names should be treated as a trademark in cyber space as they serve the same purpose and function of the product. Individuals and entrepreneurs get their trademarks registered as a domain, and spend huge amount of money in doing so. People take undue advantage of the registrations of domain name and thus pose a great threat to ICANN in resolving the issues. Domain names are registered on a first come first serve basis, so a person can register a domain name to which the consequent trademark may not be owned by him. This arises conflict between the trademark and the domain holder. So it is always advised to a trademark holder to register its brand as a domain in the cyber space to avoid the issue of conflict. This is not only fatal to the trademark owners but also disadvantageous to the online consumers of product or services, since they might end up in landing to a website that they never intended.

Here are the different types of domain name disputes listed down below:

1. Cyber squatting

The domain name dispute arises when someone registers a domain name with a trademark where the person registering such domain name does not have ownership over such trademark either by registration or by use. This is the most common type of domain name dispute. Individuals take undue advantage and practice this to generate revenue by misrepresenting that they are owners of such a trademark to which they have registered a domain. By doing this an individual who might be a general customer to the trademark will end up visiting a website which is not owned by the trademark owner. Individuals also do this in order to block the other party from having a legitimate space in the cyber space as a competitor for a period of time which would help generate more money through his own website as no competitor in cyber space exists.

In *Tata sons ltd. V. Ramada Soft ltd.*¹¹ Ramada, Ramada being a software company registered domain names targeting the leading giant TATA, both are direct

¹¹ Tata Sons Ltd. v. Ramada soft, D2000-1713.

competitors. Ramada registered 16 domain names of the company TATA like tata.com, jrdatata.com, "tatapowerco.com", "tatahydro.com", "tatawestside.com", "tatahoneywell.com", "tatayodogawa.com", "tatateleservices.com", "tatassl.com", "tatatimken.com", "jrdatata.com", "ratantata.com" etc., so that Ramada can negotiate with TATA and generate revenue. TATA filed an application to the ICANN and .IN with appropriate fees to get the detailed information of different websites existing in the cyber space with the name TATA. Grounds of misrepresentation, illegitimate use of name TATA was figured out. Court ordered that the entire domain name with name TATA shall be categorized as domain name fraudulently registered and shall be cancelled.

In *SBI cards.com vs. Domain Active Property Limited*¹², Domain Active Property Limited has registered the name sbicards.com. State Bank of India found out that an Australian company had already registered the particular domain name when they wanted to register its domain name. They filed an application in the WIPO on the grounds that, SBI stands for State Bank of India and that they have acquired distinctiveness in India and all over the world. The Australian company claimed that SBI is just an arrangement of letters, they have a website for selling properties and that State Bank of India phrase is nowhere used on their website. Court decide to grant injunction on the Australian company, as SBI is a well-known trademark, has acquired distinctiveness, has trans-border reputation not only in India but all over the world. The trademark should be protected as the ambit of SBI is larger than that of the Australian company. Domain name was eventually transferred to State Bank of India.

In *Intermatic v Toeppen*¹³ and *Panavision v. Toeppen*¹⁴, both the companies had electronic goods store but had not registered a domain name in cyber space. Toeppen registered both the domain names. Case was filed against him and he was given warning by the court.

2. Typo squatting

Typo squatting is also known as URL hijacking, it targets Internet users who incorrectly type a website address into their web browser in the url section for e.g., "Google.com" instead of "Google.com". This hijacking is done to misrepresent users

¹² SBI Cards and Payment Services Private Ltd v Domain Active Pty Ltd (2005 (31) PTC 455).

¹³ Intermatic Incorporated v. Dennis Toeppen, No. 96 C 1982.US. 26, 1996.

¹⁴ Panavision International, L.P., a Delaware Limited Partnership, v. Dennis TOEPPEN; Network Solutions, Inc., US. No. 97-55467.

and for generating revenue through his own website by fooling people and misrepresenting to be someone else's. This is done in bad faith to take control of a domain name from another, who already has an established good faith in the market, to fool their users in the cyber space by registering a deceptively similar domain name.

In *Satyam Infoway Ltd vs Siffynet Solutions Pvt. Ltd.*¹⁵ a domain name similar to sifi i.e. "siffi" was registered as to misguide the original users. This was the 1st Supreme Court case regarding domain name. Court said that, as domain names can be equated with trademark, laws relating to trademark in India will also be applicable to domain name in absence of a specific law or provision addressing the domain name.

3. Linking

Linking one source with another in order to advertise the other website. For an advertising contract, mutual consent of both the parties is needed. If linking is done with mutual consent no legal action will arise, but there is no consent, it is illegally done then a dispute of linking will arise. Linking is of two types namely:

- i. Hyper linking
- ii. Deep linking

Hyper linking is a linking made by one source to another source where the homepage is not bypassed and when one hyperlinks the URL, the person lands into the homepage of another website.

