

DOMAIN NAMES V/S A V/S TRADE MARKS: A STUDY IN NATIONAL AND INTERNATIONAL LEGAL PERSPECTIVES

Abstract of Thesis

**SUBMITTED TO THE
BABASAHEB BHIMRAO AMBEDKAR UNIVERSITY
LUCKNOW**

**BABASAHEB
BHIMRAO
AMBEDKAR
UNIVERSITY**



**प्रज्ञा शील करुणा
ESTABLISHED 1996**

FOR AWARD OF THE DEGREE OF

Doctor of Philosophy IN LAW

SUPERVISOR

PROF. SUBIR K. BHATNAGAR

DEAN

SCHOOL FOR LEGAL STUDIES

SUBMITTED BY

MUNISH SWAROOP

ENROLLMENT NO. 028/09

**DEPARTMENT OF HUMAN RIGHTS
SCHOOL FOR LEGAL STUDIES
BABASAHEB BHIMRAO AMBEDKAR UNIVERSITY
(A CENTRAL UNIVERSITY)
VIDYA VIHAR, RAEBARELI ROAD
LUCKNOW-226 025**

2017

Abstract

The Ph.D. thesis “**Domain Names *vis a vis* Trade Marks: A Study in National and International Legal Perspectives**” is divided into eight chapters. The first chapter is the “Introduction” of research work. At the initial stage, the selected area of research work has been identified. After identification of research problem, a synopsis of research work and its basic structure were developed. The main objectives of research study are put forth in this chapter. A review of literature is also put forth in this chapter. A para of hypothesis is constructed in which five assumptions are made. On the basis of research observations, utilizing qualitative and quantitative research method techniques of research methodology, all assumptions are proved. Further, the selection of research problem, statement of research problem, significance of research study, scope of research study are also briefly mentioned in this chapter.

The historical development of both the domain name and the trade-mark systems is convoluted and complex. Researcher does not intend to provide a detailed analysis of the historical developments. However, researcher felt it necessary to provide a broader context within which to frame the most relevant legal principles and structures of domain-name law and the foundations that underpin it. For this reason chapter 2 titled “*Trade Marks and Their Development*” gives a basic exposition of the history of trademarks and trade-mark law as well as short discussions on the nature and functions of trade marks in order to inform a comparison regarding the fundamental characteristics of trademarks and domain names, and the consequent interplay between the two systems. This is critical to a proper understanding of the process of domain-name dispute resolution. In this chapter researcher has attempted to review the relevant literature, focusing specifically the early history and evolution of trademarks, protection of trademarks at international level, and highlight basic features of trademark in general. Further in this chapter researcher dealt with the development of trademarks laws at the

national and international level. Chapter deals with trademarks in general, what are trademarks and famous trademarks, legal protection of trademarks and famous trademarks, quick view on international treaties and conventions concerning trademarks such as: Trade-Related aspects of Intellectual Property Rights (TRIPs) and Paris Convention for the Protection of Industrial Property, as well as studying the national protection in India according to the Indian Trademark Law of 1999. After going through the brief historical development of trademark law researcher found that the long-run history of the law of trademarks has been one of expanding subject-matter and scope of trademark protection. The traditionally protected trademarks were words and graphic designs. With the progression in time, the scope and subject-matter of protection of trademarks widened. Now in this sensory world anything which is having perceptible feature can be put under the category of trademark. Further in this expanding field of trademark protection, the outbreak of internet has brought a vast change. The internet has shrunken the world and brought it onto the screen of a computer. It has changed the way we live. There is a huge amount of information on the net, which is available to anyone who can access it. By just typing a word through a search engine one can have more information than one can handle. It is the cheapest and the fastest system of communication, commerce and entertainment. This chapter of research study ends with a finding that the scope and the subject-matter of the trademark protection are still expanding.

