DOMAIN NAMES *VIS A VIS* TRADE MARKS: A STUDY IN NATIONAL AND INTERNATIONAL LEGAL PERSPECTIVES

Thesis

SUBMITTED TO THE
BABASAHEB BHIMRAO AMBEDKAR UNIVERSITY
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2017

Dedicated to my Late Mother and Father

DECLARATION

I, **Munish Swaroop**, hereby declare that this research work for the award of Ph.D. degree in Law entitled **“Domain Names *vis a vis* Trade Marks: A Study in National and International Legal Perspectives”** has been done by me on the basis of original research material and information taken from other research works has been duly acknowledged.

I further declare that this is an original work and has not been previously submitted in part or full for any other degree or diploma in this or any other university.

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CERTIFICATE

This is to certify that the thesis titled **"Domain Names *vis a vis* Trade Marks: A Study in National and International Legal Perspectives"** submitted by **Mr. Munish Swaroop** is an original research work and has not been previously submitted in full or part for award of any other degree or diploma to this or any other university.

This thesis submitted to Babasaheb Bhimrao Ambedkar University, Lucknow satisfies all the requirements as stipulated in the Doctor of Philosophy (Ph.D.) regulations, 1999 as amended in 2013 and it is fit for submission and evaluation for the award of degree of Doctor of Philosophy of the University.

Date: Supervisor

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Dated: **(Munish Swaroop)**

PREFACE

The thesis analyses selected aspects of domain-name disputes, mainly from the perspective of trade-mark law. It discusses the evolution of the domain-name system and how it operates as background to a more detailed discussion of the theoretical classification of domain names. The thesis then examines the interplay between trademarks and domain names, and the resolution of domain-name disputes resulting from the inherent tension between these two systems. The main principles of domain-name dispute resolution are identified by way of an analysis of the Judicial decisions and .IN Domain Name Dispute Resolution Policy (INDRP) panel decisions. This analysis always addresses, too, the extent to which national trade-mark law principles (with reference to the laws of India, the United Kingdom, and the United States of America) apply, and the extent to which this is appropriate.

In recent times, the domain name issue has become most complicated issue in the world. The main feature of this research study is to critically evaluate and elucidate the legal mechanism dealing with Domain Name disputes in India as well as in the world. The study has been divided into eight chapters. The first chapter of this research study is ‘Introduction’. In this chapter the subject matter of the research work has been introduced. The second chapter is about historical evolution of trademarks. E-commerce and its effect on traditional trade are discussed in third chapter of this research study. The fourth chapter gives the detail note on Domain names. The fifth chapter deals with the interrelation between trademarks and Domain names. The six chapter of this research study evaluates the role Judiciary and Legislature in this regard. The latest case law and legislative provisions have been cited at appropriate places. The seventh chapter is about role of Alternative Mechanism in dealing with domain name issues at national as well as International level. In the last chapter some useful suggestions along with the conclusion of the study have also been given for proper resolution of domain name disputes.

It is an occasion for me to feel proud in presenting this research study. I hope and trust that this research study would be more useful for today as well as for future. Although, I have put in my best efforts to avoid all the mistakes but despite this if any mistake has been left out ignorantly, for that I personally tender my apologies.

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ADNDRC –	Asian Domain Dispute Resolution Centre
ARPA-	Advanced Research Projects Agency
CAC –	Czech Arbitration Court
ccTLD -	Country-code Top Level Domain
DNS -	Domain Name System
EC-	E-commerce
ECJ –	European Court of Justice
EU –	European Union
FTDA-	Federal Trademark Dilution Act 1995 (U.S.)
gTLD -	generic Top Level Domain
http-	Hypertext Transfer Protocol
IANA -	Internet Assigned Numbers Authority
ICANN -	Internet Corporation for Assigned Names and Numbers
Inc. –	Incorporation
INTA –	International Trademark Association
INWG-	International Network Working Group
IP –	Internet Protocol
ISP's-	Internet Service Providers
NAF -	National Arbitration Forum
NSF-	National Science Foundation (America)

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UDRP -	Uniform Domain Name Dispute Resolution Policy
URL-	Universal Resource Locator
WAN-	wide area networks
WIPO –	World Intellectual Property Organization
www-	World Wide Web

"For business to communicate effectively on the Internet, it is essential that they have a unique "address" that is easily recognizable to customers"

-Gary W. Hamilton[1].

[1]Gary W. Hamilton, "Trademarks On The Internet: Confusion, Collusion Or Dilution?" 1995.

Chapter-1

1.1. Introduction

The internet has shrunken the world and brought it onto the screen of a computer. Internet has changed the way of our life. There is a tremendous amount of information on the internet, which is accessible to any individual who can get to it. By simply writing a word through a web index one can have more data than one can deal with. It is the cheapest and the fastest system of communication, commerce and entertainment.

A significant utility of internet is that it brings markets of world to one's door step or one's desktop. The customer can sit in the solace of his/her home while shopping everywhere throughout the world, searching for the best items at the most ideal least cost. Such sites and information regarding the products have been set up in the public domain by different people, governments, enterprises, and associations and so on, who want to be noticeable and known. A registered "Domain name" on the internet can only make it possible.

Every computer, which is connected to the internet possess an exclusive numerical addresses called Internet Protocol (IP) Address. Domain names are the recognizable and simple to recall names for the IP addresses on the web. Domain names are utilized as a helpful way for finding information on the web. It might be noticed that, with the course of time, domain names have advanced from being a "simple to recall name" to "trade symbol". Consecutively, this has made domain names as important as trademarks.

In spite of the fact that domain names on the web are thought to resemble trademarks, there are some practical contrasts between the two. Trademarks are the marks or names that individuals can use to separate their products or services from other products or services in the market. There are no less than three primary functions that a trademark performs for the specific product or service. First, it informs the prospective consumer about the manufacturer of the product. Second, it refers the quality of the product. Third, a trademark is an advertisement both for the product and the manufacturer.

On the other hand, the primary function of the domain name is to provide an easy to recall combination of letters for a generally complex numerical Internet

Protocol (IP) address. As such, domain names represent the website. In any case, domain names are property as in they have money related value. Along these lines, one might say that domain names have risen as a commercial property right however are not the same as trademarks.

On the other hand, the 1990's bring the privatization of the web and subsequently commercialization of the web. It is this commercialization which set up the present dynamics between trademark law and domain names. The Trademark law originally developed with a specific end goal to give holders of trademarks intellectual property rights. Interestingly, the domain names system was not created with the reason for granting some sort of property rights to the holder of domain name. The fact that a domain names registrant did not have to be the trademark owner led to considerable instances of what came to be called "cyber squatting"[1]. Cyber squatting occurs where a domain name is used, registered or sold with the aim of yielding from someone else's trademark goodwill. It can bring about genuine harm to the trademark by lessening the uniqueness of the mark or utilizing it in a way damaging to the holder of mark.

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 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

[1] Hutchinson J, 'Can Trade Mark Protection Respond to the International Threat of Cybersquatting?', Winning Entry, Lord Lloyd of Kilgerran Undergraduate Prize 2000, 2001 (1) The Journal of Information, Law and Technology (JILT) *available at*: <http://www2.warwick.ac.uk/fac/soc/law/elj/jilt/2001_1/hutchinson/>. (accessed on 15.09.2015).

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,[3]. But it does not mention anything about domain names.

Because of the staggering demands and pressure on the national courts, Internet Corporation for Assigned Names and Numbers (ICANN)[4] proclaimed a private arbitral forum in 1999 for the determination of domain names disputes called Uniform Disputes Resolution Process (UDRP)[5]. ICANN is a non profit organization situated in California which controls the allocation of domain names and in this way involves an awesome position in connection to web administration. Initially, ICANN was under direct control of United States Department of Commerce, but in 2009, U.S. liberated it from its direct control. ICANN performs the administrative responsibilities for the assignment of IP addresses, parameters of domain name system and its protocol.

We all know that internet is here to stay forever. There have been several million domain names and hundreds of conflicts. Although there are a few methods of resolving these disputes, the parties are still heavily dependent on the conventional system of courts, particularly with respect to violation of a trade-mark. One of the key reasons for this is that trademarks are territorial rights and usually a trader whose trademark is registered in a territory would be governed by the law of that territory. Consequently, when looking for redress for disputes, the trader for relief will turn to the judicial system of that territory. Domain names have no territory because of their presence and accessibility on a global scale. Therefore, infringement of a trademark by domain name may have more serious consequences than ordinary violations. In

[2] (2004) 6 SCC 145.
[3] Preamble, the Information Technology Act, 2000.
[4] For more details, visit the ICANN web site at http://www.icann.org.
[5] See, www.icann.org and www.arbiter.wipo.int.

fact, its presence on a global scale is also the reason why traders also want to have their trademark as a domain name.

The global reach of internet is the main factor that lends unique character to this revolutionary technological innovation. While distance does not matter in transacting via cyberspace, it is the transgression of the court to secure physical presence of the party located outside the territorial jurisdiction of the respective court, and enforce its orders.

Broadly, the issue involved in Domain Name dispute is the registration of existing trademark as Domain name.

The infringement of the Trademark on Internet has been uncontrolled on account of the supported endeavours of the traffickers to get maximum financial advantage due to the absence of policing on the web. Yet, certain administrative and legal measures have hindered the unleashed trademark violators in cyberworld. The present need is to find out a balancing approach, which handles the question with the help of both law and technology.

1.2. Need for present study

Disputes with regard to the registration of domain names, including claims of trademark violations, have turn out to be gradually more common with the rising commercial potential of the Internet. According to the Global Legal Post, 'the number of domain name dispute cases adjudicated by the World Intellectual Property Organisation (WIPO) hit 3,036 in 2016, up 10 per cent in the last year from 2,754 and up by two thirds (66 per cent) in the past decade from 1,824 and also suggested that with the growing number of new domains, the potential for disputes may increase[6]. Recently, India has achieved critical progress in building up an e-commerce sector and domestic Internet infrastructure, and has come out as a noteworthy destination for international commerce, especially related to communication and information technologies. Alongside this development, domain name disputes have turned out to be more common in India as well.

[6] *Available at:* http://www.globallegalpost.com/bigstories/domainnamelegaldisputeshitrecordhigh273 07685/(accessed on 03/01/2017).

The most important and challenging issue to be solved is the fair and successful resolution of the domain names disputes. The domain name may be identified as so-called "innovation in the information and communication technologies world". Actually, a domain name is the address of any computer connected to the Internet. The Final report of the WIPO Internet Domain Name Process highlights, "a domain name is an IP address in a human-friendly form"[7] . For that reason, when depicted human-friendly form corresponds to a trademark or company name, it transforms into essential and profitable asset. To be specific, when domain name is related with a trademark, it turns into an intense business tool. Thus, organizations underline the need to possess domain name that associates with its trademark.

Accordingly, there is a trademark in every domain name disputes; the related dispute has been controlled by the traditional law, i.e. trademark law, unfair competition, passing off and other like practices. An unprecedented growth of the Internet and, almost, uncontrollable character of Internet caused challenges with the application of conventional legislative means while making a decision on domain name disputes.

The Internet Corporation for Assigned Names and Numbers (ICANN) which was established in 1998 is an internationally recognized, non-profit organization that addresses Internet Protocol (IP) address space allocation, root server system management functions, generic Top-Level Domain name (gTLD) and country code (ccTLD) Top-Level Domain name system management and protocol identifier assignment. Respectively, in 1999 ICANN launched the Uniform Domain Name Dispute Resolution policy (UDRP) – a brand new tool for efficient solution of international disputes. Since the development of the UDRP the emphasis was on implementing the best methods to reach solutions in the most controversial and challenging domain name issues. Yet UDRP suffers from certain kind of shortcomings.

[7] See World Intellectual Property Organization (WIPO), The Management of Internet Names and Addresses: Intellectual Property Issues, Report of the WIPO Internet Domain Name Process, *available at*: http://www.wipo.int/export/sites/www/amc/en/docs/report-final1.doc (accessed on 03/01/2017).

There is a need to respond to reasons which are creating tensions between trademark owners and domain name holder and the ways by which disputes relating to domain name can be successfully determined with the main focus on the present legislative and alternative dispute redressal system. At the same time, there is also need to reveal major shortcomings in the UDRP system and also to consider what is meant by these flaws.

1.3. Review of literature

Though there are not enough significant books and articles written directly on the theme of thesis, but some good work related to the topic was reviewed. The review of some of the books and articles, which the researcher has gone through, are as under:

Legal Dimensions of Cyberspace: edited By S.K. Verma And Raman Mittal, Indian Law Institute, New Delhi, 2004. This book is the first book in the country wherein every chapter has been written by most experienced experts available in the country. This book is also intended to form the basis of an e-learning course on the subjects to benefit users all round the country. I found this book very use full for all concerned with Internet/cyber transmissions and other information. However there is no chapter directly dealing with the issue of Domain name disputes.

Indian Perspective on Domain Names, article By Silky Mukherjee (Lecturer, Gujarat National law University), Law, Development and Socio-Economic Policy (Challenges in the 21^{st} century India), EBC, 2012.This article concern with the Domain Names issues especially in India. This article gives brief picture of correlation between trademarks and Domain Names. Researcher found this article of great help in understanding the basic concept of Domain Names. However this article lacks in providing remedies for domain name disputes.

*Cyber Laws***,** by Justice Yatindra Singh (Judge of Allahabad High Court), Universal Law Publishing Co., 2010, 4^{th} edition. This book is a complete manual to the different legal issues arising out of the extraordinary expansion of Internet including practical information regarding technology related issues and academic and the underlying legal principles which have been applied in these areas.

In sum, the book discusses in a suitable manner how some people are abusing the wonders of the internet to highlight criminal activities in the Internet.

What's In A Name? Disputes Relating to Domain Names in India, article by Swati Deva, International Review of Law, Computers & Technology, 2012. This article looks at how the Indian legal framework has dealt the issue of cybersquatting, both at the level of registration of domain name and during the determination of resolution of issue related thereto. This examination was done in the backdrop of the Indian court's orders regarding domain name disputes and India's quest to modernize its legal regime regarding information technology and trade mark through enactment of the Information Technology Act 2000 and the Trade Marks Act 1999, respectively. But this Article lacks in providing International perspective of Domain names disputes.

An Article*, "The Threat of Domain Names to the Trademark System"*, 3 J.World Intell. Prop. 323, 323 (2000) written by Assafa Endeshaw, focus on the issue of domain names-trademarks but it fails to makes in depth study of the steps that is necessary for resolving the domain name dispute.

An Article, *"The Uniform Domain Name Dispute Resolution Policy: A Cheaper Way To Hijack Domain Names And Suppress Critics"*, Harvard Journal of Law & Technology Volume 15, Number 1 Fall 2001, written by Keith Blackman, makes core focus on the Alternate resolution for Domain name disputes, but it fails to make in depth study of the steps that are necessary for improving the UDRP system.

1.4. Significance of study

The proposed study can prove to be of great significance to develop a frame work that may prove instrumental in resolving the domain name and trademark disputes. If the study succeeds in its goal then it could be proved to improve the whole system of e-commerce.

1.5. Statement of Problem

The initiation of global information networks and digital technologies, particularly the Internet, introduces law and legal principle with new and extra-ordinary difficulties/challenges. A far reaching and comprehensive examination of all these challenges, and the diverging ways in which they have been met, would obviously demand an investigation, however such an investigation is beyond limitation of one doctoral thesis. For this reason researcher has preferred to research only one of the most controversial and dynamic areas of cyber law i.e., domain-name dispute, and then mainly one point of view i.e., trademark law.

Domain name is, from numerous points of view, the sign board of the contemporary business association; this makes the very function of domain name like that of a trademark. Because of the significance of domain name, a few issues emerge on how domain names relates with trademarks. The two most significant perspectives in this relationship are an immediate after-effect of the two most significant parts of trademark act: the establishment of a trademark and protection given to owner of the trademark.

Domain names are equipped for utilizing/reflecting existing trademarks. At the point when third party use trademarks this can, when certain conditions are met, brings about violation of trademark. Domain names are in this way, in specific conditions, likewise fit for encroaching trademarks.

Keeping the forgoing in view, there are a lot of questions to be answered like; whether there is any effecting and comprehensive law concerning domain names? Whether Domain names and Trademarks are same? Legal position of Domain names under trademark law both at international level and national level? Can the judiciary tackle the problem of domain name infringement in a effective way? Does domain name need a separate law for its protection? This is what the study intends to accomplish.

There is no single law which deals directly with the issues related to domain Names. There is a need to correlate trademarks with domain names, so we can analyze whether they are interrelated or distinct with each other.

1.6. Objectives of Research work

The specific objectives of study are as follows:

1.To investigate how does domain names relate to trademarks.

2.To examine the characteristics of trademarks.

3.To examine the characteristics of Domain Names.

4.To evaluate the protection given to the Domain names in the international law and the national legal system.

5.To understand under which circumstances can a Domain name infringe a trademark rights.

6.To assess the role of judiciary in this regard.

1.7. Hypothesis

1. The domain names are identical to trademarks.
2. The evolution of E-commerce has affected the trade and commerce very much.
3. The domain names registration often infringes trademarks.
4. Resolution of the domain names disputes is not done appropriately in our country as well as at the world level.
5. Lack of a separate, direct and comprehensive legislation for the protection of domain names often results in the violation of domain names.

1.8. Research methodology

It is a doctrinal research. The qualitative method and to a lesser extent on, quantitative research method is used. For this thesis, quantitative method is used only consist of case law. Case law is the chief source for answering specific aspects associated to the research question.

The explanation behind for opting qualitative research method is related to the fact that this method provides the best insight into specific aspects dealing with domain names and trademarks and into standard aspect related to trademarks. Specific aspects like domain names issue is based on expert sources i.e. academic articles.

The preferred research methods has resulted in a comparative examination whereby resources, dealing with trademark on the one hand and domain names on the other hand, are contrasted with each other.

With regard to the characteristics of trademarks and domain names extensive reference of the available literature is used. Examples of such materials are books on trademarks, patents, domain names, intellectual rights and allied rights.

1.9. Delimitations

As far as this thesis is concerned detailed technical requirements on how domain names function are beyond the scope of this research plan and therefore, these are being left out.

1.10. Scheme of the work

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 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.This brief historical overview of trademark laws demonstrates the fact that the functions of trademarks are constantly evolving.

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.

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)[8] and its consequent control of the domain name system.

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.

"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 six. 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 this chapter researcher concluded 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. As far as India is concerned, there is no enactment which directly deals with the domain name disputes issues; the law is yet to be developed unlike the USA.

Role of Alternative Dispute Resolution Mechanism in Addressing Domain Name Disputes is discussed in chapter seven of this research study. As the judiciary

[8] See ICANN *available at* https://www.icann.org/ (accessed on 03/01/2017).

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.

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. The study finds that there is a close nexus between trademarks and domain names and domain names are identical to trademarks, hence, the related hypothesis is proved. The evolution of Internet which resulted in occurrence of E-commerce has totally changed the way of trade and commerce and ultimately resulted in the new type of dispute relating to domain name and, therefore, hypothesis related to them got proved. Domain name and trademarks are two different things. While trademarks are intellectual property on one hand and on the other hand a domain name is an IP address in a human-friendly form i.e., a technical thing. The dispute only arises while registering trademarks as domain names. The related hypothesis is proved. The fact, that the number of domain name dispute cases adjudicated by the World Intellectual Property Organisation (WIPO) hit 3,036 in 2016, up 10 per cent in the last year from 2,754 and up by two thirds (66 per cent) in the past decade from 1,824 itself proved the hypothesis that Resolution of the domain names disputes is not done appropriately in our country as well as at the world level. It is right that judiciary, around the world, has played a pivotal role in resolving the domain name disputes. Judiciary, especially in the India, United States of America (U.S.A.) and United Kingdom (U.K.), is breaking new grounds and formulating novel concepts that are stretching the horizons of existing laws and laying a strong foundation for the new ones. However, judiciary alone not able to provide quick and adequate protection, which is very much crucial for a commercial entity. Thereby proving the hypothesis related to it. It is suggested that a new legislation should be drafted for the protection domain names and for resolving the domain name and trademark disputes in India.

Chapter-2

Trade Marks and Their Development

2.1. Introduction

The relationship between e-commerce and intellectual property has established many issues concerning the protection of intellectual property on the Internet; the most important of these issues is domain names and their relation to trademarks.

Trademarks are essential tools of today's business. The exclusive right to the use of a distinctive mark facilitates business organizations compete in the open market by distinguishing their products from those of other business associations, and helps customers identify the origin of a goods or services by linking it with a particular business organization. The exploit of trademarks by companies, and dependence on trademarks by consumers, may become more significant as the digital environment, when a trademark name is used as a company's address (domain name) in cyberworld, consumers identify where to go online to conduct business with that company. It is clearly noticeable that commercial companies are trying to develop some new means of dealing with their trademarks by making use of the goodwill they acquired in the real world and transfer such goodwill to the Internet.

Using domain names has generated a rapidly growing set of disputes, such as, conflicts between firms asserting traditional trademark entitlements and the registrants of identical or confusingly similar domain names. Furthermore, there are many types or kinds of conflicts between domain names and trademarks.

Thus in such a situation where domain names directly effecting trademarks, it becomes important to know how they are related to each other, and for that it is necessary to understand, why and how the concept of trademark developed.

2.2. History and Development of Trade Mark Law

Trade Mark is one of the most significant branches of intellectual property. Keeping their role in mind as commercial identifiers, and distinguishing one's goods or service from those of others, trademark plays an important role in organizing the marketplace and encourages honest commercial competition between the competitors using different trademarks.

The practice to mark the goods for different uses has been known since prehistoric times, and indeed before legal protection was even an issue. There are examples of pottery-bearing and cattle branding markings[1] from as long ago as 5000 BC. In general sense, trademarks became important because of widespread trade in the ancient world, especially from Egypt, and later within the Roman Empire[2]. On account of the very long distances over which trade occurred and the perils of such journeys, the main function of these marks were to worked proprietary marks which conclusively indicated the ownership of goods, for instance in cases of piracy and shipwreck, in addition to assisting the illiterate who wants to deal with these goods[3].

With the passage of time these marks advance into the present arrangement of trademark protection and registration. The present framework enables the customer to distinguish and buy a goods or service on account of its origin and quality, indicated by its distinctive trade mark, which fulfils their requirement.

Thus trade mark provides exclusive right to use and protection against the unauthorised used. The object of this chapter is to give brief historical overview to demonstrate the fact that the nature and functions of trademarks are constantly evolving. From this starting point, it will be easy to trace the continual evolution of the modern trademark in the later part of this chapter. Tracing the evolution will also helps in understanding the characteristics of trade mark and how domain names are similar to trademarks.

The protection of these trademarks is therefore of great importance to businesses, which is why trademark law has been introduced in basically every jurisdiction in the world. There is also an international standard for trademark legislation.

2.2.1. Ancient History

The history of trademarks can be traced back to very early days of civilization. In fact the concept of trademarks, even if not trademarks in the modern sense has

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[1] Sheon Ono, *Overview of Japanese Trademark Law*- I, 11(Yuhikaku, 2nd ed.1999) *available at*: https://www.iip.or.jp/e/e_publication/ono/ch1.pdf.

[2] Pickering, C. D. G, *Trademarks in Theory and Practice*, 36 (Hart Publishing, 1998).

[3] *Id*. at 37.

evolved thousands of years. The history of trademarks is about as old as the histories of humankind and religion. The roots of trademarks can be followed back similar to the beginning of the goods circulation. Researchers while excavating the historical site such as ancient Egypt have come across excavated artifacts from places with a variety of symbols carved thereon for superstitious and religious reasons. "Potters marks" appeared in relics left from the Greek and Roman periods and were used to identify the maker (potter) of a particular vessel.[4]

The earliest recognised example of the marked pottery was made during the reign of Chinese Emperor Hoang-To, around 2700 B.C., some twelve centuries before the introduction of ceramics to Europe.[5] These Chinese potteries show two types of marks: the name and the period of Emperor and/or the name and the place of the manufacturer. It was probably the trade from Indus Valley civilization which was responsible for the beginning of European pottery; emblems affixed to Hindu merchandise found throughout the eastern Mediterranean region reveals that there was substantial commerce between the subcontinent and Asia during 1200-1300 B.C[6]. Unlike the Chinese marks, these marks bear simple picture symbols of the craft, rather than imperial or personal designations.

The studies relating "potters marks" are famous among the archeologist researching the cultural heritage of marks, The purposes that such markings intended to fulfill were different needs such as – some marks were indicators of ownership, while others were indicators of the source of the goods.[7]However, in the sense of the modern meaning it is quite difficult to say that these marks are trademarks.

The excavation throughout the Egypt and temples at Nineveh reveals the use of common building bricks having names which are considered to be of the manufacturers. These marks also contain intricate pictures which are believed to be mark of the brick's maker[8]. The studies shows that during this period bricks were use

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[4] Sheon Ono, *Supra* note 1.

[5] Abraham S. Greenberg, *The Ancient Lineage of Trade-Marks*, 876 (J Pat Off Soc'y, 1951) *available at:* http://booksc.org/g/Mark%20S (accessed on 10.03.2016).

[6] *Id*. at 878.

[7] Kelbrick Roshana Alice, "Statutory Civil Remedies in Trade Mark*"*, University of South Africa 9(1997).

[8] *Available at*: www.compilerpress.ca/.../Paster%20**Trademarks**%20Early%20History%2- (accessed on 11/03/2016).

only construction purpose only after they had dried for some two to five years, and that they can be used in a building only after the age of the brick had been attested to by a local magistrate who marked them with his seal of approval[9].

The potteries of Greek civilization commonly contain pictures of classical heroes' adventures, however it also bear a mark at the bottom of the pot which is believed to signify the origin of the product. There are some examples of Grecian sculpture which shows that it was not necessary to have the inscription of the sculptor's name. However on decorated pieces, the name of the decorator is also included[10]. It is reported that beside the maker's name, cup handles for the use at the Ceramicus of Athens often displayed abstract trademarks in the form of figures of lion's heads, bees, oil jugs and Mercury's staffs [11].

In Roman civilization goods were also marked with a variety of inscriptions. There were Italian stonecutters' marks on the walls of Pompeii, on the ancient Roman city walls and on the buildings of the Palatine[12]. The researches suggest that marked stone was used only in the ordinary constructions. However, they are not found on the materials of the more artistic and pretentious buildings such as the bridges of Rome Coliseum and the Forum or the gates[13].

Studies shows the pottery used during the Roman Empire was often marked with the date of the manufacture alone, sometimes they are also marked with the initials or name of the product's maker or the period's consul.

The Empire saw the extension of mark usage on ceramics to include the names of the owners of estates where the kilns were located, the owners or lessees of factories, and the freed men or slaves in charge of the production. It has been suggested that these trademarks indicate a governmental regulation whereby faulty

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[9] Abraham S., *Supra* note 5 at 877.

[10] *Available at:* www.compilerpress.ca/.../Paster%20**Trademarks**%20Early%20History%2-(accessed on 11/03/2016).

[11] Edward S. Rogers, "Some Historical Matter Concerning Trade-Marks" 9 *Mich L Rev* 29 (1910) *available at:* https://archive.org/details/jstor-1276308 (accessed on 11/03/2016).

[12] Leon E. Daniels, *The History of the Trade-Mark*, 239 (7 *TMR Bull* , 1911) full text *available at:* http://www.compilerpress.ca/Library/Paster%20Trademarks%20Early%20 History%20TMR%201969.htm (accessed on 12/03/2016).

[13] *Ibid*.

workmanship might be punished and the source of responsibility for inferior goods absolutely established[14].

The lamps in Roman empire bear various inscriptions: dedication to deities; simple trademarks; acclamations used at public games and events; date of manufacture; the name of maker or place where made or just plain facts[15]. The fabrication of these lamps has been attributed to slave manufacture as indicated by the presence of only one name. These slaves' names generally occur in the genitive, the word *officina* (workshop or factory) being understood. One rare piece is inscribed "*Diogenes fecit*" and several finds exhibit the abbreviation f. (for "*fecit*"; "he made") after the slave's name[16]. Compilations include over six thousand different identification seals and designs used on Roman ceramics. These marks were also used for advertising purposes. Oil-burning lamps, which appear to have been very popular during the fifth century in Rome, bear such inscriptions as *VTERE* ("use this") and *EME* ("Buy me")[17].

It is to be understood that the marks were not confined only to stone walls and pottery. Trademarks have been found on gems, gold and silverware, marble, bronze instruments, glassware, knives and other iron articles and lead pipe. Even the bread of Pompeii bears the designating seals. Attesting to the trade-locale extension theory of trademark importance are the customs of the Roman oculists[18].

Possibly, Wine was the most important commodity of the Romans, and it was subject to extensive trademark use, the jugs often describing the the date of the

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[14] Leon E., Supra note 12 at 245.

[15] Daphne Robert Leeds, *Trademarks-Our American Concept*, 1451-1452 (46 TMR, 1956) *available at:* http://ir.lawnet.fordham.edu/cgi/viewcontent.cgi?article=1121&context=iplj (accessed on 13.03.2016).

[16] Samuel Birch, *History of Ancient Pottery: Egyptian, Assyrian, Greek, Etruscan, and Roman* (1873) book *available at:* http://www.bokus.com /book/9781296723576 /history-of-ancient-pottery/ (accessed on 14.03.2016).

[17] Egbert Jacobson (ed.), *Bernard Rudofsky- Notes on Early Trademarks and Related Matters,* 9 (Seven Designers Look at Trademark Design, 1952) *available at:* http://www .thisisdisplay.org/bookstore/ seven_designers_look_at_trademark_design_lustig_rand_bayer_burtin (accessed on 15.03.2016).

[18] *Available at:* www.compilerpress.ca/.../Paster%20Trademarks%20Early%20History%2- (accessed on 11/03/2016).

wine's pressing, the manufacturer of the wine, and origin of the grapes[19]. The Romans were well aware with signs for shops and inns.[20]

Above description illustrate us a side of commercial life of Romans which is often ignored by legal historians. These manufacturers' marks are no wonder. They are connected with the same system of marking that is known in modern trade. It is, yet, not clear whether this institution of trade ever turned into a system of established law, and whether it did not rely upon commercial honesty and integrity rather than upon the law.

2.2.2. Middle Ages

The expansion of trade during the Middle Ages resulted in the establishment of very large quantities of municipal legislations and guild regulating the use of marks. Politics in Medieval Europe had a great influence on the use of trademarks - the formation throughout Europe of the great trade and craft guilds, the establishment of the Hanseatic League in northern Germany for the protection of sea-trade, the rise of the free cities which were sovereign and self-directing and the disintegration of the feudal system. All of these factors had a played an important role in developing a system of trade marking and trade supervision which was both complex and discriminating.

Inter-urban rivalry was naturally further increased by the civic pride of the municipalities which had grown strong through their several successes in asserting their rights against former rulers[21]. These influences led to the establishment of a standard quality for local products and the use of the municipal mark (usually the coat of arms of the municipality) on all goods made within its boundaries[22].

The trade and craft guilds, which sprang up throughout Europe and England from the eleventh to thirteenth centuries were more potent in trade than the municipal authority. The guild began in most cases as an organized protest against aggression and usurpation, whether by outlaws, rulers or magistrates.

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[19] Edward S., *Supra* note 11 at 31.
[20] Egbert Jacobson, *Supra* note 17.
[21] Leon E., *Supra* note 12 at 246.
[22] *Ibid*.

However Guild movement was limited to the towns only. The guild movement put forward a Masonic order following its devotion towards charity and brotherhood and its love of ritual; in order to bring religious reforms and for the spiritual welfare of its members the guild performs duties of church; Performing its strict regulation regarding the conduct of its members and its municipal and policing authority, guilds some time usurped the government functions; and in its direction and oversight of the trade activities of its members, it look like a present-day trade union even though its scope was much broader.[23]

These guilds were deeply rooted in the trade and working classes. This resulted in the formation of two distinct organizations, the craft guild whose members were craftsmen and the trade guild which is composed merchants. In order to control the activities of its members each of these of guilds declared regulations. By compelling the worker to use his mark, the guilds thus strengthened their control of the trade[24]. There was a rule that when any person becomes a master craftsman he becomes entitled to choose a mark which he can use it for entire of his life in all the goods he produced. It was compulsory to use marks, as part of the duty towards the community, and demanded by the strict social order of craft guilds of the Middle Ages.[25]

During the middle Ages it was very common to mark upon artistic productions the monogram or device of the artist or name of craftsman.

In his classic work on the subject of trademarks, Lucien-Brun, states that “in France trademarks were regarded as property and protected against infringement by civil remedies”[26].

In the beginning of the thirteenth century, the imitation of precious marks became quite common and damaging that violation of marks was made a wrong, in some cases even as felony, and was strictly punished.

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[23] *Id.* at *248.*

[24] Edward S. Rogers, *Supra* note 11 at 36

[25] *Id*. at 30.

[26] Joseph Lucien-Brun, *Les Marques de Fabrique et de Commerce*, Introduction 30 (1895) as quoted in Rogers, *supra* note 11, at 33.

There are many examples of such type of legislations. The Elector of Palatine in the fourteenth century pronounced "an edict stating that the sale of spurious wine was a most outrageous form of deceit, and punishing by hanging any innkeeper who sold ordinary wine as Rudesheimer"[27].

In 1544, Charles V[28] directed his attention to Flemish tapestries demanding that "any master workman who makes or causes to be made any such tapestry, shall work upon one end and upon the bottom of the said tapestry a mark or symbol, and such signs as the city may require; that it may be known by the said marks of what city and of what master the said tapestry is a product.[29]"

Kohler reports [30] that "*an edict of the magistrates of Brussels, 1525, established a system of protection for the originators of new tapestry designs; and in 1528 another edict required that each piece of a certain size should bear, on one side, the mark of the maker, and on the other, that of the city*."

A royal edict of Charles IX[31] in 1564 the imitators of marks and the counterfeiters were put in the same category and were capitally punished. Statutes protecting the drapers of Carcassone (1666) denounce the imitators of mark. In 1376, punishment was fixed for imitators of the marks of the goldsmiths, in the 1400's for the imitators of weavers, and in 1518 for imitators of calendars[32]. It is to be noted here that above mentioned enactments were not general in nature; even for some trades, infringement was only a civil wrong and for some trade the infringement of trademark was a felony [33].

The English Parliament enacted a law in 1266 which states that: "Every baker shall have a mark of his own for each sort of bread in order that would-be customers should know what kind of bread they were being offered[34]."

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[27] Edward S. Rogers, *Supra* note 11 at 33.
[28] Duke of Burgundy and Holy Roman Emperor (24 February 1500 – 21 September 1558),
[29] Joseph Lucien, *Supra* note 26 at 31.
[30] Edward S. Rogers, *Supra* note 11 at 50.
[31] King of France from 1560 until his death in 1574.
[32] Edward S. Rogers, *Supra* note 11 at 34.
[33] Joseph Lucien, *Supra* note 26 at 30.
[34] Benjamin G. Paster,Trademarks - Their Early History: Part I, *available at*: www. compiler press .ca/.../Paster%20Trademarks%20Early%20History%2(accessed on 11/03/2016).

In the beginning of the thirteenth century, all the workers in France had their mark, and were under legal duty to mark all of his products. In order to fix the responsibility for the work this duty of marking the products was obligatory and not the optional. The products were then inspected and approved through public stamping.

In Scots law, there are evidences of laws concerning trademarks. In an Act of 1487 entitled "The binde of Salmond, and measure thereof," it is prescribed that "every town shall have, in addition to hoop irons serving to bind and measure barrels containing salmon".[35]

The use of trademarks by printers was an inevitable consequence of conditions which resulted from an absence of any notion of property in literary work . The first book published under a printer's mark was *Psalterium Latinum* printed in Mainz[36] (a city in Germany) by *Johann Fust and Peter Schoffer* in August, 1457.[37]

In middle ages, the peril of the sea increases the value of private marks to those merchants who trade across the seas. Merchants' marks were registered, and certificates issued attesting to mark ownership. Just suppose that an accident occurs during a sea voyage and all the cargo is lost and subsequently recovered, at that time it is the Merchants' mark which can help in determining the identity of goods recovered .[38]

All through Europe, various so-called marks of control or guarantee were appended by local authorities to verify that the goods having marks were of a approved quality standard. These were used in relation with other marks, and are similar to modern inspectors' stamps on dairy, meat and other perishable Items. These control marks were more concerned with regulating the quality, price, weight or size of the commodity, not with the identification of the maker of the product,

[35] *Available at:* www.compilerpress.ca/.../Paster%20Trademarks%20Early%20History%2-(accessed on 11/03/2016).
[36] It is known as Mayence in French.
[37] Egbert Jacobson, *Supra* note 17.
[38] Robert C. Lind, Trademark Law 43 (5 North Carolina Academic 2006).

except to point out on whom the responsibility lays in cases where the standard not be met [39].

Similar legislations appeared in England, Germany, Italy and France.

2.2.3. MODERN TIMES

As modern capitalism has developed the drive to sell products and services using some mark, brand or name has invaded more and more fields. Some foods and a few other staples are still sold to the consumers without branding, but the overwhelming tendency is towards some form of labeling to indicate source. Before industrialization, there were, of course, instances of traders or trader groups who deployed marks of various kinds to distinguish their products. But the demand for general legal protection against unfair imitation of marks and names is a product of the industrial revolution that followed factory production and growth of canals and railways. That demand swelled immensely with the development of modern advertising and large scale retailing. Most advertising teaches the consumer to buy by product mark or house name and keeps reiterating its massage in the hope of persuading buyers not to defect to rivals. Trade marks and names have become the crux of marketplace competition[40].

2.2.3.1. ENGLAND

At the beginning, trademarks were not by and large observed as something requiring legal protection until the industrial revolution began. That's why common law and equity didn't troubled itself with the question relating to protection of trademarks until relatively later on; with the result, that many scholars were initially satisfied to believe that the law of trademark protection was the sole outcome of the late eighteenth and early nineteenth centuries. However when the requirement for a general protective law arose, it was met in following three ways: at first by common law alone, then additionally through registration of trademark and lastly on an international community level [41].

[39] Leon E. Daniels, *Supra* note 12 at 58 & 59.

[40] Cornish, Llewelyn, Aplin, et.al., *Intellectual Property: Patents, Copyright, Trade Marks And Allied Rights* 630(Thomson Reuters, 8th ed. 2013).

[41] Pickering, *Supra* note 2 at 630.

The trademark protection in the English common law is based on the findings of the Court in an unreported case *Southern v. How* of 1618.[42] But, after this, there was a vacuum in the law on this matter until decision in the case of *Blanchard v. Hill*. The facts of Blanchard's case is that "plaintiff, a maker of playing cards, sought an injunction restraining the defendant from making use of the Great Mogul as a stamp upon his cards, to the prejudice of the plaintiff. The plaintiff further said that he had the sole right to this stamp as a result of the charter which was granted to the card makers' company by King Charles the First"[43].

The facts of Blanchard's case are particularly notable; the plaintiff was seeking protection of a mark for playing cards pursuant to a charter granting exclusive rights to card makers, and royal charter had been at the centre of a long political struggle between Parliament and the Crown. [44]

Lord Hardwicke was of the view that "the intention of the charter (under which the plaintiff claimed rights) (was) illegal," and said the court would "never establish a right of this kind, claimed under a charter only from the crown, unless there had been an action to try the right at law."[45]

Relying on the precedents of the court, Lord Hardwicke observed that where the intention of defendant is to pretend its goods as those of the plaintiff, it is suitable to grant injunction. He further stated that "*It is also important to note that the trademark law developed from an early form of passing off. Long before the establishment of a formal system of registration of trademarks, it was usual for the courts to restrain the use by one trader of another trader's mark*".

The *Sykes v. Sykes*[46]**,** the first ever reported case which demonstrates that the courts were considering a trademark a type of proprietary right which relied on the fraudulent use of a similar mark for its enforcement. In this case, the plaintiff was

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42 (1618) Popham 143.

43 (1742) 2 Atk. 484.

44 Thomas Nachbar, "Monopoly, Mercantilism, and the Politics of Regulation*" 91 VA. L. REV.* 1313 (2005) *available at:* http://papers.ssrn.com/sol3/papers.cfm?abstract_id= 1912621 (accessed on 16.03.2016).

45 Mark P. McKenna, "The Normative Foundations of Trademark Law" *Notre Dame L.Rev.19* (2006) *available at:* http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1912621 (accessed on 16.03.2016).

46 3 B. & C. 541 (K.B. 1824) *available at* : caselaw.findlaw.com › Caselaw › New York › NY Supreme Ct. (accessed on 16.03.2016).

manufacturer of a shot-belt and powder-flask, and sold for profit. The plaintiff usually marks his goods with the words "Sykes Patent," so as to indicate that they were produced by him. The defendant whose name was also "Sykes" claims that he had as much right to use "Sykes Patent". The court allowed an action for damages only on the proof that it was used in bad faith.

After the decision in Sykes case, there were number of similar cases before the court where the liability was fixed on the ground that competitor sought to pass off its goods as those of the claimant. Those cases generally were brought as actions on the case, in the nature of deceit. Yet one must be careful not to read those cases through modern lenses – despite the form of action, courts in these early cases invariably described the defendant as having practiced fraud on the plaintiff.[47] Courts of equity starts taking care of trademark claims in the first part of the nineteenth century. Initially the court was of the view that where claimant proves the exclusive right to use the particular mark, equity intervened to protect interest even without evidences regarding the bad intent. [48]

By the second half of the nineteenth century, it was clear that marks applied to goods that had become distinctive, had an intrinsic value and were worthy of some form of legal protection. Such protection was available through the use of Royal Charters and court action[49].

As a result, It was in the second half of nineteenth century that the enactment relating to the trademarks made its appearance[50]. The English courts were dealing trademarks through the action of passing off [51], however this proved to be not enough

[47] *Ibid.*

[48] *Id.*at 21.

[49] Tina Hart, Linda Fazzani,Simon Clark,et.al., *Intellectual Property Law*, 630 (Palgrave Macmillan, 4th ed. , 2006).

[50] F. Schechter, "The Rational Basis of Trademark Protection," Harvard Law Review, 813-833(1927) *available at:* http://www.worldcat.org/title/rational-basis-of-trademark-protection/oclc/65153785 (accessed on 16.03.2016).

[51] S. Ricketson, *The Law Of Intellectual Property*, 599 (Law Book, Sydney, 1984).

and enactment of trademark registration began to make their appearance in Europe: England 1862 and 1875, France 1857, and Germany 1874[52].

"The Merchandise Marks Act," which focused on provisions dealing with deceptive indications, was passed in England on August 7, 1862. The "Trade Mark Registration Act" was also passed in 1875. The Trademarks Registration Act 1875 was enacted to overcome the difficulties faced in some trademark violation cases. The Act contains provision relating to entry of trademarks on register which is still followed. Entry of a mark on the Register is prima facie evidence against the unauthorised use by third parties. The 1875 Act provides the essentials of a trademark, benefit from registration giving practitioners and the courts the criteria for determining what could legally amount to a trademark.

Under the English common law system, the improper use of marks and fraud falls under the category of passing off an action for which remedies were contemplated that continues today. An equity law remedy regarding trademark was to supplement the common law protection, however, in England there was no comprehensive law for protection of trademark until 1905[53], nearly 50 years after the France.

The Act 1905 was amended in 1919 and then in 1937, until enactment of new Act in 1938. This Act of 1938 essentially changed the framework from numerous points of view, creating an application publication system, creating an examination-based process, and allowing registration based on intent-to-use. The act of 1938 surpassed the trademark law of France in many ways. As a result, the trademark laws of U.S. were very much influenced by the 1938 Act. England's 1938 Trademark Act contained new concepts such as “non-claiming right system, a consent-to- use system, a defensive mark system, and associated trademarks.”

On October 1, 1986, a service mark registration system was incorporated (The 1986 Act) in England. By 1995, the U.S, England, Germany, Japan and France, the so-called G5 nations ("Group of 5") were all using a service mark registration

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[52] S.P. Ladas, *Patents, Trademarks, and Related Rights: National and International Protection*, 8 (Harvard University Press, Cambridge, Vol. 1, 1975) as refered in book *available at:* https://books.google.co.in/books?isbn=1351927132 (accessed on 16.03.2016).

[53] Cornish, *Supra* note 40 at 633.

system. Today, almost every industrialized nation has a service mark registration system. Following a European Community's directive[54], in October 10, 1994, England extended the scope of its trademark subject matter, amending its trademark requirements. In addition to this, the provisions relating to the defensive mark system and the associated trademarks system in 1938 Act were abolished.

2.2.3.2. UNITED STATES

Just as its English predecessor, American law relating to trademark was chiefly a result of judicial decisions. Even before the passing of first Federal Trademark Act of 1870 in America, there were state level and trade centric statutory provisions relating to marks.[55]At the outset, American courts were mainly concerned with the loss to manufacturer from illegitimate attempts to divert its trade, and they tried to remedy that harm following existing forms of action. The same focus was followed while deciding trademark cases and thus they made it clear that the purpose of trademark law was to protect a party from improper diversion of their trade[56].In *Coats v. Holbrook*, for example, the court (Chancery Court of New York) opinioned "a person is not allowed to imitate the product of another and 'thereby attract to himself the patronage that without such deceptive use of such names would have ensured to the benefit of that other person. [57]"

Similarly, in *Partridge v. Mench*, the court relying on the fact that the there is a monetary interest of the complainant in the good will of his business or trade, and considering the fact that he has bind himself with a particular trademark or sign or label, held, "he [was] entitled to protection against any other person who attempted to pirate upon the goodwill of the complainant's friends or customers, or of the patrons of his trade or business, by sailing under his flag without his authority or consent". [58]

The objective of customary American trademark law at that point was quite clear – it tried to safeguard the manufacturer's interest against illegitimate attempts to

[54] *Id*. at 635.
[55] McKenna, *Supra* note 45 at 22.
[56] *Id.* at 26.
[57] 2 Sand. Ch. 586, 7 N.Y. Ch. Ann. 713 (C.C.N.Y. 1845)
[58] 5 N.Y.Leg.Obs. 94, 2 Barb.Ch. 101, 5 N.Y. Ch. Ann. 572, 47 Am.Dec. 281 (C.C.N.Y.1847) *available at:* http:// www.archive.org /stream/cu31924019300387/cu31924019300387_dj vu .txt (accessed on 20.03.2016).

divert its trade. American courts quickly concluded that in many cases this protection was based on a property right, which was originally according to the perspective of English equity courts. Thus, even in English law and equity decisions there is a deep disagreement regarding the basis of trademark protection; there is no such disagreement with the decisions of US courts [59]

It can be concluded from the early history of the U.S. trademark protection that in the beginning of 19th century the development of trademark protection was rather slow. The reason for this was that in those days the trademarks were not in general use nor were they given more attention by the State Legislatures or Congress. It was with the rapid increase of trade and industrial activities, which they had gained popularity. Gradually, the manufacturers felt the need for business identification and thus started using the trademark. Therefore, the need for the protection of the trademark from any type of violation arose. This in July 8, 1870, led to the enactment of the first federal act namely the Federal Trade Mark Act for the protection of trademarks.