Deep linking is when one website deeply links an internal page of a website bypassing the home page of that website it is called deep linking.

If the linking is done without mutual consent, illegally, there won't raise any statutory remedy, but a remedy under passing off will be made.

4. Framing

Framing is a method of splitting one window into two or more screens. A web page can be inserted into a frame, and that portion of the screen will remain static as a user moves through other web pages. This method is called "framing," because it allows a

¹⁵ *Satyam Infoway Ltd vs Siffynet Solutions Pvt. Ltd Appeal (civil) 3028 of 2004 (India).*

webmaster to send an individual through numerous web pages while retaining the appearance and the utility of the frame inserted.¹⁶ Framing is of two kinds:

- i. Static frame
- ii. Mobile frame

When half of the content is already provided and there is a read more option or a know more option linking it to the whole content. It is on the users' option to click on the entire content or not. Whole content is not displayed and the user's permission is needed. This is called a static frame.

In a mobile frame, there is no express option for the users. The whole content is there on one screen, where one can scroll up or down, left or right to read the whole content.

In *Washington Post v Total News*,¹⁷ the phenomenon of framing was discussed. Here the business as well as the audience of both the companies were same. Total news was doing some illegal and unethical act. They used to collect different news from other sources and showed as if they themselves have written that post. They used to use the design or writings of different other sources including Washington post. Washington post contended that framers are subject matter of copyright. Court accepted Washington post's contention and said that Total news is passing off other sources content under his name. A copyright action was also brought about as the copyright of some other source was being infringed.

Dispute Resolution Mechanism for Domain Name Disputes

The Uniform Domain Name Dispute Resolution Policy (UDRP) is a process established by the Internet Corporation for Assigned Names and Numbers for the resolution of disputes regarding the registration of internet domain names. The Internet Corporation for Assigned Names and Numbers (ICANN) was formed as a non-profit entity in 1998, primarily at the instigation of the U.S. Department of Commerce.¹⁸ ICANN is charged with administering

¹⁶Himanshu Sharma and MartandNemana,India: Legality Of Metag-ing, Linking & Framing <http://www.mondaq.com/india/x/525188/Trademark/Legality+Of+Metaging+Linking+Framing> (April, 02,2018 15:58).

¹⁷ *Washington Post v Total News* No.97 Civ. 1190(PKL) (S.D.N.Y., filed Feb. 20, 1997)

¹⁸ A. Michael Froomkin, *Wrong Turn In Cyberspace: Using ICANN to Route Around the APA and the Constitution*, 50 DUKE L.J. 17, 24, 70-72 (2000); Jonathan Weinberg, *ICANN and the Problem of Legitimacy*, 50 DUKE L.J. 187, 209-12 (2000).

the Internet's addressing systems, including the domain name system. In particular, ICANN directs accredited registrars to require domain name registrants to submit to the Uniform Domain Name Dispute Resolution Policy.¹⁹ ICANN has attracted considerable attention over the past two years for its role in approving and rejecting various proposals for new top-level domains (TLDs) to supplement ".com" and other existing TLDs.²⁰ The Uniform Domain Name Dispute Resolution Policy currently applies to all generic top level domains some country code top level domains, and some older top level domains in specific circumstances. Under the UDRP, any person or entity with rights in a trademark may initiate an administrative dispute resolution proceeding by submitting a complaint to one of the four ICANN-approved dispute resolution service providers: the World Intellectual Property Organization (WIPO), the National Arbitration Forum (NAF), e-Resolution, and the CPR Institute for Dispute Resolution.²¹ Under the policy, most types of trademark-based domain-name disputes must be resolved by agreement, court action, or arbitration before a registrar will cancel, suspend, or transfer a domain name. Disputes alleged to arise from abusive registrations of domain names (for example, cyber squatting) may be addressed by expedited administrative proceedings that the holder of trademark rights initiates by filing a complaint with an approved dispute-resolution service provider.²²

¹⁹ ICANN, Policies Applicable to ICANN-Accredited Registrars (com, net and .org), (April, 02,2018 15:58) <http://www.icann.org/general/consensus-policies.htm>

Laurence R. Helfer & Graeme B. Dinwoodie, Designing Non-National Systems: The Case of the Uniform Domain Name Dispute Resolution Policy, (April, 02,2018 15:58) <http://papers.ssm.com>.

²⁰ Much of the controversy surrounding ICANN's legitimacy appears to stem from its effective control over expansion of the top-level domain space. Joe Salkowski, Dot-Corn Credentialing Gets More Competitive, CHI. TRIB., Mar. 19, 2001, Bus. see., at 4; ICANNWATCH, (April, 02,2018 15:58) <http://www.icannwatch.org>.

²¹ ICANN, Rules for Uniform Domain Name Dispute Resolution Policy 3(a) (approved Oct. 24, 1999) (April, 02,2018 15:58) <http://www.icann.org/udrp/udrp-rules-24oct99.htm>;

ICANN, Approved Providers for Uniform Domain Name Dispute Resolution Policy, (April, 02,2001 15:58) <http://www.icann.org/udrp/approved-providers.html>.