The Evolution of E-commerce/Trade is discussed in the third chapter of this research study. The purpose for discussing E-commerce is that it has brought significant changes in the traditional trade and thereby expanding field of trademarks. This chapter is a sort of bridge between traditional trademarks and modern day Domain names. In this expanding field of trademark protection, the outbreak of internet has brought a vast change. In this chapter a detail note of the development of E-commerce as well as of the Internet has given. The internet has shrunken the world and brought it onto the screen of a computer. It is the cheapest and the fastest system of communication,

commerce and entertainment. The 1990's the privatization of the internet has resulted in the commercialization of the internet. It is this commercialization of the Internet which resulted in the dawn of Electronic commerce (E-commerce). The basis of every online business is the E-Commerce website that it creates on internet. Beside number of Website's characteristics, one of the most important characteristic is Domain Name. It serves as a foundation for web and promotional activity. The emergence of E-commerce has ultimately led to many new disputes. Among these disputes, the dispute relating to trademarks and domain names is most prominent. Its effects are far reaching, affecting not only the field of technology development but also the realm of business marketing and strategy. Online consumers have found that the use of Internet offer new and previously unknown possibilities and it also empowers not only as information provider, but also as forums of dialogue between manufacturers and sellers regarding their commercial, ethical and social responsibilities. Online traders get better their websites by revealing the information relating to products so to support their advertising claims such as merchandize dimensions, colour, manufacturers name and product model/serial numbers price, discount amounts and the time period for the discounts, shipping and handling costs, return and exchange policy, and even third party reviews regarding goods and services. E-Commerce is rapidly changing the way we do business around the world. In the Business-to-Consumer segment, sales through the web have been increasing dramatically over the last few years . Consumers from well developed countries as well as from developing countries are getting used to the new shopping trends. However, as every coin has a flip side; similarly it has been observed that doing online trade or business also has dangers and legal issues related with it. The quick pace of e-commerce advancement has generally left the legal framework struggling to keep up and gasping for breath. In much the same way as companies doing online business must invent new business rules and procedures, the legal system is attempting to adjust existing laws to fit new settings where it is unclear how these laws will apply. At the point

when the Internet initially created, many considered it to be a chance to exploit instabilities in the law. A few practices occupied with by organizations were untrustworthy and in the end perceived as unlawful, a few practices are presently being imagined that raise new considerations, and ultimately led to new disputes. Among these disputes, the dispute relating to trademarks and domain names is most prominent.

Chapter four titled “Domain Names: History and Characteristics” provides a brief historical explanation of the origins and development of the domain-name system. Chapter deals with domain names in general, what are domain names, how does it work? why do we need domain names? who controls domain names. It includes not only an evolution of the system itself but also discussions of the legal measures, the interests and institutions involved, and the policies and documents drafted, all which eventually resulted in the development of the Internet Corporation for Assigned Names and Numbers (ICANN) and its consequent control of the domain name system. According to final report of the WIPO Internet Domain Name Process, “a domain name is an IP address in a human-friendly form” .Domain names are the simple English references to the IP addresses. Similar to the IP numeric addresses, the domain names are divided into fields separated by point (in the Internet language called “dot”). If, for example, you would like to visit the Babasaheb Bhimrao Ambedkar University website, would you rather remember the IP address **14.139.228.229.**, or type “*www.bbau.ac.in*”. By associating a familiar string of letters—the domain name—with an IP address, the DNS makes it considerably less tough for Internet clients to remember sites and email addresses. In the example above, the “*bbau.ac.in*” part of the address is called the domain name. The “www.” part identifies to your browser that you are looking for the World Wide Web interface for that domain name.” To keep the identification of communicating gadgets easy and mnemonic, Domain Name System (DNS) has been developed. This system enables use of universally unique and easy-to-recall names for Web pages and mailboxes called domain names, rather than long strings of numbers or codes (IP

addresses). The DNS history is also the history of how the Internet Corporation for Assigned Names and Numbers (ICANN) came about. The history of the DNS started out unknowingly a few decades ago, as discussed in the above para, while its existence was only important to limited number of users and organisations and its administration largely informal.

However, as the Internet developed during the nineties, becomes important, particularly in the acknowledgment of its tremendous commercial value, so did it also lose its innocence. Number of people had a smaller or larger extent of vested interests in Domain Name System (DNS) policy and rule making, leading to number of conflicts, many of them are still very significant today. The majority of these conflicts eventually flow from one elementary question, the most controversial point of conflict – who manage and run the DNS? At the moment, the answer is very simply, ICANN control and runs the DNS.