However, in 1897, due to the conflict with the provision relating to patents in the U.S. Constitution, the Supreme Court had held the Act unconstitutional. It was therefore abolished. A trademark law) based on the interstate commerce clause in the U.S. Constitution (Art. 1, sec. 8, cl. 3) was enacted in its place on March 3, 1881 for the trademarks used in inter-state commerce (and in commerce with Indian tribes)[60]. However, this law did not fit to the speed of American economical development and therefore amendment in 1905. It amended occasionally during subsequent years.

On July 5, 1946, American trademark law i.e, Lanham Act was enacted. This enactment put the America trademark law on the same footing of English or German trademark laws. The name of this act was named after a member of Congressman who had dedicated himself to its creation in accordance with American traditions. The Lanham Act and English trademark law are similar in the sense that both the law adopted use-based principles as their foundation. Initially, this Act, put much emphasis on use than the English law by requiring not just an intention to use the mark, but an actual use of the mark in order to registered the mark. Following the

[59] McKenna, *Supra* note 45 at 27.
[60] Art. 1, sec. 8, cl. 3

International trend this requirement for the registration of marks was altered by the House of Representatives through amendment to the Act on October 19, 1988, and this was approved by the Senate. It was come into force on November 16, 1988. Now under amended Act, intent to use is now sufficient to apply for trademark registration[61].

The Lanham Act of America is different from the English law in a sense that it protects the marks under state trademark law in addition to Federal trademark law[62]. The Lanham Act requires a publication of applications made for marks and also adopted the principle of examination. Further, for the very first time in United States this trademark law approved the registration of service marks[63].

Lanham Act defines a trademark as, includes any word, name, symbol, or device, or any combination thereof___

(a) used by a person, or

(b) which a person has a *bona fide* intention to use in commerce and applies to register on the principal register established under this act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown. [64] This provision requires that a mark in order to become a trademark must be distinctive. Here, distinctiveness of a mark is required in order to identify the source of a particular good.

In order to determine the distinctiveness of a trademark, the court examines whether the relationship between the mark and the product falls into the subsequent categories:

(1) generic,

(2) suggestive,

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[61] Anne Hiaring, Lynn S. Fruchter, "Understanding Basic Trademark Law" 10 (San Francisco: Practising Law Institute 2004).

[62] *Available at* the Homepage of the IP Mall, Pierce Law Centre, http://www.ipmall.info/hosted_resources/lipa/patents/Patent_Act_of_1870.pdf, last visited on 12-03-16.

[63] Anne Hiaring, *Supra* note 61.

[64] Lanham Act, 15 U.S.C. § 1127 *available at:* https://www.law.cornell.edu/ uscode/text/15/1127 (accessed on 12-03-2016.)

(3) descriptive,

(4) fanciful and

(5) arbitrary [65]

The Trademark Law Revision Act 1988 (TLRA) upgraded US treatment of intellectual property by conferring on producers earlier protection of their marks before they had been used and goodwill had been created.

In 1999, another amendment introduced the Anti-Cybersquatting Consumer Protection Act. This act regulates trademark violations on the Internet through domain names. The main objective of this act is that those who have trademark rights also have rights over the respective domain name; therefore nobody except Microsoft can register the domain name www.microsoft.com on the internet. This act protects the Trademark of that company in cyberspace.

2.2.3.3. TRADEMARK LAWS IN INDIA

In India, trademark law before 1940 was solely based on the common law principles such as equity and passing off as they were followed in England till the passing of the Registration Act of 1875. Although there are some forms of proprietary protection for marks were prevailing in India, but for the first time statutory recognition to Trademarks Law was given in 1860. [66] The problems relating to law of passing off and infringement these were solved in accordance with the section 54 of the Specific Relief Act, 1877 and the problem relating to registration was obviously dealt under Indian Registration Act 1908 by obtaining a declaration as to the ownership of a trademark.[67]

To overcome the aforesaid difficulties the Indian Trademarks Act was passed in 1940, this corresponded with the English Trademarks Act. After this there was an

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[65] Two Pesos Inc. vs. Taco Cabana Inc., 505 US 763(1992) *available at:* https://www.leagle.com/decision/19921268505US763_11248/TWO%20PESOS,%20INC.%20v.%20TACO% 20 CABANA,%20INC(accessed on 30.04.2016).

[66] Section 478 and 480 of Indian Penal Code [Repealed by the Trade and Merchandise Marks act, 1958(43 of 1958, sec 135, w.e.f. 25-11-1959)].

[67] *Available at:* https://en.wikipedia.org/wiki/Indian_trademark_law -(accessed on 18.03.16).

increasing need for more protection of trademarks as there was a major growth in trade and commerce.

` The replacement to this act was the Trademark and Merchandise Act, 1958. This Act merged the provisions related to trademarks contained in other existing laws like, Criminal Procedure Code (Cr.P.C.), the Indian Penal Code (I.P.C.) and Sea Customs Act. This Act was passed with a view to provide for better protection and registration of trademarks and to prevent the use of fake/false marks. The provision relating to registration in this entitles the owner of the trademark to have an exclusive right over the trademark. In short the act was passed with the aim to provide better protection of trademarks, easy registration and to prevent fraud.

The Trade Marks Act, 1999 repealed the Trade and Merchandise Marks Act, 1958 and is presently the governing law in India related to registered trademarks. This act was enacted to comply with the provisions of the Trade Related Aspects of Intellectual Property (TRIPS)[68]. Though, in the present Act some aspects of the unregistered trade marks have been enacted, but primarily they are governed by the common law rules (Passing off and equity) evolved out of the judgments of the courts. Where the law is not clear, the rules evolved by the English courts have been applied in India after taking into consideration of the legal procedure, laws and substance of India.

In spite of the fact that the Act was passed in 1999 yet all the provisions of the Act came into force on 15th September, 2003. Besides, the Central Government notified the establishment of Intellectual Property Appellate Board and specified Ahmadabad, Chennai, Delhi, Mumbai and Kolkata as places of benches of Intellectual Property Appellate Board with effect from 15th September, 2003. Further the Central Government made provision for the transfer of pending proceedings to such Appellate Board with effect from 6th October, 2003.

[68] Trade Related Aspects of Intellectual Property. TRIPS is an international agreement administered by the World Trade Organization (WTO) that sets down minimum standards for many forms of intellectual property (IP) regulation as applied to nationals of other WTO Members. The TRIPS agreement introduced intellectual property law into the international trading system for the first time and remains the most comprehensive international agreement on intellectual property to date.

Meaning of Trade Mark Under The Act

Section 2(1)(m) of the Trade Marks Act,1999 defines a mark as: 'Mark' "includes a device, brand, heading, label, ticket, name, signature, word, letter, shape of goods, packaging or combination of colours numeral shape of goods, packaging or combination of colours or any combination thereof"[69].

Section 2(1)(zb) defines "Trade mark" "as a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours"[70].

Section 2(1)(z) of the Trade Marks Act, 1999 defines "service" as service of any description which is made available to potential uses, and includes the provision of services in connection with business of any industrial or commercial matters such as banking, communication, education, financing, insurance, chit funds, real estate, transport, storage, material treatment, processing, supply of electrical or other energy, boarding, lodging, entertainment, amusement, constriction, repair, conveying of news or information and advertising[71].

The Trade Marks Act, 1999 also defines-"well known trade mark", "as a mark in relation to any goods or services which has become so to the substantial segment which uses such goods or services such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first mentioned goods or services"[72].

The "trademark" means 'a mark capable of being represented graphically and which is capable of distinguishing the goods and services of one person from those of others'[73]. Mark includes name or word. Name includes any abbreviation of a name[74].

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[69] Trade Marks Act, 1999.
[70] *Ibid.*
[71] *Ibid.*
[72] *Id*. at section-2(zg).
[73] Dr. B.L.Wadehra, *Law Relating to Intellectual Property*, 133(Universal Law Publishing co. 4th ed, 2009).
[74] *Lakmikant V. Patel v . Chetanbhat shah*, AIR 2002 SC 275.

2.3. The Modern Concept of Trade Mark[75]

Whatever the wording used, essentially a trade mark was an indication which enabled the goods or services from a particular source to be identified and thus distinguished from goods and services from other sources. Excepting slight differences, the trade marks under most of the national laws include mark, device, brand, word or signature provided it establish relation to the goods and services to which these are attached. Whatever used as trade mark being permissible under the national laws, the mark must be able to identify the goods or services in respect of which it is used. Therefore, under all domestic laws, the trade mark is defined as a mark which is used in relation to goods for the purpose of indicating or to indicate a connection between the goods and the proprietor having the right to use the mark in the course of trade.

The functions of trade mark are different from property mark because the trade mark signifies the manufacture or quality of goods to which it is employed, whereas the property mark indicates the ownership of those goods or services. The trade mark concerns the goods themselves but the property mark denotes the proprietor of the goods.

The modern concept of trade mark encompasses its legal definition, purposes, functions and nature of rights attached to it. The sole purpose of trademark is to distinguish the goods or services of one from those of another and therefore the trade mark must acquire be distinctive character and be used or intended to be used in course of business. If the trade mark is not used in course of business or trade, it might forfeit the statutory protection.

The essential features of modern trademarks are the following[76]:

(a) It must be mark which may be packaging shape of goods, combination of colours;

(b) capable of being represented graphically;

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[75] Dr.Jayanta Lahiri, *Lectures on Intellectual Property Laws*, 154-155(R. Cambray & Co. Private Ltd. Ist ed, 2009) .

[76] Trade mark, *available at*: https://en.wikipedia.org/wiki/Trademark,Trademark Law *available at*: www.nalsarpro.org/PL/Presentations/PL306.pdf, New Types of Marks *available at*: www.wipo. int /edocs/mdocs/sct/en/sct_16/sct_16_2.doc,Trade Marks Work Manual - 2008 - Controller General of Patents ... *available at*: ipindia.nic.in /tmr_new /TMR_ Manual/TMR_Manual_2008.pdf.

(c) mark trade mark must be capable of distinguishing the goods or services from one person from those of others.

(d) the mark must be used in course of trade;

(e) the trade mark or mark when used in course of trade must indicate a connection in the course of trade between the goods and services and the person who enjoys the right as proprietor to use the mark or proprietor of the mark or permitted user to use the mark.

Any mark which fails to satisfy the aforesaid features cannot get the statutory protection as a valid trade mark.

2.4. Trade Marks in World Trade

Similar to all other intellectual property rights, trademarks are also territorial rights. It means that a registered trademark offers protection against unauthorized use by third parties within the jurisdiction of the country where the mark was registered. Unlike copyright, there is no automatic extension of a national trademark to other countries. Keeping this problem in mind, a number of international conventions and arrangements were adopted which provides some international protection to national trademarks. These are the "Paris Convention", and "the TRIPS agreements". There is also a Community Trademarks System that creates a trademark that gives rights throughout the European Community[77].

2.4.1. Paris Convention

In order to create some recognition and interaction among the different nations in relation to each other's national intellectual property rights this Paris Convention was established in 1883. The convention recognises the principle of priority in matters of registration of intellectual property rights. This rule regarding priority recognises the date of first filing for a particular intellectual property rights in any member nation. The period of priority differs from intellectual property right to intellectual property right, but in the case of trademarks the period is fixed to six months. It is for the very first time that an international protection is given to

[77] Tina Hart, *Supra* note 49 at150.

trademarks.[78]This is not the case in the United Kingdom, because rights in passing off can be built up through sufficient use of a trademark without registration and those rights can act as an obstacle to any subsequent application to register the trademark by a third party.[79]

Another notable provision concerning marks, found in Article 6bis, protects unregistered marks that qualify as "well-known" in a member nation. It provides the international protection to "well-known" trademarks. Member nations are under duty to prohibit the use within their territory, or to cancel if already registered, and to refuse to register the marks for identical or similar goods which are already famous in the country and can create confusion with another trademark. As the well-known mark has already having goodwill in the native country, allowing the use or registration of a confusingly similar mark will amount to an act of unfair competition and deceives the public. Whether a mark is well-known is determined by the applicable domestic law, although a trademark need not have been used in the country to be well-known there.[80]It is to be noted here that this international recognition of national trademarks is of limited only to trademarks which are 'well-known' in other member nations. Under Paris Convention no definition of the phrase 'well-known' is given and therefore member countries have formulate their own definition from case law. The World Intellectual Property Organisation (WIPO) is of the view that this is unsatisfactory for a provision having international effect. [81]

2.4.2. The Madrid System for the International Registration of Marks[82]

The Madrid system provides a means to protect the trademarks in many countries simultaneously. It is relatively less expensive, effective and simple. Non member nation, who want join the system can join one or the other of two international Treaties – either the Madrid Protocol or the Madrid Agreement. Recent trend shows that new countries prefer the Madrid Protocol, which is more novel of the two. Japan ratified the Protocol in early 2000; the United States has become its

[78] *Id*. at 151.
[79] *Ibid.*
[80] Paris Convention, Article 6bis.
[81] *Available at:* http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch2.pdf-acessed on 11.03.16.
[82] *Available at:* http://www.wipo.int/madrid/en/- accessed on 11.03.16.

member on November 2, 2003[83]; and in October 2004, by the European Union (EU) as such. The Madrid Union currently has 98 contracting parties, covering 114 countries[84].

The procedure for the simultaneous application for registration of their marks in member countries is welcomed and found to be novel by many trademark owners.

Since April 14 1891, The Madrid Agreement Concerning the International Registration of Marks ("the Madrid Agreement"), allowed the nationals of members countries to protect their trademarks, in any or all of the other member nations. One can get his mark registered by filing single international application filed in one language, with a minimum of formalities, with one fee, paid in a single currency, in one place and resulting in only one registration, with one number and one renewal date. There are presently 55 countries which became party to this agreement.

At least 100 years after the Madrid Agreement, on June 27 1989, a related Treaty namely “Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks” was adopted. It is generally called as "the Madrid Protocol" and it follows the same objective and same working pattern as of the Madrid Agreement. Although there are many similarities between the Madrid Agreement and the Madrid Protocol but Infact they are two separate treaties. On account of their many similarities and sharing of ‘Common Regulations’, they are non-separable that’s why in combination they are referred as "the Madrid system".

There are some advantages and some disadvantages for trademark owners in Madrid Protocol. However it is strongly believed that the advantages far outweigh the disadvantages as the following discussion illustrates.

- The registration procedure of marks is quite simple, namely “ONE application in ONE place with ONE set of documents in ONE language with ONE fee in ONE currency resulting in ONE registration with ONE number and ONE renewal date covering more than ONE country”.
- It is less expensive.

83 See, list of members *available at* http:// www. wipo. int/ export/ sites/ www/ treaties/ en/ documents/ pdf/madrid_marks. pdf- accessed on 10/05/16.

84 *Available at*- http://www.wipo.int/madrid/en/members/- accessed on 10/05/16

- On account of its simple procedure and cheapness there are chances that soon many countries will become members of this protocol, which ultimately increase the possibilities of particular trademark to get protected in many countries.
- An application can be made in either English or French and, if neither their mother language is, they may communicate directly with WIPO, as WIPO has the capacity to entertain general correspondence in a variety of languages. However, most owners entrust the task of their trademark applications to firms of local attorneys who are proficient in English language.

2.4.3. TRIPS Agreement

Trade-Related Aspects of Intellectual Property Rights' (hereinafter referred to as the "TRIPS Agreement") Article 15(1), contains a now widely accepted definition of trademark, namely "any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings." [85]

This definition reflects the origin function as well as the distinct function of trademarks. The elements which required being present in a mark to serve as a trademark should be of International standard. The first element relates to the core function of trademarks, it must indicate the commercial source of services or goods and so that the goods or services be separated from that of competitors. It follows that a trademark must be distinctive. Article 15(1) of the TRIPS Agreement stipulates it must be "competent to distinguish the goods or services of one undertaking from those of other undertakings."[86] In fact any mark which is capable of making distinction between the goods or services of undertakings in the commercial world may serve as a trademark, provided that it must comply with standards of public order or morality.

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[85] TRIPs ,Article 15(1).

[86] Document prepared by the Secretariat, Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, World Intellectual Property Organization, Sixteenth Session, Geneva, November 13 to 17, (2006).

Nearly all national trademark laws provide for the protection of visible signs[87], for example: words, including personal names; drawings, paintings, letters, numerals, figurative elements and devices, figures, combinations of colours, pictorial devices, such as logotypes, or combinations of the above.[88] Even the three-dimensional signs, relating to product shape or product packaging also considered to be fit to be trademarks. New types of trademarks, such as olfactory marks, sound marks, multimedia marks and colour marks are evolving in the market on the basis of changing consumer needs and new marketing and advertising strategies.[89]

The scope of protection is defined in Article 16 of the TRIPS Agreement, which enable the owner of the mark to oppose the use of a similar or identical sign on similar or identical services or goods in the normal course of business, where such use would create confusion. The use of confusing similar mark raises a presumption as to bad faith. The definition of the scope of trademark protection in Article 16 allows Members a considerable degree of flexibility regarding the level of protection that will be provided. For instance, the essential requirement is that a “similar” mark may not be used on “similar” goods or services. It can be strictly enforced, such that signs and goods must be confusingly similar to justify protection, or it can be done generously, such that signs and goods need only be within a category or class to justify protection. As a matter of fact it is applied differently by different legal systems, and different courts within the same legal system. There are other flexibilities built into Article 16. Furthermore, Article 16 of the TRIPS Agreement supplements Paris Convention rules on “well known” marks, essentially limiting the class of persons to whom a trademark or service mark must be well known in order to qualify for protection.[90]

General assemblies of the “WIPO” and the “Paris Convention”[91] in 1999, jointly recommended better protection for well-known trademarks (‘Joint Recommendation’).[92]

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[87] *Available at:* http ://www.wipo.int/edocs/mdocs/sct/en/sct_16/sct_16_5.doc- (accessed on 11.03.16.)

[88] *Ibid.*

[89] *Ibid.*

[90] *Available at:* http://www.wipo.int. Report on United Nations Conference on Trade and Development, “Dispute Settlement under WTO,” New York and Geneva, 15(2003).

[91] 20 March 1883, last revised at Stockholm, 14 July 1967, 828 U.N.T.S. 305 [Paris Convention].

[92] *Available at:* http:// www. wipo.int/ documents/ en/document/ govbody/wo_gb_ ab/doc/a34_ 13.doc[Joint Recommendation].

As in article 6bis, the Paris Convention had since 1925 prohibited the registration of imitations or copies of "well-known" marks where confusion was likely to result.[93] The protection of well-known marks under TRIPs was much ahead to the protection under Paris convention. Now 'Well known' marks for services and not just goods are protected. A mark's notoriety is to be judged by reference to "the relevant sector of the public" (not necessarily everyone), and notoriety may come from advertising the mark, not just using it. More importantly, TRIPS extended the reach of well-known registered brands to catch use on dissimilar goods or services if the use would indicate a connection between the mark and the registered owner, and the owner's "interests" were "likely to be damaged".[94] The concept dilution was elaborated and extended by the Joint Recommendation on Trademarks. Among other things, the distinction between registered and unregistered well-known marks is also removed. Apart from this, the Joint Recommendation accepted that the TRIPs article 16.3 can be read in restricted form to possibly cover confusion, so two provisions were included, which are prepared by mixture of US and EU law, which are clearly preserving well-known marks from dilution[95].

The owner of the mark could bring action where:

(i) the use of that other mark is likely to weaken or diminish in an unjust manner the distinctive character of the well-known mark;

(ii) his interests are likely to be damaged by such use. [96]

Trademark law is territorial in part because the early Intellectual Property conventions of the late nineteenth century, the Paris Convention and the Berne Convention for the Protection of Literary and Artistic Property, were based on the principle of national treatment.[97]

A signatory state was required to provide protection to citizens of other signatory states which is in the line of protection afforded to its own nationals. It is to

[93] David Vaver, "Unconventional and Well-Known Trademarks," Singapore Journal of Legal Studies, 13(2005).

[94] TRIPs, Article 16(2&3).

[95] *Available at:* http://www.wipo.int/edocs/pubdocs/en/marks/833/pub833.pdf-accessed on 16.03.16

[96] *Available at:* http://www.wipo.int/documents/en/document/govbody/wo_gb_ ab/doc/a34_ 13. doc [Joint Recommendation] (accessed on 14.03.16).

[97] Berne Convention for the Protection of Literary and Artistic Works, 24 July 1971, 1161 U.N.T.S. 31.

be noted that, law is contextual, and geography is a central part of context. As mentioned earlier trademark rights are territorial in nature. Trademark rights that have been defined territorially flowed logically from the intrinsic purpose of trademark law. Whether viewed as an instrument to protect consumers against confusion or to safeguard producer goodwill, the function of trademark law was served by identifying rights in the local manufacturer. The area in which a mark was used was the vital determinant of the geographic reach of rights, as indeed one might expect in a use-based trademark system. Territoriality reflects efforts to protect goodwill to the extent of its geographic reach. On the other hand, digital communication and global markets have encouraged a need for the motivation of International trade and more effectual international enforcement of rights.[98]

The Paris Convention imposed very few obligations related to substantive content of national laws. The national treatment principle ensured that nationals of Paris Union countries were able to seek national rights in foreign countries on equal terms with national applicants.[99] Regardless of the development and growth of the international trademark system, both with respect to substantive harmonization and procedural matters, the crucial proposition that trademark laws are national remains principally intact as a theoretical matter. Trademark rights are classically acquired through national mechanisms but territoriality requires a producer to obtain separate rights for each territory (country) in which it desires protection.[100]

2.4.4. European Community's Trade Mark System

In reality, the European Union's (EU) trademarks Law is the outcome of an innovation and massive program of reform under the motivation of the single market initiative[101]. Prior to this, protection relating to trademarks was based on the different system of the national protection of member states under the international umbrella of

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[98] Georgios I. Zekos, "Trademarks and Cyberspace," Riga Graduate School of Law, the Journal of World Intellectual Property, Vol. 9. No. 5, p. 506 (2006).

[99] *Ibid*.

[100] *Ibid*.

[101] The European Economic Community (EEC) was a regional organisation which aimed to bring about economic integration among its member states. It was created by the Treaty of Rome of 1957. Upon the formation of the European Union (EU) in 1993, the EEC was incorporated and renamed as the European community (EC) *available at* https://en.wikipedia.org/wiki/European_Economic_Community

the Madrid Agreement, which is neither a Community initiative nor gives rise to any unified Community system of trademark protection[102]. Due to this, within the Community there were ten systems for trademark protection varying from country to country which causes unnecessary expense, confusion, and uncertainty, and more over it causes hindrance on the free movement of goods and services.[103] On account of this faulty legal system, a huge legal reform was required. Finally, in 1964, the Working Group was formed to consider the problems of trademark protection with the community.

In 1973, the first text of proposals was published. After that in 1976 memorandum by the Commission was published. It was followed by seventeen meetings of interested parties and experts to discuss the proposals, which was in 1980, resulted in the modification of the proposal. This modified proposal, after consultation with the European Parliament was submitted to the Council of Ministers by the Commission. The said proposal attacked in two ways, a Regulation to create a European Community wide trademark, and Directive to harmonise national laws.[104]

Toward the end of the 1980s, the European Community (EC), while acting under the influence of judicial trends adopted the Directive,[105] is intended to approximate laws of the Member States of the European Union that relate to trade marks. The Directive was designed to harmonize disparities in the respective trade mark laws that had the potential to impede the free movement of goods and provision of services and distort competition within the European Union. Nonetheless, this harmonization of different national legislation was not able to remove the hindrances resulted due to the territorial nature of those rights that laws of convention member conferred on trademarks. To allow businesses to conduct their economic activity

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[102] The European Economic Community (EEC) was a regional organisation which aimed to bring about economic integration among its member states. It was created by the Treaty of Rome of 1957. Upon the formation of the European Union (EU) in 1993, the EEC was incorporated and renamed as the European community (EC) *available at* https://en.wikipedia.org/wiki/European_Economic_ Community

[103] Terence Prime, *European Intellectual Property Law*, 75(Ashgate Publishing Company, 2000)

[104] *Id.* at 77.

[105] Council Directive No. 89/104/EEC *available at:* https://en.wikipedia.org/wiki/ Trade_ Marks_ Directive.

without further limitations within the whole area of the Common Market, it was necessary to institute a Community-based system of trademarks.[106]

If the Community Trademark[107] establishes a fully integrated system of trademark registration on a broader basis of European Community, it was also desirable that the national systems should integrate their trademark law with each other as well as with the community trademark. Such integration among the transnational regional community can be accomplished only if both Community and national legal system are as similar to one another as possible. The drafting of the Directive and the Regulation were drawn together, and their provisions were also put together so that, for example, what is registerable trademark under one is likely to be a registerable trademark under the other.[108]

The Community Trademark Regulation was formed in December 20, 1993 through Regulation (EC) No. 40/94. However, the rules of said (Community Trademark Regulation) CTMR did not find concrete application until 1 April 1996, when the Office for Harmonization in the Internal Market (OHIM) (Marks, Drawings and Designs), which is in charge of managing the new Community title of intellectual property and is located in Alicante, Spain, began functioning. It is solely through registration at the OHIM, community trademark can be acquired and produces similar impacts all through the Community's region (i.e. is a unitary feature).[109]

Both the Regulation and the Directives share the same long-term objective, according to the "two-pronged system" that was later incorporated in the Community Design Law. Though, laws in the Regulation and the Directive are quite similar, but the two instruments differ as to application modes and nature, due to which the solution of the International problems also gets affected. Relating to this problem, the most important differential datum of the CTMR appears from Recital No. 1 where it was said that the new intellectual property title was created and called to fulfill the requirements of firms. Recital No. 1 reads in part, "… whereas in order to create a

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[106] Steano Sandri,Sergio Rizzo,et.al., *Non-conventional Trademarks and Community Law* , 1(Marques, 2003).

[107] 'Community trade mark' is replaced by 'European Union trade mark' by Regulation (EU) 2015/2424 of 16, December, 2015.

[108] Terence Prime, *Supra* note 103 at85.

[109] In 2009 codified as Regulation [EC] No. 207/2009 which is amended by Regulation (EU) 2015/2424 of 16, December, 2015.

market of this kind and make it increasingly a single market, not only must barriers to free movement of goods and services be removed and arrangements be instituted which ensure that competition is not distorted, but, in addition, legal conditions must be created which enable undertakings to adapt their activities to the scale of the Community."[110]

The Community Trademark cannot be viewed as an alternative to national trademark. They have been designed in such that they fulfill the needs of businesses that are interested in the European market or at least have a tendency to work within the European Union. Therefore, in the choice and use of marks, one may easily imagine the short-term implications of commercial strategies of trans-national characters, which had been sought and which are protected by the Community legislation.[111]

The particular task of the Regulation is to provide for a harmonized system of single trademark law to cover all community members. The task of harmonizing the national laws was undertaken by Directive and the harmonization of provision of a Community Trademark was carried out by Regulation. Art 235 of the Treaty of Rome provides the legal basis to Regulation. A regulation is applied directly, whereas the Directive is required to be implemented by the national assemblies, this is a perfectly appropriate system for harmonisation where national laws have to be expanded to meet the relevant needs of the Directive. On the contrary Regulation has its own legal force without the need for intervening national legislation, as it is appropriate to have for the creation of such a large autonomous Community.[112]

The Directive provides for two-stage process for the trademark registration. First of all, it is necessary to establish whether the mark is registerable or not (Art, 3), and, secondly, to establish it is not in conflict with third party rights (Art. 4). This establishes a two-pronged process to registration. The first requires enquiry as to the registerability of a mark, the second inquires into conflicting prior rights if any[113].

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110 Terence Prime, *Supra* note 103 at 2.
111 *Ibid.*
112 *Id.*at 9.
113 *Id.* at 87.

The Directive defines trademark under Article 1 as "any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods, or of their packaging, provided that such signs are competent to distinguish the goods or services of one undertaking from those of other undertakings"[114].The grounds on which the registration can be refused are:

a) signs which does not fall under the definition of trademark;

b) trademarks that does not have any distinctive character;

c) trademarks which consist solely of indications or signs which may serve, in trade, to designate the origin, quantity, kind, quality, intended purpose, value, or of rendering of the service, geographical or the time of production of the goods or other characteristics of the goods;

d) trademarks which consist exclusively of indications or signs which have become custom practices of the trade;

e) marks which consist of particular shape of goods which gives considerable value to the goods;

f) trademarks which are against the morality and public policy;

g) trademarks which are fraudulent in nature.[115]

It is to note that no type of sign is automatically excluded from registration as a Community Trademark. An inclusive list of types of signs used most frequently by undertakings to identify their goods or services is provided under the Art. 4. It is intended to improve the implementation of court judgments and administrative practices to trade necessities, and to encourage enterprises to apply for Community Trademark. It is the Trademarks Office, the national courts, or in the last resort, the Court of Justice will be responsible for determining whether, any sign (for e.g. sign denoting sound, smell, or taste) may constitute Community trade-marks or not.[116]

[114] Trademark Directive, Art. 1.
[115]Trademark Directive, Art. 1.
[116] Terence Prime, *Supra* note 103 at 88.

However, one can question regarding the signs on sounds, smells and taste that they lack in fulfilling the important requirement i.e., the mark must be capable of being represented graphically. For that it is to be noted that marks does not need to be graphic in it, but it must be capable of being represented graphicaly. The need of graphic representation enables existing mark owners to monitor new applications and any potential conflicts with their existing rights against which they can bring legal action.

Regarding the distinctiveness of a mark the provision of Directive is very clear as it provides that distinctiveness may be either inherent or generated through public perception. The Directive also contains the provision relating to grounds for refusal of registration of a mark. Some of the grounds are obligatory only, and others are not obligatory. In this manner, member nation may have varying reason for refusal or deficiency, although every one of them will have as a focal centre those which are obligatory. The required grounds are various and have no clear principle supporting them except public policy and the demands of a coherent registration system. The following shall not be registered or, if registered, shall be liable to be declared invalid:[117]

(i) **Art. 4(1) (a).**

signs which cannot constitute trademarks (as provided under the Directive, such as signs which are not exclusive, cannot be graphically represented, or are not able to distinguishing the goods or services of one undertaking from those of other undertakings. They are liable to be refused for registration, and, if registered, shall be liable to be declared invalid[118].

(ii) **Art. 4(1) (b):**

trade marks which are devoid of any distinctive character. However Art.4(4) provides a saving clause that if, before the date of application for registration, following the use which has been made of it, it has acquired a distinctive character. A trade mark shall not be declared invalid for the same reasons if, before the date of

[117] *Id.*at 90.

[118]Trademark Directive Art. 3 (1) (a) *available at* : http://eur-lex.europa.eu/legal-content /EN/TXT/?uri=CELEX%3A32015L2436

application for a declaration of invalidity, following the use which has been made of it, it has acquired a distinctive character.[119] Therefore, the Directive is very much clear on the point of distinctiveness of a mark that it may be either inherent or may be accumulated public perception[120].

(iii) **Art. 4(1)(c):**

trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services [121].

(iv) **Art. 4(1) (d):**

trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade[122].Often the generic business term becomes a type of product within a related business such as gramophone, linoleum or shredded wheat, but it can be applied equally to other conditions like generic business picture marks or colours.

(v) **Art. 4(1) (f):**

trademarks which are contrary to the accepted principles of morality or public policy are liable to be rejected. [123]

(vi) **Art. 4(1) (g):**

trade marks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or service are also not fit for registration.[124]

[119] Trademark Directive, *Id at* Art. 4(4).
[120] Trademark Directive *Id at* Art. 4 (1) (b).
[121] Trademark Directive *Id at* Art. 4 (1) (c).
[122] Trademark Directive *Id at* Art. 4 (1) (d).
[123] Trademark Directive *Id at* Art. 4 (1) (f).
[124] Trademark Directive *Id at* Art. 4 (1) (g).

(vii) **Art. 4(5):**

The final ground for refusal of registration arises where it is identical with an earlier trademark and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected [125]. Of course, if the later mark were to be used for similar goods and services there would be no need to rely on this anti-dilution provision.

2.4.5. Singapore Treaty on the Law of Trademarks (2006)[126]

With the objective to create a dynamic and modern international framework for the harmonization of administrative trademark registration procedures Singapore treaty was concluded in 2006 and it came into force in 2009. Based on the Trademark Law Treaty of 1994 (TLT), this Singapore Treaty is wider in scope and it addresses latest developments in the area of communication technologies. The Singapore Treaty applies to all the marks registerable under the law of a given member nation. Contracting Parties are free to choose the means of communication with their offices (including communications in electronic form or by electronic means of transmittal). Relief measures in respect of time limits as well as provisions on the recording of trademark licenses were introduced, and an Assembly of the Contracting Parties established. However, other provisions of the Singapore Treaty (such as the requirements to provide for multiclass applications and registrations) closely follow the TLT. The two treaties are different, and can be independently approved or followed.

Singapore Treaty is the first of its kind international treaty which explicitly recognize non-traditional marks. This Treaty applies to all types of marks, including non-traditional non-visible marks such as sound, olfactory or taste and feel marks, as well as visible marks, such as three-dimensional marks, colour, position and movement marks, and holograms. The Singapore Treaty's Regulations on the Law of Trademarks provide for the form in which the marks can be represented in applications, which may include non-graphic or photographic reproductions.

[125] Trademark Directive Art. 4(5).

[126] *Available at:* http://www.wipo.int/treaties/en/ip/singapore/summary_singapore.html-(accessed on 15.03.2016).

The Singapore Treaty left the contracted parties to accept the form and means of the transmitters of communication, either to accept communications on paper, in electronic form or in other form. This has consequences on formal requirements for applications and requests, such as the signature on communications with the office. The treaty holds a very important provision of the TLT, i.e. certification, attestation, or authentication of any signature on paper communications may not be required. However, Parties to the contract are free to decide whether and how they want to implement the certification mechanism of electronic communication.

The Treaty offers for relief measures when a holder or an applicant has lost the deadline in an action for a procedure before an office. Member States must make accessible, at their will, no less than one of the accompanying help measures: Expansion of deadline; Continuous processing; and reinstatement of rights in so far as the failure to meet the deadline was inadvertently or in spite of necessary care required by the circumstances.

The Singapore Convention contains provisions for recording a trademark license, and establishes the maximum requirements for the licensing requests, and its modification or cancellation.

The establishment of an assembly of contract parties initiated flexibility in defining the details of administrative procedures for implementation by National Trademark Offices, where it has been presumed that future development in trademark registration procedures and practices will warrant amendments to those details. Assembly is endowed with power address the questions relating to the future development of the Treaty, powers to modify the Regulations and the Model International Form.

In addition to above, Resolution Supplementary to the Singapore Treaty on the Law of Trademarks and the Regulations there under was also adopted by the Diplomatic Conference, with a view to pronounce an understanding on several issues by the Contracting Parties, and it also provides that the Treaty does not impose any obligations on Contracting Parties to

(i) register new types of marks, or

(ii) implement electronic filing systems or other automation systems.

The resolution also includes special provisions for providing additional technical support and technical and technical support to the developing and less developed countries (LDCs) so that they can be able to take full advantage of the provisions of the treaty. It was believed that LDC will be in the form of primary and main beneficiaries of technical assistance by contracting parties. The Assembly evaluates and monitors, at regular intervals, the progress of the assistance so given. There should be an amicable settlement of any dispute arising in relation to the interpretation or application of the Treaty by means mediation and consultation under the auspices of the Director General of WIPO.

The Treaty is open to States members of WIPO and to certain intergovernmental organizations. Instruments of ratification or accession should be submitted with the Director General of WIPO.

2.5. Scope of Protection of Trade Marks: Extended Discourse

As a result of the legislative changes in the definition of "trademarks", different types of non-traditional trademarks have been accepted more widely in recent times. Such developments are the result of standardised, inclusive legal definition given by international treaties on Intellectual Property Rights i.e., Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). Examples of such non-conventional marks are- sound trademarks (also known as aural trademarks), motion trademarks, Single colour trademarks, hologram trademarks; shape trademarks (also known as three-dimensional trademarks or 3D trademarks[127]).

- **Colour as Trademark**

U.S. Supreme Court in *Qualitex Co. v. Jacobson Products Co.* held that “colour is freely protectable and registerable, as long as certain conditions are met. First, the colour sought to be protected must not be functional. That is, the colour cannot have a utilitarian purpose and cannot be one that others in the field have a

[127] *Available at:* https://en.wikipedia.org/wiki/Non-conventional_trademark-accessed on 19.03.2016.

competitive need to use. Second, the colour sought to be protected must be distinctive under traditional trademark analysis"[128].

- **Sound as Trademark**

  In, *Mark B.V. v. Kist ('Shield')***,** The European Court of Justice (ECJ) ruled that "sound marks were registerable but must comply with the requirement of graphic representation already mentioned" [129].

- **Scent as Trademark**

  The ECJ did hold that "smells could be registered as trademarks, even though the smell was not in itself capable of being perceived visually, provided it could be represented graphically. This could be by means of images, lines or characters, and should be clear, precise, self-contained, easily accessible, intelligible, durable and objective"[130].

- **3-D Marks as Trademark**

  In Henkel's case, Te case was regarding a bottle containing liquid detergent for wool, the ECJ ruled that "three-dimensional (3D) marks, consisting of the packaging of a product, which for reasons related to the nature of the goods (no intrinsic shape) are put on the market in a packaged form, the packaging of the goods is to be considered equivalent to the shape of the goods in the meaning of Trade Mark" [131].

2.6. Concluding Remarks

The long-run history of the law of trademarks has been one of expanding subject-matter and scope of trademark protection. As has been discussed above, the trademarks traditionally protected were words and graphic designs. With the

[128] 514 U.S. 159, 115 S. Ct. 1300 (1995) *available at:* http://www. casebriefs .com /blog/law/property/property-law-keyed-to-singer/intellectual-property/ qualitex-co-v-jacobson-products-co/ (accessed on 20.06.2016).

[129] *Shield Mark BV v. Joost Kist* H.O.D.N. 2004 E.T.M.R. 33 *available at:* http://www. inta.org/ Advocacy/Documents/INTAShieldmarkJKist.pdf (accessed on 20.06.2016).

[130] Sieckmann, 1C-273/00 [2002] E.C.R. I-II737 *available at:* http://www .wipo. int/edocs/ mdocs/sct/en/sct_16/sct_16_2.doc (accessed on 20.06.2016).

[131] ECJ 12 February 2004, C-218/01 *available at:* http://www.kilburnstrode.com /resources/news/2004-3-25-ecj-case-on-3d-mark-for-packaging-perwoll (accessed on 20.06.2016).

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.

Initially trademark rights were concerned only with the following:

a) To protect the public from any type of deception, mistake or confusion as to the quality and origin of goods, services, arising out of a confusingly similar Sign/mark on the similar or same services / goods in the commercial world;

b) To protect the owner’s investment in goodwill linked with the trademark. It provides protection to the owner's commercial identity against use of confusingly similar trademark by a newcomer.

It is quite evident from the Legal evolution that trademarks are today protected not only to avoid consumer confusion, or just to advertise but also to reward producer of goods or services with an sufficient return on investments made to procure strong brands. The liberal approach adopted by the Courts amply endorses this view.

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.

A significant utility of internet is that it brings markets of world to one’s door step or one’s desktop. The consumer can sit in the comfort of his/her home while shopping all over the world, looking for the best products at the best possible lowest price.

The 1990’s brought about the privatization of the internet and thus commercialization of the internet. It is this commercialization which resulted in the dawn of Electronic commerce (E-commerce). As E-commerce has grown, the internet has become a virtual space in which unfair trading with trade marks and names is likely to take place. To some extent the structure of the system causes old dangers of public confusion to appear in new forms.

A detailed chapter on E-commerce and its effect on the traditional trade are provided next to this chapter.

Chapter-3

Evolution of E-Commerce/Trade

3.1. Introduction

In these days of internet craze, everyone talks about the Electronic Commerce (E-Commerce)/ Electronic trade (E-trade) revolution and the internet of the new knowledge-based economy. The internet allows E-commerce to offer consumers with increasingly cheap, well-timed, and precise information. Consequently, customers can straight away compare the prices and choose the merchant with the lowest price. Marketers no longer completely control the communication process but now are both observers and participants in ongoing dialogues that often are driven by consumers themselves [1]. E-commerce is a comprehensive term that explains how technology can benefit the whole business process and communications with third parties.

Internet Shopping is becoming increasingly popular and internet sales amounted to 1.9 trillion U.S. dollars in 2016 and projections show a growth of up to 4.06 trillion U.S. dollars by 2020[2]. The statistics around the world shows that there are 32 countries with more than 43.4 % of internet penetration rate[3]. The number of internet users has been increased from 6.8 % in 2000 to 43.4 % in 2015[4]. The internet has a considerable impact on consumer behaviour and it has led to the emergence of an era of consumer empowerment.

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

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[1] Annie Field, *E-commerce: A Brief History*, 16 (Webmergers, 2004).

[2] Internet World Statistic, *available at*: http://www. http://www.internetlivestats.com/internet-users/ (accessed on 01/04/16).

[3] *Ibid.*

[4] *Ibid.*

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[5].

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[6]. Consumers from well developed countries as well as from developing countries are getting used to the new shopping trends.

In present time, E-Commerce simply means buying and selling of goods and services using the internet; refers to both financial and informational electronically mediated transactions between an organization and any third party it deals with [7].The ability of organization to successfully adapt and integrate its management practices with new Information Technologies offered by the internet is the key to survive in the new information age revolution [8]. Traders are using the internet to make their offerings more expedient and personalized.

It is the flexibility offered by computer networks and the availability of the Internet, E-commerce develops on traditional commerce. E-commerce creates new opportunities for performing profitable activities online. It promotes easier cooperation between different groups: businesses sharing information to improve customer relations; companies working together to design and build new products/services; or multinational company sharing information for a major marketing campaign.

3.2. Defining E-Commerce

According to the editor-in-chief of International Journal of Electronic Commerce, Vladimir Zwass, '*Electronic commerce is sharing business information, maintaining business relationships and conducting business transactions by means of*

[5] Raymond Hennessey, *Introduction to E-commerce*, 2 (Rayport, 2010).
[6] Annie Field , *supra* note 1 at 18.
[7] Raymond Hennessey, *supra* note 5 at 12.
[8] P. Timmers, *Electronic Commerce – Strategies and Models for Business-to-Business Trading*, 2(John Wiley & Sons, 2000).

telecommunications networks'[9]. Thus, E-commerce is the use of electronic systems to engage in commercial activities. E-commerce helps businesses to buy and sell goods and services, provide customer service and create greater corporate awareness.

E-commerce, in simple words, is the commercial transaction of services in an electronic format. In broader sense, e-commerce is a method that fulfils the needs of businesses, consumers and traders by reducing and improving the quality of products and increasing delivery speed.

Electronic Commerce has been defined in Sec. 2(44) of the CGST Act, 2017 to mean the supply of goods or services or both, including digital products over digital or electronic network[10].

E-commerce also referred as paperless exchange of business information using electronic data Interchange, Electronic Fund Transfer etc. It not only helps in simple exchange of data but also general mercantile acts i.e., advertisements, publicity, contracts, negotiations and fund settlements[11]. E-commerce refers to all types of commercial transaction between organizations and individuals that are based upon the processing and transmission of digitized data, including text sound and visual images[12].

The world Trade organization (WTO) Ministerial Declaration on E-commerce[13] defines e-commerce as, "The production, distribution, marketing, sales or delivery of goods and services by electronic means"[14].

As per European commission, "e-commerce covers more than the buying of goods online. It encompasses a different set of loosely defined behaviours, such as

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[9] International Journal of Electronic Commerce by Vladimir Zwass, *available at:* https://books.google. co.in/ books? isbn=1591403561 (accessed on 10/04/16).

[10] Available At: http://www.cbec.gov.in/resources//htdocs-cbec/gst/faq-e- commerce.pdf;jsessionid= 2CF19CE07BEBCE4B34219DD2D3930664

[11] Smith Dayle, *The E-Business Book: A step-by-Step Guide to E-Commerce and Beyond*, 11 (Princeton: Bloomberg Press,2001).

[12] E-commerce Dialogue, *available at* :14.139.60.114:8080/.../E-Commerce_A%20New%20 Bussiness %20Parad/Transatlantic (accessed on 10/04/16).

[13] *Available at*: https://www.wto.org/english/thewto_e/minist_e/mc9_e/brief_ecom_e.html (accessed on 12/04/16).

[14] Sarbapriya Ray ,*Emerging Trend of E-Commerce in India: Some CrucialIssues, Prospects and Challenges, available at:*https://www.scribd.com/document/69435880/3-Sarbapriya-Ray-Final-Paper (accessed on 13/04/16).

browsing the Internet for goods and services, gathering information about items, shopping to completing the transaction”[15].

According to the office of Tax Policy at the U.S. Department of Treasury[16]: E-commerce means any transaction that happens with the facilitation of electronic "tools and techniques".