The vast majority of disputes are submitted to either WIPO or NAF, possibly because of perceived relative biases of the various providers. Michael Geist, Fair. Corn: An Examination of the Allegations of Systemic Unfairness in the ICANN UDRP (Aug. 11, 2001, 15:58) <http://aixl.uottawa.ca/geist/geistudrp.pdf>;

Milton Mueller, Rough Justice: An Analysis of ICANN's Uniform Dispute Resolution Policy (Nov. 9, 2000, 10:04), <http://dcc.syr.edu/roughjustice.pdf>.

²²Uniform Domain-Name Dispute-Resolution Policy (April, 5, 2018, 19:56) <https://www.icann.org/resources/pages/help/dndr/udrp-en>.

Declaration to be given by an applicant before registering with Internet Corporation for Assigned Names and Numbers:

1. Applicant should have true knowledge of the facts and application for registration.
2. Undertake the responsibility that once domain is registered that domain name will not violate or infringe any others' trademark or domain name.
3. Undertake that the domain name is not being registered for unlawful purpose.
4. Undertake that the registration of the domain name will not violate any law in force basically referring to trademark act.
5. Only when their undertakings/declarations are taken the domain name will be registered.

Certain grounds on which post grant opposition can be made. Rule 4 Uniform Domain Name Dispute Resolution Policy. They are the following:

1. Being identical, confusingly or deceptively similar.
2. Person who has registered a domain name with a trademark as a part of such domain name with a trademark as a part of such domain name does not have legitimate interest over such trademark.
3. Bad faith registration. Conditions to establish bad faith registration:
 - i. Purpose is to sell or transfer it to another person in consideration of money, and not us it on its own.
 - ii. When the other party can establish that the person has only registered prior to him to block the domain name.
 - iii. To dispute the business of another
 - iv. When a person has registered a domain name in such a manner that the products being sold to the customers under the trademark of another who has a better goodwill in the market. Intention of gaining commercially.
4. When the application has been submitted to Internet Corporation for Assigned Names and Numbers. It will appoint an arbitrator or a provider so as to dissolve the dispute.
5. Arbitrator will give reasonable time period to add any amount of fact they want to in their application.
6. If case goes in favour of complainant, there will be some effect to registration of domain name.

Change in domain name can be brought by three ways:

1. When the applicant wants the change as in who has registration.
2. When it receives a copy to do so when court gives an order to make changes in domain name
3. When Internet Corporation for Assigned Names and Numbers receives an award of the arbitration then the change in domain name can be made.

Changes that can be brought to existing domain name:

1. Cancelling the domain name all together
2. Transferring domain name from one party to another in a dispute.
3. Adding another stakeholder to the domain name
4. Allowing subsequent registration after complaint on someone else's name.

Uniform Domain Name Dispute Resolution Policy (UDRP) Procedure

1. Complaint is filed.
2. Formal commencement is done.
3. Within 20 days' response is given by the authority
4. Panelists are appointed; there can be either 1 or 3 panelists.
5. Decision is given by WIPO within 14 days.
6. WIPO forwards the decision to parties, ICANN and to the registrar within 3 days
7. Decision is implemented by the registrar.

Domain name dispute resolution in India is carried on by INDRP (.IN Domain name dispute resolution policy). . INDRP claims to be in line with the policies of the internationally accepted domain name dispute resolution policy i.e. by UDRP. One can file complaints regarding any domain name regarding the .in ccTLD. . INDRP resolves disputes relating to the country code top level domain. If a complaint is filed under the INDRP, the registry is responsible for appointing an arbitrator for the dispute resolution. All the decisions made are binding under the Arbitration and Conciliation Act 1996 of India.

Disputes relating to bad faith registration, registrant having no rights or legitimate interests or is identical or confusingly similar service can be filed under the INDRP. It also lays down the guidelines as to when can a dispute be called under the bad faith registration. They are the following:

1. Purpose is to sell, rent or transfer it to another person in consideration of money, and not us it on its own.
2. When the other party who does not have ownership has only registered prior to him to block the domain name in the cyber space
3. When the registrant has intentionally attempted to attract internet users to his website, by creating a confusingly, deceptively similar scenario.

Conclusion

Internet has played a vital role in the concept or property. The debate over virtual properties of domain name still continues to be in force. Domain names are many a time equated with trademarks as they have similar purpose of identification of source. Domain name is an extension of the real world. The interrelation between them and the domain name being the most significant factor on the internet brings a lot of issues and disputes into picture. The Uniform Dispute Resolution Policy has been very effective in resolving the domain name disputes on the internet. Efforts are being made at national levels too for providing resolution to such disputes but the pace at which internet is growing and impacting our lives nowadays has made it difficult.