Chapter Five titled as “Trade Marks *vis a vis* Domain Names” deals with the interaction between trademarks and domain names by discussing the main similarities and difference between trademarks and domain names as well as explaining the conflict between domain names and trademarks, when registering trademarks as domain names (Cybersquatting, Typosquatting, Domain Name Parking, Domain Tasting, Reverse Domain Name Hijacking, Domain name front running Domain Kiting, Gripe / Protest Websites, ‘Url’ Path etc.) and the use of trademarks in web pages and search engines, such as, using ‘url path’ designing web pages, using a trademarks in search engines (key wording), clashes of trademarks and the use of trademarks as a link in the website. Moreover, this chapter clarifies that universal nature of the disputes relating to domain name has led to flooding of courts with competing claims from the trademark holders and the original domain names registrants. In most countries, legislation has been slow to keep pace with the technological outbreak that has resulted in the emergence of domain names as a sui generis asset class, which requires legal safeguard. Whether a domain name can be

regarded as a trademark? The researcher analysed it on the basis of following criteria i.e.,1.there needs to be a sign- This will automatically include all domain names because they may only consist of characters which are contained in the UNICODE character table . To conclude, all domain names are eligible to be regarded as signs under trademark law.2. this needs to be capable of being represented graphically- Trademark need to represent graphically and domain names are e.g. displayed on computers, tablets and mobile phones all of which require them to be represented graphically. The question whether a domain name can be represented graphically has therefore the obvious answer that it can be. To conclude, a domain name is in all circumstances eligible to fulfil this criterion. and 3. the sign has to be distinctive- from the decision of Hon'ble Supreme court's opinion in *Satyam Infoway Ltd. v. Sifynet Solutions (P) Ltd*¹, Where the apex Court observed that domain names are distinctive.

From the discussion under this chapter it is clear that there are similarities between the Trademark and domain names and these similarities give rise to different kinds of domain name disputes. The universal nature of domain name disputes has led to flooding of courts with competing claims from the trademark holders and the original registrants of domain names. The friction between trademark law and domain names is an inevitable outgrowth of the Internet. In the absence of better legal alternatives, trademark owners initially attempted to fight cybersquatters by invoking trademark rights in the domain name, most typically in the second level domain string. However, traditional trademark law did not contemplate trademark disputes occurring in a global, electronic medium. In particular, the uniqueness and global reach of domain names serve to complicate the application of traditional trademark concepts. Several countries, including India, have tried to extend the scope of traditional trademark law to the online world through amendments and judicial outreach. However, United States of America has taken lead in addressing domain name disputes by suitably introducing new legislations and expanding

¹ (2004) 6 SCC 145.

the horizons of existing ones through judicial activism. The courts in U.S.A. and U.K. are largely responsible for the emergence of cyber jurisprudence in the global context.

“Legislative and Judicial Approach towards the Domain Name Disputes: A Study of U.K., U.S.A., and Indian Legal System” is the title of Chapter 6. In this chapter along with the applicable legislations, some of the landmark decisions from the courts in U.K., U.S.A. and India have been discussed in order to understand the development of judicial mind as applied in for the protection of domain names. In U.K. there is no particular legislation dealing with the domain names. And moreover, there are a handful cases that have been resolute in courts, perhaps because lawsuit is not the first preference of the parties essentially, there are two possible legal grounds on which the courts in the U.K. relies in addressing domain name disputes i.e, Trademark Infringement, and Passing-off. In the U.S.A. initially the most effectual tools available in the American legal system to deal with the domain names disputes were law relating to traditional trademark and unfair competition and the relatively recent Federal Trademark Dilution Act of 1995 (FTDA) incorporated into the U.S. Trademark Act of 1946 (“Lanham Act”). Now the domain name disputes are tackled under the Anti-Cybersquatting Consumer Protection Act, 1999 (ACPA). In India, on one hand the old Trade Marks Act has been replaced with the Trade Marks Act of 1999 , on another, an all in all new Information Technology Act (IT Act) was adopted in 2000 to make way for the acknowledgment of electronic information and data. In spite of the fact that these administrative activities were brought to keep pace with the technological changes, neither of the Acts particularly deals with domain names or the question related thereto.”