According to the Internet Tax Freedom Act (ITFA), 1998[17], e-commerce means "any transaction conducted over the Internet or through internet access, comprising the sale, lease, license, offer or delivery of property goods, services or information, whether or not for consideration, and includes the provision of Internet access.”

According to the Gartner Group[18] e-commerce means an evolving set of:

(a) Any simple software applications that connects individual consumers or multiple enterprises to enterprises for business purposes.

(b) The purpose of business strategies is to improve the relationship between enterprises and individuals and enterprises by using information technology.

(c) Business processes (such as buying or selling or order status checking or payment) that, by definition, cross boundaries and

(d) Technologies and tools that enable and implement these applications, strategies and processes.

Other important dentitions of e-commerce often found in publications and the media are:

- *“Electronic commerce is about doing business electronically”*[19].

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[15] *Available at*: www.ecommerce-europe.eu/- (accessed on 13/04/16).

[16] *Available at:* https://www.treasury.gov/resource-center/tax-policy/Pages/default.aspx (accessed on 12/04/16).

[17] Internet Tax Freedom Act, *available at:* https://www.fas.org/sgp/crs/misc/R43772.pdf (accessed on 13/04/16).

[18] Definition of E-commerce, *available at:* www.gaftner.com/ (accessed on 13/04/16).

[19] P. Timmers, *Supra* note 8.

- *"E-commerce, ecommerce, or electronic commerce is defined as the conduct of a financial transaction by electronic means"*[20].

- "*Electronic Commerce (EC) is where business transactions take place via telecommunications networks, especially the Internet"*[21].

- *"Electronic commerce describes the buying and selling of products, services, and information via computer networks including the Internet"*[22].

Thus, E-commerce simply means a commercial transaction between any individuals or business organisations, which happens in or over electronic system. The only key factor is that the commercial transactions happen over an electronic medium. It can be led over phones, fax machines, automatic teller machines (ATMs), electronic payment systems such as prepaid telephone cards, Electronic data interchange (EDI), TV and the Internet.

3.3. Brief History of E-Commerce

Vladimir Zwass[23]was of the opinion that "in its purest form, electronic commerce has existed for over 40 years, originating from the electronic transmission of messages during the Berlin airlift in 1948". The next stage of e-commerce development was the Electronic data interchange (EDI). In the 1960s a cooperative effort among industry groups made a first attempt at common electronic data formats. However, these formats were only for the purpose of transportation, purchasing and financial data for intra-industry transactions only. By the end of 1970s the work for national Electronic Data Interchange (EDI) standards begins, which developed well into the early 1990s.

3.4. Advent of the Internet

Before 1970s, the term "E-commerce", referred to electronic exchange of data such as sending business documents i.e., purchase orders and voices electronically.

[20] Definition of E-commerce, *supra* note 16.
[21] E. Turban, J. Lee, D. King, H.M. Chung, *et.al., Electronic Commerce: A Managerial Perspective* (Prentice Hall ,1999).
[22] *Available at*: www.whatis.com › Retail industry › Internet technologies (accessed 12/04/16)
[23] Editor-in-chief of International Journal of Electronic Commerce, See also *supra* note 9.

Later, with the growth of Internet, the term of E-commerce has gone under a vital change[24].

The meaning of the term 'electronic commerce has gone under a vital changed over the last 30 years. Originally, 'e-commerce' meant electronically facilitation of commercial transactions, usually using technology like Electronic Data Interchange (EDI), introduced in the late 1970s, to send commercial documents like purchase orders or invoices electronically.

The 'e' in e-commerce refers to the use of technology; and the 'commerce' refers to be traditional business models. E-commerce is the complete set of processes that support commercial business activities on a network. In the 1970s and 1980s, information analysis also involved. The growth and acceptance of telephone banking, automated teller machines (ATM) and credit cards in the 1980s were also types of e-commerce. The enterprise resource planning systems (ERP), data warehousing and data mining were included from 1990s[25].

When the World Wide Web (www.) was introduced in 1994, researchers have forecast that this will soon become key to world economy, but it took four years that http based protocols should be widely available to users[26].

The first e-commerce business on internet was done in USA and in some European countries in 1998. These sorts of business are shaped with beginner and unprofessional sites and it has been extended quickly. In 2005, Electronic Commerce on the Internet was fast spread in most of the cities of America, Europe and East Asia. Initially due to its costs, only business and financial institutions and corporations could use Internet. But the widespread use of the Internet has changed the structure of electronic commerce, became very popular form.

In the digital era, these activities are more accurately called 'Web Commerce'- the buy of goods and services over the Internet, more often than not with secure connections (HTTPs, Hyper Text Transfer Protocol, unique server protocol that

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[24] Karnika Seth, *Cyber Laws in the Information Technology Age*, 207(Lexis Nexis , Butterworth Wadhwa, 2009).

[25] *Ibid.*

[26] Ravi Kalakota, Andrew B.Whinston, *et.al.*, *Electronic Commerce:A manager's Guide*, 112 (Addison Wesley Longman Inc,1997).

encodes confidential ordering information for customer protection) with e-shopping carts and with electronic payment modes, like credit and Debit cards.

With the dawn of the Internet, the word e-commerce started to include:

- Electronic trading of tangibles and non- tangible goods (information).
- It includes almost every steps of business, such as, ordering payment and delivery and delivery supports.
- The electronic provision of services such as after sales support or on-line legal advice.
- Electronic support for alliance between organisations like a mutual on-line engineering and design or virtual business consultancy teams.

In the present scenario, the term 'E-commerce' necessarily means transaction on internet. In technical terms, E-commerce is a 'commerce based on bytes'[27]. Therefore, it is important to identify the term Internet, as it will help in understanding how E-commerce is different from traditional commerce.

The E-commerce and the first electronic computers evolve together, which were built in the 1950s .However; e-commerce gains extensive popularity only with development of the World Wide Web in the 1990s. A sequential arrangement of events concerning the Internet and e-commerce is provided below.

3.4.1. Sequential arrangement of events in the evolution and development of E-Commerce and Internet: [28]

1. First electronic computer, ENIAC, is built at the University of Pennsylvania in **1946**.
2. The first artificial satellite i.e., Sputnik, launched by Soviet Union in **1957**.

[27] E-commerce Dialogue, *supra* note 11.
[28] Internet World Statistic, *supra* note 2.

3. The Advanced Research Projects Agency (ARPA) was formed by U.S., to develop U.S. leadership in science and technology applicable to the military in **1958**.
4. The Advanced Research Projects Agency Network (ARPANET), established in **1969** .
5. Electronic data interchange's (EDI) first applications developed in **1970**.
6. Initial work on an Internet Protocol or transmission protocol that allows diverse computer networks to communicate and interconnect with each other in **1973**.
7. Opening of Telnet, the first commercial version of ARPANET by BBN in **1974**.
8. Internet Protocol and Transmission Control Protocol established by ARPA. This resulted into a definition of an "internet" as a connected set of networks, specifically those using TCP/IP, and Internet as connected TCP/IP internets in **1982**.
9. IAB- Internet Activities Board was created in **1983**.
10. William Gibson (Science fiction author) in his novel, *Neuromancer* coins the term "cyberspace". Computers with registered IP address exceed 1,000 in **1984**.
11. Number of Internet users exceeds 10,000 in **1987**.
12. A Cornell University graduate student created the Internet worm. Internet worm disables 6,000 of 60,000 Internet hosts. Some of the US's top science and research centers were affected in **1988**.
13. Number of Internet users exceeds 100,000 in **1989**.

14. World Wide Web (www.) was developed by Sir Tim Berners-Lee, working at CERN in Geneva, Later, people refer to the Internet itself as the Web in **1991**.
15. www. Released by CERN in **1992**.
16. Pizza Hut starts selling pizza on its website. First Virtual, the first cyber bank, opens in **1994**.
17. First Electronic postal stamps used US Postal Service in **1997**.
18. Number of Internet users exceed 360 million in **2000**.
19. Users in over 200 countries are connected with each other by internet in **2011**.
20. Presently there are 3366 million users of internet in the world i.e. 46.4% of the world population in **2015**[29].

3.5. Internet

Internet is a method of interfacing a computer to any other computer at anyplace on the planet by means of dedicated servers and routers. The computers which are connected over the Internet can send and get an extensive variety of information, for instance, content, plan, voice, video, and PC programs. Nobody possesses Internet, although several organizations of the world work together for its functioning and development[30].

The Internet is the worldwide arrangement of interconnected computer networks that use the Internet protocol suite to connect billions of devices worldwide. It is a network of networks that consists of millions of academic, government networks, and private & public business of local to global scope, linked by a broad array of electronic, wireless, and optical networking technologies[31]. The Internet conveys broad variety of information and services, such as electronic mail, telephony, applications of the World Wide Web (www), the inter-linked hypertext documents and peer-to-peer networks for file sharing.

[29] Internet World Statistic, *supra* note 2.
[30] *Available at*: http://www.businessdictionary.com/definition/internet.html (accessed on 04/04/16).
[31] *Available at:* https://en.wikipedia.org/wiki/Internet (accessed on 03/04/16).

The Internet was emerged in 1968's the U.S. experiment called ARPA (Advanced Research Project Agency), thus was called the ARPANET[32]. The ARPANET was intended to enable fundamental research and communications to go on regardless of the possibility that network were damaged in a war. In this way it started as a method for the military to communicate even if other forms of communication broke down. It was the U.S.'s Department of Defense sponsored project.

The primary precursor network, the Advanced Research Projects Agency's Wide Area Network (ARPANET), in its early days served as a backbone for military networks and interconnection of regional academic in the 1980s[33]. The financing of the National Science Foundation Network as a new backbone in the 1980s, and in addition private funding for other commercial extensions, prompted worldwide participation in the development of new networking technologies, and the merger of many networks[34]. The connecting of business networks and enterprises by the early 1990s denotes the start of the move towards the modern Internet, and created a sustained exponential development as generations of institutional, personal, and mobile computers were connected to the network.

As discussed above, the Internet was intended to enable key research and communications to proceed even if some parts of the network were damaged in a war. This is conceivable in light of the fact that Internet is a huge network, which connects numerous smaller groups of computer networks. It is thus a "network of networks". Each hub or link in this network is à computer or a webpage connected together.

This worldwide web of connected systems and computers has no centralised communications channel, control point or storage location. The Internet exists and functions as a result of the fact that huge number of separate computers and computer networks freely choose to use some standard approaches to exchange information and communications with different computers. The system by which

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[32] *Available at*: https://en.wikipedia.org/wiki/Internet (accessed on 03/04/16).

[33] See *supra* note 28.

[34] Bill Stewart, (ed.), *Internet History :One Page Summary* (January, 2000) *available at*: https:// ruichenjiang. wordpress.com/2014/09/23/what-is-internet/ (accessed on 6/04/16).

computers communicate with each other is called as Internet Protocols (IP)[35]. A communication sent over the network of computers travels through number of routes to its destination[36].

An IP address is a numeric address that indicates the location of a computer on the Internet.

Here it is also important to understand "World Wide Web" (www) which empowers users to access information (i.e., a hyper media with text, sound and graphics) over the network. The www is hence a worldwide online store of information. Keeping in mind the end goal to see material on the www, one needs a browser[37]. The browser process the material from various formats; for example, the format "html" (hypertext markup language) if the www address ends with the letters "html", or text format if the www address ends with "txt". One needs a special locator to identify a location on the WWW. The locator is called a URL (Uniform Resource Locator)[38]. The URL comprises of two sections, separated by **://.** The initial segment shows the sort of resource and the second the resource location (i.e. "protocol ://host/path/filename")[39]. The most widely recognized convention is http (hypertext transfer protocol) where path refers to the directory or directories in which the file is located , host refers to the domain name, and filename is the name of the file that you actually want[40]. For instance http://www. wipo.org= /Intenet/domains/.

Despite the fact that the Internet has been widely used by scholarly community since the 1980s, the commercialization incorporated its technologies and services into virtually every part of modern life. Use of Internet developed quickly in the West from the mid-1990s and from the late 1990s in the developing world[41]. In the twenty

[35] D.L Burk, *Trademarks Along the Infobahn: A First Look at the Emerging Law of Cybermark*, 1 (Rich J.L. & Tech,1995).
[36] Intenet history *available at:* http://www.isoc.org/Intemet-history/ (accessed 10/04/16).
[37] S. Dayal, *The Internet*, 145 (Butterworths,1997).
[38] *Ibid.*
[39] *Ibid.*
[40] *Ibid.*
[41] See *supra* note 29.

years since 1995, Use of Internet has grown 100-times, measured for the period of 1 year, to over 1/3 of the world population[42].

Most customary communications media, including television and telephonic, are being redefined or reshaped by the Internet, bringing forth new services such as Internet telephonic communication and Internet television. Book, daily Newspaper and other print publishing are adapting to website innovation, or are reshaped into web feeds and blogging. The entertainment industry was at first the quickest developing sector on the Internet[43].

The Internet has empowered and quickened new types of individual connections through social networking, Internet forums, and instant messaging. Internet shopping has become exponentially both for real traders and small artisans and retailers. Business-to-business and fiscal administrations on the Internet impact supply chains across entire industries.

Presently, internet is the world's quickest developing commercial center with a gigantic increment in the globalization condition for marketing products and services[44]. Today the internet has been considered as the single most important innovation of the 20th century and digital marketing is changing advertising, companies, and customization.

There is by all accounts quick growth of adoption of the internet by consumers for different purposes, including online shopping and information search. The internet is a global network of interconnected networks[45]. This incorporates millions of private, organizational, corporate, and government networks. A large portion of computers in these networks hold files, for e.g. Web pages that can be accessed by all other networked computers.

As stated above, there is no centralised control of the Internet. Every computer acts independently. Therefore, there is no one to complain to when things go wrong, no one to ask for permission to join the network, and no central

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[42] Internet World Statistic, *supra* note 2.
[43] A study of on-line retailing *available at*: www.forrester.com (accessed 04/04/16).
[44] Internet World Statistic, supra note 2.
[45] D.L. Burk, *supra* note 32.

authority to govern Internet usage. Additionally, the Internet is a worldwide system, with no regional limits. Indeed, the Internet is not administered, it is co-ordinated. One may simply say that the Internet is run by engineers who voluntarily take their time to maintain, manage and program the Internet[46]. As a result of the Internet's origins, the bodies which have until now assumed a part in the operation and self-administration of the Internet are regularly of US origin and have a majority, or at least a large number, of US members. The Internet is developed, regulated and represented by different enti-ties, for example:

- The US National Science Foundation (NSF)[47].
- The Internet Society (ISOC)[48].
- The Internet Engineering Task Force (IETF)[49].
- The Internet Architecture Board (IAB)[50].
- The World Wide Consortium (WWes43C)[51].
- Internet Corporation for Assigned Names and Numbers (ICANN)[52].

In the past decade, consumer behaviour has changed dramatically. In the present time, consumers can place many goods online, ranging from slippers to cars. Many people have swapped their daily newspapers with online releases of these media and are increasingly getting information from web[53]. Nowadays, if experts need to recognize the most significant impacts on buyer conduct as of late, the appropriate response would be the internet. The reason, why the web is drastically changing purchaser conduct is that it causes us to seek more effectively and productively than any time in recent memory.

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[46] *Available at:* http://www.ljx.com/Intemet/frankdom.html (accessed on 05/04/16).
[47] *Available at:* http://www.nsf.gov (accessed on 05/04/16).
[48] *Available at:* http://www.isoc.org(accessed on 05/04/16).
[49] *Available at:* http://www.ietf.org(accessed on 05/04/16).
[50] *Available at:* http://www.iab.org/iab/(accessed on 05/04/16).
[51] *Available at:* http://www.w3.org/(accessed on 05/04/16).
[52] *Available at:* http://www.icann.org(accessed on 05/04/16).
[53] A study of on-line retailing, *supra* note 40.

One of the fastest-growing use of the Internet, is Shopping and more than 40 %of the Internet users report shopping as a primary use of the web[54]. The total number of Internet shoppers has reached more than 42 million[55], and it is relied upon to keep developing. Indeed, even buyers who have not utilized the Internet to buy goods and services , are using it for information searching that ultimately led to shopping in the conventional channels.

Very basis of each and every online business is the E-Commerce webpage that it creates on internet. Once the site catches the attention of the visitors, they should want to investigate it further. This inclination comes with easy to understand instructions, good design, speedy navigation on the site and easy to recall names.

The masters of E-Commerce were aware these facts and therefore, they have the correct sort of devices with them to "read" the mind of the users and to set up a website that would be useful to the client[56]. In such situations, the experts take a look at the already running website and attempt to decide the reason for the absence of traffic. Site guests may use both distant and nearby cues: consumers may tap on a link since they look for that particular link[57]. At different circumstances, consumers click since they trust the link will bring them nearer to what they look for. In short, the motivations for search vary, but regardless of the motivation, the online searcher persistently judges whether to keep on reading, scroll, investigate or click.

3.5.1. Some important characteristics of website[58]

1. **Domain Name**

The domain name strategy of an organisation associates closely to an company's branding and marketing strategy. It serves as a foundation for website

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[54] *Available at:*http://www.internetworldstats.com (accessed on 05/04/16).

[55] Internet World Statistic, supra note 2.

[56] *Available at*: www.rouge-media.com/blog/is-your-ecommerce-site-working-properly/ (accessed on 9/04/16).

[57] *Available at*: https://books.google.co.in/books?isbn=1466681349(accessed on 9/04/16).

[58] *Available at*: http://www.spritzweb.com/resources/good-website-characteristics.html,See also, return onnow.com/2014/11/8-characteristics-quality-website-business/, See also, www.webinfozone .com/. ../top10-characteristics-and-qualities-of-a-good, See also, smallbizsense.com/7characteristics-of-an-effective-small -business-websi See also, www.orangesoft.com.my/blog/characteristics-of-a-good-website- design, See also, www.auswebdesign.com.au/good-web-design-characteristics (accessed between 1/04/16 to 9/04/16).

and advertising activity. The perfect domain name strategy lets a prospective visitor navigate the webpage with no assistance. (As this is also a main theme of this research work therefore it is dealt in detail in the next chapter).

2. **Well Designed**

One of the principal things anyone will look for on a site is the design of webpage. After all, an aesthetically satisfying site won't just fulfill over analysis by internal teams (and let's be honest, most internal teams obsess over design during a relaunch), but additionally encourage visitors when arrive on the site itself. Design plays more than just representing your company as a professional, cutting edge business. Moreover a well designed site is also more likely to appeal to search engines for ranking.

3. **User Friendly Navigation**

Great website navigation is like a GPS that enables the user to locate the significant substance out of your website. If there are lot of content on your website then it provide a search box so guest can quickly find what they are searching for. It will be good for visitor to keep his navigation consistent from page to page to avoid any possible confusion.

4. **Professional and Simple Design**

A decent site ought to attract client's attraction automatically. It will be better to use simple colour scheme and the text used doesn't require a magnifying glass to read. With every design element added, take a step back and make sure ensure it fills a need and does not take away from the ease of use of the site. Separating the text into subheads and bullet points will enhance the design of the webpage and make the text more scanable.

5. **Speed**

How long will visitor wait for a page to load before they surrender and leave a site. Coding, number of Illustration, the server speed, other action on the site and the ability of a user's computer influences the speed of the site page.

6. Clarity of Information on a Website

This is nicely explained by Chuck Letoumeau[59] who defines Web accessibility to mean "anyone using any kind of web browsing technology must be able to visit any site and get a full and complete understanding of the information as well as have the full and complete ability to interact with the site if that is necessary."

7. Website Readability

Sites are designed keeping in mind the ideas of intuitiveness, achievability, comfort and client necessities. Information with regard to goods and services must be of high quality and easily accessible regarding customer satisfaction.

3.5.2. Internet: It's Importance in The Era Of E-Commerce[60]

1. The Internet is a speedy and flexible communications tool.
2. Communications can be customized in accordance with the customer needs based on account histories and other data.
3. New customers can be reached easily.
4. The Internet can increase an organization's geographic scope beyond its conventional areas.
5. The Internet provides a low cost, effective way of transacting with customers compared to traditional selling costs.
6. A site can be open for business at all times providing customer convenience.

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[59] *Available at:* https://books.google.co.in/books?isbn=3540075445

[60] *Sources*:www.oecd.org/sti/ict/broadband
www.zakon.org/robert/internet/timeline
www.davesite.com/webstation/nethistory.shtml
www.computerhistory.org/exhibits/internet_history/internet_history_90s.shtml-(accessed between 01/04/16 to 18/04/16)

7. It is an intelligent advertising tool enabling effective two-way dialogues amongst customer and organization to help accomplish procurement and maintenance goals.

8. The Internet can be used as a timely sales promotion tool with the use of focused specialist privileges and e-coupons.

9. The Internet gives crucial estimation of events and responsibility providing marketers with tool to secure budget increases.

10. The Internet's worldwide reach additionally gives chances to source new providers and merchants to maintain competitive advantage.

11. The Internet gives marketers with a rich source of marketing information for decision-making purposes.

12. Online marketing research supported with appropriate software provides latest information analysis to update the research process.

13. The Internet can give a test bed for goods or promotions.

3.5.3. Demerits of the Internet[61]

There are likewise a few issues related with the Internet that advertisers must comprehend and react to. These are laid out underneath:

1. Customer imperviousness to change, particularly disadvantaged people and older.

2. Public worries over protection issues, for example, chat-rooms and spam.

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[61] Sources:www.oecd.org/sti/ict/broadband
www.zakon.org/robert/internet/timeline
www.davesite.com/webstation/nethistory.shtml
www.computerhistory.org/exhibits/internet_history/internet_history_90s.shtml-(accessed between 01/04/16 to 18/04/16)

3. Lingering security questions over extortion, fraud and phishing (hackers) and network security and stability (worms).

4. Lack of trust with unknown virtual traders.

5. The internet's sensory boundaries limiting of senses like taste and touch which impact purchaser decisions.

6. Unavailability of Internet access for those in rural areas and low-income groups.

7. High costs of broadband connections deter those who want to avail high speed.

8. Social effects of the web for example debts generated from online gambling.

9. Poor levels of online client's service and satisfaction.

10. Complexities of cross-border trading.

Though there are certain demerits with Internet, but without any doubts it can be said that it has changed the traditional commerce and the lifestyle of the consumer. Not too many years ago individual shopped in their neighbourhood stores with long lines, wobbly shopping carts and weather problems. Notwithstanding when internet shopping was begun, individuals felt uncomfortable in giving their personal information and using their debit and credit cards. That has all changed. Easy search, time saving, easier returns policies, good offers and discounts, faster delivery, have all changed the behaviour of the consumers towards online shopping.

3.6. E-Commerce: An Online Approach

With the advent of the e-age, the world has witnessed newer and more efficient means of transacting business through the use of computer and Internet[62]. E-commerce is buying and selling goods and services over the Internet. E-business is a structure that incorporates not just those exchanges that centre on buying and selling goods and services to generate money, but also those transactions that helps in revenue generation. These exercises incorporate customer service, offering sales

[62] Karnika Seth, *supra* note 22 at 205.

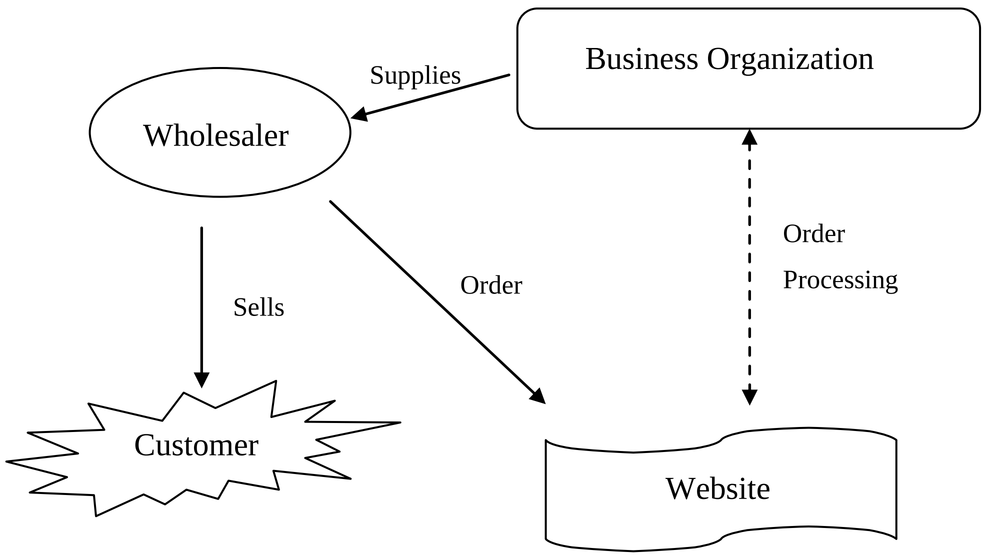
support and generating demand for goods and services, or encouraging communications between business partners.

The development of e-commerce is like a roller-coaster ride. It is growing but it is facing bumps as well. One may say it is part of the growing up process. The initial period of internet business hurled another business nomenclature using different stage and combinations of 'Business' and 'Consumers', like

- "Business-to-Business"(B2B),
- "Business-to-Consumer"(B2C),
- "Consumer-to-Business"(C2B) and
- "Consumer-to-Consumer"(C2C)[63].

(a) B2B (Business-to-Business)

As the name proposes, it is a business stage including two autonomous or even dependent business entities. It acts a business facilitator, arbitrator, dealmaker between or among commonly contributing business units[64]. For e.g. Organizations doing business with each other, such as manufacturers selling to distributors and wholesalers selling to retailers. Pricing is based on quantity of order and is often negotiable[65]. Following flow chart will clear the above point[66]:

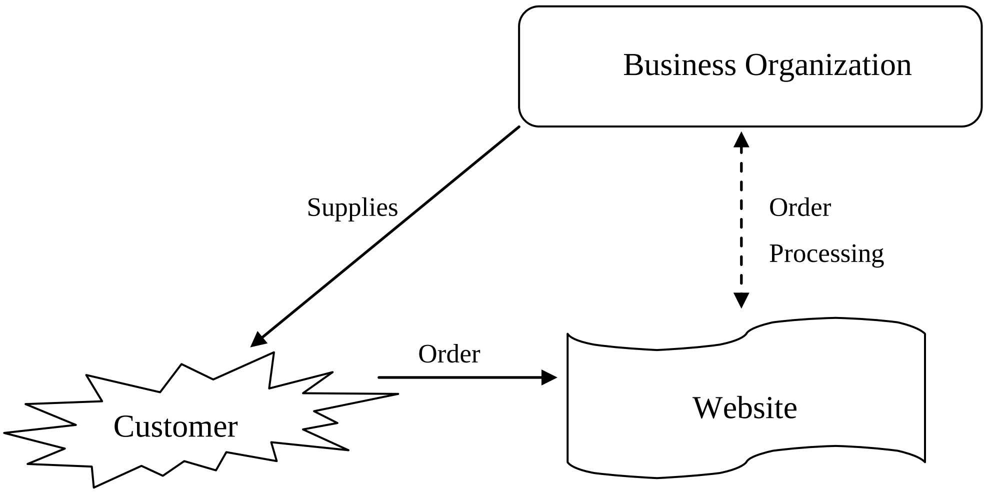


[63] S. K. Verma and Raman Mittal (eds.), *Legal Dimensions of Cyberspace*, 53 (Indian Law Institute, New Delhi, 2004).
[64] *Ibid.*
[65] Karnika Seth, *supra* note 22 at 205.
[66] *Available at*: www.tutorialspoint.com(accessed on 03/03/16).

(b) B2C (Business-to-Consumer)

It refers to transactions between a business and its ultimate consumer thus it make electronic retail shops that offer data, goods, and services amongst business and customers in a retailing transaction or it is an Internet and electronic trade display that shows a money related exchange or online deal between a business and buyer[67].

Following flow chart will clear the above point[68]:



(c) C2C (Consumer-to-Consumer)

It is an Internet facilitated medium, which includes buying and selling among consumers and it is a business model in which two buyers bargain business with each other straightforwardly [69]. It symbolizes a consumer business platform, where one consumer acts a seller of goods or services in an online medium to other consumers at a value. One may call such process as 'consumer2consumer' sales. This is a change over conventional selling or sale processes, where the relationship is as “business2consumer”[70]. Following flow chart will clear the above point[71].

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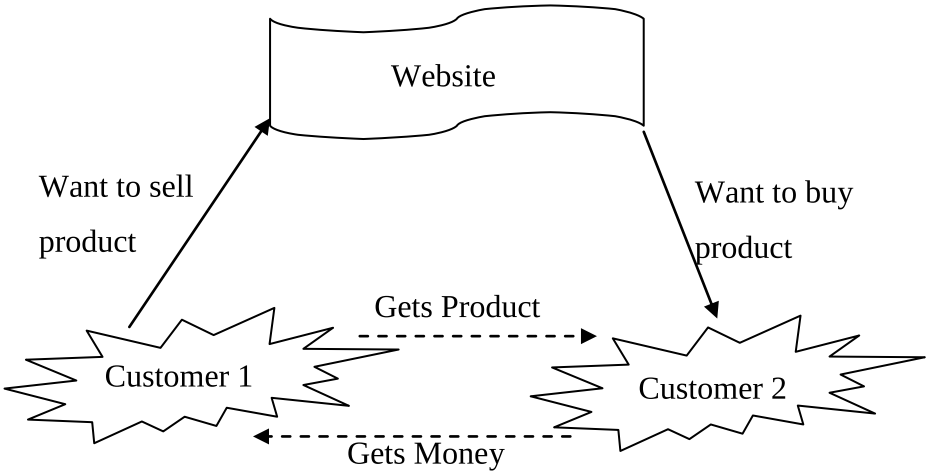
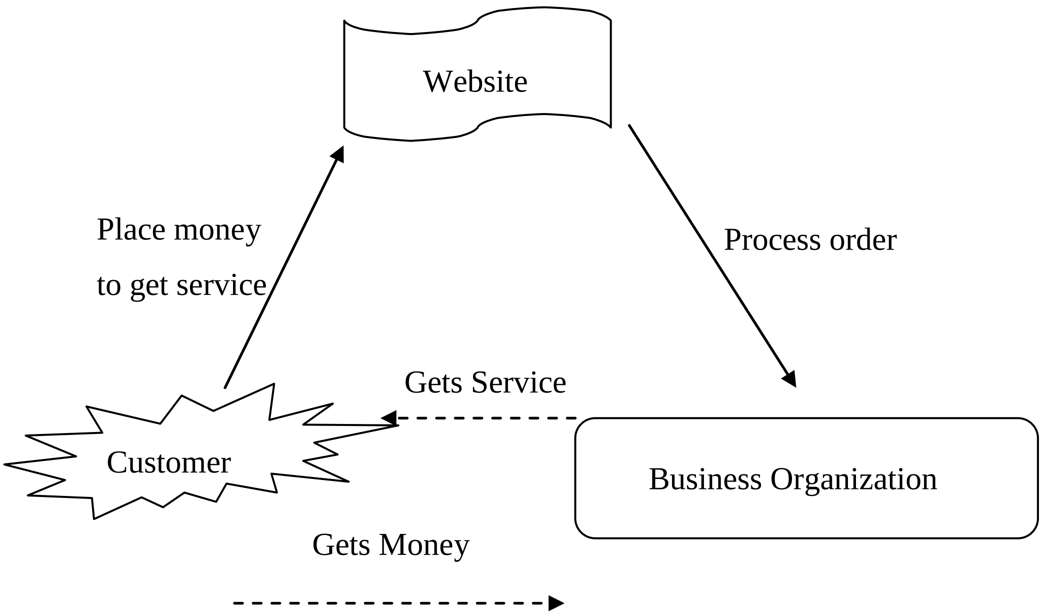
[67] International journal of scientific & technology research volume 2, issue 4, April 2013 *available at:* www.ijstr.org- (accessed on 15/04/16).
[68] See *supra* note 63.
[69] International journal of scientific & technology research, *supra* note 64.
[70] S. K. Verma, *supra* note 60.



(d) C2B (Consumer-to-Business)

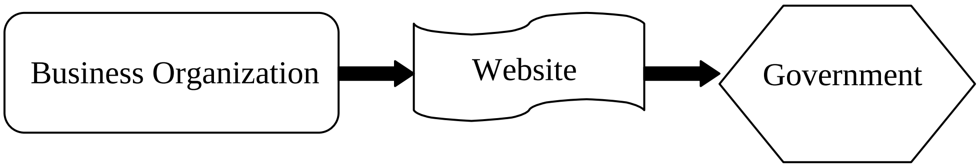
Consumer-to-Business is the sale and purchase of information goods or services from consumer to business or it is a business model where ultimate user creates goods and services that are utilized by business organisations[72]. A consumer uploads his venture with a set budget on internet and within hours organizations survey the buyer's necessities and offered on the venture, the customer audits the offers and chooses the organization that will finish the venture[73]. Following flow chart will clear the above point[74]:



[71] See *supra* note 63.
[72] International journal of scientific & technology research, *supra* note 64.
[73] Karnika Seth, supra note 22.
[74] See *supra* note 63.

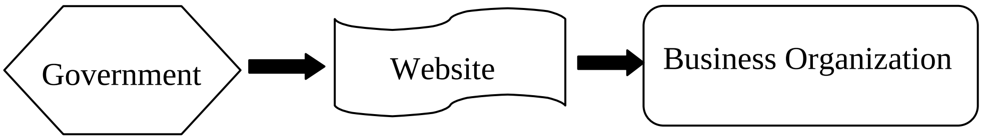
(e) Business - to - Government

B2G demonstrate a variation of B2B model. Such sites are utilized by governments to exchange and trade data with different business associations. Such sites are licensed by the government and give a medium to organizations to submit application structures to the government. Following flow chart will clear the above point[75].



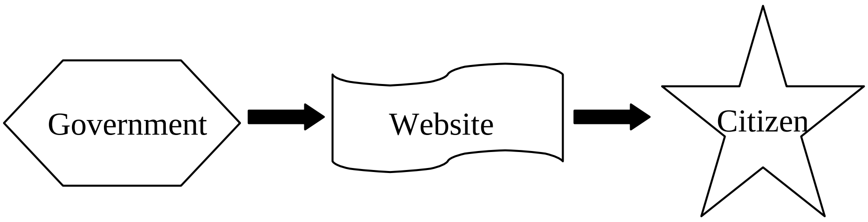
(f) Government - to - Business

Governments utilize B2G model sites to approach business associations. Such websites support tenders, auctions, and application submission functionalities. Following flow chart will clear the above point[76]:



(g) Government - to – Citizen (G2C)

Governments utilize G2C model sites to approach citizen in general. Such websites support auctions of vehicles, machinery, or any other material. Such site additionally gives services like registration to birth, marriage or death endorsements. The primary goal of G2C sites is to decrease the normal time for satisfying citizen's request for different government services. Following flow chart will clear the above point[77].



[75] *Ibid.*
[76] *Ibid.*
[77] *Ibid.*

Here it is important to understand what is E-governance?

3.6.1. E-governance: A Government-citizen interface

E-governance is a kind of 'window of opportunity' facilitating a much faster, convenient, transparent and dynamic interaction between the government and its people. More and more State Governments are in the process of creating a network of e-services and e-administration.

The e-governance models that have so far emerged in India have been utility driven and community based. Nevertheless, the core concept behind such models has been the same - to deliver the government services in the most effective and efficient manner. For example, the central Government and most of the state governments have taken initiatives regarding computerization of land record system, online payment of municipal dues, filing and settlement of complaints & grievances, filing of income tax returns etc.

(h) Mobile Commerce (M-Commerce)

In 1997 the term of Mobile Commerce was invented with an aim "the buying and selling of products, information and services" by means of wireless handheld gadget such as mobile phones, laptops and personal digital assistants. These wireless gadgets communicate with computer networks that can lead to conduct online buying of goods. Mobile commerce permits user to access Internet and shopping in it without the need of finding a place for the user to plug in the internet. Mobile commerce transactions are continuing to improve and in the phrase a wide range of goods and services, online banking, bill payment, information delivery and so on.[78]

Advantages of M-commerce.

Two primary characteristics are driving the interest in m-commerce: mobility and reachability.

Mobility infers that the Internet access travels with the customer. M-Commerce is attractive because wireless offers information to customers from any

[78] Yaser Ahangari Nanehkaran , "An Introduction To Electronic Commerce" *available at:* www.ijstr.org/final-print/apr2013/An-Introduction-To-Electronic-Commerce.pdf (accessed on 7/04/16).

location. This enables employees to contact the office, from location they happen to be or customers to work immediately on any shopping impulse.

Reachability implies that individuals can be reached whenever, which the vast majority see as a comfort of present day life. (Obviously, you can block certain circumstances or certain messages).

These two attributes—mobility and reachability—break the geographic and time hindrances. As a result, mobile terminals such as a PDA (personal digital assistant) or a mobile phone with Internet access can be utilized to get continuous data and to communicate from anyplace, any time.

3.7. What makes e-commerce unique?

The elements that determine web based trading from regular trades materialize in three areas: information flow, commodity flow and cash flow. Information flow represents the methods for trading, cash flow puts the conditions for trading, and commodity flow is the consequence of the trading process. There are three factors that make e-commerce novel[79]:

Virtuality:

E-commerce is done in a virtual online environment where the purchaser and seller don't take part in face-to-face contact. Rather, customers utilize a information about sellers, the goods and services they offer, conditions and pricing[80].

Unboundedness:

As the Internet has no physical limits, one can do online transactions from any place where an Internet connection is available. For consumers this implies that Internet shopping is not constrained by time or space, bringing down the money required for searching for goods and services as well as saving time and energy. For online traders this implies they are likewise not compelled by time or space.

Multiplicity of actors involved:

Large of actors in addition to the buyer and the seller are involved in the e-commerce trading process to certify authentication.

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[79] Binding/Purnhagen, Regulations on E-Commerce Consumer Protection Rules in China and Europe Compared - Same Same but Different, 3 (2011) *JIPITEC* 186 para. 1.

[80] *Ibid.*

3.7.1. Legal recognition to e-commerce practices

Legal acknowledgement of E-commerce practices has made considerable progress from the underlying appropriation of UNICITRAL's Model Law on Electronic commerce by the General Assembly of United Nation in early 1997[81]. The motivation behind the UNCITRAL Model Law on electronic trade is to empower the utilization of electronic business and to furnish countries with demonstrate enactment "governing the use of alternatives to paper-based methods of communication and storage of information". It is based on "functional equivalent" approach and extends notions such as "writing", "signature" and "original" of traditional paper-based requirements to a paperless world. It gives legal acceptance to electronic records and digital signatures.

Nations, by accepting the UNCITRAL's Model Law on E-commerce have not only given credibility to e-commerce practices, but also helped in bringing uniformity in e-commerce all over the world. The most significant part is that nations' laws on e-commerce have been founded on alike technology platform, i.e. asymmetric cryptosystem.

India became the twelfth country in the world to adopt the UNICITRAL's Model Law on Electronic commerce on October 17, 2000. The Information Technology Act, 2000 is based on the Model Law on electronic commerce. It amends the Indian penal code, 1860, the Indian evidence Act, 1872, the Banker's Books Evidence Act, 1891 and the Reserve Bank of India Act, 1934[82].

3.8. Advantages and Disadvantages of E-Commerce

The invention of new telecommunication networks and modern online devices has resulted in a new business. In fact, electronic commerce has become one of the most popular activities on the web. Electronic commerce created many benefits for organizations, consumers and society however, some disadvantages and serious problems stem from this issue.

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[81] The General Assembly of the United Nations by resolution A/RES/51/162, dated ',30th January 1997 has adopted the Model Law on Electronic Commerce adopted by the United Nations Commission on International Trade Law (UNCITRAL).

[82] S. K. Verma, *supra* note 60.

3.8.1. Advantages of e-commerce to Society

By e-commerce, people would nowadays be able to work and do their purchasing from home instead of by going around. This will bring about less traffic and air pollution. For individuals in Third world nations, many services and goods are currently accessible which were inaccessible before. Additionally, opportunities and higher education services are easily achievable for students.

Non-profit organisations, including government services, additionally advantage from internet business by the online payment system which supports the payment of tax refunds and Pensions rapidly and safely. Public services such as education, health care and public social service also benefit from e-commerce. For example, rural doctors and Nurses can access professional information and the latest health care technologies. In general, e-commerce makes goods and services all the more effortlessly accessible without geographic constraints.

The flip side of this is that many new issues of concern have emerged and there is a need for placing security mechanisms for smooth e-commerce transactions[83]. E-Commerce provides the following benefits to the society.

- Distant learning and education.
- Makes it probable to work from home only.
- No outdoor shopping thereby resulting in less traffic.
- Health care services.
- Smooth the process of delivery of public services.
- Decreased HR costs for organisations since they can have smaller office buildings, less parking spots, less IT services, etc.
- The society everywhere now can appreciate the accessibility of the item at their doorstep from any piece of the world which generally would not have been conceivable.

[83] Karnika Seth, *supra* note 22.

3.8.2. Disadvantages of e-commerce to society

As individuals turn out to be more used to interacting electronically there could be a disintegration of individual and social skills which may in the end be hindering to the world we live in where individuals are happier with interacting with a screen than up close and personal. There is additionally potential threat that there will be an expansion in the social gap between specialized haves and have-nots – so individuals who don't have specialized abilities become unfit to secure better-paid employments and could form an underclass with potentially dangerous implications for social solidarity. As new technology dates quickly the problem of disposing off old computers, keyboards, monitors, speakers and other hardware, will also increase[84]

3.8.3. Advantages to organisations

- Using e-commerce, businesses can grow their market to national and International markets with least capital investment. An association can without much of a stretch find more clients, best providers, and appropriate business accomplices over the globe.
- E-commerce causes associations to decrease the cost to manage, create process, distribute and retrieve the paper based data by digitizing the data.
- E-commerce enhances the brand value of the organisation.
- E-commerce encourages associations to give better client services.
- E-commerce improves the business procedures and makes them speedier and proficient.
- E-commerce decreases the printed work.
- E-commerce boosts the productivity of businesses. It underpins "pull" type supply administration. In "pull" type supply administration, a business procedure begins when a demand originates from a client and it utilizes without a moment to spare assembling way.

[84] *Available at:* http://www.straight-on.com/ecommerce_definition.htm (accessed 14/04/16).

3.8.4. Disadvantages of e-commerce to organisations

Lack of sufficient system security, reliability, standards and communication protocols is one of the major concerns for the organizations. There are various reports of sites and databases being hacked into, and security gaps in programming [85].

Quickly developing and evolving technology, so there is dependably a sentiment attempting to 'catch up' and not be left behind[86].

Under pressure to improve, innovate and create plans of action to exploit the new opportunities which at times prompt procedures unfavourable to the association. The straightforwardness with which plans of action can be replicated and copied over the Internet builds that pressure and curtails longer-term competitive advantage[87].

Confronting expanded rivalry from both national and global contenders often leads to price wars and ensuing unsustainable misfortunes for the association.

There are issues where more established business frameworks can't communicate with web based and Internet infrastructures, prompting a few associations running just about two autonomous frameworks where information can't be shared. This often leads to investing in new frameworks or a foundation, which connects the distinctive frameworks. In the two cases this is both financialy expensive and also troublesome to the proficient running of associations[88].

3.8.5. Advantages of e-commerce to customers

For customers, the advantages occur in the buying process' product research evaluation and execution. E-commerce provides customers with a Platform to search information through global markets with a wider range of choice, which makes comparison and evaluation easier and more efficient.

There is comparative ease of access, and speed and convenience. Less expensive goods and services is one of the advantages for customers who buy on online. Furthermore, delivery time and costs can be spared by purchasers when they

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[85] See *supra* note 63.
[86] *Ibid.*
[87] *Available at:* http://www.commerce.net/research/barriers-inhibitors/2000/Barriers2000 study. html (accessed on 05/04/16).
[88] *Ibid.*

buy digital goods and services. i.e., distance education delivered via the Internet, e-books, music and audio clips, software, games, and music and audio clips [89].

3.8.6. Disadvantages of e-commerce to customers

- Computing equipment is required for people to take part in the new "computerized" economy, which implies an underlying capital cost to clients.
- A fundamental technical knowledge is required of both computing equipment and surfing of the Internet and the www.
- Cost of access to the Internet, whether dial-up or broadband tariffs[90].
- Not just the initial cost of buying equipment but making sure that the technology is updated routinely to be good with the changing necessity of the Internet, sites and applications[91].
- There is no genuine control of information that is gathered over the Web or Internet.
- Data protection laws are not universal thus sites facilitated in various nations might possibly have laws which secure protection of individual information.
- Physical contact and relationships are replaced by electronic processes. Clients can't touch and feel merchandise being sold on-line or gage voices and responses of individuals.
- A absence of trust is also there because they are communicating with faceless computers[92].

[89] Karnika Seth, *supra* note 22.
[90] *Available at:* www.oecd.org/sti/ict/broadband (accessed on 14/04/16).
[91] *Available at:* http://www.ecommerceeducation.com/benefits-of-ecommerce.asp (accessed on 05/04/16).
[92] See *supra* note 63.

3.9. Differences between E-Commerce and Traditional Commerce

Because of the exponential development of web, nature and structure of rivalry in customary method for working together and internet business has been changed significantly. In conventional method for doing trade, most organizations needed to compete within a single industry and often within a specific limited geographical area, however the web is breaking every one of these limits. Example: Online Shopping for Electronics, Apparel, Computers, Books, DVDs & more. The company began as an online bookstore but quickly expanded into new products and markets such as music, videos, and home improvement supplies.

Because of the expanded popularity and accessibility of Internet access many traditional small companies are thinking about web based business as a legitimate and gainful deals channel. However, e-commerce and traditional commerce are altogether different, and it's important to weight carefully the contrasts between online business and customary business so as to choose on the off chance that it would be a solid match for your business or only an exorbitant mix-up.

The traditional Commerce is based on the following rules:

- It needs to hire sales executive, sales managers, accountants, and other staffs.
- Operates at business hours inside a specific timeframe.
- Requires location renting/purchasing, staff employment, advertising, inventory shipping and taking care of all totals up the high-cost condition which makes many individuals refute from beginning a business completely.
- No sharing of the data with the contenders.
- The premise of a conventional business relies upon the recurrence of new and old clients purchasing from them to keep the business running[93].

In the present quick paced world, in order remain in contention and flourish in the business world, it is vital to break - through these traditional guidelines and adjust

[93] *Available at:* http://EzineArticles.com/?expert=Irene_Lizarraga (accessed on 15/04/16)

the data innovation methods for working together. Online business has vital stages clarified beneath:

- It is connected with publicizing of the items electronically and empowering the clients to peruse through the accessible offers.
- It includes an agreement between the involved parties to continue with the succeeding phases. Order is made for the goods after an agreement is concluded.
- E-payment modes on the internet are used for receiving payments.

3.10. Traditional commerce versus e-commerce

1. **Direct Interaction**

Traditional commerce is frequently based around the up close and personal communication. The client has an opportunity to make inquiries and the business staff can react to them instantly to guarantee an agreeable exchange.

E-Commerce does not offer direct connections unless elements, for example, related things or live talks are executed. Be that as it may, it is rarely done.

2. **Lower Cost**

In Traditional commerce, higher costs required, for example, for business space lease and opening an online store[94].

E-Commerce is typically significantly less expensive than keeping up a physical store in a similarly popular area.

3. **Reach**

In Traditional commerce, you are limited to individuals who really gone to your shop. E-commerce also exposes to excessive number of different types of marketing that should be possible absolutely online which regularly brings about a more deals and even pedestrian activity to the store.

In E-Commerce, with an online shop, your business should be possible with anyone living in a nation you are capable and willing to send e-mail to. No ability

[94] Traditional Commerce vs. E-Commerce *available at:* http://www.academia.edu/6477010/TRADITIONAL _COMMERCE_VS._E-COMMERCE (accessed on 16/04/16).

constrains in an online store and you can have the greatest number of customers as your stock can serve[95].

4. Returns Rate

In Traditional commerce, the client will be acquiring the item face to face, where he will have the capacity to touch and check the things, to ensure whether they are appropriate or not and even try them on, which decreases the quantity of returning items or complaints because of a thing not being as promoted on an inventory[96].

In E-Commerce, expect an essentially higher rate of profits if you start trading online the greatest number of individuals will simply request and attempt the things at home and won't delay to return them as they can do it by present without chatting on anybody up close and personal.

5. Trademarks

Trademarks are of considerable importance in traditional trade as well as in e-commerce and are of similar significance in the online world as in the physical world.

The brand plays a crucial role in e-business, more so because the consumer is deprived of face-to-face interaction in the virtual market.

6. Domain Names

In traditional commerce, there was no issue regarding domain names, as there was no use of internet.

While in case of e-commerce, domain name is of great importance and it will not wrong to say that e-commerce revolves around the domain names. Importance of domain name can be assess on the fact that it is some time considered as trade mark of virtual world. Once an individual or company decides that they want an online presence, usually through a website, they will need to obtain a domain name.

Domain names are the human-friendly forms of internet addresses, which are commonly used to find web sites. Each domain name is linked to an Internet Protocol address which is numeric, and the user-friendly address is attached to this unique code and allows users to navigate around the internet. The difficultly with the numeric system is that it is not easy for the consumer to remember and these addresses could be mistyped without an easy way of spotting the error.

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[95] *Ibid.*

[96] *Available at:* ufdcimages.uflib.ufl.edu/IR/00/00/37/87/00001/FE82000.pdf (accessed on 16/04/16).

Therefore, the domain name system creates a word-based structure, which is much more user-friendly for the consumer. There are two main types of domain name: the top level domain, with prefixes such as ,.com,, ,.org, and '.net' and the second level domain such as '.uk' and '.fr'. Domain names form the basis of other methods or applications on the internet such as file transfer or email addresses[97].

3.11. E-Commerce: Legal Issues

(i) Jurisdiction

Are e-commerce and the Internet borderless?

The improvement of digital law has for quite some time been molded by the belief that the Internet is borderless. Numerous observers contend that without boarders, the Internet is impenetrable to the real space laws that mirror conventional geographic limits. Courts have by and large acknowledged the vision of a borderless Internet as prove by their hesitance to much think about how possible it is that geographic refinements may be conceivable on the web[98].

(ii) Consumer Issues

Unlike the offline environment, where buyers enter a store, assess potential buys and decide for themselves the dependability of a dealer, the online world does not give a similar chance to utilize a "purchaser's sense." Rather, numerous shoppers are compelled to continue on confidence, knowing minimal about the vender to whom they are entrusting their charge card information[99].

(iii) Taxation

Since nations and states as often as possible depend on sales taxes as a critical source of income, expanding sales on the Internet raise vital tax assessment strategy contemplations. Unless the exchange happens between a purchaser and a vender dwelling in the same taxing jurisdiction, collection of sales tax rarely, if ever, occurs. Detecting that the Internet could cause tax dollars to be lost, a few nations and states have started to consider instituting Internet taxes. Restriction to such plans is furious;

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[97] Kavin M.Rogers, *The Internet and The Law*, 10-11(Palgrave Macmilan,2011).

[98] Michael Geist, A Guide to Global E-Commerce Law, University of Ottawa, Faculty of Law, Attachement 4*available at:* https://www.itu.int/ITU-T/special-projects/ip-policy/final /Attach04.doc (accessed on 12/04/16).

[99] *Ibid.*

be that as it may, as it is expected that such charges would extremely hose the development of electronic commerce[100].

Proponents of a tax-free Internet fear that governments see the Internet as a lucrative new source of income and will race to force new taxes on exchanges occurring inside their purview. Given the Internet's particularly non-geographic design, accumulation of new taxes would post critical enforcement challenges since it is much of the time misty definitely where an exchange happens when it is directed on the web. In addition, purchasers and organizations may be discouraged from grasping the Internet's business potential because of worries with consistence and cost.

(iv) Privacy

Privacy is one of the most complex legal issues facing e-commerce ventures today. Many sites, such as the one in our case study, have little interest in actively profiling their users or discovering personal information about them. However, these sites will often collect significant amounts of personally identifiable data that may trigger liability risks[101].

Internet users fear the loss of personal privacy, in light of the capacity organizations and their sites need to gather, store, and process individual information. For instance, sites extract information from customers through a form, and afterward record information about their client's browsing habit. After collecting user information, the sites coordinate the information with their own and statistic data to make a profile of the client's inclinations, which is then used to advance focused advertisements or provide customized services. he sites may likewise participate in web lining through which they value a purchaser as indicated by their profiles [102].

(v) Web tracking

By using tracking software, organizations can track people's movements on the Internet. Programs such as “cookies” raise a cluster of protection concerns. The tracking history is stored on your PC’s hard drive, and any time you revisit a certain

[100] *Ibid.*
[101] E-commerce and Consumer Privacy, *available at:* cis-india.org/internet.../blog/privacy/ consumer-privacy-e-commerce (accessed on18/04/16).
[102] *Ibid.*

Web site, the computer knows it. Programs such as Cookie for example, Cookie Cutter are intended to enable clients to have some control over cookies.

(vi) Disintermediation.

The use of E-Commerce may result in the elimination of some of a company's employees as well as brokers and agents. This result is called disintermediation—that is, "eliminating the intermediary." This outcome is called disintermediation—that is, "dispensing with the mediator." The way in which these unneeded workers, especially employees, are dealt with may raise moral issues, for example, how to deal with the dislodging.

(v) Internet Governance

The discussion about who is responsible for governing the internet is of critical importance. The body that runs the internet has the responsibility for acting as 'gate-keeper' and provides the rules for saying who can have an online presence and who cannot.

(vii) Trade Marks and Domain Names

A trademark law serves to secure a business's goodwill/reputation by enabling it to distinguish its marks from those of contenders. Trademarks can emerge under state law or customary law; yet, keeping in mind the end goal to accomplish more full security, registration is required under government trademark law.

With the passage of time, there have been many trade mark disputes amongst blocks and mortar organizations permitting trademark law to adequately develop in order to give direction with reference to what kind of lead is admissible and what direct constitutes encroachment. In any case, the Internet has introduced one of a kind difficulties and concomitant opportunities for trademark infringement[103].

Domain Name Registration is one case of how the Internet gave a challenge to conventional trademark and name protection. While trademark law empowered an organization to register its marks in order to prevent marketplace confusion with

[103] *Available at:* http://jstor.org (accessed on 28/04/16).

regards to the source or nature of the, all bets were off when domain name registration first commenced.

Trademark law allows various parties to use the same name, if it is for various products and services and does not cause marketplace confusion[104]. However, on the Internet just a single use can utilize a domain name in light of the fact that a domain name is really an address and just a single registrant can involve a specific address. For instance, while ‘Hamdard’ owns its trademark in the normal business world, it doesn't naturally have the exclusive right to register as "hamdard.com", consequently enabling another party to hop in first and register that name.

3.12. Concluding Remarks

The Internet and other computerized systems are the main impetuses behind a dramatic change in the way business dealings are done. Increasingly, networks and information technology are being utilized to electronically configured market, purchase, offer, and deliver items and services around the world. Such buying and selling is called Electronic commerce (e-commerce). E-commerce is a new method business is another strategy business that blends the greater part of the earlier techniques and transaction styles. E-commerce have affect on numerous ranges of business for e.g., financial aspect, marketing, computer science, economics and bookkeeping, management information system, production and operation management, human source management, business law, morals and ethics.

Without a doubt, the power of the Internet to reach any part of the world holds breathtaking potential for enhancing international trade and boosting worldwide economy. This Internet Economy has seen gigantic development.

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

[104] Ricketson, *The Law Of Intellectual Property*, 603 (*Law Book*, Sydney,1984).

adjust existing laws to fit new settings where it is unclear how these laws will apply.

Amidst this legitimate turmoil, many nations across the world have enacted e-commerce legislation. However, much more is needed to successfully control the tangled web. Adequate legal documentation coupled with Effective risk management strategies will go far in securing e-commerce business. Despite the fact that the Internet is a goldmine without satisfactory legitimate assurance, it could turn into a landmine. Nonetheless, with the quick extension internet & e-commerce is set to assume an imperative part in the Twenty first century, the new open doors that will be tossed open, will be available to both small companies and large corporations.

The government should provide a legal framework for e-commerce so that while international and domestic trade are allowed to expand their horizons, basic rights such as intellectual property, consumer protection, privacy, prevention of fraud, etc are all taken care of.

There has been necessity that some of these issues must be addressed. The rise of the internet as an instrument for web based business has brought about complex intellectual property issues. By a wide margin, the most intellectual property ideal with respect to the Internet is intellectual property: trademarks, copyrights and patents. One manner of resolving problems is by enacting legislation. Governments have since quite a while ago perceived these rights. Intellectual property laws has been ordered in many nations and a hefty portion of these nations are signatories to international intellectual property treaties. Those working together in these purviews have realized that they should comply with these laws or pay the cost.

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.

The arrangement of dispensing rights under trademark laws, works sensibly well in the physical world, which can be divided both topographically and by sorting the goods or services on offer; there is far less apportioning in the Internet. Organizations that have contributed huge measure of time and cash in their trademarks have been astonished when they have endeavoured to utilize their trademarks as a major aspect of their domain names, just to find that the names have been taken by cyber squatters or electronic pirates who register well known domain names in the hope of ransoming them back to their legitimate proprietor. The issue of domain name registration and dispute resolution as well as litigations is the one that has caused great controversy and cries for reform time to time.

Utilization of trademarks on the web has also lead to various other issues, i.e. whether there is any effecting and comprehensive law concerning domain names? Whether Domain names and Trademarks are same? Legal position of Domain names under trademark law both at international level and national level? Can the judiciary tackle the problem of domain name infringement in effective way? Does domain name need a separate law for its protection? There is no single law which deals directly with the issues related to domain Names. There is a need to correlate trademarks with domain names, so we can analyze whether they are interrelated or distinct with each other. This is what the coming chapters will discuss.

Chapter-4

DOMAIN NAMES: HISTORY AND CHARACTERISTICS

4.1. Introduction

It is now clear from the Chapter three that the internet assembles the world into one single market and with a little investment a business gets access to this worldwide marketplace. The Internet is a novel and unique medium for human communication worldwide[1]. Internet presence gives organizations enormous possibilities. With goods and services accessible online, the business can reach virtually everyone.

In addition, the Internet has the advantage of reaching the potential client at home or at the workplace. For the shoppers, the Internet gives a proficient and quick way of doing commercial exchanges. The Internet is easy to access and accommodates the comfort of shopping at home. It is beyond any doubt that the Internet is getting important to e-commerce - this is the new pattern and the eventual fate of advertising, offering and buying goods and services.

One of the reasons for the growing popularity of the Internet among individuals is the easy to understand way of searching the "www". An organization's World Wide Web address ordinarily comprises of its trade name with the expansion of ".com". The part of the "www" address after "www" is known as the "domain name". As an organization's domain name regularly is its trade name, potential clients discover their way through the "www" by perusing, looking and surfing the "www" by domain names.

Therefore, one of the active elements in commerce through the Internet is domain names. The significance of having a domain name in the internet is like a trade name in the real world links domain names to trademarks.

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[1] Paul Sugden, "Trademarks and Domain Names" in Jay Forder and Patrick Quirk (eds.), *Electronic Commerce and the Law* 199(Australia: John Wiley & Sons, 2001).

Having considered the Internet, its history, technical and administrative structure and the development of e-commerce, this chapter will focus on domain names. The Internet is right now facing the development of a contention zone concerning the creation and registration of domain names. To completely understand the domain name issue it is critical to inspect what a domain name is, what are its attributes and how the Domain Name System (DNS) right now works.

4.2. The Domain-Name System

It is defined as –

> *"... a hierarchical decentralized naming system for computers, services, or other resources connected to the Internet or a private network. It associates various information with domain names assigned to each of the participating entities. Most prominently, it translates more readily memorized domain names to the numerical IP addresses needed for locating and identifying computer services and devices with the underlying network protocols".*[2]

The DNS is the central system for routing activities on the Internet. The main job of the DNS is to furnish clients with an easy and dependable means of connecting and interacting on Internet sites, and of sending and getting e-mail, to state only the most noticeable of Internet services. The Internet's great rise as a worldwide resource and basic communications medium that is easy to utilize and predictable is directly attributable to the DNS. In spite of the fact that the Internet is somewhat decentralised, the DNS is organized in a centralised hierarchical manner.

4.3. Domain Names: Meaning

In order to understand domain names it is first necessary to understand what IP addresses are.

[2] Domain Name System, a*vailable at* :https://en.wikipedia.org/wiki/Domain_Name_System (Accessed on 05/06/2016).

4.3.1. Internet Protocol (IP) Addresses

Among various other protocols, Internet uses an important protocol named Internet Protocol (IP)[3] which makes computers and other gadgets possible to instantly communicate with one another over a diverse range of physical links. The fundamental identifier on the internet is an IP address. An IP address is a binary number that uniquely identifies computers and other devices on a TCP/IP network[4].

Each and every computer linked to Internet is given a unique electronic address, which is called Internet Protocol (IP) address. Each identifiable location in Internet has distinctive IP address[5].

Moreover any machine associated with the Internet has an IP address: fax machines, mobile phones and Xbox games even pop containers have IP addresses. For each situation, the IP address acts both like vehicle license plate and like a phone number: it indicates ownership, enables the machine to be located by different machines, and engages specialists to track and ensure individuals' privacy and security, if require be

How IP addresses look:

IP addresses have two common formats[6].

- **IP version 4**
- **IP version 6**

IP version 4 addresses are consists of of four numbers-just segments isolated by dots:

•e.g. 786.2.2.3

•e.g. 453.28.99.11

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[3] C.M. Kozierok, *The TCP/IP Guide: A Comprehensive, Illustrated Internet Protocols Reference*, 45 (No Starch Press, 1st Ed.,2005).

[4] How Domain names works, *available at* http://www.google.co.in/url?q=http:// compnet working.about.com/od/workingwithipaddresses/g/ip-addresses.htm&sa=u&ved=0 ahukewjuq833 vih pahxbno8khb1xde0qfggimac&usg=afqjcnftj6hqiwptspwo_egyntcdyjt6bq (Accessed on 06.06.2016).

[5] Peter B. Maggs, *et al.*, *Internet and Computer Law: Cases – Comments – Questions*, 457 (St. Paul, MN: West Group, 2001).

[6] *Available at*: http://netforbeginners.about.com/od/i/f/ip_address.html (Accessed on 08.06.2016).

•e.g. 36.52.321.202

IP version 6 addresses are more complicated. IPv6 addresses are consists of 8 segments:

••e.g. 6ffe:0700:2323:9:800:f6ff:fe56:45cf

•e.g. 82da:d2:4:8f6b:4aa: ff: fe14:3c1a

P address is not the same as www domain name addresses. For about each web server, the IP address is imperceptibly converted into characteristic English "domain name" for usability. Be that as it may, actually, the IP address is the genuine identifier of a web server...the domain name is basically a redirector pointer to enable individuals to discover the web server.

Here are three IP addresses, with their equivalent domain names. Both the IP address and domain name URL can be utilized to associate with a same web server:

••e.g. 74.125.224.72 = www.google.com

•e.g. 69.63.176.13 = www.facebook.com

•e.g. 216.58.203.133= www.gmail.com(India)[7]

Internet authorities designate extensive packs of IP address numbers to regional internet service providers. Those ISP's (Internet Service Providers), thus, dole out the IP address to each server and each web client who logs on. Yes, there are a huge number of IP addresses to active at any moment.

Actually each host associated with the Internet has an exceptional IP address. An Internet Protocol Address[8] is the numerical address of the form 352.3.86.20 (IP Version 4) or 2017:250:44:250:1:1:1:35 (IP Version 6) by which a location in the web is located. Computers on the Internet utilize IP addresses to route traffic and set up connections among themselves. E.g. at the point when a demand for a Webpage is sent from a customer PC framework to a Web server, the customer PC incorporates the IP address of the Web server.

[7] *Ibid.*

[8] Domain Name System, *Supra* note 2.

Every IP addresses are consist of string of digits delimited by periods (commonly known as dots). The delimited field indicates the network, sub-network and the local address, read from left to right. A typical IP address might appears as "122.228.29" where "122" denotes the network, "228" denotes the sub-network and "29" denotes the computer itself. All the numeric form is known as the IP address.

4.3.2. Domain names

As the ubiquity of the Internet expanded so too the trouble to remember these numerical addresses wound up noticeably self-evident [9]. Thus, for the purpose of convenience, a word/letters based framework called as Domain Name System (DNS) was presented[10]. In simple, a domain name is the word / alphabet based substitute to the numeric IP addresses. These swaps to the string of numbers are human memorable and understandable in nature[11]. Domain names is converted into a thirty-two-bit dotted decimal notation or a number consisting of four octets (sets of eight binary digits), that specifies a network address and a host ID on a network.[12] Just like the address of a person in the real world, the domain names are the addresses of the respective computer in the global computer network[13]. While signing onto the Internet through a server, the server would translate the said domain name into its specific corresponding numerical IP address.

Domain names can contain up to 255 characters consisting of: characters A to Z, 0 to 9, and/or "-"; 63 characters per node; and up to 127 node levels[14]. To ensure that each node is uniquely identified, DNS requires that sibling nodes - nodes that are "children" of the same "parents" - be uniquely named. For example, these "absolute" names are unique: beckett.incognito.com and beckett.af.mil[15].

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[9] Paul Sugden, *Supra* note 1at 203.

[10] Michael Froomkin, "ICANN□s Uniform Dispute Resolution Policy" – Causes and (Partial) Cures", *available at:* http://papers.ssrn.com/abstract=2718986 (Accessed on 08.06.2016).

[11] Michael Chissick and Alistair Kelman, *Electronic Commerce: Law and Practice* 17 (London: Sweet & Maxwell, 1999).

[12] Michael.Froomkin, "A Wrong Turn in Cyberspace: Using ICANN to Route around the APA and the Constitution" *available at:* http://papers.ssrn.com/sol3/papers.cfm? abstract_id=252523 (Accessed on 10.06.2016).

[13] Pankaj Jain and Sangeet Rai Pandey, *Copyright and Trademarks Laws Relating to Computers* 89(Lucknow: Eastern Book Company, 1st edn., 2005).

[14] *Ibid.*

[15] *Id.*at 90.

According to final report of the WIPO Internet Domain Name Process, "*a domain name is an IP address in a human-friendly form*"[16].Domain names are the simple English references to the IP addresses[17]. Similar to the IP numeric addresses, the domain names are divided into fields separated by point (in the Internet language called "dot"). For example, "www.facebook.com" is a characteristic example of a domain name. As mentioned above, the overlapping system of mnemonic addresses is designed to make the Internet more users friendly. Therefore, when a domain name is typed into a computer, the Internet automatically converts the domain name to the numbered IP address. Domain names serve as unforgettable names for Internet users, like networks, computers, and services.

A domain name corresponds to an Internet Protocol (IP) resource. Individual Internet host computers use domain names as hostnames or host identifiers. Hostnames are the leaf labels in the domain name system usually without further subordinate domain name space. Hostnames appear as a component in Uniform Resource Locators (URLs) for Internet resources such as web sites (e.g., en.wikipedia.org). [18]

The term "domain name" can be described as a mean of defining IP (Internet Protocol) address to which it is ascribed. Technically, the domain name has the subordinated character under the relation to the so-called IP-address which possesses any information resource in the Internet.

Domain name is different from Universal Resource Locator (URL) and website. Domain name, being the alternative to IP address, forms only part of the other two[19]. However the refinement between space name and site is obscuring, since it doesn't have much practical significance, and hence many utilize these terms reciprocally. While domain name is a part of the website, the URL is the extended

[16] See World Intellectual Property Organization (WIPO), The Management of Internet Names and Addresses: Intellectual Property Issues, Report of the WIPO Internet Domain Name Process, 30 Apr 1999, *available at:* http://www.wipo.int/export/sites/www/amc/en/docs/ report-final1.doc (Accessed on 06/04/2016).

[17] *Ibid.*

[18] Clacky McSnackins, "Explaining the Difference between a URL and a Domain", *available at*: http://www.helium.com/items/235627-explaining-the-difference-between-a-url-and-a-domain (Accessed on 15.06.2016).

[19] *Ibid.*

path of the website,[20] which helps in finding the site. This can be better understood from the example. In “http://www.un.org”, “un.org” is the domain name, “www.un.org” is the website, and http://www.un.org is the URL[21].

In the starting, the role of domain name, much the same as postal addresses, was restricted to give address for computers on the web for the purpose of communication. However the circumstance changed soon with the start of business exercises over the Internet. The domain name system has assumed a vital part in the development of the current day e-commerce. The identification of products as the goods or services provided by respective entities is indispensible in the contemporary business, since it causes the purchasers to go for quality goods and services. While in the conventional trade this capacity of distinguishing identification is performed by the trademarks of the business organisations,[22] on the Internet, the domain names play out a similar capacity [23].

Domain names, being the uncomplicated and easily memorable form of Internet addresses, are made in such way that they function to enable the natives to find the particular webpage on the Internet among quickly expanding uncountable number of sites. This causes the online clients to reach the website of the particular merchant from where they mean to buy[24]. In this way, with the expansion in online business exercises, the domain name has not just procured the status of being the business identifier, additionally has been considered as most important by the dealers, since the name draws in the clients in the cutting edge business[25].

4.4. Need of Domain Names

To make it easier to find a given location on the Internet, the Domain Name System, or DNS, was invented. The DNS translates IP addresses into unique alphanumeric addresses called domain names that are easier to remember. If, for

[20] *Ibid.*

[21] Suzanne James, “Explaining the Difference between a URL and a Domain”, *available at*: http://www.helium.com/items/56913-explaining-the-difference-between-a-url-and-a-domain (Accessed on, 05.05.2016).

[22] Shahid Ali Khan and Raghunath Mashelkar, *Intellectual Property and Competitive Strategies in the 21st Century* 191 (The Netherlands: Kluwer Law International, 2004).

[23] Stim Richard, *Trademark Law* 99 (Canada: West Legal Studies, 2000).

[24] Anish Dayal, “Law and Liability on the Internet” in Kamlesh N. Agarwala and Murali D. Tiwari (eds.), *IT and Indian Legal System* 56 (New Delhi: MacMillan, 2002).

[25] Paul Sugden, *Supra* note 1.

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[26]. 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).

4.5. Importance of Domain names

The original scope of domain names was to serve a technical function in order to undercover long and entangled numerals into alpha-numeric content which is easier for Internet clients to recall and find [27]. However domain names have developed and are considered to be more than a connection among the Internet user and the computer hosting the website. In fact domain names assume a critical part in branding for internet business organizations and are related with merchandise and services, organizations and resources. A domain name is the main thing an Internet client interacts with while getting to an Internet site[28]. This shows the significance of domain names. A domain name which is easy to recollect has the advantage of being easier for previous visitors to remember and drives more clients to that site due to its accurate relevance to the subject of the search of Internet surfers[29].

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26 Development of Domain Names *available at*: www.netregistry.com.au/files/getfile.php?f=beginners-guide-domain-names.pdf (Accessed on 22.06.2016).

27 An overview of the domain name system *available at:* http:// sunburn .stanford.edu/~eroberts/courses/cs181/projects/the-domain-name-system/what.html (Accessed 0.08.2016).

28 Louise Davidsson and Sara Thulin, The Legal Status of Domain Names in Sweden, *available at* :http://www.google.com.mt/url?sa=t&rct=j&q=&esrc=s&source=web&cd= 1&ved=0CC4QFjAA &url=http %3A%2F%2Fhj.diva-portal.org%2Fsmash%2Fget%2 Fdiva 2% 3A3529%2FULL TEXT 01ei=wvhXUaKKH-Xj4QSk_IGADQ&usg=AFQjCNH seh8 FXctsVdVS23 1wr5x XRha 7BA> (Accessed 23.08.2016).

29 Xuan-Thao N. Nguyen, 'Cyber property and Judicial Dissonance', Geo Mason L. Review 10(2) 187 *available at:* http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1493482 (Accessed 28.08.2016).

Domain names are also used as uncomplicated identification labels to indicate control or ownership of a resource. A significant task of domain names is to give easily identifiable and memorizable names to numerically addressed Internet resources. This thought enables any resource to be moved to an alternate physical area in the address topology of the system, universally or locally in an intranet. Such a move normally requires changing the IP address of a resource and the relating interpretation of this IP address to and from its domain name.

The domain name is referred to as the only *domain* and domain name registrar, which is generally known as *domain owners*, even though domain name registration with a registrar does not provide any legal ownership of the domain name, only a special right of use.

The use of the domain name in e-commerce can be subject to trademark law. The number of active domains crossed 200 million in 2016[30]. It is a word or phrase that can be use as a domain name. When thinking of a domain name, think of catchy words or expression that are easy to remember and that will convey more traffic to your site. Domain names are generally as short as possible, around 5 to 20 characters is. The shorter the domain name the easier it will be to remember.

In order to see where we are going, it is frequently useful to consider where we have been. In light of that, a brief overview of the history of the DNS is justified before we move further.

4.6. Historical development of Domain name System (DNS)

The domain name system (DNS) is like a "telephone book" of the Internet. Similar to using the telephone book to look up a name in order to find a phone number, you look up addresses in DNS to find an IP address. The Domain Name System (DNS) is developed to keep the identification of communicating devices easy. There is a particular procedure for registration of domain name.

4.6.1 DNS Past

Right from its formation in the 1980s, the DNS has effectively fulfils the requirements of Internet users. DNS has gone through number of disputes, including

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[30] *Available at*: http://www.icann.org/en/registrars/accredited-list.html (Accessed on 26.08.2016).

those relating to its security and technical troubles, maintenance organization, structural anxiety, and variances over how it should be tackled. These disputes, and also others yet to be seen in the future will surely impact the continued use of the DNS and the related systems. In essence, it starts with a brief DNS development, dividing its history into three parts—which is believed, are the Digital Era, Development Era and Domain Name Era[31].

4.6.2. The Digital Era

The very first wide area networks (WAN) started to work in 1969. This WAN was called ARPANET after the funding organization, the U.S. Department of Defense i.e., Advanced Research Projects Agency (ARPA). The organization that managed the interpretation of names to addresses for every ARPANET host computer at that time was known HOSTS.TXT, named after the core data file in the system. At the begin only four nodes linked by 50kbps lines spanned the west to east coasts of the United States, but by 1971 a total of 15 nodes with 23 hosts linked key universities across the country[32]. Updates to the HOSTS.TXT system were performed by FTP transfers and e-mail change requests. These updates were regularly needed so to stay away from the network with outdated versions. Although inconvenient, this sanctioned a primal form of name-based references to be used over ARPANET[33].

4.6.3. The Development Era

Soon after the formation of the Bob Metcalfe's Ethernet network protocol at Xerox PARC in 1972, the ARPANET extended worldwide by adding nodes in Norway and England and fetching sum of nodes to 29.

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[31] Pope, Michael Brian; Warkentin, Merrill; Mutchler, Leigh A.; and Luo, Xin (Robert) (2012) "The Domain Name System—Past, Present, and Future," *Communications of the Association for Information Systems*: Vol. 30, Article21. Available at: http:// aisel .aisnet .org/cais/vol30/iss1/21 (Accessed on 12.07.2016).

[32] *Ibid.*

[33] *Ibid.*

The connection crisis due to the lack of protocol standardization was being dealt with by the International Network Working Group (INWG), leading the way for systems such as Datapac and Telnet, and creating the Internet we know these days[34].

A total of 61 nodes were in existence in 1975. Separate networks with connections to ARPANET began to form, together with BITNET at the City University of New York, NASA's SPAN, and CSNET[35]. CSNET was the outcome of collaboration between the Bolt Beranek and Newman (BBN), funded by the National Science Foundation (NSF) and the University of Delaware, Purdue University, the University of Wisconsin, RAND Corporation. The objective of CSNET was to connect computer science departments at institutions that were without ARPANET access. The node sum up to 113 in 1983, and security issues resulted in the ARPANET being split into the MILNET network for military sites with 68 nodes, leaving the remaining nodes of ARPANET for the computer research community[36].

A backbone network i.e. NSFNET was built by the NSF in 1985 initially to connect 5 NSF-supported supercomputers, generated demand for a major upgrade in 1988, plus plans in 1989 to move from a T1 to a T3 connection[37]. An outburst of connections from non-computer science researchers at universities and other organizations followed when the NSF lets self-organized networks connection to NSFNET. By 1989, ARPANET no longer existed[38].

4.6.4. The Domain Name Era

In 1983, with the movement of ARPANET to the Transmission Control Protocol or Internet Protocol suite of protocols and came to known as the Internet, the population of networks outburst. The centrally maintained HOSTS.TXT file starts facing problems, such as name collisions, consistency anomalies traffic and load[39].

At that time it becomes clear that HOSTS.TXT was unable to meet the requirements of the ever-increasing Internet, and that an extra strong system was

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[34] *Ibid.*
[35] *Available at*: http://aisel.aisnet.org/cais/vol30/iss1/21 (Accessed on 12.07.2016).
[36] *Ibid.*
[37] *Ibid.*
[38] Pope, *Supra* note 31.
[39] International Journal of Computer, Electrical, Automation, Control and Information Engineering Vol:8, No:1, 2014 *available at*: www.scholar.waset.org/1999.4/9997604 (Accessed on 06.06.16).

required. In 1984, a group consist of Craig Partridge, Paul Mockapetris, and Jon Postel others met the need when they published "RFC 882" which resulted in the formation of the distributed naming system called as the DNS[40].

The DNS is a distributed database that permits local administration of the segments on the general database. Information in each fragment of the database are accessible over the whole system through a customer server scheme comprising of name servers and resolvers. Similarly as each phone number is a special grouping of numbers, so is the IP address for every computer on the Internet[41].

Instead memorizing 66.220.144.0, we can just enter www.facebook.com and the DNS translates, or resolves, the domain name to the IP address[42].

It is qualified to take note of that the domain names are registered on first-come first-serve basis. ICANN[43] is an short form of "Internet Corporation for Assigned Names and Numbers" which is a private non profit international organization perceived by the US government for organising the Domain Name System. The foundation of ICANN did not happen overnight. Various attempts were made to move the administration of Domain Name System from the hands of US government to any private entity from 1994 to 1998[44].

The US government signed an agreement in 1996 with the Network Solutions Inc. (NSI), a private organisation for operating the Domain Name System. The same agreement was further renewed till 1999[45]. As a critical stride towards privatization of the Domain Name System, a White Paper[46] was released by the US department of Commerce in 1998. In October of 1998, the United States Department of Commerce ("DoC") and Network Solutions, Inc. ("NSI") revised their agreement, under which

[40] *Ibid.*
[41] *Ibid.*
[42] Pope, *Supra* note 31.
[43] For further details visit https://www.icann.org/.
[44] The Internet Domain Name System *available at:* https://www.internetsociety. org/.../The%20Internet % 20Domain%20Name%20System (Accessed on 07.07.2016).
[45] *Ibid.*
[46] See White Paper *available at* : http://www.icann.org/en/about/agreements/white-paper (Accessed on 26.07.2016).

NSI had been the sole registrar and registry administrator for the .com, .org, and .net top-level domains[47].

In November of 1998, the DoC identified ICANN, a newly-formed, private, non-profit corporation as the entity that would oversee the transition to competition under the Shared Registration System. Some portion of ICANN's obligation included implementing and establishing a procedure for registrar accreditation that would guarantee a move to a competitive domain name registration system giving continued Internet stability and domain-name durability[48]. ICANN started as an endeavour by the little gathering of technologists centred in the Internet Society to hold control of "their" web as it advanced into a commercial medium [49].

The ICANN facilitates the Internet Assigned Numbers Authority (IANA) functions, which are important technical services crucial to the continued operations of the Internet's underlying address book, the Domain Name System (DNS). The IANA functions incorporate:

(1) the harmonization of the task of technical protocol parameters as well as the administration of the address and routing parameter area (ARPA) top-level domain;

(2) the allotment of Internet numbering resources;

(3) the administration of certain responsibilities related with Internet DNS root zone administration such as generic (gTLD) and country code (ccTLD) Top-Level Domains; and

(4) Other services[50].

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47 *Ibid.*

48 *Ibid.*

49 Muller Milton, "*ICANN and the Internet Governance*", The Journal of Policy Regulation and Strategy for Telecommunications Information and Media (1999) *available at:* http://papers.ssrn.com/soI3/papers.cfm?abstract id=203973 (Accessed on 06.07.2016).

50 *Ibid.*

It is important that ICANN doesn't register domain names directly. It authorizes domain names registrars for the generic top level domain all over the world. Registration of the domain names are followed by such registrars and the DNS is administered by the ICANN. It has given the institutional system for the development of a global, uniform procedure for the resolution of trademark holder's and domain name registrant's disputes[51].

In October 2004, requirement for the registration of domain names in India were announced to be liberalised. Centre for Development of Advanced Computing which beforehand called as the National Centre for Software Technology, set up under the Ministry of Information Technology, Government of India, was made the domain name registration authority for India's country code top level domain called as in. "**.IN**" is India's top-level domain on the Internet. Like .org, **.in**, can be used for Web sites, e-mail and other.

4.7. Introduction to ICANN

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 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.

By October 1998, ICANN was officially formed under Californian law[52], subsequently to the conclusion of a Memorandum of Understanding (MOU) between the Department of Commerce (United States) and ICANN in November 1998 which

[51] Consim Info Pvt. v Google (n 9) *available at :*https:// indiankanoon.org/doc/586984 (Accessed on 15.07.2016).

[52] Froomkin, *Supra* note 10.

put a seal of endorsement on the official acknowledgment of ICANN as the association responsible for the domain name registration capacities [53]. The Memorandum of Understanding also resulted into number of linked arrangements between the United States Department of Commerce, NSI and ICANN that basically provide the official legal basis to DNS administration till this day.

In December 1998 after the conclusion of Memorandum of Understanding, a contract signed between the ICANN and University of Southern California for the transfer of the functions and responsibilities of the Internet Assigned Numbers Authority (IANA) to ICANN[54].

In February 2000, the United States' National Telecommunications and Information Administration signed an agreement with ICANN regarding the performance of the Internet Assigned Numbers Authority technical functions in terms of which the United States government essentially permitted the transfer of the responsibilities and functions from the University of Southern California to ICANN[55]. The above contract has since then renewed, modified and extended a number of times[56].

4.7.1. Relationship of ICANN's with the U.S. Government

There is no statutory authority of the US's Department of Commerce (DOC) over ICANN or the DNS. However, on the grounds that the Internet evolved from a network infrastructure made by the Department of Defense, the U.S. government initially possessed and worked the key segments of network engineering that empower the domain name framework to work. The 1998 Memorandum of Understanding amongst ICANN and the Department of Commerce started a procedure planned to move technical DNS coordination and administration capacities to a private-sector -non-profitable entity . While the DOC assumes no part in the

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[53] *Ibid.*

[54] See University of Southern California/ICANN Transition Agreement (24 December 1998), *available at*:http://www.icann.org/en/general/usc-icann-transition-agreement. htm (Accessed 24.07.2016).

[55] See ICANN/US Government Contract for the IANA Function (9 February 2000), *available at* ;<http://www.icann.org/en/general/iana-contract-09feb00. htm> (Accessed 24.07.2016).

[56] The United States Government Contract for the IANA Function and Modification to ICANN *available at:* http://www.icann.org/en/general/iana-contract.htm (Accessed 24.07.2016).

interior administration or everyday operations of ICANN, the U.S[57]. government, through the DOC, holds a part as for the DNS by means of three separate contractual understandings. These are[58]

- the Affirmation of Commitments (AoC) between DOC and ICANN, which was signed on September 30, 2009;
- the contract between IANA/ICANN and DOC to perform various technical functions such as allocating IP address blocks, editing the root zone file, and coordinating the assignment of unique protocol numbers; and
- the cooperative agreement between *DOC* and VeriSign to manage and maintain the official DNS root zone file.

However, recently the US has confirmed it is finally ready to cede power of the internet's naming system, ending the almost 20year process to hand over internet's governance completely to ICANN, a Non Profit organisation. From 1, October 2016, the ICANN will turn into an exclusive organisation that answers to different partners who want a say over the internet. Those partners include nations, business organisations and groups offering technical expertise. From that date, the US will lose its dominant voice in spite of the fact that ICANN will stay in Los Angele[59].

4.7.2. ICANN's Structure

Board of Directors

The ICANN's 'Board of Directors' is accountable for the strategies made by ICANN. This board is comprises of 15 voting members and 6 non-voting liaisons, every one of whom are competent to attend Board meetings. The voting members are formed by 8 members chosen by the Nominating Committee, which is comprised of persons representing the a range of supporting organisations and constituencies[60]; 2

[57] Congressional Research Services, *Internet domain Name: Background and policy issue* by Lennard G. Kruger(2015) *available at*: https://www.icann.org/en/system/files/files/report-23feb14-en.pdf (Accessed on 20.07.2016).

[58] *Ibid.*

[59] US ready to 'hand over' the internet's naming system BBC News *available at:* http :// www.bbc.com/news/technology37114313 (Accessed on 22.08.2016).

[60] The composition of the Nominating Committee, Article VII.2 *available at:* https: //www .icann.org/resources/pages/nomcom-2013-12-13-en (Accessed 17.08.2016).

members each to be selected by each of the 3 supporting organisations which are the Generic Names Supporting Organization (GNSO) and the President of ICANN ex officio, the Country-Code Names Supporting Organization (ccNSO), Address Supporting Organisation (ASO)[61].

According to bylaws of ICANN, the supporting organisations and the Nominating Committee, in selecting the directors, must get to ensure that the Board of Directors is composed of members who in the aggregate must exhibit diversity in culture, skills, experience, geography, and perspective[62]. The Nominating Committee is additionally required to guarantee through its choices that the Board of Directors incorporates at least one director who is a citizen of a nation in each of ICANN's geographical areas and that no area is over-represented[63].

4.7.3. Supporting Organisations

Every ICANN's supporting organisations decides its own functions and is autonomously structured. Supporting organisations form a key part of ICANN's organization and were formulated to give assistance regarding the policy implementation and recommendations within the region of their specified focus areas. Supporting organisations' main task is to 'help and promote the expansion of Internet policy and support diverse and international involvement in the technical administration of the Internet'[64].

(i) **Address Supporting Organisation (ASO):**

The main function of the Address Supporting Organisation is to advice the Board of Directors on policy issues concerning management, operation and assignment of Internet addresses[65].

(ii) **Country Code Names Supporting Organisation (ccNSO):** The main task of Country Code Names Supporting Organisation is to initiate international strategies relating to country-code top-level domains and

[61] *Id* at Article VI.

[62] Bylaws for the Internet Corporation for Assigned Names and Numbers, as amended, Article VI sections 2.2 and 2.3*available at:* http://icann.org/en/general/bylaws.htm (Accessed 17.08.2016).

[63] *Id* at Article VI section 5.

[64] See http://www.icann.org/en/structure.htm (Accessed 18.08.2016).

[65] Article VIII section 1.1 *available at*: http://www.icann.org/en/structure.htm (Accessed 18.08.2016).

encouraging harmony across the ccNSO's community[66].The ccNSO comprised of ccTLD managers that have approved to be members of the ccNSO and a ccNSO Council charged with supervision of the policy development process of the ccNSO[67]. The three members selected by the ICANN nominating committee, the members of the ccNSO within each of ICANN's five geographic areas, and ccNSO Council liaisons and observers selects the ccNSO Council comprises of three members selected by[68].

(iii) **Generic Names Supporting Organisation (GNSO):**

From a trade-mark point of view the Generic Names Supporting Organisation is considered to be the most significant supporting organisation. This organisation is entrusted with the development and encouragement of policies identifying with generic top level domains[69]. This organisation has been at the front line of advancements including the protection of trade marks in the new gTLDs, the addition of new gTLDs, and Uniform Dispute Resolution Policy (UDRP). It has a constituency structure with specific stakeholders each represented by an individual constituency. All 7 GNSO constituencies represent gTLD registries, Internet service, registrars, intellectual-property interests, connectivity providers and commercial and business users of the Internet, non-business Internet users[70].

4.7.4. Advisory Committees

Apart from the above three supporting organisations, in order to obtain external expert advice, there is also an arrangement for four advisory committees and two mechanisms in the ICANN's structure. While the responsibility of the detailed policy advancement which directs to recommendations to the ICANN board is on the supporting organisations, the advisory committees are in charge of giving advice to the ICANN board in their relevant areas of expertise.

[66] *Id* at Article IX section 1.
[67] *Id* at Article IX section 2.
[68] *Id* at Article IX section 3.
[69] *Id* at Article X section 1.
[70] *Id* at Article X section 5.

The following are the four specific advisory committees giving advice to the ICANN board:

(i) **Government Advisory Committee (GAC):**

It was set up to consider and give suggestion on the functions of ICANN regarding the worries of national governments, specifically in the subject where they can be an interaction between the strategies of ICANN and different laws and global contracts or where they could possibly control public policy issues[71]. The GAC is open to all national governments however is not just comprise of representatives of national governments but also treaty organisations and intergovernmental organisations such as the European Commission, the African Union Commission (AUC), International Telecommunications Union (ITU), WIPO, and various other regional bodies[72].

(ii) **Security and Stability Advisory Committee (SAC):**

The main task of the SAC is to give advice to the ICANN board and ICANN community on issues with regards to the integrity and security of the address allocation systems and Internet's naming. The members of SAC are selected by the ICANN board and which are drawn from operators of the Internet Infrastructure and other security experts[73].

(iii) **Root Server System Advisory Committee (RSSAC):**

The RSSAC was created to advise the ICANN board on the operation of the root name servers of the domain-name system. RSSAC is comprises of the operators of authoritative root name servers and other members selected by the ICANN board[74]. It also inspect and suggest on the various security facets of the root name server system and re-examine the

[71] *Id* at Article XI section 2.1.

[72] The detailed lists of the current GAC governmental representatives and organisational observers, see https://gacweb.icann.org/display/gacweb/About+The+GAC(Accessed 20.08.2016).

[73] *Supra* note 65 at Article XI section 2.2.

[74] *Id* at Article XI section 2.3.

distribution of the root name servers, number and location, while considering the performance the robustness and reliability of the complete system[75].

(vi) **At large Advisory Committee (ALAC):**

This committee comprises of two members chosen by each of the Regional At-Large Organizations (RALOs), one for each of the five ICANN geographic regions, accordingly ten members chosen by the RALOs, and another five members chosen by the nominating committee. The five members chosen by the nominating committee must comprise one citizen of a country within each of ICANN's five geographic regions. ALAC's function is to consider and give guidance with respect to the functions of ICANN, in so far they relate to the interests of individual Internet users[76].

The under mentioned two mechanisms give external expert advice to ICANN:

(i) **Expert Advisory Panels:**

After consulting the GAC on the reasonable source from which to look for exhortation if the guidance sought concerns issues of public policy, the ICANN board may either all alone or on a recommendation of an ICANN supporting organisation or advisory committee, select an expert advisory panel[77]. The ICANN board can refer any issues of public policy relating to ICANN's task to a treaty organisation or multinational governmental[78].

(ii) **Technical Liaison Group (TLG):**

The Technical Liaison Group is consisting of representatives from the four organisations:

- the "International Telecommunications Union's Telecommunication Standardization Sector (ITUT)",
- the "European Telecommunications Standards Institute (ETSI)" ,
- the "Internet Architecture Board (IAB)" and

[75] *Ibid.*
[76] *Supra* note 65 Article XI Section 2.4.
[77] *Id* at Article XI-A Section 1.2.
[78] *Ibid.*

- the "World Wide Web Consortium (W3C)"[79].

The main function of the TLG is to channel technical information and give direction to the ICANN board and to other ICANN entities[80]. This function includes two sub functions, the first is a responsive component which requires the TLG to interface either the ICANN board or other ICANN bodies with suitable sources of technical data if required, on the other hand second component requires the TLG to operate as 'watchdog' by drawing the ICANN board's attention to the international technical standards issues that are significant to ICANN's activities[81].