The discussion under this chapter leads us to the conclusion that the technological changes bring challenges to the basic principles of Intellectual property laws and internet and the digital revolution poses complex problems for their protection. There are various steps already a boot to tackle the domain

name dispute, especially cybersquatting on International level. So far as India is concerned, there is no legislation which is directly related to the domain name disputes; the law is yet to be developed unlike the USA. It is only governed by the Trade Mark Act 1999, which does not have any express law on the point of domain name disputes. However, the Information Technology (Amendment) Act 2008 provides punishment for cheating and personating by means of any communications device or computer. There is still an urgent need for definite laws in this field, as most of the decisions are more inclined towards the protection of trademarks rather than domain names.

Role of Alternative Dispute Resolution Mechanism in Addressing Domain Name Disputes is discussed in chapter 7 of this research study. As the judiciary and legislative measures are not able to provide quick and adequate protection, which is very much crucial for a commercial entity. Therefore with the purpose to overcome problems associated with the short-comings of national legal systems, alternative dispute resolution mechanism devised by some non-judicial which provides fast and efficient settlement of disputes between domain name owners and trademark holders. This chapter is solely focused on the alternative mechanism devised for the proper resolution of domain name disputes. In this chapter all the dispute resolution providers are discussed in detail. Besides discussing the role of Uniform Domain Name Dispute Resolution Policy (UDRP), Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) and four ICANN-Approved Dispute Resolution providers, detail note of national alternative dispute redressal mechanism is also given. In India, the registrants are required to submit to a mandatory arbitration proceeding under the .IN Domain Name Dispute Resolution Policy (INDRP). In India .in ccTLD registration is managed by INRegistry, which was created by National Internet Exchange of India (NIXI), a Government of India undertaking. Researcher also tries to find out how far these alternative mechanisms are successful in resolving the domain name disputes.

The study finds that administrative-level remedy to the domain name disputes passionately secures the well-known names, trade names and trademarks. ICANN has figured Uniform Domain-Name Dispute Resolution Policy (UDRP), which permits holders of service mark and trademark to arbitrate certain claims against a registrant of domain name before an Approved Dispute Resolution Service Provider. Rules for UDRP supplement the policy and provide the procedure to be followed during administrative proceedings for the solution of disputes under the ICANN UDRP. In addition, such proceedings are also administered by the Supplemental Rules of the Provider managing the proceedings, as posted on its site. In case of conflict between the Supplemental Rules of any Provider and these Rules, these Rules prevail.”

Domain Name disputes has been uncontrolled because of the supported endeavours of the traffickers to get most extreme financial advantage from the absence of policing on the Internet. Notwithstanding, certain lawful and administrative measures have backed off the infringement released by trademark violators in web world. The need of the hour is to adopt an adjusting approach, which handles the issue with the assistance of both innovation and law.

In the last chapter, on the basis of this research study, certain conclusions are drawn and some suggestions are also placed for consideration. On the basis of findings of this research study, it is inferred that the problem of domain name dispute needs to be addressed urgently. Trademarks are significant part of businesses. The amount of money which the Business organizations are investing in their trademark, itself reveals the importance of trademarks. Even the mark which is not get registered by owner has also got the protection of trademark law. This protection prevents another party from using the identical or similar mark in business. Just like in case of trademarks use in the real world, an owner’s permission to use the mark is also required on the Internet. In the recent past, legal researchers have dedicated a lot in

consideration regarding how the digital broadcasting of data over the Internet and how it has confronted and examined traditional legal principles, particularly in the field of intellectual property. The Internet causes exceptional inconvenience before those who are trying to save the intangible value and goodwill sum up in a trademark. The flooding of activities on internet has quickly changed the nature of the Internet from the “cozy, non-commercial environment” to a medium through which commercial traders can offer on-line services, advertise and sell goods, distribute software and other products.

An IP address through which an individual or a company can be located by any person having Internet access is called domain name. Domain names serve to locate and distinguish the various users, computers, resources, and files accessible on the Internet. It is because of domain name a business organisation is virtually visible on the Internet, without it users would not know how to find it. As business organizations are free to choose their domain names from among the available names, they usually choose names from the name which is often common and everyday words or famous trade names or which are easy to memorize.