4.7.5. ICANN's Ombudsman

The byelaws of ICANN also set up the office of the Ombudsman whose main function is to give an independent internal assessment of possible complaints by the ICANN community members who considered that any ICANN body or representative has treated the member unjustly[82].

4.8. The WIPO (World Intellectual Property Organisation)

4.8.1. Introduction

The World Intellectual Property Organization (WIPO) comprising 188 Member States, is an independent intergovernmental organization headquartered in Geneva, Switzerland,[83] WIPO's chief objective is to promote, through international cooperation, the creation, use, protection and dissemination of intellectual property. As part of its activity, WIPO manages more than 20 treaties, including the Berne Convention for the Protection of Literary and Artistic Works, the Paris Convention for the Protection of Industrial Property, the Patent Cooperation Treaty and the Madrid Agreement Concerning the International Registration of Marks and the Protocol to that Agreement[84].

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[79] *Id at* Article XI-A section 2.2.
[80] *Id at* Article XI-A section 2.3.
[81] *Ibid.*
[82] Bylaws, *supra* note 62 at Article 5.
[83] *Available at:* http://www.wipo.int/amc (Accessed on 20.06.2016).
[84] *Ibid.*

The WIPO Arbitration and Mediation Centre established in 1994, offer substitute to court litigation for the solution of commercial disputes among private parties relating to intellectual property.

With the active involvement of many of the intellectual property experts and leading alternative dispute resolution (ADR), the WIPO Centre has created the "WIPO Mediation, Arbitration, Expedited Arbitration, and Expert Determination Rules and Clauses". The WIPO Rules and Clauses, which exist in a few dialects, incorporate the recent advancements in the area of dispute resolution and can be used in any legal framework in the world. The WIPO Centre administers, and advises on, methods conducted under these Rules. Moreover, parties can draw upon a growing list of over 1,000 independent WIPO arbitrators, mediators and specialists from somewhere in the range of 70 nations[85].

The most prominent work of WIPO is the Uniform Domain Name Dispute Resolution Policy (UDRP), based on recommendations of WIPO to address several abusive practices in the domain name system.

4.8.2. WIPO Internet Domain Name Process

White Paper[86] of Department of Commerce of the United States' alongside tending to larger policy issues with respect to Internet governance, for example the setting up of a new private non-profitable corporation for Internet governance(i.e. ICANN), has also dealt certain intellectual-property issues in response to the increasing concern over the conflict between trademarks and domain names.

White paper also considered the important question i.e., how to resolve dispute that arises as a result of the conflict between the system for the registration and protection of trademarks and the DNS.

Instead of making any particular suggestions or recommending specific action, as it did with the administration of the DNS and the switching of the governance to a new provisional governing body, the White Paper asks for a

[85] *Ibid.*

[86] See White Paper *available at: http://www.icann.org/en/about/agreements/white-paper* (26.07.2016). As an important step towards privatisation of the Domain Name System, a White Paper was released by the US department of Commerce in 1998.

procedure of international consultations carried out under the supervision of the World Intellectual Property Organisation (WIPO).

The first WIPO's Internet Domain Name Process was conducted in 1998, an open international process of consultations concerning possible ways and procedures for deciding and prevent domain name disputes.

The proposal would deal with mainly three issues:

(1) a uniform dispute resolution system(discussed fully in the coming chapter);

(2) the effect of creating new gTLDs on intellectual-property rights; and

(3) the protection of famous and well-known trademarks.

The White paper contains the following paragraph formulating WIPO's mandate:

> "*The US Government will seek international support to call upon the World Intellectual Property Organization (WIPO) to initiate a balanced and transparent process, which includes the participation of trademark holders and members of the Internet community who are not trademark holders, to (1) develop recommendations for a uniform approach to resolving trademark/domain name disputes involving cyberpiracy (as opposed to conflicts between trademark holders with legitimate competing rights), (2) recommend a process for protecting famous trademarks in the generic top level domains, and (3) evaluate the effects, based on the studies conducted by independent organizations, such as the National Research council of the National Academy of Sciences, of adding new gTLDs and related dispute resolution procedures on trademark and intellectual property holders. These findings and recommendations could be submitted to the board of the new corporation for its consideration in conjunction with its development of*

registry and registrar policy and the creation and introduction of new gTLDs.[87]"

This process is popularly identified as the "WIPO Internet Domain Name Process", in this manner initiated on the basis of a demand presented to WIPO by the U.S. government with the publication of the White Paper.

A combination of seventeen physical meetings held in fourteen countries, paper-based consultations and online consultations were used in conducting the WIPO Process. Through three Requests for Comments the Governments, professional associations and industry, intergovernmental organisations, individuals and corporations were invited to participate.

A comprehensive final report which was drafted WIPO published on 30 April 1999 after round of consultations and comments[88]. It contains a number of significant suggestions and a number of fresh recommendations, served as the medium for change, directing both policy and system towards improvement that shaped the future of the DNS. The two main suggestions of the Final Report which are relevant are as follows:

(i) **Best Practices for Registration Authorities:**

In order to lessen the stress that exists between domain names and trade mark rights the report made proposals for the implementation of various enhanced least 'best practices' for domain-name registration authorities (registrars) registering domain names in the gTLDs. This incorporated a formalised agreement that would clearly mention the rights and duties of the parties as well as the realization of precise and dependable contact details of registrants to be used for defending intellectual property rights in the international Internet environment[89].

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[87] See WIPO Internet Domain Name Process *available at: http://www. wipo.int /amc/en/processes/ process1/* (Accessed on 26.07.2016).

[88] WIPO Final Report, *available at:* http://www.wipo.int/amc/en/processes/ process1/report /final report.html (Accessed on 26.07.2016).

[89] WIPO Final Report, para- 54-111, *available at:* http://www.wipo.int/amc/en/processes/ process 1/report/finalreport.html (Accessed on 26.07.2016).

(ii) **For Abusive Domain Name Registrations, a Uniform Administrative Procedure:**

The Final Report suggested for the adoption of a UDRP so that an administrative dispute resolution procedure can be established to resolve the trademark-domain name disputes in all gTLDs[90]. WIPO limited the extent of the projected dispute-resolution system, by recommending that the administrative procedure be limited to 'abusive registration, cases of bad faith' of domain names that infringes the trademark rights, or the cases of 'cybersquatting'[91]. And for all the other disputes parties would need to move towards national courts or other types of private adjudication like mediation or negotiation. These cures would be implemented by the domain name registration authorities under the dispute resolution policy as agreed and defined in the domain name registration agreement. The registrant bind themselves to the procedure while signing the domain name registration agreement and thereby making the administrative procedure mandatory in nature[92]. The administrative procedure is available to each and every one and having same procedure in all the open gTLDs.

4.9. Domain Name structure

The Domain Name System (DNS) is hierarchical system of domain names technically supported by DNS-servers which by means of special databases of domain names automatically create for them equivalents in the form of digital IP-addresses, and which serves as a source for placement of information resources on the Internet[93]. From positions of Intellectual property right the IP-address has no any value, and from this point of view, carries out a secondary role in relation to the domain name. Given these estimates, it can be concluded that the DNS was presented in order to assist Internet users with easily remembered domain name, in other words, the domain name system was designed to make the Internet accessible to human beings[94].

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[90] *Id* at para- 152-228.

[91] *Ibid.* the practice of registering names, especially well-known company or brand names, as Internet domains, in the hope of reselling them at a profit in bad faith.

[92] *Id at* para-158-162.

[93] Laurence R. Helfer, "International Dispute Settlement at the Trademark – Domain Name Interface", *available at*:http://papers.ssrn.com/soI3/Delivery.cfn/SSRnID265922code0104 04630.pdf?abstract tid= 265922 &rulid=9615131&mirid=3(Accessed on 23.07.2016).

[94] For detail see http://www.icann.org/en/participate/what-icann-do.html.

From organizational point of view, every domain name consists of a number of levels (domain levels) separated from each other by dots. Domain name can have any number of levels (also known as sub-domains), but in practice there are always five or fewer[95].

Let us try to understand with the help of example, in the domain name <www.allahabadhighcourt.in>, which is the location of the Allahabad High Court web site, ".in" is the top-level domain; ".allahabadhighcourt" is the second level domain.

Structurally domain name consists of two or more parts; each of them is characterized by certain level:

1. Top level domain (TDL) which comes from the right part.
2. Second-level domain and,
3. Sub-domains

Top-level domains are of following types:

4.9.1. Generic top-level domains (gTLDs)

The gTLDs are intended to provide information about the type or nature of the organizations. Until November 2000, there were 7 generic top-level domains (gTLDs). Three of them are open, in the way that there is no restriction on the persons or entities that may register names in them[96].

These Seven gTLDs are:

I. **.com** - for the commercial organizations,

II. **.net** - for the subjects which primary activity is connected with information networks,

III. **.gov** - for governmental structures,

[95] Torsten Bettinger, *Domain Name Law and Practice :An International Handbook*, p.5 *available at:* books.google.co.in › Law › Commercial › International Trade(Accessed on 20.07.2016).

[96] *Available at :*http://arbiter.wipo.int/domains/cctld/ (Accessed on 17.07.2016).

IV. **.org** - for the non commercial organizations,

V. **.edu** - for educational institutions,

VI. **.int** - for the international organizations,

VII. **.mil** - for military (power) structures and etc[97];

4.9.2 Country code top-level domains (ccTLDs)

The ccTLDs generally give information about the location of organizations. The ccTLDs accepts a two letter country code, which assists in recognizing the country of the holder of the domain name. By virtue of this, each country has distinct TLDs[98]. Beside the above gTLDs, there are also 243 country code top-level domains (ccTLDs)[99], based on the two-letter ISO-Norm 3166 for example[100],

- for India - .**in**,
- for Russia - **.ru**,
- for United States of America - **.us**
- for Germany – **.de**,
- for Italy- **.it,** etc;

Each ccTLD can have a second level. For example, in India there can be

- .edu.in (educational institutions) etc,
- .ltd.in (for private limited company),
- .co.in (for company).

Even though the users are free to register their domain names under any ccTLD or gTLD, but they did not get right over either of them[101]. As gTLD and ccTLD are generic in nature, therefore they are open to everyone for registration. They are managed by nationally designated registration authorities. On one hand

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[97] Torsten, *Supra* note 95.
[98] Alwyn Didar Singh, *E-Commerce in India: Assessments and Strategies for the Developing World* 86 (New Delhi: Lexis Nexis Butterworths, 2008).
[99] *Supra* note 96.
[100] International Journal of Computer, *available at*: www.scholar.waset.org/1999.4/9997604 (Accessed on 19.07.2016).
[101] Stim Richard, *Supra* note 23 at 16.

some domains are open to all, as there is no restriction on the persons or entities who may register names. On the other hand some domains are limited, in that only entities or persons fulfilling certain norms (for e.g., domiciled within the territory) may register domain names in them.

Functionally, the gTLDs and the ccTLDs are same. The connectivity provided by both ccTLD and gTLD domains is same. As mentioned above, there are some open gTLDs and ccTLDs, where there is no restriction in terms of use, and there are some restricted gTLDs and ccTLDs, where persons or entities are restricted to use it unless fulfilling certain norms. The ccTLD database portal is provided on WIPO centre web site, helping online searches for dispute resolution information and the registration related to each ccTLD[102].

4.9.3. New gTLDs

Initially, there were seven gTLDs, namely, .org, .int .net, .edu, .gov, .mil and .com. After 2000, few new gTLDs are activated with the efforts of the ICANN[103].The Internet Corporation for Assigned Names and Numbers (ICANN) on November 16, 2000, ratified the beginning of the under mentioned seven new gTLDs:

- **.biz** (for business purposes);
- **.info** (unrestricted);
- **.museum** (for museums);
- **.name** (for personal names);
- **.coop** (for cooperatives);
- **.pro** (for professionals); and
- **.aero** (for the aviation community);

Some of these new gTLDs are "unsponsored gTLDs" as they are open for registration by the general public, while others are "sponsored gTLDs" as they meant at registration and use by specific user communities. The examples of unsponsored

[102] *Supra* note 96.
[103] ICANN, "New gTDL Programme," *available at:* http://www.icann.org/en/topics/new-gtlds/ program- en.htm (Accessed on 23.07.2016).

gTLDs are .pro, .name, .info and .biz, whereas the examples of sponsored are .museum, .coop and .aero. The .info is the minimum restricted of the new gTLDs, as under it any name can be registered by any one[104].

For personal names of individuals the .name gTLD is reserved (for both commercial and non-commercial purposes). The .coop to cooperatives, .museum to museums and .aero gTLD is reserved to members of the aviation community worldwide. ICANN plans to further increase the number of gTLDs. Where as.biz is slightly less open and it is intended for registrations stated to be "used or intended to be used primarily for bona fide business or commercial purposes". The .pro gTLD is made for professionals, and is so far limited to lawyers, physicians and accountants.

Presently there are 323 TLDs[105], categorized into the following types:

1. generic names - generic top level domain (gTLD),
2. domains associated with countries and territories - Country-code top level domains (ccTLDs),
3. domain names- Internationalized top level domains (IDN),
4. reserved for testing internationalized domain names- testing,
5. specialized domains with a sponsor representing a community of interest- sponsored top level domain (sTLD), and
6. generic domains without a sponsoring organization- unsponsored top level domain (uTLD).

4.9.4 Second-level domains

The second levels domains are referred to as sub-domains. In the left side of TLD the sub-domains exist. The sub-domain can further be divided into several levels

[104] Thus, in 2002 ICANN has launched operation of seven TLDs, both sponsored and unsponsored. Four of them such as .biz, .info, .name, and .pro were unsponsored, and the other three, exactly .aero, .coop, and .museum were sponsored. Further, in 2003 ICANN has introduced of six new TLDs like .asia, .cat, .jobs, .mobi, .tel and .travel, that were sponsored.

[105] World Academy of Science, *available at*: www.scholar.waset.org/1999.4/9997604 (Accessed on 23.07.2016).

starting with the second level domain. There can be third level, fourth level, fifth level and so on, with virtually no limitation. The business organisations more often than not want to have their trademark as their second level domain, with a specific end goal to set up their identity over the Internet. The rest of the sub-domains would usually portray the subdivisions in the second level domains. Following example helps in understanding the different levels of domains found in a domain name.

www.educationportal .uk .gov .in

(4) (3) (2) (1)

(1) Generic top level domain (gTLD)

(2) Country code top level domain (ccTLD)

(3) Second level domain

(4) Third level domain

Second-level domain names are often formed on the basis of the name of a company (e.g., facebook.com), product or service (e.g., rediffmail.com)[106]. Under a gTLD, second-level domains are registered by the applicant (for example <icann.org> by ICANN or <apple.com> by Apple Technology Company) with the respective registration authority responsible for the management of the gTLD[107].

Administrators of ccTLDs often create compulsory second-level domains. For example, the national registration authority introduced .in in our country India, for example .gov.in for government bodies, .co.in for commercial enterprises; .sch.in for schools and .ltd.in, for limited companies[108]. In case of above ccTLD, it is the third-level domain that is required to be registered by competent parties.

The registration of domain names is based on a first-come, first-served principle and the open ccTLDs and gTLDs usually do not apply an examination procedure. As functions of a domain name is like an address, no two bodies can have

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[106] See http://en.wikipedia.org/wiki/Domain_name (Accessed on 26.07.2016).

[107] *Supra* note 96.

[108] Anjan Sen, “Intellectual Property Rights in Internet Environment□, *Indian Juridical Review*, Vol. 1, 2005, pp. 7 - 18 at p. 11.

the same domain name under the same top-level domain. However, t is, possible for separate entities to register the same name in different top-level domains. Consequently technically, it is possible for one party to register a particular word in one top level domain, and other parties to register the same word in other top-level domains.

4.9.5 Third and fourth-level domains

Third and fourth-level domains are generally selected by the registrant of the second-level domain name however, as mentioned above; certain registration authorities limit the second and third-level domains to assign, for instance, the function or area of the domain.

4.10. Domain Name acquirement

There are two chief ways to acquire a domain name. You can either register your domain name yourself or you can get your web host or ISP (Internet Service Provider i.e.godaddy.com) to register it for you.

In order to register a domain name oneself, one should pick a Registrar. A Registrar is an ICANN certify domain Registration Company. There are so many Registrars on the Internet these days. The market is getting increasingly competitive; which implies that one can buy domains names for a low annual fee.

Most Internet facilitating companies offers domain registration services to their customers. When one registers a domain name through an internet host they will register their domain name for them through their own approved registrar.

Today, the ICANN regulates the development and its architect of the top-level Internet domain name space. Domain name registrars derive their authority from ICANN, for the purpose of registration and reassigning the domain names.

The registration of domain name happens on web. There are several open access sites giving information with respect to available domain names, requirements of national registration and other incidental issues[109]. In this manner any intended registrant can verify these details for free. The WHOIS directory is one of the major

[109] See http://www.networksolutions.com/whois/index.jsp (Accessed on 22.07.2016).

directories, which give for information about the availability of domain names for registration[110]. After registration domain names takes up to 72 hours to become available on the web. This is the reasonable time period required for spreading the information about the new domain name to thousands of name servers throughout the Internet.

As the domain names are one of a kind, therefore no two people can register the same domain name[111] each competing registrar of domain name maintains universal database of unavailable domain names[112]. This prevents the registration of already existing domain name and thereby keeps away from bedlam in the cyber world. An important aspect of the domain name registration is that the registration is valid for specific period, extending from one to ten years, after which the domain name holder should renew it from time to time[113]. The inability to restore brings about the cancelation of registration of domain name, and in this manner becomes available for fresh registration by anybody.

4.10.1. Procedure for Registration of Domain Names

As said above the registration of domain names is based on a first-come, first-serve principle and offers a unique, global presence on the internet. As mentioned above ICANN is the only body which governs the registration of domain name at international level. The ICANN became the overall governing body with respect to the management of the Domain Name System (DNS). It was made responsible for the following:

(i). Internet Protocol Address Space Allocation

(ii). Protocol Parameter Assignment

(iii). Domain Name System Management

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[110] *Ibid.*

[111] Sunando Mukherjee, "Passing off in Internet Domain Names - A Legal Analysis", *Journal of Intellectual Property Rights*, Vol. 9, March 2004, pp. 136 - 147 at p. 137.

[112] *Available at:* http://www.ez-domainnameregistration.com/detailed_process.htm> (Accessed on 24.07.2016).

[113] Different registries offer different registration periods subject to different registration rates. *Available at*: http://www.thesitewizard.com/archive/registerdomain.shtml (Accessed on 25.07.2016).

(a). Procedure for Registration of a Generic Top Level Domain Name (gTLD)

ICANN accredits domain name registrars for the gTLDs throughout the world, who in turn register the domain names. Following are two such accredited registrars in India:

(i). Polar Software Ltd. (signdomains.com)

(ii). Direct Information Pvt. Ltd. (directi.com)

Registrations are done by these accredited registrars and the Domain Name System (DNS) is managed by the ICANN. Any person interested in registering a domain name can approach any of the ICANN accredited registrars[114]. The domain name registrant would be required to furnish his address and other necessary details. Then an agreement would be signed whereby the domain name registration would be subject to the Uniform Dispute Resolution Policy (only in case of gTLDs .com, .net, .org) and after the payment of a nominal fee, the registrant would be entitled to use the registered domain name.

(b). Procedure for Registration of Country Code Top Level Domain (cc TLDs i.e '.in') in India

On October 28, 2004, the Government of India, Ministry of Communications and Information Technology, announced a liberalization of the registration requirements. Under the new registration rules which became effective from January, 2005, unlimited generic '.in' registration were offered at the second level of domain name and also at the third level in the zones of domain registration, '.co.in', '.net.in' and '.org.in'. Registrations were carried out by Registrars to be appointed by the '.in' Registry. The National Centre for Software Technology (NCST)[115], a scientific research and development institution under the Ministry of Information Technology, Government of India, was made the domain name registration authority for India's '.in' country code top-level domain (ccTLD) and thus is the ccTLD Manager. NCST

[114] A table listing all registrars, their locations and the various TLDs that they may support is available at Registrar Accreditation: Overview, ICANN, at http://www.icann.org /registrars/accreditation-overview.htm.

[115] The NCST is now known as the Centre for Development of Advanced Computing (C-DAC).

had been registering domain names in the '.in' ccTLD since 1995. The primary duty of the ccTLD Manager is one of public service and to manage and operate the ccTLD Registry in the interest of and in consultation with the Local Internet Community, mindful of the interests of the Global Internet Community.

The Internet Management Group (IMG), a committee formed by the Government of India, oversees the Internet domain name registration related activities for the '.in' ccTLD. This committee consists of the members representing the following:

(i). Bharat Sanchar Nigam Ltd. (BSNL)

(ii). Ministry of Information Technology (MoIT)

(iii). Videsh Sanchar Nigam Ltd. (VSNL)

(iv). National Centre for Software Technology (NCST)

The NCST is the elected manager of the '.in' ccTLD. As such it is in charge of the operations of the DNS services for the '.in' domain name space. The '.in' ccTLD is separated into sub-categories, called as the second-level domains (SLDs).

4.11. Nature of Domain Names: Technology or Intellectual property

Julius Stone, one of the profound scholars of Jurisprudence, has rightly pointed out that "the right to property exists due to the recognition given in the civilized society for men who have discovered or created by their own labour, physical or mental, something that is beneficial to them under the existing social and economic order". The need to control such things forms the basis of recognition of such rights[116].

There is a division of opinion among the legal scholars regarding the status of domain names as intellectual property. On the one hand, Domain name serve a useful purpose by designating where information is to be sent. On the other hand, they often indicate origin, and the public views them as trademarks. The two functions are fused in the same entity-the domain name. The scholars, who are of the view that domain

[116] Julius Stone, *The Province and Function of Law* 529 (Delhi: Universal Law Publishing Co. Pvt. Ltd., 2000).

names are not intellectual property, consider it as only an authorized ideal to utilize the name for a specific reason, that is, to set up the nearness of the domain name holder over the Internet[117]. As per them, to qualify as a property in the virtual world, the things need to have monetary value, in the cyberworld[118]. Domain names however are subject to sale, their sales are not perceived under law, and consequently they are without financial value. Hence, the rights that radiate from domain names are legally binding rights and not property rights.

The followers of intellectual property status of domain names might tend to get support from Roscoe Pound's view that "*the Proculians had the practice of awarding the new thing to its maker because prior to his labour that thing had not existed*"[119].

The response to the inquiry whether domain names are intellectual property lies in the understanding of Intellectual property rights. So let us try to understand these rights-

Intellectual property (IP) is legal property right over creations of the mind, both commercial and artistic, and the related areas of law. Under intellectual property law, owners are given certain rights for various types of intangible properties, such as symbols, and designs; ideas, words, phrases, discoveries and inventions; and musical, literary, and artistic work. The intellectual property rights give the maker of original works monetary incentive to create and share ideas through a form of transitory monopoly.

While applying the above logic to domain names, the scholars advocate that the registrant applies his knowledge and ability to choose such name which helps for his ID and satisfaction of different purposes over the Internet. So he must be given some kind of property rights over his creation. Consequently, domain names, URL, email accounts and so on are delegated intellectual property.

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[117] Paul Sugden, *Supra* note 1 at 208.
[118] Peter B. Maggs, *Supra* note 5.
[119] Roscoe Pound, *An Introduction to the Philosophy of Law*, Second Indian Reprint 110 (Delhi: Universal Law Publishing Co. Pvt. Ltd, 1998).

The researchers likewise contend that the idea of property and contract have experienced progressive changes[120]. In the time of computerized information, the value has moved from merchandise and land to control of data and different intangibles. Given the significance of intangibles like domain names, the holder of them attests his privilege against the entire world. In this manner, the supporters contend that if the privilege can be stated against outsiders not in privity with the holder of that right, it ought to be portrayed as property right, regardless of the possibility that the contractual rights are related with it[121].

Now days the court acknowledged that domain names possess all qualities of intellectual properties and therefore confer property rights on their owner.

In *Caesars World, Inc. v. Caesars-Palace.com*[122]

The court held that "*even if a domain name is no more than data, Congress can make data property and assign its place of registration as a suits*." Further the court proclaimed that property is anything that a man can possess and exchange to someone else and which infers an incentive to its proprietor. The court decided that given the qualities of domain names, which, all things considered, might be possessed, exchanged and sold, there is nothing which avoids domain names being classified as property.

In the *Cable News Network v. cnnnews.com*[123] whereby the court likewise found that domain names are properties which have their suits in where the registrar is found.

In the case of *Kremen v. Network Solutions, Inc*[124] the court held that a three-prong test ought to be adopted to set up whether domain names are property. At first place, it held that there must be an intrigue fit for exact definition. Secondly it must be

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[120] Jacqueline Lipton, "A Revised Property: Concept for the New Millennium" a*vailable at:* http://papers.ssrn.com/soI3/cf dev/AbsByAuth.cfm?per id=188170 (Accessed on 02.08.2016).

[121] Anupam Chander, "The New, New Property" *available at: http://papers. ssrn.com/sol3/papers. cfm?abstract_id=418853*(Accessed on 05.08.2016).

[122]Full text *available at:* http://www.internetlibrary.com/pdf/Caesars%20 World%20v.%20 Caesars-Palace.com.pdf.

[123] Full text *available at:* law.justia.com/cases/federal/district-courts/FSupp2/177/ 506/ 2571196/ (Accessed on 06.08.2016).

[124]Full text *available at:* http://www.casebriefs.com/blog/law/property/property-law-keyed-to- cribbet /what-is-property/kremen-v-cohen-network-solution-inc/2/ (Accessed on 06.08.2016).

equipped for restrictive ownership or control and thirdly the putative proprietor more likely than not built up an authentic claim to exclusivity. The court for this situation noticed that domain names fulfill every criterion and likewise ought to be delegated intangible property.

In *Tucows v Renner*[125] the court also held that domain names grant propriety rights on the registrant by making reference to academic literature and practice.

In *Rediff Communication Limited v. Cyberbooth and Anr*[126]Hon'ble Supreme Court was of the opinion that "*the high importance and value attached to a domain name makes it a major corporate asset of any company*".

In *Tata Sons Ltd v Manu Kosuri & Ors*[127], the High Court held that "*internet domain names are not merely internet addresses but are in fact corporate assets that are extremely important and valuable and as such, are entitled for protection equivalent to that afforded to any property*".

Why domain names needs to be classified as property?

An explanation in relation to the legal nature of the domain names is important because first of all, it affects how businesses should relate to the domain names they register and operate. Financing issues are the greatest worry for organizations who are thinking about the likelihood of utilizing their domain names as security for their advances or the likelihood of their domain names being distained. Further, the explanation additionally correlated from a accounting perspective which would decide how domain names ought to be represented in an balance sheet.

Secondly, domain names should be classified as property rights not on the grounds that they are important but rather in light of the fact that they convey the qualities of property and concede its holder/proprietor no less ideal than a proprietor of customary property. The fact that domain names are valuable should only serve as an impulse for legislators so that the legal nature of the domain name is clearly different from the trademark.

[125] *Tucows.Com Co. v. Lojas Renner* S.A., 2011 ONCA 548 (CanLII) *available at:* <http://canlii.ca/t/fmjtv> (Accessed 29.06.2016).
[126] AIR 2000 Bombay 27
[127] III AD Delhi 545, 90 (2001).

4.12. Concluding Remarks

Internet has over the period of time proved a viable medium for businesses to effectuate multifarious transactions right from the supply of raw material till the delivery of the finished product. Internet has also proved a very cost effective and efficient advertising tool. The consumers as well as businesses now turn to Internet because they have found it a convenient medium to shop. This information for consumer is available on different websites. These websites have unique addresses called domain names. The information seekers must either know domain name of the site which they are looking for or they have to enter key words in search engines. If they have to enter key words, they will invariably try for the already established trade name of the trader. Businesses would always prefer to have their domain names based on the trade name by which they are known to their consumers. It has been now observed that the domain names that are based on a well known trademark or trade names are being registered by those who are not in any way associated with these trade names with an object to confuse consumers who will take it as the associate of the such trademark owner or will resell the domain name to the true owner of the trade mark at some exorbitant price.

Therefore, domain names are in many ways the sign-board of the modern day organization; this makes the domain name a valuable asset or property and thereby make the function of domain names similar to that of a trademark/ trade name. Because of the significance of domain names a few issues emerge on how domain names identify with trademarks/exchange names. The likelihood for domain names to be viewed as trademarks/exchange names themselves has, up to now, predominantly been rejected.

However with the internet getting to be, or already being, the principle outlet for organisations the expulsion of this probability is easily proven wrong in view of the capacity that domain names satisfy in day to day business. This is considerably more so since the released generic Top-Level Domain. Generic Top-Level Domain implies the last part of a domain name, the top-level, is not limited anymore to only a few predetermined options. Rather private people and associations would now be able to register any number of new top level domain names. This will prompt expanded potential outcomes for domain names to reflect trademarks/exchange names, and furthermore to be regarded as such.

Domain names are equipped for utilizing/reflecting existing trademarks/exchange names. At the point when outsiders utilize trademarks/exchange names this can, when certain conditions are met, result in infringement. Domain names are along these lines, in specific conditions, also equipped for infringing trademarks. The theory is that domain names identify with trademarks since: they can be viewed as trademarks and have, in specific conditions, the likelihood to infringe existing trademark rights.

In order to prove the above hypothesis it is necessary to make a study of the similarities and the differences between domain names and trademarks. The next chapter will deal with this issue.

Chapter-5

Trade Marks v*is a vis* Domain Names

5.1. Introduction

Now it is clear from the previous chapter that Domain names are the unique addresses assigned to particular computers that are connected to the Internet. Without such unique addresses, computers would not be able to send packets of information to the correct location[1]. The Domain naming system, its nature, characteristics and the history of its development, is well-explained in the previous chapter.

From its nature it is also very much clear that on one hand domain name is simply that guides computers and users to the site that corresponds to the address through the Internet.

On the other hand, using domain names has acquired a role of intellectual property which generated a rapidly growing set of disputes, such as, conflicts between firms asserting traditional trademark entitlements and the registrants of identical or confusingly similar domain names. Furthermore, there are many types or kinds of conflicts between domain names and Trademark, but the popular disputes or conflicts between domain names and Trademark are when one person registers a domain name completely identical with a registered well-known trademark, which was owned by another person or firm, or registering a domain name largely similar to a registered well-known trademark.

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.

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[1] The actual Internet addresses (Internet Protocol addresses) are unique numbers, each with an assigned corresponding unique name m order to deal with the frailty of human memory. Thus, the Internet address of the Babasaheb Bhimrao Ambedkar University website is actually 14.139.228.229, but it is easier to remember the name that corresponds to that number, namely, "www.bbau.ac.in".

What constitutes trademark and what are its characteristics has been already discussed in the Chapter two. For our current purposes, it is to be investigated whether a domain name can be regarded as a trademark/trade name and if they are then at point they interact with each other and what dispute is arising out of it. When assessing this question, the best way is to analyse what the similarities and differences are between these two concepts.

Mainly this Chapter deals with the interaction between Trademark and domain names by discussing the main differences and similarities between Trademark and domain names as well as explaining the conflict/dispute between domain names and Trademark.

5.2. Are Trademark and Domain Names same?

When the use of marks incorporated in domain names increased through the 1990s as a tool of mark owners to promote their commercial activities, the basic tension between trademark law and domain names surfaced and intensified. There are two aspects to this problem.

First, there is similarity between Trademark and domain names as source identifiers. Like Trademark, domain names have the capacity to distinguish between sources of goods and services, more precisely, between Internet locations of those who offer/promote them on the Web.

Second, the nature and purpose of Trademark and domain names are conceptually different.

The first question that needs to be settled regarding domain names as constituting Trademark in the online medium is whether domain names actually comprise of Trademark? To answer this question, we need to study this aspect under two different scenarios:

5.2.1. Main Differences between Trademark and Domain names

Although domain names on the internet are considered to be like Trademark, but there are practical differences between the two that should be noted here.

Trademark are those marks or names that persons use in their business to distinguish their products or services from other products or services in the market. There are, at least, three main functions that a trade mark performs for a particular product or service.

- First, it informs the prospective consumer about the manufacturer of the product or the service provider.
- Second, it refers to the quality of the product or service by that particular manufacturer or service provider.
- Third, a trade mark is an advertisement both for the product/service and the producers/providers[2].

Therefore, a person who buys a particular product from a shop or uses a service would know who the producer/provider of that product or service is and can also make a prediction about its quality.

On the contrary, the main function of a domain name is to serve as an easy to remember combination of letters for an otherwise complicated numerical IP address. In other words, domain names represent the web site and its origin. There may be an indication to the contents of the site and its owner, however, the registration of a domain name does not give rise to any proprietary rights, such as Trademark provide[3].

Also, while some identical or similar Trademark may co-exist if they relate to different products and/or jurisdiction, domain names are exclusive.

The right to a trade mark does not exist on its own. A trade mark is always connected to a trade and can be transferred or owned with the trade and not without it. Domain names, on the other hand, can be registered, bought and sold irrespective to the product, information or service they belong to.

The following table sets out the main differences between Trademark and domain names:

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[2] W. Cornish and D. Llewelyn, Intellectual *Property: Patents, Copyright, Trademark and Allied Rights* 586–592 (Sweet & Maxwell, London, 5th edn., 2003).

[3] A. Deveci, "Domain names: has trade mark law strayed from its path?" International Journal of Law and Information Technology Vol 11, p 203, 2003 *available at*: https://pdfs. semanticscholar.org /f882/c3e145 cb016f2 b12e350b996afa9354af34b.pdf (Accessed on 16.08.2016).

Trademark	**Domain Names**
1. A trademark may consist of words, letters, designs, numerals, the shape of goods or their packaging colours, etc. and any combination of such signs.	1. A domain name must be contextual in form (e.g. www.bbau.ac.in).
2. A trademark may not be registerable if it is identical or similar to a previously registered trade mark. Further, similarity of the applied-for goods or services and the goods or services of the previously registered trade mark would be taken into account in assessing whether consumers would be confused about the trade origin of the applied-for goods or services.	2. A domain name is registerable if it is not identical to a previously registered domain name.
3. A trade mark which consists exclusively of a sign which describes the characteristics of the applied-for goods or services may not be registerable. Signs such as “fresh bread” in respect of bakery services would be considered as descriptive and non-distinctive and hence not registerable (while “fresh bread”	3. A domain name may describe the characteristics of the applied-for goods or services, e.g. “freshbread.com” for a bakery.

would be fine for clothing).	
4. A trademark shall be registered in respect of the class of goods or services as classified under the Trade mark act.	4. A domain name does not have to be registered in respect of a particular class of goods or services.
5. A registered trade mark is generally valid for 10 years and can be renewed for further periods of 10 years. In India trademark registration to remain valid, it has to renewed every 10 years for registration granted prior to September 15,2003 have a 7-year term, and registrations granted on or after September 15,2003 have a 10-year term. Trademark can be renewed for an additional 10-year term.	5. A domain name is valid for a small contract period as agreed between the registrant and the accredited registrar and is subject to renewal.
6. Legal proceedings may be initiated before the Registrar of Trade Marks or the Court of the respective country.	6. Mandatory administrative proceedings before an approved dispute resolution service provider are required for certain types of disputes and legal proceedings may also be initiated in a court of competent jurisdiction.

But domain names are property in the sense that they have monetary value. Therefore, it can be said that 'domain names have emerged as a commercial property right but are different from, Trademark, trade names, and corporate names'[4].

5.2.2. Similarities between Trademark and Domain names

In the modern world of electronic commerce, every business organization is concerned about establishing its identity over the Internet. This function of identifying the business enterprise over the Internet is performed by domain names[5]. Picking a suitable domain name is not an easy task. A number of factors need to be taken into consideration in doing so. One of the major factors is to include the trademark within the domain name[6]. This is because the inclusion of trademark, which is well established to identify the enterprise in the real world, would foster the establishment of identity of the said enterprise over the Internet. The consumers, who are generally unaware of specific domain name of an enterprise, can easily locate the enterprise by typing its well-known trademark.

Thus, the Trademark, which perform the function of identification of enterprises in the real world, also can perform similar function in the virtual world in the form of domain names[7].

The similarity between Trademark and domain names can also be seen in the domain name disputes (fully discussed in the later part of this chapter). In the cases where the domain name is related to a trademark, the trademark right is a formal and substantial prerequisite for the successful domain name dispute. Today, the disputes relating to domain names that infringe the Trademark stand as the most common form of domain name disputes[8].

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[4] S T. Johnson "Internet domain name and trade mark disputes: shifting paradigms in intellectual property", Arizona Law Review Vol 43, p 465, 2001 *available at:* corkonlinelawreview.com/ editions/2003/ 2003xiii.pdf (Accessed on 03.08.2016).

[5] Sharon K. Black, *Telecommunications Law in the Internet Age*, 407 (San Francisco: Morgan Kaufmann, 2002).

[6] Rodney D. Ryder, *Guide to Cyber Laws*, 241 (Wadhwa and Company, New Delhi 3rd edn., 2007).

[7] Digital Technology Law Journal, Vol. 1, No. 1, 1999, *available at* http:// www.austlii.edu.au/ au/journals/DTLJ/1999/4.html (Accessed on 05.08.2016).

[8] Mladen Vukmir, "Intellectual property Rights", in H. Vanhees (ed.), *International Encyclopedia of Laws - Intellectual Property*, 291 (Wolters Kluwer, India) Pvt. Ltd, New Delhi, Vol. 2, 2006).

5.3. Whether a Domain Name be regarded as a Trademark?

Whether a domain name can be regarded as a trademark? When assessing this question, the first step is to analyse what the similarities between these two concepts. Legislation dealing with the establishment of a trademark will be used as the primary guideline for this analysis. The criteria for establishing a trademark are:

- there needs to be a sign[9],
- this needs to be capable of being represented graphically[10] and
- the sign has to be distinctive[11].

Let us put these criteria to domain name in order to examine the potential qualification of a domain name as a trade name.

Whether a Domain Name be Seen as a Sign?

Trademark need to consist of signs; this is the subject matter of the trademark/ trade name. Based on literature, a sign may in particular consist of words, letters and e.g. numerals[12]. This will automatically include all domain names because they may only consist of characters which are contained in the UNICODE character table[13]. To conclude, all domain names are eligible to be regarded as signs under trademark law.

Whether a Domain Name be 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.

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[9] Trade Marks Act,1999 (Act 47 of 1999), s. 2(1)(m) defines a mark as: 'Mark' includes a device, brand, heading, label, ticket, name, signature, word, letter, shape of goods, packaging or combination of colours numeral shape of goods, packaging or combination of colours or any combination thereof.

[10] Trade Marks Act,1999 (Act 47 of 1999), s. 2(1)(zb) defines "Trade mark" as a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours.

[11] *Ibid.*

[12] Jennifer Davis, *Intellectual Property Law*, 189 (Oxford university press, 3rd edn., 2008).

[13] UNICODE character table, *available at*: http://unicode-table.com/en/#control-character (Accessed on 20.08.2016).

Whether a Domain Name is distinctive?

The most important condition to fulfil for many Trade marks is whether they are able to indicate the origin of a good or service by distinguishing them from those of their competitors. A good example, in my opinion, to illustrate whether a domain name can be regarded as distinctive is Hon'ble Supreme court's opinion in *Satyam Infoway Ltd. v. Sifynet Solutions (P) Ltd*[14], Where the apex Court reiterated the observations of several High Courts to the effect that

"*the use of the same or similar domain name may lead to a diversion of users, which would result from such users mistakenly accessing one domain name instead of another. This may occur in e-commerce with its rapid progress and instant (and theoretically, limitless) accessibility to users and potential customers and particularly so, in areas of specific overlap. Ordinary consumers / users seeking to locate the functions available under one domain name may be confused if they accidentally arrived at a different but similar website, which offers no such services. Such users could well conclude that the first domain name owner has misrepresented its goods or services through its promotional activities, and the first domain owner would thereby lose its customers*[15]".

It is apparent, therefore, that a domain name may have all the characteristics of a trademark and could found an action for passing-off. For the purpose of this thesis the judgement is relevant because it can be concluded that a domain name can have the potential to be distinctive. There have been other cases involving domain names which were regarded as distinctive to support this. The given example was just one of them but, for the purpose of this question, the mentioned case give a clear answer that domain names can be regarded as distinctive.

The conclusion therefore is that a domain name has the potential to comply with the three primary criteria for establishing a trademark/trade name. Domain names can be regarded as registered/ unregistered Trademark. Evidence with domain names being registered as Trademark/trade names can be found in many jurisdictions.

[14] (2004) 6 SCC 145.
[15] *Ibid.*

5.4. Domain name whether Trade Mark?-Judicial Approach

The courts have been consistently propounding that Trademark and domain names are analogous[16]. The function of domain names is same in cyberspace which the Trademark perform in real space. Factors to be considered in Deciding Whether Use of Trademark in Domain Name can Cause Likelihood of Confusion

(a) The first thing that needs to be seen is the location of the mark's use within the domain name. For example, an unauthorised use of "Microsoft" in a Second Level Domain (e.g., www.micr0soft.com) is likely to cause confusion in the minds of consumers.

(b)Another factor that influences the decision of courts while determining the trademark infringement in domain names cases is the fair use defence comprising of nominative use and descriptive fair use.

(c) Another factor that needs to be determined while considering whether there is a trademark violation in cyberspace is the likelihood of dilution of an existing trademark.

(d) Another vital test for determination of a domain dispute is whether the alleged domain name is generic or not. It is a settled principle of trademark law that if a term is generic for particular goods and services, then it cannot receive trademark protection.

Some of the important cases in which the symbolic relationship between the trademark and domain name was established are as under.

5.4.1. Foreign Courts

In the United Kingdom, the question of whether a domain name is an item of property or whether it is merely a contractual right which entitles the registrant to use the domain name has been resolved through decisions of court.

[16] F.A. Mir, M.T. Banday, "Mechanics of Domain Names and Indian Judicial Approach to their Disputes: A Study", in proc. of World Congress on Information and Communication Technologies (WICT 2011) pp. 176-188, published by IEEE., *available at:* waset.org/Publication/techno-legal-interplay-of-domain-names-a.../9997604 (Accessed on 21.08.2016).

English court expressed in *Marks & Spencer v. One in a Millions*[17] that with the development and advancement in technology, services provided on the Internet have also come to be recognized and accepted and are given protection, so as to save such service provider and that domain names are not only capable of being registered as trade marks but that domain names are, by virtue of use, also capable of generating goodwill that can be protected by means of an action for passing-off.

In an American case *Jews for Jesus v. Broadsky*[18]. It was laid down that due to the nature of Internet use, defendant's appropriation of plaintiff's mark as a domain name and home page address cannot adequately be remedied by a disclaimer. It was also observed that considering the vastness of the Internet and its relatively recent availability to the general public, many Internet users are not sophisticated enough to distinguish between the subtle differences in the domain names of the parties.

In *ActMedia, Inc. v. ActiveMedia Int'l Inc*[19]., the United States District Court for the Northern District of Illinois held that Active Media International's registration of the domain name "actmedia.com" infringed up on ActMedia's federally registered trademark for the name.

In *MTV Networks v. Curry*[20], MTV Networks (MTV) sued one of its former video jockeys, Adam Curry, for trademark infringement in connection with his web site, "mtv.com".

In *Washington Speakers Bureau, Inc. v. Leading Authorities, Inc*[21]and *Playboy Enterprises International Inc. v. Global Site Design, Inc*[22]. It was laid down that once trademark of the plaintiff is registered by the defendant as his sub domain, consumers will be confused as to source and the difference in the top level domain name will not eliminate that confusion.

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[17] Full text *available at:* avocat.blogs.com/avocatblog/2004/12/domain_names_in.htm (Accessed on 25.08.2016).

[18] *Available at:* www.finnegan.com/publications/updatenewsletters/pubdetail.aspx?pub...43 ed... (Accessed on 22.08.2016).

[19] *Available at:* www.lawcitations.com/case/n/actmedia-inc (Accessed on 22.08.2016).

[20] *Available at:* www.loundy.com/CASES/MTV_v_Curry.html(Accessed on 22.08.2016).

[21] 33 F. Sup. 2d at 501. *available at:* www.internetlibrary.com/cases/lib_ case 118. cfm (Accessed on 23.08.2016).

[22] W. L. 311707 at 2. *available at:* www.wipo.int/amc/en/domains/search/overview2.0/ (Accessed on 23.08.2016).

5.4.2. Indian Courts

The first among the cases is *Titan Industries Limited v. Prashanth Koorapati and Ors* [23] as it is the first case decided by any Indian court which accorded trade mark protection to domain names. Facts of the case were, the plaintiff had registered TANSHIQ as his trade mark for the production and marketing of Jewellery and watches since 1994 and had registered this trade mark in 23 countries. The defendant had registered 'tanshiq.com' as its domain name which was based on the plaintiff's trade mark. The plaintiff objected the use of its trade mark as a domain name by the defendant on the ground that the domain name is squarely based on his registered trade name. The consumers would tend to believe that the defendant is an affiliate of the plaintiff. It is likely to cause confusion and deceive the public and will ultimately divert business traffic to the defendant. This would give an unfair advantage to the defendant who would be able to cash the reputation and goodwill of the plaintiff which would cause financial loss to him. An exparte ad-interim was issued by the court against the defendant restraining him from registering a name or operating any business, manufacturing, selling or offering for sale, or advertising any goods under the name TANSHIQ or any other name deceptively similar thereto; or including the word TANSHIQ as an essential feature of a domain name on the Internet. The court also restrained him from conducting any activities with the name TANSHIQ that could lead to passing off the business and goods of defendant as those of plaintiff.

In *Info Edge (India) Pvt v. Sailesh Gupta per* Dr Mukundakam Sharma J. "*The domain name becomes more than a mere Internet address as it also function as a designation of origin and a symbol of goodwill i.e. a trademark and therefore, it is entitled to protection*[24]*.*"

In *Acqua Minerals Ltd v. Pramod Borse*[25],After referring to the dictionary meaning of the word 'domain',63 the Delhi High Court opined as follows:

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[23] Delhi High court suit No. 179 of 1998 Decision dated 28 Jan 1998 *available at:* www.iptjournal .com/cybersquatting-cases-india/ (Accessed on 26.08.2016).

[24] *Available at: Info Edge (India) Pvt v. Sailesh Gupta*, 2002 (24) PTC 355 (Del) https:// indiankanoon .org/doc/1162252/ (Accessed on 28.08.2016).

[25] AIR 2001 Del. 463.

> *If an owner or possessor of a trade mark has prior and exclusive use and lone claim over the trade mark, he attains not only superior title but absolute ownership thereof. This is what is the genesis of the word 'domain' and when the property or territory or the activity relates to a trade or commerce and has been given the name or mark under which the commercial activities are identifiable with and carried out under the said name, the user or owner thereof has a domain over it and therefore, such a domain name has the same protection as any trade name has been provided under the Trade and Merchandise Marks Act, 1958.*

In *Rediff Communication Limited V. Cyberbooth and another*[26],the court refer the case of *American Civil Libereties Union v. Reno*[27] explained the Internet domain name system. In cases of similar domain name the threat of passing off was explained with the help of *Marks & Spencer P.I.C. v. One in a Million*[28] , the court held that a domain name is not just an Internet address it is more than that and therefore is entitled to the equal protection as trade mark.

In *Manish Vij and Ors. v. Indra Chugh And Ors*[29], the court after going through domain name as well as trademark protection held that the term 'Kabadibazaar' is a vivid term and hence cannot fit to be called trademark unless it is proved that it has having a second meaning. The principles of descriptive terms that are applicable to trademark generally are applied to domain names. This proves that the court treats both domain names and Trademark on the same platform.

The Supreme Court of India in *Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd*[30], observed that the Internet had become a powerful medium for business activities and hence, the function of a domain name was very much akin to that of a trademark; the only difference being that the latter is protected by domestic laws,

[26] AIR 2000 Bom 27.

[27] *Available at*: 929-F Supp. 824 https://supreme.justia.com/cases/federal/us/521/844/case. html (Accessed on 28.08.2016).

[28] 1998 F.S.R. 265. avocat.blogs.com/avocatblog/2004/12/domain_names_in.html (Accessed on 28.08.2016).

[29] AIR 2002 Delhi 243.

[30] (2004) 6 SCC 145.

while the former is potentially accessible all over the world and gets exclusivity on that level - something which the domestic laws are inadequate to protect. The Supreme Court further observed:

- A domain name is a word or a name capable of distinguishing the subject of trade or service made available to potential users of the Internet.
- Similar domain names may be a ground of complaint and similarity of the domain names is to be decided on the possibility of potential customers being deceived by them.
- The defences available against a complaint are similar to those available against an action of passing-off under trademark law.

The Apex Court further observed:

> "*As more and more commercial enterprises trade or advertise their presence on the Web, domain names have become more and more valuable and consequently, the potential for dispute is high. While a large number of Trademark containing the same name can easily exist together because they are either belong to business in different jurisdictions or associated with different products, etc., the distinctive nature of the domain name providing global exclusivity is much sought after. The fact that many consumers searching for a particular site are likely, in the first place, to try and guess its domain name, has further enhanced this value.*"

In *Yahoo Inc. v. Akash Arora and Netlink Internet Services*[31]

The decision of this case marks the beginning of the application of passing off doctrine to domain name disputes. This is the first case in India in which passing off action was invoked or the resolution of domain name disputes.

In *Zee Telefilms Ltd. & Ors v. Zee Kathmandu &Ors*[32].

The court held that a mechanism should be globally put in place wherein the registered trademark holders should be asked to registered the mark with the ICANN accredited registrars with a stipulation that in case any person seeks to register a

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[31] 1999 PTC (19) 201, 1999 IIAD Delhi 229, 78 (1999) DLT 285, *available at:* https://indiankanoon .org/doc/1741869/. (Accessed on 29.08.2016).

[32] *Zee Telefilms Ltd. & Ors v. Zee Kathmandu & Ors*, 2006 (32) PTC 470.

domain name consisting of the registered mark, no objection would be required to be obtained from the owner of the registered mark.

In *Tata Sons Ltd v Manu Kosuri & Ors.*[33]

In this case the defendant registered a series of domain names incorporating the well-known trademark "TATA". The Court, in delivering judgment, referred to *Rediff Communication Limited v. Cyberbooth & Anr*[34] and *Yahoo Inc. v Akash Arora & Anr*[35], both mentioned above, and held that internet domain names are not merely internet addresses but are in fact corporate assets that are extremely important and valuable and as such, are entitled for protection equivalent to that afforded to registered Trademark.

The conclusion after going through the above similarities and differences and going through the decision of Indian as well as Foreign courts with regard to the question whether domain names, can be regarded as Trademark is as follows. At the moment, for the purpose of research, it can be said that domain names can be regarded as Trademark. However, this question requires further academic research and more jurisprudence in order to be given a definitive answer.

5.5. Domain name Disputes

At first, domain names are nothing but user-friendly addresses. However, in a commercial marketplace, they came to be seen as marketing tools and brand names[36]. With the advancement of e-commerce, the domain names have come to acquire the same value as a trademark or the business name of a company. The value attached to domain names makes it lucrative for cyber criminals to indulge in domain name infringements and the global nature and easier and inexpensive procedure for registering domain names further facilitates domain name infringements[37]. When a person gets a domain name registered in bad faith, i.e. in order to make huge profits by registering a domain name corresponding to a trademark of another person, Thus,

[33] III AD Delhi 545, 90 (2001)
[34] *Available at:* https://indiankanoon.org/doc/806788/ (Accessed on 29.08.2016).
[35] *Available at:* https://indiankanoon.org/doc/1741869/ (Accessed on 29.08.2016).
[36] *Ibid.*
[37] *Ibid.*

domain names became a tradable commodity, a market resource object being contended by interested parties.

So many legal issues on domain name have arisen, and accordingly more and more disputes between domain name holders and complainants have been taken before relative courts all over the world.

Among various disputes one of the most important is domain name's conflict with Trademark. With the growth of the Internet, especially the influx of commercial enterprises onto the Internet, domain names have come into conflict with Trademark.

Then, when domain name is in conflict with trademark? It seems there is no simple answer. Therefore it is necessary to know under which Circumstances a domain name can infringe a trademark.

5.5.1 Circumstances under which a Domain Name can infringe a Trademark

As we have seen in the chapter two that a trademark can be infringed if any unauthorised person uses an identical trademark[38].

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[38] Trade Marks Act,1999 (Act 47 of 1999), s.29 provides that

(1)a registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark:

(2) A registered trademark is infringed by a person who, not be being a registered proprietor or a person using by way of permitted use, uses in the course of trade a mark which because of --

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark : or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark: or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark.

is likely to cause confusion on the part of the pubic , or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that its is likely to cause confusion on the part of the public.

(4) A registered trademark is infringed by a person who not being a registered Proprietor or a person using by way of permitted use, uses in the course of trade, a mark which-

(a) is identical with or similar to the registered trade mark and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered : and

Once a mark is registered under the Act, it gives the proprietor an exclusive right to use the trademark in relation to the goods or services in respect of which it is registered. It also gives the proprietor a right to obtain relief in the form of injunction, damages, or any other legal relief against the infringer of this right[39].

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trademark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if in particular he---

(a) affixes it to goods or the packaging thereof:

(b) offers or exposes goods for sale puts them on the market, or stock them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark:

(c) imports or exports goods under the mark: or

(d) uses the registered trade mark on business papers or in advertising.

(7) A registered trademark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of the trade mark if such advertising---

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters or

(b) is detrimental to its distinctive character or

(c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark maybe infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use a mark shall be construed accordingly.

[39] Section 28(1) provide the rights conferred by Registration. 28 (1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of trade mark in the manner provided by this Act.

(2) The exclusive right to the use of a trade mark given under sub-section

(1) shall be subject to any conditions and limitations to which the registration is subject.

(3) Where two or more persons are registered proprietors of Trade marks,

which are identical with or nearly resemble each other, the exclusive right to the use of any of

those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.

However Section 27(2)[40] and Section 135[41] of the Act provide the remedy of passing off[42] in favour of the unregistered marks. The scope of this remedy has been extended to professions and non-trading activities as well.

Let us now deal with the question under which circumstances domain names can infringe Trademark. The most common forms of domain name and trademark conflict is merely registering a domain name as it give rise to certain legal disputes between trademarks and domain names The research will analyse to what extent the registration of domain names can infringe registered/ unregistered Trademark.

During the initial years of Internet, domain names were considered as equivalent to real world physical addresses. However, with internet assuming the role

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[40] Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods or services as the goods of another person or as services provided by another person, or the remedies in respect thereof.

[41] Relief in suits for infringement or for passing off. Section 135 (1) The relief which a court may grant in any suit for infringement or for passing off referred to in section134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery up of the infringing labels and marks for destruction or erasure.

(2) the order of injunction under sub-section (1) may include an ex parte injunction or any interlocutory order for any of the following matters, namely:---

(a) for discovery of documents :

(b) preserving of infringing goods, documents or other evidence which are related to the subject matter of the suit:

(c) restraining the defendant from deposing of or dealing with his assets in manner which may adversely affect plaintiff’s ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff

(3) Notwithstanding anything contained in sub-section (1), the court shall not grant relief by way of damages (other than nominal damage) or on account of profits in any case---

(a) where in a suit for infringement of a trade mark, the infringement complained of is in relation to a certification trade mark or collective mark: or

(b) where in a suit for infringement the defendant satisfies the court---

(i) that at the time he commenced to use the trade mark complained of in the suit he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was on the register or

that the plaintiff was a registered user using by way of permitted use: and

(ii) that when he became aware of the existence and nature of the plaintiff’s right in the trademark, he forthwith ceased to use the trade mark in relation to goods or services in respect of which it was registered; or

(c) where in a suit for passing off, the defendant satisfies the court--

(i) that at the time he commenced to use the trade mark complained of in the suit he was unaware and have no reasonable ground for believing that the trade mark of the plaintiff was in use; and

(ii) that when he became aware of the existence and nature of the plaintiff’s trade mark he forthwith ceased to use the trade mark complained of.

[42] Passing-off is a Common Law remedy being, in substance, an action for deceit, i.e., passing-off by a person of his own mark, which is not registered under the Act.

of quality e-commerce platform, the concept of domain names also underwent vital change. From just addresses, domain names graduated to online brands that are associated with the goodwill of the owner of domain names. This started the race for getting online brand identity as domain name registration is based on first-come-first-served rule, which could preclude the owner of trademark from claiming first right on the identical domain name.

The technically sound(computer savvy) persons saw a goldmine in well-known names and registered identical and / or similar domain names in bulk so that when the trademark owners seek to register domain names of their choice, they were served with ‘Not Available’ message. The technically sound person who is now a registrants of such domain names, now, come into picture and offer to sell the domain names desired by the trademark owners at a price much higher than the registration cost of such domain names. This example is not only case pertaining to abuse of domain name registration process.

5.6. Legal Disputes Regarding Domain Name Registration

The legal disputes regarding registering trade marks as domain names give rise to domain name and trademark disputes include:

1. **Cybersquatting**
2. **Typosquatting**
3. **Domain Name Parking**
4. **Reverse Domain Name Hijacking**
5. **Domain Tasting**
6. **Domain name front running**
7. **Domain Kiting**
8. **Gripe / Protest Websites**
9. **‘Url’ Path**

5.6.1. Cybersquatting

The word 'Cybersquatting' is derived from word 'Squatting' meaning the act of occupying an deserted or unoccupied building or space, usually residential, that the person taking does not own, rent or otherwise have right to use[43]. Cybersquatting (also known as domain squatting), simply means to register a domain name that is either similar, or confusingly similar to, the trademark of another with the intent to sell the domain name to the trademark owner at profit. In other words we can say "registration of well-known trademark as domain names by a person who is not original trademark owner, who afterwards try to sell the domain name back to the original trademark owner[44].

Under the World Intellectual Property Organization (WIPO), cybersquatting refers to something if[45]:

• the domain name is either same or confusingly similar to trade mark in which the complainant has a right;

• the person having the domain name has no legitimate interest or right in respect of the domain name; and

• the domain name has been registered and is used in bad faith.

Fundamentally, cybersquatting concerns a particular activity:

> *The registration as domain names of well-known Trademark by non-trademark holders who then try to sell the names back to the trademark owners. Since domain name registrars do not check to see whether a domain name request is related to existing Trademark, it has been simple and inexpensive for any person to register as domain names the marks of established companies. This prevents use of the*

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[43] Cybersquatting, Typosquatting, And Domaining *available at:* https://www.jw. com/wp-content/uploads/2016/05/1276.pdf (Accessed on 29.08.2016).

[44] *Ibid.*

[45] The WIPO Uniform Dispute Resolution Policy, 1999 Para-4(a), https:// www .icann .org/ resources/pages/policy-2012-02-25- en (Accessed 29.08 2016).

domain name by the mark owners, who not infrequently have been willing to pay "ransom" in order to get "their names" back[46].

U.S. legislation, Anti-Cybersquatting Consumer Protection Act (ACPA), 1999, defines cybersquatters as those who:

(1) register well-known trademarks as domain names in order to extort money from the original owners of the marks;

(2) register well-known trademarks as domain names tries to sell those marks to the highest bidder;

(3) register well-known trademarks to take advantage consumer confusion by misusing the domain name to distract consumer from the trademark owner's site to the cybersquatter's own site;

(4) Often target distinctive marks to defraud consumers, and also engage in counterfeiting activities.

The term 'cybersquatter', generally, refers to a legal person lacking a legitimate claim over the domain name, but still registers it for any of the following purposes:

(a) to sell the same for profit, or

(b) to prevent the trademark holder from gaining access to the name, or

(c) to divert traffic to another website, or

(d) to harass or ridicule the competitor or prevent them from establishing a website using that name.

The court in *Interstellar Star ship Servs. Ltd. v. Epix. Inc*[47] observed that:

"Cybersquatting is the Internet version of an unlawful land grab. Cyber squatters register well-known brand names as Internet domain names in order to force the rightful owners of the marks to come forward and

[46] *Available at:* http://law.justia.com/cases/federal/district-courts/FSupp2/309/309/2310792/ (Accessed on 29.08 2016).

[47] 304 F.3d 936, 946 (9th Cir. 2002) available at: https://cyber.law.harvard .edu/ property00/domain/ Interstellar.html (Accessed on 29.08.2016).

> *pay for the right to engage in electronic commerce under their own name".*

The meaning of cybersquatting can be abridged in *Manish Vij v. Indra Chugh*[48], where the court held:

> *"An act of obtaining fraudulent registration with the intention to sell the domain name to the legitimate owner of the trade name at a premium".*

The most glaring example of cybersquatting is the first recorded case decided by NSI is McDonald's case. In 1994 a journalist preparing an article on domain name policy realized that McDonalds.com was available. He registered the domain name. The fast food chain McDonalds pressured Networks Solutions Inc (NSI) into taking action against the journalist. At that time, there was no formal dispute policy in place. A week after revoking the registration, NSI realized it had made a mistake and reversed its decision. Finally McDonalds paid US $3,500 for retaining the domain name.[49]. The menace of cybersquatting not only eats into the goodwill of trademark holders, sometimes, it is also a silent assassin in that it may take a considerable time before the original trademark holder becomes aware of the cybersquatting problem.

The first case that was decided under the UDRP was the *Word Wrestling Federation case*[50]. The United States based World Wrestling Federation (WWF) brought a suit against a resident of California who had registered the domain name www.worldwrestlingfederation.com and had later offered to sell it to WWF at a huge price. It was held that the domain name registered by the registrant was in violation of WWF's trademark as it was too identical or confusingly similar to WWF and that the registrant had no legitimate right or interest to register such a name. The court finally ordered to transfer the registration of the domain to WWF[51].

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[48] AIR 2002 Del 243

[49] Rohas Nagpal *IPR & Cyberspace – Indian Perspective authored* 12(2009).

[50] *World Wrestling Federation Entertainment, Inc. v. Michael Bosman award available at*: http:// www.wipo.int/amc/en/domains/decisions/html/1999/d1999-0001.html (Accessed on 30.08.2016).

[51] *Available at*:http://cyber.law.harvard.edu/metaschool/fisher/domain/dncases/cardserv.htm (Accessed on 30.08.2016).

Another important case on this point is *Panavision International LP v. Toeppan*[52], Court held that the defendant's acts of registering more than two hundred and forty Trademark as domain name and then later offered to sell to their rightful owners is a act of cybersquatting.

The term "cybersquatters" emerged in the mid-1990s to designate a certain type of commercial opportunism related to the immature phase in the development of the Internet. Cybersquatters are those registrants who grasped the commercial value of domain names incorporating well-established Trademark. Because the registration process for domain names has been on a "first come, first served" basis, some were fast enough to register domain names before the mark owners. Later, these registrants attempted to sell for profit the rights to use the domains to the mark owners.

So long as a cybersquatter possesses the domain name, the trademark owner remains unable to register his own trademark as a domain name. In that way, a cybersquatter violates the right of the trademark owner to use his own trademark.

It is relevant to note that there is nothing wrong with the practice of reserving a domain name. Often, cyber squatters register words or phrases they hope will someday be sought after by new companies or new businesses. Such 'speculative domain name registration', (read, speculative cybersquatting) is very much legitimate. The problem spawned by cybersquatting is augmented as entrepreneurs try to take advantage of the reputation of others by registering domain names which attract members of the public[53].

5.6.2. Typosquatting

Another way of gaining commercial benefit is by buying a domain name which is confusingly similar to a well known existing domain name. Typosquatting, literally, means sitting over (squatting) a domain name, which is variation of a famous trademark. Typosquatting is, essentially, a corollary to cybersquatting where the domain name registrant registers a variant of a famous trademark. Typosquatting simply means the practice of registering a domain name with a small deviation in the spelling of a trademarked word. There is only slight difference in the domain name

[52] *Available at*: www.finnegan.com/publications/updatenewsletters/pubdetail.aspx?pub...77c0 ... (Accessed on 30.08.2016).

[53] *Available at*: http://www.legalserviceindia.com/articles/cddisp.htm (Accessed on 30.08.2016).

from the actual domain name so that in case the user ends up making a typing error, they are automatically redirected to the replica website and get caught in 'mousetrapping'. For instance, micros**0**ft.com (for microsoft.com), siffy.com (for sify.com), yaho.com (for yahoo.com), etc. The purpose of a typosquatter is the same as that of a cybersquatter; only the mode of trademark infringement is slightly different.

In this scenario, the user gets barraged with advertisements[54].A domain name which is strikingly similar to another domain name is considered to be registered in 'bad faith' according to the Article 4b(iv) of the UDRP. For instance, Microsoft had filed more than 300 cases complaining the registration of misleading and 'confusingly similar' domain names[55].

In *The Mashantucket Pequot Tribe v. Redican*[56], Court observed that "*Typosquatting in general, is the 'registering [of] domain names that are intentional misspellings of distinctive or famous names."*

In *Expedia Inc v Alvaro Collazo*[57] it was held that Typosquatting' connotes the situation where advantage is taken of common misspellings of words made by Internet users who want to locate a particular site of a particular provider of goods or services, with the intent of deriving some form of benefit there from.

Typosquatting also called a fake URL, a sting site, or URL hijacking. It is a type of cybersquatting, and possibly brand jacking which is based on mistakes such as typographical mistakes made by Internet users while inputting address of a website into a web browser. As soon as Internet user accidentally enters a wrong website

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[54] Dara B Gilwit, 'The Latest Cybersquatting Trend:Typosquatters, Their Changing Tactics, and How to Prevent Public Deception and trademark Infringement' (2003) 11 Wash UJL 267 at page 275 cited inopenscholarship.wustl.edu/cgi/viewcontent.cgi?article=1326&context=law (Accessed on 30.8.2016).

[55]*Available at*: http://www.theinquirer.net/inquirer/news/1029896/microsoft-sues-over-300-misleading-domain-names>(Accessed 30.08 2016).

[56] F.Supp.2d 196 (D. Conn. 2005) Southern Co., 324 Fed.. Appx. at 312 at n.2 *available at:* law.justia.com/cases/federal/district-courts/FSupp2/309/309/2310792/> (Accessed 30.08 2016).

[57] WIPO Case No D2003-0716; Bettinger op cit note 14 at 1036 *available at:* www.wipo.int /amc/en/domains/decisions/html/2004/d2004-0787.html (Accessed on 01.09.2016).

address, they may be directed to any URL (including an alternative website owned by a cybersquatter)[58].

The typosquatter's URL will generally be of following kinds; all are almost same to the victim site address (we can understand it by taking "research.com" as example)[59]:

- A misspelling based on typos: reaserch.com.
- A misspelled word or foreign language word, of the intended site: reserch.com.
- A different top level domain: research.org.
- Domain name phrased in a different way: researchs.com.

A misuse of the Country Code Top Level Domain (ccTLD): research.cm by using .cm, or research.co by using .co. A person leaving out either the letter o or the letter m in .com in error could land at the bogus URL's website.

It is necessary to understand what is common misspelling is, for e.g, while typing in google.com many people accidentally type googlw.com as the "e" and "w" keys on the keyboard are next to each other. Registering the domain googlw.com to intercept traffic meant for google.com would be typo-squatting.

One of the most popular case involving typosquatting is the US case of *Shields v Zuccarini*[60], the accused John Zuccarini registered the misspelled domain names of many popular websites and when the user would be diverted to those websites, he was mousetrapped and will have to click on the succession of advertising window in order to exit, which profited the accused with ten to twenty-five cents a click. The first claim against him was brought by the artist owner of 'Joe Cartoon' Joseph Shields and was made to pay a compensation of $10,000 along with a permanent injunction, but he continued with his activities. Afterwards came a series of claims by individuals and corporations. It was then found that Zuccarini's activities extended to some popular brand's and celebrity's websites. Claims were also brought by the Wall Street Journal, Encyclopaedia, Calvin Klien, Yahoo! and Britannica. The court

[58] *Available at:*https://en.wikipedia.org/wiki/Typosquatting (Accessed on 01.09.2016).

[59] *Ibid*.

[60] 89 F.Supp. 2d 634 (E.D.Pa.200) *available at:* www2.ca3.uscourts.gov/opinarch/002236.txt (Accessed on 01.09.2016).

imposed a total of $88,000 fine but he still did not stop. On further claims, he remained unavailable for the hearings. The courts addressed him as

> "*a person who had discovered a simple, yet highly lucrative moneymaking scheme. While never leaving his apartment, he could collect nearly a million dollars a year in advertising royalties.*"

In *Rediff Communication Limited v. Cyberbooth and Anr*[61], in this case the domain name "radiff.com" was registered by the defendant which was similar to the plaintiff's domain name "rediff.com". Deciding in favour of the plaintiff, the Court was of the opinion that the high importance and value attached to a domain name makes it a major corporate asset of any company. The court went on to state that a domain name is much more Cybersquatting may take the form of typosquatting, where the domain name registrant registers a variant of a famous trademark.

An important case decided by Indian Domain Name Dispute Resolution Policy (INDRP), *Bloomberg Finance L.P., (BF) v. Mr. Kanhan Vijay*[62] – This was the most important case of 2009 before the Arbitration Panel. Here the plaintiff registered a domain name www.bloomber.net.in. But BLOOMBERG was a registered service mark in not just in India but abroad as well. But the respondent's bad faith was established by the Panel. The panel is of the view that there was a want for of due diligence on the part of the respondent towards their claims and that the domain name should be accordingly transferred to the complainant.

Starbucks Corporation v. Mohanraj[63] (Decided on 26th November, 2009)Respondent's domain name www.starbucks.co.in was confusingly similar to complainant's domain name www.starbucks.in. It was contended that the respondent's domain name is confusingly similar & identical to the complainant's domain name. It was also contended that the respondent had no lawful interest in the domain name. Further it was contended that the mark was used by the respondent in bad faith. The respondent on the other hand contended that at the time of registration the .IN registry or his registrar didn't ask him to submit any supportive documents to

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[61] AIR 2000 Bombay 27.

[62] *Available at:*https://registry.in/system/files/bloombergnetin_0.pdf (Accessed on 01.09.2016).

[63] *Available at:* www.ssrana.in/Intellectual%20Property/.../Domain-Name-Case-Law-in-India. aspx (Accessed on 01.09.2016).

register the domain name. The respondent further submitted that that the complainant had neglected the disputed domain name for 4 years at the time of registering www.starbucks.in even though the .co .in was available before the .in extension was released. The respondent prayed for cancellation of complaint and to allow him to use the domain name for his own purpose of another business which would not be in complainant's industry.

The rejoinder submitted by the complainant stated that the mere fact that at the time of booking/ registering the domain name www.starbucks.co.in the .in registry or his registrar did not ask respondent to submit any supportive documents / evidence to register the Domain, did not bestow upon him any absolute right in the said domain name. Further it was submitted that respondent had not given any explanation as to how he came about adopting or hit upon the domain name www.starbucks.co.in, when he is the registered proprietor of the trade mark Starbucks in India since 1995. Also it was submitted that the respondent is neither commonly known as Starbucks nor making a legitimate or fair use of the said domain name. The complainant further submitted that the domain name of respondent was identical to complainant's registered trade mark and service mark Starbucks. The complainant further submitted that it had bonafide right in the registered trade mark Starbucks and the respondent had no right or legitimate interest in the domain name and he had got it registered for unjust enrichment. The domain name had been used in bad faith and therefore the respondent was not entitled to retain the said the domain name. The complainant prayed for the transfer of the domain name www.starbucks.co.in to the complainant.

The learned arbitrator held that the disputed domain name was confusingly similar or identical to the complainant and that they had right in the trademark. Regarding the question of legitimate interest, it was held that since the respondent did not provide any positive, cogent and specific evidence that it was known or recognized by domain name, he had neither put forth nor provided such evidence. Therefore, the respondent had no right or legitimate interest in the domain name. Further it was held that the respondent had got the domain name registered in bad faith. Also it was held that domain name be transferred to the complainant.

In *Google Inc. v. Gulshan Khatri*[64] (Decided on 6th May, 2011) the Complainant filed the instant complaint challenging the registration of the domain name googlee.in in favour of the respondent. The grievance of the complainant was regarding the latter's act of adopting an identical domain name and that also in respect of similar services to that of the complainant.

The Complainant contended in its claim that the Respondent simply wished to usurp the domain name and ride on the goodwill that the Complainant has built over the years by its hard work. Further it was contended that the disputed domain name was visually, conceptually and substantially identical to the Complainant's domain name and that there was no difference between both the domain names. The complainant further contended that the name googlee.in appeared immediately and obviously connected with the Complainant and its business and the public would perceive it as such. It was also contended that both the domain names were used as search engines. The Complainant further contended that the confusion which is likely to be brought into people's mind through the disputed domain name would not only improperly benefit the Respondent but also disrupt the business of the Complainant, dilute its rights and expose it to the risk of fraud.

The Complainant further submitted that the disputed domain name was registered in favour of the respondent on 17th February 2007 whereas the same domain name google.in had been extensively operating and serving the market worldwide way back from 1997. Furthermore the Complainant submitted that it had not authorized, licensed or otherwise consented to the Respondent's use of its mark or brand. The respondent did not deny the knowledge and use of the domain name/trade mark GOOGLE 'by the Complainant.

The learned Arbitrator held that impugned domain name googlee.in was identical and confusingly similar to the other prior registered domain name and registered trade mark of the complainant and directed the Registry to cancel the said domain name forthwith and transfer the said domain name in favour of the Complainant.

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[64] *Available at:* www.ssrana.in/Intellectual%20Property/.../Domain-Name-Case-Law-in-India.aspx (Accessed on 01.09.2016).

The Delhi High Court recently upheld an arbitral award directing transfer of domain name registered as 'Googlee' to Google.Inc., noting that the former had adopted a 'slavish' imitation of Google's writing style , font, colour scheme and layout[65].

In *Maruti Udyog Ltd v. Maruti Software Private Ltd*[66] - a complaint was brought against the respondent in this case, who registered the domain name "marutionline.com". The court held that the domain name was registered in bad faith as there was no evidence to suggest that the respondent intended to use the domain name for legitimate purposes.

SBI Cards and Payment Services Private Ltd v. Domain Active Pty Ltd[67]14, - The respondent had registered the domain name "sbicards.com". It was held that the registration was made with the intention to create confusion with the product, services and trademark of the plaintiff. The respondent was ordered to transfer the domain name to the complainant.

Typosquatting has caused annoyances for Internet users for a long time. Since users lack effective counter measures, speculators keep registering domain names to target domains and exploit the traffic arriving from mistyping those domain names. Existing studies of typosquatting focused on popular domain names and thus have only shown the tip of the iceberg. Similar to traditional cybercrimes like spamming or financial credential fraud, typosquatting has minimal transparency, allowing what may be an unprofitable activity to continue because new entrants see its effects and attempt to become profitable typosquatters themselves. Investigating such speculative, "gray area" behaviour longitudinally can give us insights which might generalize to traditional cybercrime and cybercriminals.

5.6.3. Domain Name Parking

Domain parking refers to the registration of an internet domain name without that domain being associated with any services such as email or a website. This may

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[65] *Available at:* http://www.livelaw.in/delhi-hc-orders-transfer-domain-name-googlee-google/ (Accessed on 07.04.2017).

[66] *Available at:* http://arbiter.wipo.int/domain/decisions/2000-0520.html (Accessed on 01.09.2016).

[67] What is cybersquatting and its Legal Position in India *available at:* http:/ /blog. ipleaders. in/cybersquatting-position-india/#ixzz4AV8kozUo (Accessed on 01.09.2016).

have been done with a view to reserving the domain name for future development, and to protect against the possibility of cybersquatting. Since the domain name registrar will have set name servers for the domain, the registrar or reseller potentially has use of the domain rather than the final registrant[68].

It (Domain name parking) usually occurs when a domain name registrant deposits its domain names with a Registrar or Parking Service Provider who "creates placeholder pages and then invites...Internet advertisement networks to fill them with advertisements" as opposed to constructing a functional website[69].

Domain parking can be classified as monetized and non-monetized. In the former, advertisements are shown to visitors and the domain is "monetized". In the latter, an "Under Construction" or a "Coming Soon" message may or may not be put up on the domain by the registrar or reseller. This is a single page website that people see when they type the domain name or follow a link in a web browser. Domain names can be parked before a web site is ready for launching[70].

The best way to understand Domain Parking, let's take an example of a user who is looking to buy a Ferrari online. It is very much possible that he directly goes to FerrariCars.com, believing it to be a legitimate site operated by Ferrari car manufacturers, instead of taking the Search Engine route to go to the appropriate website. When the web page loads, however, the user does not see the substantive website of the company that sells Ferrari cars. Instead, the user sees a list of hyperlinks to other websites unaffiliated with Ferrari brand, including links to competitors' websites, websites selling competitors' products, or shopping websites. The parked domain, FerrariCars.com, presents the consumer with navigation options but fails to identify the intended target of the consumer's direct navigation attempt, i.e., Ferrari cars webpage: www.ferrari.com. There are millions of such parked

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[68] *Aavailable at:*https://en.wikipedia.org/wiki/Domain_parking (Accessed on 02.09.2016).

[69] Leslie Walker & Brian Krebs, The Web's Million-Dollar Typos, Washington Post, April 30, 2006, at F01 (relaying a law professor's assertion that "the practice amounts to someone making money off some one else's trademark without permission."). Additionally, when Internet users arrive at the parked sites and click on the advertisements, the Internet advertisement networks receive payment from the advertisers and pass on a portion of the revenue to the domain name registrant *available at:*www.washingtonpost.com › Technology(Accessed on 02.09.2016).

[70] *Aavailable at:*https://en.wikipedia.org/wiki/Domain_parking (Accessed on 02.09.2016)..

domain names that frustrate trademark owners and are encountered by consumers on a daily basis.

Domain Parking yield money when the user click on links to other websites advertised on the parked page and for every such click; the advertiser indirectly pays the domain name registrant. This kind of activity is commonly referred to as Pay-Per-Click (PPC) advertising. Domain name parking results in trademark infringement because unaffiliated domain name registrants can incorporate the owners' marks into parked domain names; thereby, reducing the trademark owner's ability to control the use of their mark in cyberspace and diverting consumers to competitors' websites[71].

In *Microsoft Corp. v. Brown*[72], the court observed that "when a person looking for a Microsoft website lands on one of the defendant's websites, that person may click on one of the advertisements or hyperlinks on the site either because the person finds it easier to click on the advertisement or hyperlink than to continue searching for the Microsoft site, or because the person mistakenly believes Microsoft has authorised or endorsed the advertisements or hyperlinks. In either case, the person has been diverted from the Microsoft website he or she was seeking to visit, and Microsoft has lost that opportunity to interact with that person."

5.6.4. Reverse Domain Name Hijacking

Reverse domain name hijacking (also known as reverse cybersquatting), occurs where a trademark owner attempts to secure a domain name by making false cybersquatting claims against a domain name's rightful owner[73]. This often intimidates domain name owners into transferring ownership of their domain names to trademark owners to avoid legal action, particularly when the domain names belong to smaller organizations or individuals[74]. Reverse domain name hijacking is most commonly perpetrated by larger corporations and famous individuals[75].

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[71] Elizabeth M. Flanagan, No Free Parking: Obtaining Relief From Trademark-Infringing Domain Name Parking, 82 Minn. L. Rev. 498 (2007), *available at*: http://www.minnesotalawreview.org /sites/default/ files/ Flanagan_Final.pdf, at 500 (Accessed on 02.09.2016).

[72] No. CV06-5247 (C.D. Cal. Aug. 21, 2006) *available at:* www.law.du.edu/.../corporate... /SEC-v-Lee-Opinion-CV-14-06865-RGK-2015-BL-3 (Accessed on 02.09.2016).

[73] *Available at:* https://en.wikipedia.org/wiki/Reverse_domain_hijacking (Accessed on 02.09. 2016).

[74] *Ibid.*

[75] *Ibid.*

According to UDRP Rule 1, Reverse domain name hijacking is "using the Policy (UDRP) in bad faith to attempt to deprive a registered domain-name holder of a domain name"[76]. This definition must be linked to UDRP Rule 15(e) which stipulates in particular that "if after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.[77]"

Harte defines Reverse Domain Name Hijacking as a scenario when "large corporations use their legal and financial muscle to evict legitimate domain name holders from valuable registrations that they want. [78]"

On the basis of findings of the WIPO panels in Reverse Domain Name Hijacking cases following are the Circumstances for justification of reverse domain name hijacking:

- When the registration of the domain predates any trademark rights of the Complainant.
- When the complaint has provided no evidence of bad faith registration or use directed towards the Complainant.
- Where the Complainant has used the UDRP as a Plan "B" option to attempt to secure the domain after commercial negotiations have broken off.
- Where the Complainant has attempted to deceive the domain owner or makes misrepresentations or fails to disclose material information to the panel[79].

In *Prince Pic v Prince Sports Group Inc*[80] the American sporting goods manufacturer sought to hijack the prince.com domain name, which had been legitimately registered by Prince Computing. Although the plaintiffs owned no mark,

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[76] Rules for Uniform Domain Name Dispute Resolution Policy, Rule 1 *available at:* https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en (Accessed on 02.09.2016).

[77] *Ibid.*

[78] Ada A. Harte, "The Domain Name Debate", Technology and Entertainment Law Journal - Vol. 2, No. 1 2001, at 5.

[79] *Available at:* https://en.wikipedia.org/wiki/Reverse_domain_hijacking (Accessed on 05.09.2016).

[80] July 1997, 1 [1998] F.S.R. 21 *available at:* swarb.co.uk/prince-plc-v-prince-sports-group-inc-chd-1998/ (Accessed on 02.09.2016).

they sought and received from Justice Neuberger in the U.K. court, a declaration to the effect that it had a valuable reputation and goodwill in the name.

5.6.5. Domain Tasting

Domain tasting is the temporarily registering a domain under the five day Add Grace Period (AGP) at the start of the registration of an ICANN regulated second level domain. During this period, a registration must be fully refunded by the domain name registry if cancelled. This was designed to address accidental registrations, but domain tasters use the Add Grace Period for other purposes[81]. This golden window of opportunity, however, led to the rise of a trend, known as "domain tasting" whereby, computer users register a large numbers of domain names on a trial basis, placing advertisements on such blank website, and testing to see how much advertisement revenue each name can make.

Let us try to understand the modus operandi. When the Internet surfers click on such advertisements, both the advertising company (like Google AdSense) and owner of that domain name get a percentage of the advertisement revenue. In a way, the advertising company gets 'paid' by domain name tasters in that the advertisement clicks generated by the tasting domains occur because a user has 'tasted' that domain by clicking on an advertisement. The advertising company gets its share of revenue and passes along a cut to the person who owns the website hosting the advertisement.

It started in 2001, when the entity tasked with coordination of the Internet domain name system, the Internet Corporation for Assigned Names and Numbers (ICANN), implemented the "Add Grace Period" (AGP), a five-day grace period during which the new owner [of a domain name] can make full use of the chosen domain name, and no one else can use that domain name as the address for a website[82]. However, during the AGP, the new owner can drop the domain name for any reason, without charge. If the new owner does not drop the name by the end of the AGP, it must pay the registration fee for that domain name. The implementation of the AGP, which was meant to protect registrars and registrants from mistakes and

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[81] *Available at:* https://en.wikipedia.org/wiki/Domain_tasting (Accessed on 02.09.2016).

[82] Press Release, World Intellectual Prop. Org., Cybersquatting Remains on the Rise with Further Risk to Trademark from New Registration Practices (March 12, 2007) [hereinafter WIPO Press Release], *available at:* http://www. wipo.int/pressroom/en/articles/2007/ article_0014.html (Accessed on 02.09.2016).

fraud in the registration process, has led to the unintended consequence of domain tasting. According to the World Intellectual Property Organization (WIPO), domain name tasting is a practice in which a person or entity (who may be affiliated with a registrar) registers a domain name for a five-day grace period without payment of the registration fee, and parks it on a pay-per-click website monitored for revenue, whereupon the name is dropped or re-registered by a new registrant, thereby starting a new grace period. Only those domain names generating significant traffic are permanently registered.

Thus registrants of domain name are generally given a five-day grace period between the time a registration of domain name and the payment for owning the domain name is due. The central idea behind it is to permit registrants to fix mistakes, like accidentally misspelling a new domain name.

In *Verizon California, Inc. v. Navigation Catalyst Systems, Inc*[83], the United States District court concluded that the tasting of domain names that are confusingly similar to a trademark violates the Anticybersquatting Consumer Protection Act. At the same time, however, the court declined to enjoin the use of an automated search and registration process, even where the plaintiffs claimed that such process is "uncontrolled and ineffective" in preventing the registration of infringing domain names. The further rejected defendants' argument that domain tasting does not constitute "registration" for purposes of the Anticybersquatting Consumer Protection Act (ACPA), noting that "'reserving' versus 'registering' is a distinction without a difference— either here entitles Defendants to the exclusive control and use of the names at issue, at least for some period of time." In any event, the court concluded that the defendants' use of those domain names during the AGP by hosting websites "using the challenged domain names, on which were posted paid advertising links to other websites, in some instances selling products in direct competition with plaintiffs," satisfied the statutory requirements of the ACPA.

[83] Verizon Cal., Inc., No. CV 08 2463 (C.D. Cal. June 30, 2008), *available at*: http://docs.justia.com/cases/federal/district-courts/california/cacdce/:2008cv02463/413394 /32/0.pdf (Accessed on 02.09.2016).

VeriSign observed in January 2007, that among the top 10 domain registrars, domain tasting was liable for 95% of all deleted.net and.com domain names[84].

In April 2006, 35 million registrations were made out of which only a little more than 2 million were actually purchased. The CEO of Go Daddy[85] in February 2007 reported that out of 55.1 million domain names registrations, 51.5 million were cancelled and refunded just before the expiration of five-day grace period and only 3.6 million domain names were actually purchased[86]. ICANN, the organisation that oversees the domain name system, is of the opinion that domain tasting could lead to destabilisation of the Domain Name System (DNS), greater consumer confusion, increased costs and burdens on legitimate registrants, and the facilitation of trademark abuse and criminal activity.

When the number of domain names being tasted increases, it will also increase the level of difficulty for trademark owners to protect their marks. Although it appears that the courts are willing to find that domain tasting falls within the scope of trademark. In its report[87], ICANN has concluded that domain name tasting is down 99.7% since it implemented new policies to thwart it. The new policies limited the number of domains a Registrar could return for a refund. This changed the domain tasting model on its head and eliminated most tasting activities overnight.

5.6.6. Domain name front running

In January 2008, Network Solutions was accused of this practice when the company began reserving all domain names searched on their website for five days, a practice known as domain name front running[88].

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[84] Thomas Clabum, Google Takes Aim At Domain Tasting Profiteers, *available at:* http://www.informationweek.com/news/intemet/webdev/showArticle.jhtml?article ID= 20 5918984 (Accessed on 04.09.2016).

[85] "GoDaddy.com is the world's largest domain name registrar" About GoDaddy.com *available at:* https://www.godaddy.com/gdshop/about.asp?app%5Fhdr=&ci=4632 (Accessed on 04.09.2016).

[86] Bob Parsons, *Why It's getting harder To Get The Domain Names You Want*... Go Daddy Rescues Registerfly Customers, *available at:* http://www.bobparsons.me/147/why-getting-harder-get-domainnames-want-godaddy-rescues-registerfly%20customers.html (Accessed on 04.09.2016).

[87] ICANN Status Report To The GNSO Council On AGP Limits Policy Implementation, *available at:*http://icann.org/en/announcements/announcement-16dec09-en.htm.(Accessed on 06.09.2016).

[88] *Available at:* https://en.wikipedia.org/wiki/Domain_ name front running (Accessed on 06.09.2016).

It is an another disturbing trend related to domain tasting has been observed in the form of Domain Name Front Running wherein a domain name Registrar uses insider information to register domains for the purpose of re-selling them, or earning revenue via advertisements placed on the website landing page. By registering the domains, the Registrar locks out other potential Registrars from selling the domain to a customer. The Registrar typically takes advantage of the 5-day grace period, where the domain can be locked without payment.

The practice of Domain Name Front Running also has ICANN worried, when in October 2007, the organisation begun an investigation into the accusations that some insiders may be using inside information to collect data and purchase unregistered domain names that get a lot of DNS lookup requests – nonexistent domains that surfers frequently try to access[89].

5.6.7. Domain Kiting

Domain kiting is the process of deleting a domain name during the five day grace period and immediately reregistering it for another five day period. This process is repeated any number of times with the end result of having the domain registered without having to pay for it[90].

The practice of registering over and over again and deleting a domain name so that the registrant can, in effect, own the domain name without paying for it is called Domain kiting. Just like Domain tasting, Domain kiting also exploits the five-day add grace period (AGP) in the domain name registration system[91].

Bob Parsons, CEO of GoDaddy.com[92], observed that

"*Those involved in domain kiting, unlike domain tasting, essentially never pay the registration fee for any of their websites. Instead, they continually cancel each registration with the five-day grace period and then renew the*

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[89] Jacqui Cheng, ICANN Probing "insider trading" Allegations with Domain Name Registrations *available at:* http://arstechnica.com/old/content/2007/10/icann-probing-insider-trading-allegations-withdomain-name-registrations.ars (Accessed on 06.09.2016).

[90] *Available at:* https://en.wikipedia.org/wiki/Domain_kiting (Accessed on 06.09.2016).

[91] What is domain kiting? - Definition from WhatIs.com *available at* : whatis.techtarget .com/ definition/domain-kiting (Accessed on 07.09.2016).

[92] "GoDaddy.com is the world's largest domain name registrar " About GoDaddy.com, *available at:* https:// www.godaddy.com/gdshop/about.asp?app% 5Fhdr=&ci= 4632 (Accessed on 06.09.2016).

same name repeatedly, thus running a more or less continuous website that always falls within the AGP"[93].

Parsons further observed, "Domain tasters and kiters overlap when a domain name is "in particular profitable.[94]" Parsons is of the view that sometimes domain kiters who find that websites producing more profits than its minimal cost of registration may opt to pay the registration fee rather than peril of losing the website altogether while trying their typical kiting strategy of cancellation and renewal of domain name registration within the five day grace period. For the purposes of this research it is not necessary to make a distinction between domain name Kiting and Domain name tasting.

Hence, Domain Kiting is the outcome of Domain Tasting where the registrant cancels his domain name registration just before the five day grace period expires, and again re-registers his domain name. By repeating this process endlessly, payment for the domain name registration is postponed for an indefinite period and however the registrant at the same time is making money with the domain name.

In a related development, Google has introduced (on February 11, 2008) a new technology called 'secret sauce' in order to both spot and stop corrupt profiteer from domain kiting using Google AdSense advertisements. By restraining registrants from making money from websites unless they are at least five days old, Google wanted to prevent Domain Kiting even at the cost of revenue.

5.6.8. Gripe / Protest Websites

Gripe / Protest websites are a used as an instrument to register protests against any alleged shortcoming of the original website or against a brand name, in general. These sites are also known as "sucks" or "complaint" sites. The low cost public platform is provided by the Internet for anyone, to reach a worldwide audience by means of a "gripe" website. The Internet gives common persons the chance to publicly criticise the powerful and rich, including multinational corporations. Time

[93] Creating The Term "Domain Kiting" And Explaining How It Works And Why It Is A Problem *available at:* Hot Points Blog,http://www.bobparsons.com/DomainKiting. html (Accessed on 07.09.2016).

[94] Creating The Term "Domain Kiting" And Explaining How It Works And Why It Is A Problem, *available at:* Hot Points Blog,http://www.bobparsons.com/ Domain Kiting. html (Accessed on 07.09.2016).

and money is invested in the hope of gaining satisfaction by airing a perceived grievance and embarrassing the party which is the target of the "gripe".