The issue emerges when an organization picks a name that has as of now been enlisted as a trademark by another organization, or when two or more organisation claims to use the same name in their domain names. Law of Trademark precludes the utilization of trademark of any other person when such use would probably confuse a possible consumer as to the originality of the service or goods, has been invoked for resolution of disputes between the domain names registrant and the registered trademarks owner.

The growing number of cyber squatting cases and other domain names issues resulted in a explosion of cases coming all the way through court systems worldwide, thus requiring the requirement for developing a legal framework to deal with the emerging internet related problems and threats.

The study finds that there is no effective institution or efficient mechanism to control, prevent, or check the domain name disputes. The United States of America, for its part, introduced the federal law known as Anti-Cyber Squatting Consumer Protection Act, 1999, making cybersquatting a crime. As far as United Kingdom is concerned, there is no specific law relating to cyber squatting, but deals with it in a common law approach through the courts which apply trademark law. If we talk about India, we will find that there is no law, which directly deals with the issue of domain names disputes. But after the Supreme court's decision in May 2004 in *Satyam Infoway Ltd. V. Sifynet Solution (P) Ltd.(Satyam Infoway)*², it is well settled that domain names are to be protected on the same lines as trademarks i.e., under Trade Marks Act, 1999. However, the Indian Parliament enacted the Information Technology Act in the year 2000, in order to grant legal acknowledgment to e-commerce, to amend related statutory provisions and to give favourable consideration to the United Nations Model Law on Electronic Commerce (Model Law), to facilitate electronic filing of documents with the government agencies. But it does not mention anything about domain names.

In the last pages of this research study, it is suggested that to have a law in the form of a treaty or convention under the aegis of UN, which thoroughly covers all parts of known and potential illegal activities committed on, or with the assistance of the internet. Every country, including India, must endeavour to draft a complete Cyberspace Code, which inter alia also addresses issues relating to Intellectual Property infringement in the internet. Domain name disputes issue in cyberspace is too technical an issue to be dealt by simply extending the scope of traditional Trademark laws. However, it is also required that the technical aspects must be given appropriate treatment and due weight while enacting the Cyber law. The registration authorities are required to form policies for the less expensive and fair resolution of domain name disputes. Such policies would be fruitful only if registration authorities implement the

² (2004) 6 SCC 145.

subsequent suggestions. The famous trademarks and celebrity names have often been the target of cybersquatters and typosquatters. However, there is no internationally accepted criterion for determining as to which marks are famous and deserve protection on cyberspace. It is suggested that ICANN undertakes the task of framing an acceptable process that helps in identifying globally famous or well-known marks. Its key terms ('bad faith' & 'rights or legitimate interests') are both unfamiliar and vague. Different panellists have given seriously conflicting interpretations of these terms. The domain name registrants are still not clear (even after 37,862³ decisions) as to what constitute 'bad faith' as opposed to 'rights or legitimate interests'. Therefore there is a need to provide more accurate definitions of these terms and to provide more illustrations for terms such as legitimate interests and bad faith. It is correct that UDRP turned out to be very popular when it was launched; however it is unable to fulfil the need of a legitimate legal policy. Therefore, there is an urgent need for some changes. An appeal system within the UDRP mechanism is also suggested, which will further make the decisions given by the Panellists more consistent and precise. Though it will make the process a little costlier, the party that loses the appeal may be made to bear the costs of appeal procedure. There is nothing in UDRP which provides as to which laws should prevail in relation to the complainants and respondents coming from different jurisdiction. The only provision relating to the choice of law is Rule 15(a). So it is proposed that a provision relating to choice of law to deal disputes among complainants and respondents of different jurisdictions. Promotion of domain name 'sharing' systems in appropriate cases, where two or more people or groups with similar legitimate competing interests in the same domain name jointly host a relevant Website containing hyperlink to their respective main Web pages either on a permanent or on a temporary basis. All in all, researcher supports the view that property rights should be granted to owners of domain names so as to further enhance the development of cyberspace and e-

³ Total Number of Cases per Year *available at:* <http://www.wipo.int/amc/en/domains/statistics/cases.jsp> (Accessed on 25.01.2017).

commerce. Moreover, while domain name registrants should be able to reap the benefits of their registrations, they should also bear the burden of holding such a valuable right.