Typically, the domain names of such websites are formed by suffixing words, like ‘sucks’, ‘I hate’, and other similar phrases, to the name of the original website. For example, www.facebooksucks.com could be a gripe / protest website of www.facebook.com. Similarly, ihateyahoo.com could be a gripe / protest website for yahoo.com.

The following definition of a "gripe site" is from comments authored by a notable American lawyer, Paul Levy[95], and published online by Public Citizen, a Washington, D.C. based organization founded in 1971 by Ralph Nader:

> *"A 'gripe site' is a web site established to condemn an institution such as a political figure, union, government body, or corporation. Not surprisingly, powerful institutions often do not take kindly to being condemned, and they have invented a number of ways to try to suppress the speech of their adversaries[96]."*

In *FMR Corp. v. Native American Warrior Society*[97], The panellist Lamar Sneed, WIPO Case No. D2004-0978 (January 20, 2005), distinguished between “gripe-plus” sites and “pure” gripe sites:

> *“Gripe-plus sites present other evidence of bad faith, either intrinsically (such as offering competing goods for sale) or extrinsically (such as the registrant’s offering to sell the domain name to the trademark owner at a profit),Pure gripe sites are those that present no indicia of bad faith beyond the fact that they are highly critical of the target.. . . The weight of United States judicial opinion under the ACPA, however, is that a pure gripe site does not demonstrate a ‘bad faith intent to profit,’ even when it uses a trademark.TLD domain name or a domain name that is confusingly similar to the plaintiff’s trademark”.*

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[95] Levy is also a lawyer within the associated Public Citizen Litigation Group, another non profit making organization. He is the founder of the groups “Public Internet Free Speech Project”.

[96] *Available at:* https://en.wikipedia.org/wiki/Gripe_site (Accessed on 07.09.2016).

[97] *Available at:* https://www.jw.com/wp-content/uploads/2016/05/1276.pdf (Accessed on 07.09.2016).

Thus according to above, it is necessary to make a determination while deciding cases relating to “Gripe sites” whether the registrant acted with a bad faith intent to profit.

An important case relating to Gripe Site is *People for the Ethical Treatment of Animals v. Doughney* (PETA)[98], where the Fourth Circuit found the bad faith element was fulfilled: (1) there was a clear intent to sell peta.org to PETA and (2) the registrant had registered 50-60 domain names,.

In one more case on this point is *Coca-Cola Co. v. Purdy*[99]*;* the bad faith element was satisfied where the evidences showed:

(1) Almost 70 domain names were registered by the registrant,

(2) the website provided links to sites that solicit funds for the antiabortion movement (the registrant’s organization of choice) and sell merchandise ,

(3) there was an offer to stop using the mark if the trademark owner published the registrant’s opinion piece on its editorial page, and

(4) there was evidences of actual confusion.

The Court is of the opinion that at least eight of the ACPA’s bad faith factors are in favour of the trademark holder.

The European Courts and U.S. have repeatedly held the use of trademark in Gripe / Protest websites illegal and restored the infringing domain name to the original holder of the mark. The cases include domain names, like:

(i) Wal-MartCanadaSucks.com[100];

(ii) FreeserveSucks.com[101];

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[98] 263 F.3d 359, 362,368 (4th Cir. 2001) *available at:* https://www.jw.com/wp-content/uploads /2016/05/ 1276.pdf (Accessed on 08.09.2016).

[99] 382 F.3d 774, 776 (8th Cir. 2004) *available at:* https://www.jw.com/wp-content/ uploads /2 016/05/ 1276.pdf (Accessed on 08.09.2016).

[100] WIPO Case No. D2000-0477, *available at:* http://www.wipo.int/amc/en/domains/ decisions/ html/2000/ d2000-0477.html (Accessed on 08.09.2016).

[101] WIPO Case No. D 2000-0585, *available at*: http://www.wipo.int/amc/en/ domains /decisions/html/ 2000 /d2000-0585.html (Accessed on 08.09.2016).

(iii) DixonSucks.com[102];

(iv) NatWestSucks.com[103];

(v) DirectLineSucks.com[104].

5.6.9. 'Url' Path

A Uniform Resource Locator (URL), commonly informally termed a web address (a term which is not defined identically) is a reference to a web resource that specifies its location on a computer network and a mechanism for retrieving it. A URL is a specific type of Uniform Resource Identifier (URI), although many people use the two terms interchangeably. A URL implies the means to access an indicated resource, which is not true of every URI. URLs occur most commonly to reference web pages (http), but are also used for file transfer (ftp), email (mailto), database access (JDBC), and many other applications[105].

Most web browsers display the URL of a web page above the page in an address bar. A typical URL could have the form http://www.example.com/index.html , which indicates a protocol (http), a hostname (www.example.com), and a file name (index.html)[106].

It is an another trademark issue in the domain name litigation arises under the situation when someone uses a registered trademark, not in the main domain name but in the post-domain path of 'Url' so as to increase the number of visits to its webpage by such customers also who are aware about or searching the original trademark owner.

5.7. Concluding Remarks

From the above discussion now 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

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[102] WIPO Case No. D 2000-0584, *available at*: http://www.wipo.int/amc/en/domains/ decisions /html/2000 /d2000-0584.html (Accessed on 08.09.2016).
[103] *Ibid.*
[104] *Ibid.*
[105] *Available at:* https://en.wikipedia.org/wiki/Uniform_Resource_Locato (Accessed on 08.09.2016).
[106] *Ibid.*

flooding of courts with competing claims from the trademark holders and the original registrants of domain names. 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 needs legal protection.

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 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.

Therefore, in the coming chapters, along with the applicable international rules and national legislations, some of the landmark decisions from the courts at national as well as international level for the protection of domain names have been discussed in order to understand the development of law relating to domain names as applied in addressing domain name disputes in cyberspace.

Chapter-6

Legislative and Judicial Approach towards the Domain Name Disputes: A Study of U.K., U.S.A., and Indian Legal System

6.1. Introduction

As discussed in the preceding chapter, universal nature of domain name disputes has led to flooding of courts with competing claims from the trade mark holders and the original domain names registrants. Undoubtedly Judiciary, around the globe, is playing a pivotal role in the development and improvement of the internet jurisdiction. However, judiciary is not the only one in its endeavours to reign in digital violations and digital wrongs.

As already highlighted in the previous chapter, most of the cases pertaining to trademark violation in cyberspace relate to the misuse and abuse of Domain Name System (DNS) registration process. It was natural that some mechanism, also initiated for protection of domain name registrants as well as the trade mark owners.

In most countries, legislation was not enough fast 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 protection.

Several countries, including India, have tried to expand the scope of traditional trademark law to the online world through amendments and judicial outreach. Nations trying to address domain name disputes by suitably introducing new legislations and enlarging the scopes of existing ones through judicial activism.

However, legislative and judicial response is not enough to tackle the cyber-crimes and cyber-wrongs. Alternative dispute resolution mechanism devised by International entities is also playing a major role in addressing the legal issues arising out of domain name disputes.

Therefore, it is pertinent to go through, along with the applicable legislations, some of the landmark decisions and alternative dispute resolution mechanism both at International and National level as applied in addressing domain name disputes in cyberspace in order to find whether they are conferring the protection to the domain names in the world or not.

Let us first talk about the legislative measures taken up by different countries for the protection of domain names. It is to be noted that, United States of America has taken lead in deal with disputes relating to domain name by suitably introducing new legislations and expanding the horizons of existing trade mark legislation through judicial activism. The U.S.A's. and U.K's. courts are largely responsible for the emergence of cyber jurisprudence in the global context.

Therefore, in the coming paragraphs, 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 growth of judicial mind as applied in for the protection of domain names. The Alternative dispute resolution mechanism at national as well as International level will be discussed separately in the next chapter.

6.2. United Kingdom (U.K.)

Let us first see what UK's trademark law has to offer to the situation. 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[1].

Essentially, there are two possible legal grounds on which the courts in the U.K. relies in addressing domain name disputes.

1. Trademark Infringement, and
2. Passing-off.

6.2.1. Trademark Infringement

In order to constitute trademark infringement, the three conditions should meet:

- Confusing similarity
- Bad faith
- No rights and legitimate interests

[1]Lilian Edwards and Charlotte Waelde (eds.), *Law and the Internet: A Framework for Electronic Commerce* 136 (Hart 2000).

As already discussed, the domain names have similarities of trademarks and are capable of being infringed[2]. Section 10 (1), 10 (2) and 10(3) of Trademarks Act 1994[3], (Hereinafter referred as TMA) deals with the question of trademark's violation. The relations of these sections with domain names are examined below in detail:

Section 10(1) Trademarks Act, 1994

Section 10(1) of TMA states that-*"A person infringes a registered trade mark if he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered"*[4].

Thus in order to establish violation of trademark under this section, the domain name is required to fulfil the following conditions:

(A) domain name which is in question must identical /similar to the registered trademark.

(B) the domain name is used in the normal course of business.

(C) such use is in a relation to identical services or goods for which trademark is registered.

For the purpose of better understanding of this section, it is important to understand the terms "identical mark'/dentical goods or services".

- **Identical Mark**

It is to be noted here that in order to prove violation, the term "identical" does not mean "absolutely identical"[5]. For example, in the case of

[2] The TMA is not explicit in deciding whether the registration of a domain name incorporating a registered trademark amounts to trademark infringement.
[3] Already discussed in detail in chapter- 2.
[4] Section 10(1) of Trademarks Act, 1994.
[5] Mohammad S Al Ramahi, *Internet Domain Names & Trademark Law: Does the Current Legal Scheme Provide Adequate Protection to Domain Names under the US & the UK Jurisdictions?* 17 (British and Irish Law Education Technology Association, 2006).

Compass Publishing v Compass Logistics[6], the Laddie J held that "Compass Logistics" cannot be held identical to "Compass" and held that-

> "*Identity exists where the marks look and sound identical save to the eye or ear of an expert. Differences which ordinary members of the public will not notice...can be ignored*"[7].

- **Identical Goods or Services**

It is Not the mark only, but also the goods and services of the alleged violator must be identical, to be considered liable under this section.

In *Avnet v. Isoact*[8], in this case the plaintiffs contended that the defendants' act of using the term 'Avnet' in the domain name in relation to similar services amounted to trademark infringement and falls within the preview of Section 10(1) of the TMA and applied for summary trial. The court held that as the services provided by the defendants are not identical or similar to those of the plaintiffs, the case does not fall under sec 10(1), TMA, hence there was no infringement of the trademark The court's ruling in this case makes it clear that the ownership of a registered trademark does not necessarily give rise to a domain name incorporating the same mark unless the goods or services covered in the registration are the same as those trading online. This case can be seen as one of domain name envy[9].

Section 10(2) Trademarks Act, 1994

The section laid down that a registered trademark is infringed when:

> "*a person may infringe a registered trademark if he uses in the course of trade a sign where because –*
>
> *(a) the sign is identical with the trademark and is used in relation to goods or services similar to those for which the trademark is registered, or*

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[6] [2004] EWHC 520 (Ch), *available at:* https://www.researchgate.net/publication/30992565_COMPASS_PUBLISHING_BV_v_COMPASS_LOGISTICS_LTD (Accessed on 16.09.2016).
[7] *Ibid.*
[8] Charlotte Waelde, Abbe Brown, et.al., *Contemporary Intellectual Property: Law and Policy,*718 (Oxford University Press,4th edn.,2016).
[9] Lilian Edwards, s*upra* note 1 at 138.

(b) the sign is similar to the trademark and is used in relation to goods or services identical with or similar to those for which the trademark is registered; there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.[10]*"*

The above section provides the condition of 'likelihood of confusion' along with extending the 'similar' to 'identical' marks, services and goods. Typosquatting would fall under this section as the main aim of the typosquatter is to make confusion in the mind of the peoples.

In order to analyse whether a domain name has amount to trademark infringement, the following four steps are to be followed:

(A) Whether the domain name and the registered trademark are identical or similar?

(B) If they are similar, whether the domain name is used in the normal course of trade?

(C) Whether the goods or services provided under the domain name and that of registered trademark are identical or similar?

(D) If the goods or services provided under the domain name and the registered trademark are not identical or similar, no infringement of trademark is established, and if they are identical, whether it will cause confusion to the people?

In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*[11], the ECJ held that the distinctive character of the trademark and in particular its goodwill plays the most important role in determining whether the act had amounted to infringement under this section and said :

"The more distinctive the mark and the greater its reputation, the wider the ambit of goods and services which should be considered similar to those represented by the mark, which are therefore more likely to give rise to a likelihood of confusion. Thus, a mark which is distinctive and has a reputation

[10] Section 10(2) Trademarks Act, 1994 *available at:* http://www.legislation.gov.uk/ukpga/1994/26 /section/10 (Accessed on 16.09.2016).
[11] [1998] All ER (EC (934) as cited in Lilian Edwards, *supra* note 1 at 141.

will have protection over wide range of goods; a weak mark will have protection over a narrow range of goods. "

Also, in the case of *Avnet Inc v Isoact Limited* (discussed above), the services of both parties cannot supposed to be 'identical' but they were similar and thus, the infringement had not happened under not 10(1) of TMA as claimed but occurred in Section 10 (2). The confusion arises the moment the search engine turn in hits and does not require accessing the website. Therefore, on comparing both the sections, it can be said that section 10(1) is a much narrower and difficult to claim protection than section 10(2).

Section 10(3) Trademarks Act, 1994

A trademark is infringed when:

"*...where the trade mark has a reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.*[12]*"*

Therefore, the questions that need to be settled in a case under Section 10(3) are:

(A) Whether the reputation of the trademark is breached?

(B) Whether the use of domain name is without due course and gets unjust advantage of, or is damaging to, the distinctive character of the trademark?

One of the illustrated case on Section 10 (3) is the case of *L'Oreal S.A. v Bellure N.V and others*[13] where the respondent was included in assembling and selling the fragrances that smelled alike L'Oreal and were sold in packing that took like L'Oreal' packing.. The Court held that the respondent was liable under Section 10(3) TMA as it has infringed L'Oreal's trademark and took unreasonable advantage of L'Oreal's goodwill.

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[12] Section 10(3), Trademarks Act, 1994 *available at:* http://www.legislation .gov. uk/ukpga /1994/26/ section/10 (Accessed on 16.09.2016).

[13] [2010] EWCA Civ 535 *available at:*http://www.5rb.com/case/loreal-s-a-v-bellure-n-v-and-others-2/ (Accessed on 18.09.2016).

6.2.2. Passing Off

As already been discussed in chapter two, the tort of passing-off was visualized by the U.K. courts so to protect all those unregistered marks registered. It follows that if a person asserting to utilize and possess a space name however doesn't has registered trademark; then he may turn to the "passing-off" a common law remedy.

When a party seeks to prevent the use of a domain name, but doesn't possess a registered trademark, in that case they may invoke the tort of passing off which has the capacity to protect unregistered marks.

For a claim of alleged passing-off to succeed, in *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd*[14] Lord Diplock laid down the five requirements

- There must be a representation;
- The representation was made in the 'course of business;
- The representation must be made to likely customers of his or ultimate consumers of services or goods supplied by him;
- The representation was intended to injure the goodwill or business of another trader;
- The representation had resulted in real damage to the business or reputation of the trader who brought the suit or is likely to do so.

However, the modem formulation of the tort requires the plaintiff to satisfy the "classic trinity" test laid down by Lord Oliver in *Reckitt & Colman Products Ltd v Borden Inc*[15]. In this case the plaintiffs were in the business of selling lemon juice in yellow coloured lemon shaped squeeze packets, with 'Jif' embossed and printed on it. Therefore, the manufactured goods were popularly identified as 'Jif lemon'. The defendants also launched a identical goods which was sold in similar packet with small contrast in quantity and colours.

[14][1979] A.C. 731 at 742 *available at:* wikivisually.com/wiki/Erven_Warnink_ BV _v _ J_ Townend _%26_Sons_ (Hull)_Ltd. (Accessed on 18.09.2016).

[15] (1990) 1 WLR 491, *as cited in* Amanda Michaels, *A Practical Guide to Trade Mark Law* 4.41(Sweet & Maxwell, 2002).

The significance of this case is that Lord Oliver set out the "classic trinity" rule which implies the claimant have to show that the following elements in order to claim a right of action[16]:

- "The services or goods have a separate get up that has become linked with the product in the minds of considerable numbers of the buyers."
- "Whether deliberately or not deliberately, there has been a misrepresentation of the services and goods of the complainant, which have driven public to trust that the origin of the product is the claimant."
- "The claimant may experience the damages if the misrepresentation continues."

Agreeing that all the three conditions were satisfied, the House of Lords issued a permanent injunction[17] on the defendants barring them from selling lemon juice in lemon shaped packets.

6.2.3. U.K. Courts on Domain Name Disputes

The U.K. courts have played a pivotal role in the emergence and progress of international measures in curbing domain name disputes. Following are the most relevant cases discussed here in order to analyse the opinion of U.K. judges on trademark issues in domain name cases.

In *Harrods Limited v. UK Network Services Limited & Others*[18], the defendants, registrants of domain name *harrods.com*, were held responsible at interlocutory level for trademark infringement and passing-off. Harrods, the renowned extravagance retail chain, contended that the "Harrods" trademark was a well known mark which would endure harm to its goodwill or dilution if utilized by the rival in an domain name, to which they had no legal association or legitimate interest. This case drove the NSI to consent to take after the decision of the U.K. court and transferred the domain name to the offended party.

[16] *Ibid.*
[17] An injunction to restrain wrongful acts, which are threatened or imminent but have not yet been commenced.
[18] Chancery Division, 9December 1996, *available at:* www.domaindisputes.co.za/ downloads / Nomi netCases /HarrodsvNetworkServices.pdf (Accessed on 19.09.2016).

In *British Telecommunications PLC; Virgin Enterprises Ltd.; J Sainsbury PLC; Marks & Spencer PLC and Ladbroke Group PLC v. One In A Million Ltd. and Others*[19], the defendants registered various famous trademarks as domain names without the permission of the plaintiffs (trademark holders) with the intent of extorting money from them. For example, they registered a domain name "burgerking.co.uk", and offered it to Burger King who enjoyed the goodwill in the name and was also owner of trademark, for £25,000 plus VAT. In the same way, defendant also registered "bt.org", offered to sell it to British Telecommunications for £4,700 plus VAT. Holding the actions of defendant as an act of passing-off of the plaintiffs' famous registered trademarks, or threat of passing-off and violation, Mr Jonathan Sumption QC, sitting as deputy High Court Judge, ordered an injunction restraining One In A Million from selling or using the names and ordered the domain names to be given back to the respective plaintiffs. Mr. Sumption J. observed:

> *"One In A Million's conduct was undoubtedly calculated to infringe the plaintiffs rights in future. ...There is only one possible reason why anyone who was not part of the Marks & Spencer Pic group should wish to use such a domain address, and that is to pass himself off as part of that group or his products off as theirs. Where the value of a name consists solely in its resemblance to the name or trademark of another enterprise, the court will normally assume that the public is likely to be deceived, for why else would the defendants choose it?...Someone seeking or coming upon a website called http://marksandspencer.co.uk would naturally assume that it was that of the plaintiffs."*

The Court of Appeal held that the plaintiff had goodwill in the challenged name, that there was a probability of confusion with respect to the purchasers relating to the ownership of the domain name and a danger of damage to the goodwill or business of the appellant trademark owner resulting from this confusion. In spite of the fact that the litigants more than once declared that they had no aim to utilize the names in the course of trade, the court, in what has all the earmarks of being an

[19] [1998] Court of Appeal, July 23, 1998, *available at: avocat.blogs.com/avocatblog/2004/12/domain_names_in.html* (Accessed on 19.09.2016).

approach choice, fulfilled itself that the prerequisites for passing off were met and held the respondents to be furnished with instruments of misrepresentation.

In *Avnet v. Isoact*[20], The court's ruling in this case makes it clear that the ownership of a registered trademark does not necessarily give rise to a domain name incorporating the same mark unless the goods or services covered in the registration are the same as those trading online.

6.3. United States of America (U.S.A.)

In early days 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)[21] incorporated into the U.S. Trademark Act of 1946 ("Lanham Act")[22].

The most important piece of legislation dealing with trademarks' violation in the U.S. has been the Lanham Act, which inter alia prohibits a various activities, including false advertising, trademark dilution and trademark infringement.

6.3.1. Lanham Act, 1946

Lanham Act[23] defines the term "trademark" as "name, symbol or word, device, or any combinations thereof used by a manufacturer or seller of goods to identify and distinguish their products from those made or sold by others[24]. The Lanham Act's legislative history of reveals that Congress intended the Act to fulfil a twin purpose:

(1) to protect a trade's goodwill in its trademark; and

(2) to protect a person's ability of distinguishing goods from other goods

The Lanham Act suggests trademark owner's three major causes of action to safeguard their rights relating to trademark:

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[20] [1998] F.S.R. 16 *as cited in* Charlotte Waelde, Abbe Brown, et.al., *Contemporary Intellectual Property: Law and Policy,*718 (Oxford University Press,4th edn.,2016).

[21] Federal Trademark Dilution Act, 1995, Pub. L. No. 104–98, 109 Stat. 985 (1996) codified as amended at 15 of the United States Code (U.S.C). § 1125(c).

[22] Codified in chapter 22 of title 15 of the United States Code.

[23] Discussed in detail in the chapter- 2 of the thesis.

[24] 15 U.S.C. Section 1127 (2000).

(1) infringement of trademark,

(2) unfair competition, and

(3) dilution.

The Lanham Act's Section 32(1)[25] protects owners of registered mark against the use of their trademarks in cases of possibility of confusion as to the origin of the services and goods. However this protection was on occasion become hard to apply in cybersquatting cases because in most of the cases cybersquatters never tried to confuse anyone as to the origin of any services or goods. As mentioned, cybersquatters time and again abstained from posting any information under their registered domain since their intent was ultimately to sell the domains names for profit[26].

The Lanham Act's Section 43(a)[27] protects owner's mark (including those of unregistered marks) against confusion and bogus advertising as to the origin, affiliation and sponsorship of services and goods. In both cases, the hallmarks of trademark protection lie in the principles of its "use in commerce"/"trademark use.[28]" and "likelihood of confusion"[29]. Showing probability of confusion and trademark use by infringer forms the fundamental reason for any infringement claim under the Lanham Act. Plaintiffs looking to bring infringement claims in cybersquatting cases confronted unique troubles meeting these necessities.

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[25] Codified in chapter 22 of title 15 of the United States Code.

[26] J. Thomas McCarthy, *Trademarks, Cybersquatters and Domain Names* 231, 245 (10 DePaul-LCA J. Art & Ent. L. & Pol'y, 2000). "Generally cybersquatter has no interest in using the domain name for the identification of a website. The cybersquatter only wants to hold the name and deprive the legal owner of its use, releasing it only for a cost." *as cited in* "A Barcelona.com Analysis: Toward a Better Model for Adjudication of International Domain Name Disputes" by Zohar Efroni *available at:* http://ir.lawnet.fordham.edu/ cgi/viewcontent.cgi?article=1299&context=iplj

[27] 15 U.S.C. § 1125(a).

[28] Use requirement comes into play in two distinguishable contexts. Firstly, "use in commerce" is used in connection with acquiring and maintaining rights in the mark-by-mark holders. Secondly, trademark use in commercial setting by alleged infringer is required to establish *prima facie* infringement claim.

[29] See, *Qualitex Co. v. Jacobson Prods. Co*., 514 U.S. 159, 163–164 (1995). Trademark law protects consumers from a probability of confusion with regards to the source of products, and furthermore guarantees that mark owners will receive the monetary rewards of products bearing their marks); Anahid Chalikian, Comment, Cybersquatting, 3 J. Legal Advoc. & Prac. 106, 107 (2001).

Though Lanham Act does not cover specific cases of domain name disputes leading to trademark infringement, yet old case law remains relevant to assessing whether an unauthorised use of a trademark on the Internet is an infringement.

In *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*[30], the Ninth Circuit held that registration of a domain name for a website does not trump long-established principles of trademark law. This decision, the first by a circuit court on the issue of trademark infringement via domain name use, affirms the precedence of trademark law over Internet customs and practices. The plaintiff was using the term "moviebuff' for computer software containing a database of information on the entertainment industry. It filed for registration of the "moviebuff' trademark on August 19, 1997. The defendant, one of the United States' largest video rental stores, used the term "movie buff' as part of its service mark, "The Movie Buffs Movie Store," for which it obtained a Federal trademark registration in 1991. It also used the "movie buff' phrase extensively in its advertising since 1988. It registered the domain name moviebuff.com with NSI in 1996. When plaintiff tried to register moviebuff.com it could not do so because defendant already had it registered. However, when the plaintiff came to know that the defendant intended to use the website to provide a searchable database on entertainment similar to plaintiff's software product, it filed a suit in the Central District of California, requesting an injunction.

The District Court refused to grant the injunction, holding that the defendant was senior user of the "moviebuff" mark because of its registration of the phrase, "The Movie Buffs Movie Store," which it had used since 1986, and that it had senior Common Law rights as well. Reversing the District Court's findings, the Appellate Court enjoined the defendant from using, or facilitating the use of the mark "moviebuff', or any other term(s) likely to cause confusion, including @moviebuff.com or moviebuff.com, as the name of defendant's website service, in buried code or Meta tags on its home page or web pages, or in connection with the retrieval of data or information on other goods or services.

[30] 174 F.3d 1036 (9th Cir. 1999) *as cited in* Paul Siegel, *Communication Law in America* 452(Rowman & Littlefield, 2011).

Defendant's first argument was that its long use of "The Movie Buffs Movie Store" should be "tacked" onto its admittedly more recent use of "moviebuff.com," thereby, making the defendant the senior user of the mark. The court, however, considered plaintiff as the senior user of "moviebuff ' mark, since it began using the term on its software prior to defendant's use of "moviebuff.com."

Defendant's belated claim that "moviebuff' is confusingly similar to "The Movie Buffs Movies Store" was rejected by the court due to the long, concurrent use of the marks without any confusion.

6.3.2. Federal Trademark Dilution Act 1995 (FTDA)

In this context, the FTDA seemed more effective a tool to combat abusive registrations, injunctive relief is provided to famous marks owners against infringement of the distinctive quality of the mark[31]. Infringement may occur either as a result of "tarnishment" or "blurring" of the well known mark[32]. Under the FTDA, the mark owners have one benefit that is they are not required to prove likelihood of consumer confusion in infringement claims. Yet, the "use in commerce" requirement for infringement actions remained intact[33].

In applying customary trademark dilution principles or trademark law tests to cybersquatting cases, the primary question was whether use of the mark in a domain name may at all amount to trademark dilution or infringement.

In order to understand this issue, courts tried to include trademark dilution and infringement principles into domain name disputes, identifying the twin purpose of domain names in the modern world of commerce.

[31] § 43 (15 U.S.C. § 1125).

[32] Trademark Dilution Revision Act of 2006 has provided definitions to "tarnishment" and "blurring." Trademark Dilution Revision Act of 2006, H.R. 683, 109th Cong. (2006), §§ 2(2) (B)–(C).

[33] 15 U.S.C § 1125(c) (1).The current version of the statute states: The owner of a famous/well known mark shall be entitled to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous/well-known and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection. The Amendment noted above revises section 1125 but does not alter the principal trademark use requirement.

The "likelihood of confusion" test established by the judicial process while interpreting Lanham Act was supplemented by FTDA, which was further amended by Trademark Dilution Revision Act of 2006 (TDRA).

Senator Patrick Leahy stated that the purpose of FTDA is to:- "*help stem the use of deceptive Internet addresses taken by those who are choosing marks that are associated with the products and reputations of others*[34]."

In *Avon Products., Inc. v. Carnetta Wong*[35], the plaintiff filed a claim in just two and half weeks after the FTDA was signed into law alleging trademark dilution, after defendants, Carnetta Wong and David Lew, had registered "avon.com" and attempted to extort "a very large, but unspecified sum" of money in exchange for the domain name. Prior to this case was heard in court, plaintiff sought action through NSI's dispute policy. NSI ended Lew's registration and granted it to Avon. This case was memorable for two reasons:

(a) it was an illustration of a suit filed under the newly enacted FTDA, and

(b) this case did not have to resort to the court system; thereby, adding up another effective mechanism against possible squatters.

In *Ringling Bros. Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev*.[36],the Fourth Circuit laid down the following criterion for determining dilution of trademark: (1) defendants have made use of a junior mark sufficiently similar to the famous mark to evoke, in a relevant universe of consumers, a mental association of the two that (2) has caused (3) actual economic harm to the famous mark's economic value by lessening its former selling power as an advertising agent for its goods and services. In this case, the phrase "Greatest Snow on Earth" was held not to dilute plaintiffs mark "The Greatest Show on Earth". Unlike trademark

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[34] G. Peter Albert, Jr., Right on The Mark: Defining The Nexus Between Trademarks And Internet Domain Names, 15 J. MARSHALL L. REV. 277, 278 (1997) note 17, at 302, n.171 citing 141 CONG.REC. SI9, 312 (Dec. 29, 1995) as quoted in Matthew Edward Searing, What's In A Domain Name? – A Critical Analysis Of The National And International Impact On Domain Name Cybersquatting, *available at:* http://www.washbumlaw.edu/wlj/40-l/articles/searing-matthew.pdf. (Accessed on 16.10.2016).

[35] 984 F. Supp. 768 (S.D.N.Y. 1997) case opinion from the U.S. District Court for the Southern District of New York.

[36] 170 F.3d 449 (4th Cir. 1999) *available at:* https://www.law.berkeley.edu/.../bclt _Annual Review_ Ringling_Bros_Case_Summary(Accessed on 20.09.2016).

infringement test, the dilution doctrine does not require a likelihood of confusion. However, the protection granted by the dilution doctrine is limited to "famous" trademarks. In spite of the fact that ownership of a trademark does not entitle one to a corresponding Internet domain name, the FTDA recommends that no one else can use a domain name that relates to a "famous" mark.[37]"

Overall, the FTDA lists eight factors to use in determining if a mark is famous for purposes of the Act:

A. the extent and duration of use of the mark in connection with the goods or services with which the mark is used;
B. the degree of acquired or inherent distinctiveness of the mark;
C. whether the mark was registered;
D. the extent and duration of publicity and advertising of the mark;
E. the geographical extent of the trading area in which the mark is used;
F. the channels of trade for the goods or services with which the mark is used;
G. the extent and nature of use of the identical or similar marks by third parties; and
H. the extent of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is required [38].

The courts in U.S.A. have considered dilution of trademarks by domain names under three heads: (a) Dilution by Disparagement; (b) Dilution by Tarnishment; and (c) Dilution by Blurring. Dilution by blurring means 'the taking away of...the selling power and goodwill of an original mark by using a identical mark even if the products or services provided are not similar; thereby, generating in the mind of consumer a new association with the original mark[39]. Dilution by Disparagement may arise through typosquatting and registration of gripe sites. Dilution by tarnishment takes place where a mark is used by a third party in a way that is conflicting with the use of

[37] Jane Mulachy, Protecting Your Trademark, *available at* http://www.mercuryfrost.net/colr/editions/2003 /2003xiii.pdf. (Accessed on 25.09.2016).
[38] 15 U.S.C.A. Section 1125(c) (1) (West Supp.1996).
[39] *Toys R Us v Akkaoui*, 1996 U.S. Dist. Lexis 17090 (N.D. Cal. Oct.29, 1996) *available at:* www.internetlibrary.com/cases/lib_case246.cfm (Accessed on 01.10.2016).

the mark by its original owner such that the goodwill related with the original owner's mark becomes tarnished or degraded.

In *Clinique Laboratories, Inc. v. Dep. Corp*[40]., U.S. District Court for the Southern District of New York laid down five factors to find out if there is a blurring of the value and selling power of a mark by its unauthorised use: (a) similarity of the trademarks and trade dress; (b) similarity of the products; (c) renown of the junior mark and trade dress; (d) renown of the senior mark and trade dress; and (e) sophistication of consumers. FTDA also came in for criticism due to its ineffectiveness in dealing with the domain name disputes. For instance, defining "famous" is difficult when it comes to domain names[41].The criterion for fame is very high and the assessment is often subjective. Federal courts have held that to be famous under FTDA, a mark must be truly renowned and prominent, and therefore, most likely to be negatively affected by dilution[42].

Merely registering domain name does not constitute a commercial use. The domain name's non-commercial use that hampers a trademark owner's right to exploit the value of his trademark on the Internet will not constitute dilution. Thus, in cases where there is no sale of goods or services or advertisement on the Internet, the courts have to stretch the meaning of the statute so as to find commercial use and thus, establish dilution[43].

Moreover, FTDA does not specially forbid cybersquatting. If the cybersquatter does not try to sell domain names based on trademark to the original owner of the trademark, but rather prefers to restrain the trademark owner's use by sitting idle, it appears that the cybersquatter can hamper commercial use, and at the same time escapes liability under dilution.

[40] 1997 WL 583395 at 14-15, *available at:* law.justia.com/cases/federal/district-courts/FSupp/945/547/1457704/(Accessed on 01.10.2016).

[41] Stacy B. Sterling, New Age Bandits in Cyberspace: Domain Names Held Hostage on the Internet, 17 Loy. L.A. Ent. L. Rev. 733 (1997). *Available at*: http://digitalcommons.lmu.edu/elr/vol17/iss 3/10 (Accessed on 01.10.2016).

[42] *Avery Dennison Corp. v. Jerry Sumpton,* 189 F. 3d 868, 873 (9th Cir. 1999) , *available at:* www.internetlibrary.com/cases/lib_case221.cfm(Accessed on 03.10.2016).

[43] Jews For Jesus v. Brodsky,28 U.S.C. 1125 (c) (4)(supp. IV 1998) *available at:* https://cyber.harvard.edu/property/domain/jfj.html (Accessed on 03.10.2016).

6.3.3. The Anti-Cybersquatting Consumer Protection Act, 1999 (ACPA)

The trademark community's plea for new legislation has found receptive sentiments in Congress. Legislators were convinced that cybersquatting activities constituted a serious threat to American consumers, businesses, and e-commerce in general. They were also convinced that a new mechanism was needed to curb this threat. Spencer Abraham, at that time a Senator of Michigan, has pronounced the motivation for the new law:

> *"This legislation [ACPA] will fight a new form of high tech fraud that is causing inconvenience and confusion for consumers . . . and posing an massive threat to a century of pre-Internet American business efforts*[44]*."*

Congress concluded that the uncertainty as to the inconsistent judicial decisions, application of trademark law and the high legal cost required in order to thwart cybersquatters needed to be remedied[45]. There was no consensus on how to formulate this new law, however. During early stages of the Bill the White House objected the proposed new legislation; spokesperson Joe Lockhart observed that:

> *"We consider that basically we'd be walking down the wrong road if we legislate a cybersquatting law and then the 200 or so Internet using countries around the world started legislating their own rules and laws.*[46]*"*

Given the global nature of the Internet, the Administration favoured a more international approach to stop cybersquatting via ICANN. Criticism of the proposed legislation also came from civil libertarians who were concerned that statutory limitation on domain names would serve as a tool to suppress free speech on the Internet[47].

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[44] Peter K. Yu (ed.), *Intellectual Property and Information Wealth: Issues and Practices in Digital Age* 381 (Westport Connecticut London, 2007).
[45] *Ibid.*
[46] *Ibid.*
[47] See Aaron L. Melville, Legal Update, New Cybersquatting Law Brings Mixed Reactions from Trademark Owners, 6 B.U. J. Sci. & Tech. L. 13 (2000) (summarizing the objections to the ACPA).

The final result of Congress's efforts was the Anti-Cybersquatting Consumer Protection Act (ACPA) enacted on November 29, 1999[48]. The ACPA amended the Lanham Act by explicitly outlawing the act of trafficking in, registering, or using a domain name that is confusingly similar or identical to a mark or dilutive of a famous mark with bad intention of making profit[49]. The elements of this new violation are:-

I. the existence of a protected mark (registered or not, including a personal name),
II. with a bad faith to make profit from that action,
III. which, without consider to services and goods a related domain name was registered, trafficked, or used.

Hence, the ACPA secures distinctive marks against registration of domain names that are confusingly similar or identical. It additionally explicitly protects well-known marks against dilution growing from registrations of domain names[50]. Registration with bad intent drastically substituted the commercial "trademark use" requirement, where scienter of "bad faith" became a central requirement of the ACPA. The legislation offers a inclusive list of nine circumstances that may indicate such bad intent, though courts are at liberty to find bad faith also in other circumstances[51].

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[48]Anticybersquatting Consumer Protection Act of the Intellectual Property and Communications Omnibus Reform Act of 1999.

[49] 15 U.S.C. § 1125(d)(1)(A) (2004).

[50] Id. § 1125(d)(1)(A)(ii).

[51] Section 1125(d)(1)(B) provides:

(i) In determining whether a person has a bad faith intent described under subparagraph

(A), a court may consider factors such as, but not limited to—

(1) the trademark or other intellectual property rights of the person, if any, in the domain name;

(2) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(3) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(4) the person's bona fide non commercial or fair use of the mark in a site accessible under the domain name;

(5) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(6) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the

Another vital component of the ACPA is the foundation of *in rem* jurisdiction for cybersquatting violations. This provision permits mark owners to bring civil action against the domain name itself in the district of domain name's registration[52]. In particular, in rem action can be brought when the mark owner is unable to establish in personam jurisdiction, or is unable to locate the registrant through properly diligent efforts to find him or her. This provision was the legislative response to cases such as Porsche Cars North America, Inc. v. Porsch.com, where the court dismisses mark owner's complaint after refusing to exercise in rem jurisdiction under the FTDA when plaintiff discovers 128 registrations of domain names allegedly infringing on his mark, but could not locate the registrants[53].

As we have seen, test for unlawful cybersquatting under the ACPA is three-point. Registration of a domain name can be challenged when (i) protected mar is involved, (ii) with a bad faith intent to profit, (iii) which, without regard to services and goods, a corresponding domain name was trafficked, registered, or used. The chief innovations of the ACPA are the substitution of the "trademark use" requirement with bad faith registration and the likelihood of confusion test with the "identical or confusingly similar" standard. The ACPA may retroactively affect registrations made before its enactment (not applicable to money damages) and it stipulates a new set of remedies. In cases where the three-prong test is met, under the ACPA liability is generally imposed and owner of the mark may succeed in getting effective and powerful remedies including forfeiture or cancellation of the domain

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bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(7) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(8) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(9) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c)(1).

[52] § 1125(d)(2),15 U.S.C.

[53] Porsche Cars North America, Inc. v. Porsch. Com,51 F. Supp. 2d 707 (E.D. Va. 1999). This case is no longer good law, as it has been superceded by the ACPA and vacated and remanded by the Fourth Circuit. See Porsche Cars North Am. Inc. v. AllPorsche.com, 215 F.3d 1320 (4th Cir. 2000) *available at:*http://ir.lawnet.fordham. edu/ cgi/viewcontent.cgi?article=1299&context=iplj.

name, as well as its transfer to the mark owner[54]. The ACPA also allows owners of the mark to ask for statutory damages up to $100,000/infringing domain name[55], in addition to the other remedies such as actual damages and attorneys' fees under Lanham Act[56].

The first case that was decided under ACPA was *Sporty Farm L.L.C. vs. Sportsman's Market, Inc*[57]. Defendant (Sportsman's Market) - a catalogue company targeted at aviation enthusiasts - uses the trademark and logo 'Sporty's' to classify its catalogues. Omega Engineering, a catalogue company that sells mainly scientific instruments, registered the domain name sportys.com. Omega's owner, a pilot, was familiar with the Sporty's trademark and Sportsman's catalogues. After Nine months of registering sportys.com, Omega transferred the name to a subsidiary it made to develop and sell Christmas trees. It named the subsidiary Sporty's Farm and sold the rights to sportys.com to the subsidiary. This case was initially brought under the Federal Trademark Dilution Act (FTDA), yet the ACPA was passed before the Appellate Court rendered its decision. The Appellate Court established that new law applied on appeal. Subsequently, the court found out that there was more than enough evidence on record to demonstrate bad faith. Neither Omega nor Sporty's Farm had at all intellectual property rights in sportys.com and Sporty's Farm did not begin use of the name in a *bona fide* offering of services or goods until after the litigation began. The court further held that although the unique circumstances of the case do not fit neatly within the bad faith factors enumerated under ACPA, there is sufficient evidence to find bad intent. For instance, the court found that Omega planned to enter into aviation consumer market and direct competition with Sportsman's in the pilot and thus, their initially intent was to prevent Sportsman's from using the sportys.com domain name. The court also found that Omega created the Sporty's Farm business solely to find a use of the sportys.com name in some commercial fashion and thus, keep the name away from Sportsman's and protect against a possible infringement claim. However, since the domain name was registered prior to the passage of the ACPA, the court refused to award damages to Sportsman's Market.

[54] 15 U.S.C. § 1125(d)(1)(C).
[55] *Id* at § 1117(d).
[56] *Id* at § 1117(a).
[57] 2000 U.S. App. LEXIS 1246 (2d Cir. 2/2/2000) *available at:* www.internetlibrary .com/pdf/Sporty's-Farm-Sportsman's-Market%20(2d.%20Cir.).pdf(Accessed on 05.10.2016).

The court, inter alia, sketched a five-step procedure for the ACPA analysis:

(a) The primary question in front of the court is the application of the ACPA to the case in issue and whether the original jurisdiction of the court can be exercised on the defendant; or if an in rem jurisdiction over the domain name itself can be obtained;

(b) The court must settled on whether the trademark of plaintiffs is distinctive or and famous thus, entitled for a protection under ACPA;

(c) Thirdly, to see whether the defendant has acted with bad faith intent to profit at the time of registration;

(d) Fourthly the court must determine whether the defendant's domain name is confusingly similar or identical to the plaintiffs trademark; and

(e) Finally, the court must award proper remedy[58].

On March 22, 2000, *Shields v. Zuccarini*[59] became the second case to be decided under ACPA. The plaintiff, Joseph Shields, was a graphic designer and the maker of "Joe Cartoon," a series of cartoons. In 1997, he registered www.joecartoon.com as his domain name. When the Joe Cartoon site became popular, John Zuccarini, the defendant, registered five different domain names slightly varying from www.joecartoon.com, i.e., "joescartoon.com, joecarton.com", "joescartoons.com", "joecartons.com", "cartoonjoe.com". When the plaintiff seeks injunction, as well as legal damages under the ACPA, the defendant changed the site's content which states, it is a political protest to the plaintiff's site. The first issue the court took was whether "Joe Cartoon" was a "distinctive or well-known entitled to protection" under the ACPA. The court looked upon the factors mentioned in 15 U.S.C. Section 1125(c)(1)in order to determine distinctiveness. The court started with analysing the uniqueness of the mark. The court held "Joe Cartoon" was unique because it was the only type of Internet site of its kind in the nation using the phrase "Joe Cartoon." Then court started considering the second and third factors of the Statute, the court looked at the popularity of the site by word-of- mouth, the retail

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[58] *Ibid.*

[59] 89 F. Supp.2d 634 (E.D. Pa. 2000) *available at:* digitalcommons.law.villanova.edu /thirdcircuit_ 2001/131/(Accessed on 06.10.2016).

locations where his products appeared; the locations where he had advertised his products; and number of visitors to plaintiff s site;. The court founds that there were about 700,000 visitors per month plaintiff's sites, and that plaintiff's products had been sold all over the country both through the Internet and retail stores. The fourth factor under Section 1125(c) (1) is the location where joecartoon.com had been used. The court mentioned the geographical area of plaintiff's website was all over the nation. After that the court looked to under Section 1125(c) was the plaintiffs mark's distribution. The court held that products from Shields' cartoons were being distributed on in retail stores, the Internet and at tourist sites. The next factor under Section 1125(c) the court determined was how known "joecartoon.com" was in the consumer market. The court stated that "the award "Shock Site of the Day" that Shields won demonstrated that the site and cartoon had recognition". The final factor the court determined was the resemblance of "joecartoon.com" to other marks in use. The court simply mentioned that "in the past fifteen years, Shields' Joe Cartoon was the only such cartoon in existence". After determining that Joe Cartoon was distinctive and/or famous, the court had to decide whether defendant's domain names are "identical or confusingly similar to plaintiffs mark". The plaintiff produced evidence showing that Internet users were confused by defendant's site.

The court held Zuccarini's intention in creating the sites was to confuse the users. Then, the court had to determine whether Zuccarini acted in bad faith. The court noted the nine factors provided by Section 1125(d)(l)(B)(i), but decided on the defendant's statement made in the court. The defendant admitted to the trial court "that he registered the variations on 'Joe Cartoon,' as well as thousands of other domain names...in an effort to divert Internet traffic to his sites." Even though the factors of 15 U.S.C Section 1125(d)(l)(B)(i) implicated the defendant, he argued he was entitled to the protection of Section 1125(d)(l)(B)(ii). Zuccarini contended that his intention for registering the names was lawful because he created the sites to protest Joe Cartoon's use of "the graphic and gruesome depictions of brutality to animals..." However, the court found Zuccarini's intention in creating the sites was not to protest the brutality against animals but to make money. The court thought that it was difficult to trust that the gruesome nature of the cartoons would motivate Zuccarini to create a website to protest a cartoon, as he had never complained about animal cruelty before. In the wake of investigating all components under Section

1125, the court established that the respondent had no legitimate right to register the domain names because of the absence of a real business use of any variation of Joe Cartoon. The defendant's acts demonstrated the behaviour the ACPA was intended to prevent[60].

Mark owners found the ACPA a very helpful tool and throughout the United States these new provisions were heavily used in federal courts. In a very short time since the law had become effective, most federal appellate circuit courts got the chance to consider and apply it. In the mean time, critiques of the new law have persistently asserted that the ACPA has departed from the basics of trademark law. The law was said to have established an overbroad protection for trademarks in cyberspace[61]. The opposition has contended that the ACPA increased the potential for speech suppression by marks owners and "reversed domain name hijacking".

6.3.4. U.S.A Courts on Domain Names Dispute

The judiciary in U.S.A. has also played an important role in the in curbing domain name disputes and thereby protecting the domain names. However, only the most important cases that have emerged from the annals of the courts in U.S.A. are discussed here in order to analyse the role of judiciary in interpreting and extending the scope of legislations.

In *Intermatic, Inc., v. Denis Toeppen*[62], the Illinois court provided an injunction to the plaintiffs preventing the defendant from using the domain name "intermatic.com." Toeppen had registered 200 domain names, with a intention to sell these domain names to the owner of the trademarks. The defendant contended that he was not liable under the Lanham Act as he did not make commercial use of the "Intermatic mark". However, the court granted a summary judgment on the following considerations :

(i) long use of the Intermatic's mark;

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[60] *Ibid.*

[61] Anahid Chalikian, Comment, Cybersquatting, *available at:* papers.ssrn.com/sol3/Delivery. cfm? abstractid=957750 (Accessed on 10.10.2016).

[62] 947 F. Supp. 1227, 1996 US Dist *available at:* https://cyber.harvard.edu/property00/domain /IntermaticShort.html (Accessed on 10.10.2016).

(ii) the fact that the mark was imaginary, i.e. not merely suggestive or descriptive of the nature of the goods;

(iii) Intermatic had registered the mark under Federal trademark registration;

(iv) before the to defendant's registration of the domain name, plaintiff made exclusive use of the Intermatic mark;

(v) the Intermatic mark was never used by Toeppen in connection with any services or goods of his own.

The court granted the injunction sought to Intermatic, but granted no damages as there was no proof of bad faith on defendant's part to misuse plaintiffs mark. Defining the term 'cybersquatters' as "person who tries to profit from the Internet by withholding and later selling or licensing domain names back to organisations that spent millions of dollars building the goodwill of the trademark," the court held that "*Intermatic's name and reputation would be at defendant's mercy and could be linked with any messages on defendant's website if the domain name were allowed to remain in Toeppen's control*".

In *People for the Ethical Treatment of Animals, Inc. v. Doughney*[63],

The court upheld the lower court's order for summary judgment under the ACPA against the defendant, where defendant had used service mark PETA of the plaintiff animal protection organisation in his domain name peta.org, which directs to his website, actually stands for "People Eating Tasty Animals." The Court held that use of word "peta" by defendant in his domain name "distorted" the distinctive alliance of the mark with the animal rights organisation; and that defendant's has acted in bad faith by registering the domain name peta.org. Further, the court held that reasonable remedies under the ACPA apply retroactively to domains registered before its enactment.

In *Green Products Company v. Independence Corn By-Products Company*[64], plaintiffs and defendants were competitors in the corncob by-products industry.

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[63] 263 F.3d 359 (4th Cir. 2001) *available at:* https://cyber.harvard.edu /stjohns/PETA_v_Doughney. html. (Accessed on 01.10.2016).

Plaintiff brought the suit to compel the defendant to transfer the domain name "greenproducts.com" to the plaintiff because of defendant's infringement of plaintiff's trademark. The court denied defendant's contention that if it took every safeguard to make sure no consumer confusion, and if it was not "selling a product on store shelves using the mark greenproducts.com, then there would be no actionable confusion under the Lanham Act." The court established that defendant's use of the domain name was corresponding to its sign hanging in front of its shop that read "Green Products," and then telling customers after they had entered the store that "this store isn't owned by Green Products; it's owned by Independence Com By-Products. We don't sell anything made by Green Products, but as long as you are here, we'll tell you our products are better than Green Products." The court found that there was a possibility of confusion even though the defendant had not in fact made a website for the domain name, since users browsing the Internet might look for that address and be told that no documents match the query, leading browsers to "randomly input other domain names, guessing that Green Products was registered under some variation of its trademark." Therefore, the court ordered the defendant to transfer ownership of the domain name to the plaintiff.

In *Coca-Cola Co. v. Purdy*[65], defendant incorporated the distinctive and famous trademarks of plaintiffs, Coca-Cola Company, McDonald's Corporation, PepsiCo, Inc., and The Washington Post Company, into 60 Internet domain names that were identical or confusingly similar to the plaintiffs' marks, with bad faith intent to profit. These websites, which divert traffic to anti-abortion websites, contained disclaimers and graphic images of aborted foetuses. The plaintiffs were able to satisfy the four factors for injunctive relief and their motion for a Temporary Restraining Order and Preliminary Injunction was granted. A Federal judge ordered the defendant to shut down these anti-abortion websites with domain names that are confusingly similar to the trademark names of some of the nation's best known companies. However, the defendant appealed the injunction orders and continued buying domain name addresses such as bloodycoca-cola.com or pepsideathmills.com to continue his

[64] 992 F. Supp. 1070 (N.D. Iowa 1997) *as cited in* Robert A. Badgle, *Domain Name Disputes* 2-9 (Aspen Publishers Online , 2003).

[65] 2002 U.S. Dist. LEXIS 13443, 2002 WL 1634277 (D. Minn. July 23, 2002) (motion for preliminary injunction), afFd, 382 F.3d 774 (8th Cir. 2004) *available at :* caselaw.findlaw.com › Caselaw › United States › US 8th Cir. (Accessed on 12.10.2016).

anti-abortion protest. The defendant argued that the issue at hand is free speech and that the companies are only attempting to suppress his speech. The defendant opposes the Washington Post's abortion rights editorial position and Coke's contributions to organisations favouring abortion, and stated that it is impossible to criticise a company without using its name. Rejecting his contention, the court granted plaintiffs' request for permanent injunction. The court agreed that defendant's domain names were identical to, and confusingly similar to plaintiff's famous and protected mark.

In *Mayflower Transit, LLC v. Prince*[66], the plaintiff challenged the Internet domain name mayfIowervanlinebeware.com, the home page of which was headlined "Beware of Lincoln Storage Warehouse. Beware of Mayflower Van Line," and stated, "If you are thinking about moving or had a bad experience moving with Mayflower Van Lines or Lincoln Storage Warehouses then please read on." The court studied the nine legal aspects listed in the ACPA to decide whether the defendant's activity amounted to bad faith but mainly focused on the aspect number fourth – "whether the defendant had a 'bona fide non-commercial or fair use of the mark" - and settled that it confirmed why the defendant could not be made liable under the ACPA. The court described that the need of this element was to protect domain name registrations and users engaged in protected activities such as critical commentary. As per the court, "*the totality of circumstances in this case demonstrated that the defendant's motive for registering the disputed domain names and posting his criticism was to utter dissatisfaction of customer through the medium of the Internet*". Defendant's 'cyber-griping,' the court ruled, was a 'far cry' from the 'squatting' activity made illegal by the ACPA, in which a individual buys various domain names of famous companies at less price with the intention to sell the domain names at a higher price to those businesses.

In a Reverse Domain Name Hijacking case, *Barcelona.Com, Inc. v. Excelentisimo Ayuntamiento de Barcelona*[67], one Mr. Cobo registered barcelona.com as domain name in his wife's name, which besides offering website development and

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[66] 314 F. Supp. 2d 362 (D.N.J. 2004) *available at:* www.internetlibrary.com/ cases/lib_case342.cfm (Accessed on 12.10.2016).

[67] 330 F.3d 617, Civ. No. 02-1396 (4th Cir., June 2, 2003) *available at:* www.internetlibrary. com/cases/lib_case321.cfm (Accessed on 12.10.2016).

domain name registration services for sale also provides a relatively modest amount of information about Barcelona. Soon, Mr. Cobo makes an offer to sell domain name which the defendant did not respond. Thereafter, Mr. Cobo formed the plaintiff "Baracelona.com", Inc., and wrote a business plan to develop "barcelona.com" into a portal site containing information about Barcelona, Spain. This led the defendant to send a letter to Mr. Cobo, requesting to transfer the domain name to the City Council. Mr. Cobo refused, and transferred the domain name instead to plaintiff Barcelona.com, Inc. The City Council thereafter commenced UDRP[68] proceedings against plaintiff seeking transfer of the domain name. The arbitrator of WIPO ruled that plaintiffs registration and use of the domain name was in bad faith and improper, and ordered the plaintiff to transfer the domain name to the defendant. The plaintiff followed by commencing a reverse domain name hijacking action under 15 U.S.C. Section 1114(2)(D)(v) against the defendant in a United States District Court, which rejected plaintiffs claim holding that his use of the barcelona.com domain name was not unlawful, a prerequisite to a successful reverse hijacking claim. One important thing to note, however, was that the District Court reached this conclusion by applying Spanish trademark law, which, as interpreted by that court, rendered plaintiffs use of the barcelona.com domain name unlawful. The District Court also awarded the defendant relief on a counterclaim it did not file. On appeal to the Fourth Circuit, the court reversed the District Court's finding and held that plaintiff had in fact established a valid reverse domain name hijacking claim as a result of defendant's commencement of the UDRP proceeding. To establish a claim under Section 1114(2) (D)(v), a plaintiff must show that it is a registrant of a domain name; that its domain name was transferred, disabled or suspended pursuant to a UDRP proceeding; that notice of the reverse domain name hijacking action was given to the mark holder; and that the registration by plaintiff or use of the domain name is not illegitimate under the Lanham Act. There was no dispute that plaintiff satisfied the first three elements of this claim. There was, however, some confusion on whether the plaintiffs use was unlawful.

The Fourth Circuit held that the District Court indecently applied Spanish law in reaching its conclusion that the use was illegal. Section 1114(2)(D)(v) instead

[68] ICANN's Uniform Domain Name Dispute Resolution Policy.

called for application of U.S. law, and particularly the Lanham Act, to determine if plaintiffs registration and use was lawful.

Regarding the defence of fair use, the court recently had a chance to dwell on the matter in *Toyota Motor Sales U.S.A., Inc. v. Tabari*[69]. The defendants, Farzad and Lisa Tabari, were auto brokers who used to contact authorised dealers, ask for bids and arrange for customers to purchase from the dealer presenting the best combination of availability, price and location. They provided this service at “buyorleaselexus.com” and “buy-a-lexus.com”. This service was popular among consumers, as it raises competition among dealers, resulting in greater selection at lower prices. However, for samilar reasons, auto manufacturers and dealers weren’t so keen on this service, as it undermines dealers’ territorial exclusivity and lowers profit margins. Plaintiffs, Toyota, a well-known auto brand and an exclusive distributor of Lexus vehicles in the United States owned Federal trademark LEXUS, inter alia, objected to the defendant’s use on their website of copyrighted photography of Lexus vehicles and the circular “L Symbol Design mark.” Toyota also objected to the defendant’s use of the string Texus’ in their domain names, on the ground that such use was ‘likely to cause confusion as to the source of defendant’s website.’ The defendants separated Toyota’s logo and photography from their website and added a disclaimer in large font at the top. However, they refused to renounce their domain names. The district court upheld plaintiff’s contention and found defendant guilty of infringement. In pursuance thereof, the defendant was ordered to cease using the plaintiffs domain names and enjoined them from using the ‘Lexus’ mark in any other domain name. Upholding the appeal of the defendants, the court observed that the district court’s injunction was plainly overbroad because it prohibited domain names that, on their face, dispel any confusion as to sponsorship or endorsement. The court further observed that

> “*when customers purchase a Lexus through the Tabaris, they receive a genuine Lexus car sold by an authorised Lexus dealer, and a portion of the proceeds ends up in plaintiff’s bank account. Toyota doesn’t claim the business of brokering Lexus cars is illegal or that it has contracted with its*

[69] No. 07-55344 (9th Cir. Jul. 8, 2010) *available at:* caselaw.findlaw.com › Caselaw › United States › US 9th Cir (Accessed on 15.10.2016).

dealers to prohibit selling through a broker. Instead, Toyota is using this trademark lawsuit to make it more difficult for consumers to use the Tabaris to buy a Lexus.[70]"

Finally, the court held that because there was no risk of confusion as to endorsement or sponsorship, defendants' use of the 'Lexus' mark was fair.

From the above discussion, it is clear that the courts in both U.K. and U.S.A. have, to a large extent, considered domain names as carrying vital property rights that enjoy trademark protection. However, it depends on the facts of each case, whether the claims of trademark infringement, trademark dilution, unfair competition, and passing-off could be upheld against the defendant. The courts have also recognised the defence of fair use in domain name disputes.

After a detail study of U.K's. and U.S.A's. legislative and judicial response to the domain name disputes. Let us now discuss India's response to the said problem.

6.4. Indian Legislative response to Domain Name Disputes

Before examining the response of Indian courts to the domain name disputes, it might be useful to find out how the Indian legal framework, related to trademarks and information technology, treats the issue of domain name disputes. This examination supposes more importance in view of the fact that India has changed or enacted new laws in these areas.

On one hand the old Trade Marks Act[71] has been replaced with the Trade Marks Act of 1999[72], on another, an all in all new Information Technology Act[73] (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.

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[70] *Ibid.*

[71] Trade and Merchandise Marks, Act, 1958.

[72] Act *available at:* http://www.indiankanoon.org/doc/1017213/ (Accessed on 16.10.2016).

[73]Act *available at* http://www.mit.gov.in/sites/upload_files/dit/files/ downloads/itact 2000/ itbill 2000 .pdf Accessed on (Accessed on 16.10.2016).

However, the significant provisions of the Trade Marks Act, which may be mentioned to in case of violation of a trade mark by a domain name are discussed below. Additionally a concise dialog is made about the connection between the IT Act and the Interne.

6.4.1. Trade Marks Act 1999:

Though the new Indian Trade Marks Act, 1999 was passed by the Parliament in 1999 however it came into force on 15 September 2003. The distinction between the new and the old Act is that the new Act incorporates services as part of trade marks. Also, the new Act defines a "trade mark' as something that is capable of being represented graphically". On the other hand, under the old Act, the definition of trademark did not include 'graphical aspect'[74]. Keeping these two changes in mind, now domain names can be included with the meaning of 'trade mark'. Notably notwithstanding, even before the enactment of the new Act, the courts figured out how to cover domain name question under the old law also. 'Well-known trade mark is also defined under this new act'[75].

A casual inspection at the provisions of the Act makes it clear that it has attempted to cover as much disputes as possible under its blanket. Be that as it may, the new Act – despite the such a wide ambit and the instances of cybersquatting being matter of public knowledge, both in India and abroad, at the time of its enactment – still misses to mention about domain names in its detailed provisions. One conceivable clarification for such an exclusion could be, that it is also possible to contend that domain names disputes could presumably be settled all the more successfully by authorizing a separate law – that recommends a thorough procedure for registration of domain names and furthermore sets down tenets identified with the settlement of cybersquatting cases – as opposed to amend the trademark laws.

However only Section 134(l) (c) of the Trade Marks Act, 1999 can be connected to the domain name disputes as it gives that a suit to passing off emerging out of the utilization by the defendant of any trademark, which is confusingly similar

[74] Swati Deva (2005) What's in a name? Disputes relating to domain names in India, International Review of Law, Computers & Technology, 19:2, 165-181, DOI: 10.1080/13600860500184662 available at: http://dx.doi.org/10.1080/13600860500184662
[75] *Ibid.*

or identical to, the plaintiff's trademark, regardless of whether registered or unregistered, shall be filed before a court, not inferior to a District Court. Further, Section 135 of the Trade Marks Act, 1999, provides injunction may be granted by the jurisdictional District Court as a relief in a suit for passing-off.

Consequently, a domain name disputes including passing off claims by the plaintiff can be filed either in the High Court or a court of District Magistrate. The appeal from District Magistrate's order lies in High Court and the appeal from the High Court's decision lies in Supreme Court of India.

The District Magistrate in a suit for domain names passing-off may order either refusal or issuance to issue permanent or temporary injunction to the respondent in relation to the use of domain name in question.

6.4.2. Information Technology Act 2000

In order 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, to provide legal recognition to electronic commerce and to amend related statutory provisions, the Indian Parliament, in the year 2000, enacted the IT Act [76]. It is, in this manner, clear that the IT Act was enacted to give effect to the goal of the Model Law.

The justification behind the Model Law is clear from its Preamble which takes note of that in perspective of an expanding number of transactions in universal trade being done by methods for electronic trade and different methods for communication, the selection of the Model Law will help all states in detailing or upgrading their enactment administering the utilization of alternative to paper-based techniques for communication and storage of information[77].

This is, actually, one reason why the IT Act does not specify anything about domain names or debate identifying with them, however it defines different technical terms, for example,

[76] The Information Technology Act 2000, Preamble.
[77] Model Law on Electronic Commerce adopted by the United Nations Commission on International Trade Law through the General Assembly Resolution 51/162. For details, see http://www.uncitral.org/en-index.htm (Accessed on 20.10.2016).

access[78], *computer*[79], *computer network*[80], *electronic form*[81] *and electronic record*[82]. The entire purpose for the IT Act, basically, being to give legitimate acknowledgment to electronic trade and utilization of alternative options to paper-based techniques for communication and storage of data.

We can say that, the IT Act deals with the Internet as a means of communication and therefore, deals with electronic data interchange only. However, some people may argue that the IT law can easily enter the domain name related dispute resolution mechanism under its provisions. In any case, it appears that this dispute again overlooks the main issue that the contention over the credibility of documents in electronic shape has been squandering courts' valuable time for long. This Act has been adopted to put a conclusion to such contentions and to correct certain laws identifying with documentary evidences[83].

This is, be that as it may, not to recommend that enacting a special law managing domain name disputes require not be sought after. It is presented that if this must be done, it is desirable to enact a specific law – which controls both registration of domain names and in addition the consequent disputes related thereto – for that reason instead of inserting some provisions in the IT or trade mark law.

In *SIL Import v. Exim Aides Silk Importers*[84], the Supreme Court of India perceived the requirement for the law to interpretate a Statute by rationalizing any pertinent technological change that has happened.

6.4.3. Indian Judicial Response to Domain Name Disputes

The judicial response to Domain name Disputes has been firm and unambiguous. The courts have made it clear that no violation or passing off of trademarks as to domain names would be endured. In India the disputes identifying

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[78] The Information Technology Act 2000, s.2(1)(a).
[79] Id. at S.2(1)(i).
[80] Id. at S.2(1)(j).
[81] Id. at 2(1)(r).
[82] Id. at 2(1)(t).
[83] Swati Deva, s*upra* note 74.
[84] (1999) 4 SCC 567.

with domain names have been managed under the trademark law, as done by the courts in the UK and USA[85].

Although Yahoo! case was the first reported case relating to domain name dispute to be decided by an Indian court, but the first case, which was initiated in the Delhi High Court in 1998, i.e.,

Titan Industries Limited v. Prashanth Koorapati and Ors[86] marks the watershed in the history of the trade mark jurisprudence in India as it is the first case resolute by any Indian court which agreed trademark protection to domain names. In this case, the word "TANSHIQ" was registered by the plaintiff as his trade mark for the production and marketing of watches and Jewellery since 1994 in India as well as in 23 countries. The defendant had registered "tanshiq.com" as its domain name which was based on the plaintiff's trade mark. The plaintiff protested against such use of its trademark as a domain name by the defendant on the ground that the domain name is squarely based on his registered trade name. There are chances that customer May believe that defendant is related to Plaintiff. The consumer would tend to believe that the defendant is an affiliate of the plaintiff. This would give an unfair advantage to the defendant who would be able to cash the goodwill and reputation of the plaintiff which would cause monetary loss to him.

An exparte ad-interim was issued by the Delhi High Court against the defendant restraining him from operating any business or registering a name, manufacturing, offering or advertising for sale, or selling any goods under the name TANSHIQ or any other name confusingly similar thereto; or including the word TANSHIQ as an crucial feature of a domain name on the Internet. The court also restrained him from conducting any activities with the name TANSHIQ that could lead to passing off the goods and business of defendant as those of plaintiff.

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[85] Hutchinson 'Can trade mark protection respond to the international threat of cybersquatting?', Journal of Information, Law and Technology Vol 1, 2001. *Available at:* http://www2.warwick .ac.uk/fac/ soc/law/elj/jilt/2001_1/Hutchinson (Accessed on 20.10.2016).

[86] Case No. - S 179/1998. Order *available at*: http://courtnic.nic.in/dhcorder /dhcqrydisp_o.asp?pn=153404&yr=2002-2011. (Accessed on 20.10.2016).

However, this "tanishq.com" domain name was subsequently purchased by Tanishq Corporation of Dubai. The plaintiff bring proceedings under WIPO UDRP[87] for the domain name disputed, wherein the latter denied that it acquired the domain name from the defendant in the earlier case i.e, Mr. Prashant Koorapati. The 3-judge Panel arbitrated this case, which decided in respondent's favour on the ground that Titan Industries could not prove that the defendant lacks legitimate interest or rights in the domain name, or that the respondent in bad faith used and registered the domain name. In ruling against the complainant, however, the Panel observed that it

> *"...felt at a disadvantage in not having an Indian Panellist among its number. There are certain aspects of the respondent's evidence, which give cause for concern and which an Indian national might have been able to clarify. However, this administrative procedure is not an ideal forum for resolving issues of fact and, indeed, determining whether or not a party is being truthful. Accordingly, unless the evidence against the respondent is clear, the Panel has no alternative but to resolve the doubt in favour of the respondent.[88]"*

On bad faith registration, the Panel observed thus:

> *"The evidence supporting complainant's position is limited to the fact that complainant has registered and used the TANISHQ mark for jewellery and watches since 1995, primarily in India, where respondent's administrative contact and website developer are located and where respondent intends to do business. However, it is also undisputed that complainant did not register the mark in Dubai, where respondent is located. Further, respondent has claimed a prior intent to use the mark for a different business and there is no evidence to counter that claim. Respondent has also shown that the name TANISHQ is an apt choice for a body care product business because it conveys the meaning 'love for one's body.' On the evidence before us, it is certainly plausible that respondent registered and intends to use the name in good faith*

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[87] Titan Industries Limited v. Tanishq Corporation, WIPO Case No. D2000-1793, March 14, 2001, *available at:* http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1793.html (Accessed on 21.10.2016).

[88] *Ibid.*

for a body care business, without any intent to trade on complainant's good will. Whether the use of the mark and domain name TANISHQ for body care products may ultimately infringe complainant's trademark rights in TANISHQ for jewellery and watches is an issue beyond the scope of the UDRP.[89]*"*

Accordingly, it is obviously evident that even the contentions sent by the WIPO Panel for this situation were not sufficiently conceivable to set up the privileges of the respondent on the domain name. Having analysed this case in detail, it is safe to infer that settling domain name disputes is a troublesome task even for the experts appointed by WIPO to act as arbitrators in the disputes.

YAHOO! Inc. v. Akash Arora & Anr[90] *was* the first domain name dispute that ended up in court. Here, the Defendants adopted the name "Yahooindia.com" for similar services which as per the Plaintiff was identical to or deceptively similar to Plaintiff's trademark "yahoo.com." In addition, the defendant's site also provided similar services as those provided by the plaintiff's site. Plaintiff was the owner of the trademark 'Yahoo!' and domain name 'Yahoo.Com'. In alleging passing-off via cybersquatting, the plaintiff submitted that Domain name adopted by the Plaintiff is entitled to equal protection against passing off as in the case of a trademark. By adopting a deceptively similar trademark 'Yahooindia', Defendants are passing off their services as that of the Plaintiff. It would not be unusual for someone looking for an authorized 'Yahoo!' site with India-specific content to type in 'Yahooindia.com' and thereby the said person would reach the Internet site of the Defendants. The Defendants are in the same line of activity as the Plaintiff and have tried to be 'cyber-squatters' by dishonestly adopting a trademark similar to that of the Plaintiff.

The defendant argued on a number of points contending:

a) The trademark laws in India relate to goods and, therefore, the provisions of Indian Trade Marks Act are not applicable to the facts and circumstances of the present case which deals only with goods.
b) Trademark/domain name 'Yahoo!' of the Plaintiff is not registered in India and, therefore, there cannot be an action for infringement of the registered

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[89] *Ibid.*
[90] 1999 PTC (19) 201 (Del).*available at:* https://indiankanoon.org/doc/1741869/ (Accessed on 22.10.2016)

mark nor could there be any action of passing off as the services rendered both by the Plaintiff and the Defendants cannot be said to be goods within the meaning of the Indian Trade Marks Act.

c) The word "Yahoo!" is a general dictionary word, therefore, it could not have acquired any distinctiveness and the Defendants have been using disclaimer, so as to avoid any chances of deception.

d) The persons using Internet and seeking to reach the Internet site are all technically educated and literate persons and therefore there is no possibility of any customer reaching the Internet site of the Defendants with the intention of reaching the Internet site of the Plaintiff.

Refusing all contentions of the defendant and awarding interim injunction to the plaintiff restraining defendants from using the domain name yahooindia.com, the court concluded:

(i) The principle underlying the passing-off action is that no man is entitled to carry on business in such a way as to lead to the belief that he is carrying on the business of another man or has any connection with the other man. Since business 'goodwill' is an asset, it is a species of property, which the law protects against encroachment. Action of passing-off is not limited to goods and includes services as well. Citing *Cardservice International Inc. v. McGee*[91], the court held that the domain name serves the same function as the trademark. In the said case, it was held that plaintiffs customers who wish to take advantage of its Internet's services but do not know its domain name are likely to assume that cardservice.com belongs to the plaintiff. However, these customers would reach the defendant's website and see a home page for "Cardservice" and thereby, assume that they have reached plaintiffs site.

Court further observed :

"The services of plaintiff under the trademark / domain name 'Yahoo!' have been publicised and written about globally. In an Internet service, a particular Internet site could be reached by anyone anywhere in the world

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[91] 42USPQ 2d 1850 *available at:* www.internetlibrary.com/cases/lib_case86.cfm (Accessed on 21.10.2016).

who proposes to visit the said Internet site...as a matter of fact, in a matter where services are rendered through the domain name on the Internet, a very alert vigil is necessary and a strict view is to be taken for its easy access and reach by anyone from any comer of the globe...there can be no two opinions that the two marks / domain names 'Yahoo!' of the plaintiff and 'Yahooindia' of the defendant are almost similar...and there is every possibility and likelihood of confusion and deception being caused."

(ii) 'Yahoo!', though a dictionary word could be appropriated as domain name / trademark. The said word had acquired distinctiveness and uniqueness and was associated with plaintiffs.

(iii) Sophisticated user of the Internet may still be an unsophisticated consumer of information and not immune from confusion.

(iv) Use of disclaimer by defendants could not eliminate the problem as observed in *Jews for Jesus v. Brodsky*[92], nor would addition of the word 'india' in defendant's domain name (i.e., 'yahooindia) distinguish it from plaintiffs domain name.

This case was an important one, not just because it was the first case pertaining to domain name dispute to be decided by Indian courts, but also because it showed that the courts in India were not averse to deriving suitable interpretations from the U.S. case law in arriving at a decision.

The judgment in Yahoo! Inc. case was followed by the Bombay High Court in *Rediff Communication Ltd. v Cyberbooth*[93], where the plaintiff was an online media company carrying on the business of communication and providing services through the Internet since 6 January 1997. The plaintiff contended that the word 'Rediff' is composed of the first six letters of its group companies corporate name 'Rediffusion Dentsu Young and Rubicam Advertising Ltd'. As per plaintiff's version, in March 1999 it learnt that the defendants have got registered the domain name 'Radiff.com' on 31 January 1999. The plaintiff alleged that the adoption of the word 'Radiff',

[92] 46USPQ2d 1652 *available at:* https://www.jlaw.com/Briefs/brodsky1.html (Accessed on 21.10.2016).

[93] AIR 2000 Bom. 27.*Available at:* https://indiankanoon.org/doc/806788/ (Accessed on 25.10.2016)

which is deceptively similar to the plaintiff's trade name and style, by the defendants is dishonest and has been done with the deliberate intention to pass off the defendants business, goods and services as those of the plaintiff's and thereby illegally trade upon the reputation of the plaintiff. The defendants, in response, contended that the word 'Radiff' is coined by taking the first three letters of the word 'radical', and the first letter of the words 'information', 'future' and 'free'. According to them, the plaintiff's web site was more like a web newspaper while the defendants' web site mainly provided hypertext links to its advertisers. They further alleged that users of the web site are skilled and educated persons who cannot be confused in the two names and that there is no evidence of any reputation in the domain name 'Rediff'. The court, after referring to few cases including the case of *Cardservice International Inc*[94]., observed:

> *"A domain name is more than an Internet address and is entitled to equal protection as a trade mark. With the advancement and progress in the technology, the services rendered in the Internet site have also come to be recognised and accepted and are being given protection so as to protect such provider of service from passing off the services rendered by others as his services*[95]*."*

The Bombay High Court opined that the explanation given by the defendants for choosing the name 'Radiff' makes 'no sense' and the only object of adopting such a name was to trade upon the reputation of the plaintiff's domain name[96]. The court further stated that once the intention to deceive is established, it would not make further enquiry about likelihood of confusion. The High Court found no substance in the argument that the field of activity of the two parties was different and that there is no likelihood of any deception or confusion between the two domain names[97]. This conclusion was reached on the basis of the reputation of the plaintiff and the similarity of its trade with that of the defendants.

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[94] 950 F. Supp. 737 (E.D. Va. 1997), aff'd, 1997 U.S. App. LEXIS 32267 (4th Cir. Nov. 18, 1997) *available at:* www.internetlibrary.com/cases/lib_case86.cfm (Accessed on 21.10.2016).
[95] Rediff Communication Ltd. case, op cit, note 91, p 30.
[96] *Id.* at p 32.
[97] *Ibid.*

It might be noted here that in both the Yahoo! Inc. case and Rediff Communication case the concerned courts declined to trust that similarity would not confuse an informed or proficient Internet user. This decision is vital in light of the fact that, seemingly, even an sophisticated user of Internet may use a search engine for the information she is looking for and may get confused by the likeness of the domain names, as was observed in the *Cardservice International Inc. case* [98].

The court applied passing off principles strictly in *Online India Capital Co Pvt. Ltd &Anr v. Dimensions Corporate*[99], and refused to grant relief in favour of plaintiff. In this case plaintiff No. 2 had registered "www. MUTUALFUNDSINDIA.COM" and assigned it to plaintiff No 1. The defendant had six or seven months later registered www.mutualfundsindia.com as its domain name which was objected by the plaintiff. The plaintiff took the help of decisions handed down in yahoo (Supra) and Rediff (Supra) in support of its contention that the use of its domain name by the defendant is likely to deceive or cause confusion and divert the business of the plaintiff to the defendant.

The court showed complete agreement with the argument of the defendant that the "MUTUALFUNDINDIA" is a generic / descriptive word and is not entitled to trademark protection. The court relied on the decisions of "*House of Lords in Office Cleaning Services Ltd. v. Westminister Windows and General Cleaners Ltd.*"[100], where the House of Lords did not provide security on the word "office clearing" and other Indian decisions. It has been concluded that the plaintiff's domain name describes the services he has given them. The plaintiff has failed to demonstrate that this generic word has obtained a secondary meaning which is a pre-condition for giving protection to such words. The court also differentiates the present case from yahoo (discussed above) and Rediff (discussed above) because in last cases space names had procured distinctiveness which is lost in the present case.

[98] 950 F. Supp. 737 (E.D. Va. 1997), aff'd, 1997 U.S. App. LEXIS 32267 (4th Cir. Nov. 18, 1997) *available at:* www.internetlibrary.com/cases/lib_case86.cfm (Accessed on 21.10.2016).

[99] *Online India Capital Co Pvt. Ltd & Anr v. Dimensions Corporate*, 2000 PTC 396.

[100] *Available at*: https://oup.silverchair-cdn.com/oup/backfile/Content_public/ Journal /rpc/63/3/ 10.1093/rpc/63.3.39/2/63-3-9.pdf (Accessed on 21.10.2016).

In *Dr. Reddy's Laboratories Limited v. Manu Kosuri*[101], where the plaintiff company is the proprietor of the trademark DR. REDDY'S. The defendants had registered the domain name drreddyslab.com. The web page merely showed the caption 'welcome to the future Website of drreddyslab.com.' A suit was filed by the plaintiff company praying for a permanent injunction restraining the defendants from using the trademark / domain name drreddyslab.com, since the same was identical or deceptively similar to the plaintiffs trademark DR. REDDY'S. The plaintiff company averred that it was established in 1984 for research and development activity in the field of medicine and over 15 years, grew into a fully integrated pharmaceutical organisation. It was further contended that DR. REDDY'S is always perceived as indicative of the source of the company and the trademark DR. REDDY'S is a personal name of the plaintiff company's founder and its use as a trademark in relation to pharmaceuticals is completely arbitrary. The plaintiffs also contended that the defendants are in the business of registering domain names in India and their purpose of existence appears to be to block well-known trademark and even names of well-known personalities on the Internet. Having once registered as domain names, the defendants offer them for sale for large amounts. The potential for confusion or deception being caused on account of the adoption of the impugned trademark / name by the defendants and the likelihood of damage to plaintiffs company business, goodwill, and reputation by the operation of a website under the impugned domain name by them is enormous, and is aimed at diverting the business of plaintiff company and to earn easy, illegal, and undeserved profit. The defendants had chosen not to appear and contest.

On the basis of available materials on record, the court, after looking into well-settled legal proposition of passing-off and after observing that domain name serves same function as a trademark, held that the two names, DR. REDDY'S and drreddyslab.com being almost identical or similar in nature and there is every possibility of an Internet user being confused and deceived in believing that both the domain names belong to plaintiff, although the two domain names belong to two different concerns. The court observed that the plaintiff holds the trademark in the name DR. REDDY'S and it has acquired distinctiveness through a secondary meaning

[101] 2001 PTC 859 (Del). *Available at*: https://indiankanoon.org/doc/972287/ (Accessed on 21.10.2016)

and hence, any use of the domain name drreddyslab.com by the defendant could cause confusion and deception to the Internet users. The court restrained the defendants from using any mark / domain name identical or deceptively similar to plaintiffs trademark DR.REDDY'S.

Another case that is worth a mention is *Acqua Minerals Ltd. v. Pramod Borse*[102]. Through this suit the plaintiff has sought a decree for permanent injunction restraining the defendants, their partners from using the mark BISLERI and/or BISLERI .corn as part of their domain name or in any other mariner whatsoever as for any products, goods or services so as to result in passing off, an infringement of copyright and directing them to transfer the domain name BISLERI-com to the plaintiff. The plaintiff is the registered proprietor of the trademark BISLERI. hat the word BISLERI has no dictionary meaning and is an Italian surname which is entitled to the highest degree of protection like various other surnames which fall in this category namely Colgate, Bata etc. One Mr.Felice Bisleri, an Italian entrepreneur has set up business of mineral water in India and the business was bought by on the plaintiff 's group companies and all the rights in the BISLERI mark now vest exclusively in the plaintiff company. hat the malafides and fraudulent intentions of the defendants came to the light to the plaintiff when it was revealed that the defendants have already their own Domain Name namely info@CYBERWORLD.COM and are merely using the domain name of the plaintiff in order to trade in it and/or to pressurise the plaintiff to part with huge sums of money for the same and as a blocking or trafficking tactic. It was further contended that a person wanting to know more about their product will type bisleri.com but will be taken to the defendant's website, which has nothing to do with the plaintiffs goods. Thus, this action of defendant constitutes a mischief of passing-off by the defendants. The plaintiff also referred to Paragraph 4(b)(i&ii) of the UDRP to project the element of 'bad faith'. The question before the court was whether the domain name registered with the Network Solutions, Inc. i.e., the Registering Authority, has the same protection as the trade name or trademark registered under the old Trade and Merchandise Marks Act, 1958.

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[102] 2001 PTC 619 (Del) Available at: https://indiankanoon.org/doc/1597432/ (Accessed on 25.10.2016).

While examining the word 'domain', the court viewed that "the word 'domain' as per Chambers 21st Century Dictionary means a territory owned or ruled by one person or government. Webster's Dictionary defines it in various contexts as under: (a) a field of action, thought, and influence; (b) the territory governed by a single ruler or government; (c) region characterised by a specific feature; (d) law; (e) land of which, there is superior title and absolute ownership." The court rested the discussion on the word 'domain' by concluding that "trademark is at par with a territory and the owner of any trademark is placed in the same position as owner of a territory." Further, the court observed that "with the advancement- of Internet communication, the domain name has attained as much legal sanctity as a trade name. Since the services rendered on the Internet are crucial for any business, the domain name needs to be preserved so as to protect such provider of services against anyone else trying to traffic or usurp the domain name." The court further relied upon the 'bad faith' test under the UDRP and established that the defendants had blocked user of the trade name BISLERI from getting the registration as a domain name and as such, it has affected the trade and name of the plaintiff. "It was obvious that the domain name bisleri.com was selected by the defendants in bad faith and dishonest intention and as a squatting or blocking tactic." The court found that the main question of the defendant in adopting the disputed domain name was to acquire tremendous cash for exchanging the said domain name for the sake of the plaintiff knowing it well that they had no privilege both of registration of the domain name or of some other domain name which comprised of the plaintiffs trademark or copyright name. The suit was decreed on the ground of bad faith registration.

In, *Tata Sons Ltd. v. Manu Kosuri*[103], involved a number of domain names incorporating the brand name of the plaintiffs, like jrdtata.com, ratantata.com, tatahoneywell.com, tatayodagawa.com, tatateleservices.com, tatassl.com, tatapowerco.com, tatahydro.com, tatawestide.com, and tatatimken.com. The plaintiff averred that the defendants had misappropriated the plaintiffs trademark TATA since a part of a series of domain names that had been registered by the defendants incorporated the well-known and famous trademark TATA. The plaintiff further contended that it was the registered proprietor of TATA since 1917 in relation to

[103] 2001 PTC 432 (Del).Available at: https://indiankanoon.org/doc/542243/ (Accessed on 26.10.2016).

various goods, in various classes. It was further asserted that the plaintiff had trademarks registered in nine other countries in various classes. The plaintiffs case was that since its trademark and name TATA was already perceived as a household name due to the involvement of its companies in almost every form of business activity, a business under identical name would attract actual or potential customers' attention and induce them to subscribe to the services of the defendants or to deal in some manner with the defendants operating under the domain names believing them to be licensed or authorised by the plaintiff to do the said business. In default of the defendants, the court, on the basis of the materials on record, found that the plaintiff has been able to prove the averments made in the plaint and restrained the defendants from using the above domain names.

After discussing the-decisions in case of Yahoo, Inc. and Rediff Communications, the court observed that it is now well settled law that with the advent of modern technology, particularly that relating to cyberspace, domain name or Internet sites are entitled to protection as a trademark because they are more than a mere address. The rendering of Internet services is also entitled to protection in the same way as goods and services are, and trademark law applies to activities on the Internet.

In *Celador Productions Ltd. v. Gaurav Mehrotra*,[104] the plaintiff company is the lawful and beneficial owner of the intellectual property rights/ copyrights pertaining to the show "Who wants to be a Millionaire?" In India, the News Television India Ltd., a member of the Star TV Group has been granted the rights to produce the Hindi equivalent of the programme under the title KAUN BANEGA CROREPATI. Due to the overwhelming popularity of the show, the plaintiff licensed the production of a variety of other merchandise including a chocolate game, board game, a junior board game, etc. Apart from the unique element of the show, a circular logo with the words "Who wants to be a Millionaire?" written inside the circle together with other distinctive material including a number of 'pound' sings also used by the plaintiff. This unique logo has been customized for use in India by using a Hind equivalent KAUN BANEGA CROREPATI in place of words "Who wants to be

[104] 2003 (26) PTC 140 (Del) *Available at:* https://indiankanoon.org/doc/1840648/ (Accessed on 26.10.2016).

a Millionaire?" and symbol of rupees in place of 'pound'. The plaintiff has got registered circular logo, in August, 1998 in India. The plaintiff also has an Internet website and has also licensed ITV network in UK to run the website. Complete details about the programme i.e. the rules of programme, winners, show and other details are given on the website. And they can be downloaded by any person. It came to the notice of the plaintiff in May 2001, that defendant with an identical domain name of the plaintiff game show KAUN BANEGA CROREPATI is running an Internet website on a commercial basis. The defendant invites people to play online game KAUN BANEGA CROREPATI on his website. The defendant has copied the design, logo, trademarks and other intellectual property rights i.e., copyright of the plaintiff. Moreover the defendant has a fan club through his website and the members are charged for their membership. The court after examining finds that domain name is not just an Internet address it is more than that; therefore, person has a right to protect his domain name, the court decreed the suit.

In one of the rare occurrences, Supreme Court of India was presented with an occasion to ponder over domain name disputes between *Satyam Infoway Ltd. v. Sifynet Solutions (P) Ltd*[105].

The important question for the consideration of Supreme Court was "whether Internet domain names are subject to the legal norms applicable to other Intellectual Properties, such as trademarks". The appellant, incorporated in 1995, registered several domain names, like sifyrealestate.com, sifymall.com, sifynet.com, etc. in June, 1999, with ICANN. The word 'Sify' is an invented word, which the appellant claimed to have coined by using elements of its corporate name, Satyam Infoway. The respondent, on the other hand, started carrying on business of Internet marketing under the domain names siffynet.com and siffynet.net from June, 2001.

After the respondent refused to transfer these domain names to the petitioner, a suit was filed on the ground that the respondent by using the appellant's business name and domain name was passing-off its business and services. An application for temporary injunction was also filed, which was allowed by the trial court but on

[105] (2004) 6 SCC 145 & AIR 2004 SC 3540. Also *available at:* https://indiankanoon.org/doc/ 1630167/ (Accessed on 29.10.2016).

appeal, reversed by the High Court. The plaintiff / appellant preferred a special leave to appeal before the Supreme Court, which was granted.

The respondent contended that a domain name and the 'property names,' such as trademarks are not same. According to him, a domain name is just an IP address on the Internet. It was also stated that registering a domain name with ICANN does not confer any Intellectual Property right; that it is just a pact with a registration authority allowing communication to reach the owner's computer by means of Internet links and channelled via registration authority's server and that it was similar to registration of a company name which is a unique identifier of a company but on itself confers no Intellectual Property rights. After reiterating the principles of passing-off, the Supreme Court held that the domain names are entitled to legal protection equal to that of a trademark. The Apex Court observed as under:

> *"The use of the same or similar domain name may lead to a diversion of users, which would result from such users mistakenly accessing one domain name instead of another. This may occur in e-commerce with its rapid progress and instant (and theoretically, limitless) accessibility to users and potential customers and particularly so, in areas of specific overlap. Ordinary consumers/users seeking to locate the functions available under one domain name may be confused if they accidentally arrived at -a different but similar website, which offers no such services. Such users could well conclude that the first domain name owner has misrepresented its goods or services through its promotional activities, and the first domain owner would thereby lose its customers. It is apparent, therefore, that a domain name may have all the characteristics of a trademark and could found an action for passing off.[106]"*

The Court added that in India, there is no legislation which clearly refers to dispute resolution relating to domain names. The scope of the Trade Marks Act, 1999, is also not extra-territorial and may not allow for sufficient protection of domain names. This doesn't mean that domain names are not to be legally protected to the extent possible under the laws relating to passing-off.

Emphasising the importance of a domain name, the Supreme Court stated that

[106]*Available at*: https://indiankanoon.org/doc/148789658/ (Accessed on 29.10.2016).

> "*a domain name is available to all Internet users and the need to maintain an exclusive symbol for such access is crucial...therefore, a deceptively alike domain name may not only lead to a confusion of the source but the receipt of unsought for services.*"

The Court further stated that

> *"it may be difficult for the appellant to prove actual loss having regard to the nature of the service and the means of access but the possibility of loss in the form of diverted customers is more than reasonably probable.*[107]"

As regards passing-off, the Court observed that

> *"it is an action not only to preserve the reputation of the plaintiff but also to safeguard the public."*

Upholding the contention of the plaintiff, the Court held that

> *"the appellant is the prior user and has the right to debar the respondent from eating into the goodwill that it may have built up in connection with the name.*[108]"

The Court also discussed at some length the provisions of ICANN UDRP relating to resolution of domain name disputes. The Court acknowledged the person who first registered the domain name can protect its domain name against subsequent registrants. Confusing similarity in domain names may be a basis for grievance and similarity is to be decided on the degree of deception amongst prospective customers.

Apart from the close visible resemblance between 'Sify' and 'Siffy', the Court held that there was also phonetic similarity between the two names. By just adding word 'net' to 'Siffy' did not detract from this similarity. The Court also rejected the plea of the defendant that the word 'Siffy' has been derived from a combination of the first letter of the five promoters (namely, Saleem, Ibrahim, Fazal,

[107] *Available at*: https://indiankanoon.org/doc/1630167/ (Accessed on 29.10.2016).
[108] *Available at*: https://indiankanoon.org/doc/1630167/ (Accessed on 29.10.2016).

Fareed, and Yusuf) of the respondent. Further court found that the respondent's domain name already stood registered as in the name of one Mr. C.V. Kumar. Further, 'Siffy' as an original abbreviation was based on the initial letters of the respondent company's promoters seemed unsupported by any evidence.

Importantly, a trademark defence of 'operating in different fields' was taken by the respondent. However, the same was rejected on the ground that a deceptively similar domain name may not only lead to a confusion regarding the source but the receipt of unsought-for services. Also, on facts, it was found that the respondent was, on its website, offering software solution, integrating and management solutions and software development, which were similar to services provided by the appellant.

Finally, the Supreme Court concluded that on the basis of findings *prima facie* fraudulent adoption of the appellant's trade name by the respondent, the public association of the trade name 'Sify' with the appellant, and the investments made by the appellant in connection with the trade name, the appellant was entitled to the relief it claimed.

Addressing the jurisdiction issue in domain name disputes for the first time in *Tata Sons Ltd. v. Ghassan Yacoub*[109], the Delhi High Court accepted the contention put forth by the plaintiffs that in matters concerning Internet communications, which have transnational ramifications, the effect of the impugned transactions in India is an important factor for determining jurisdiction. In arriving at its decision, the court also considered the principles of Private International Law including the courts' ability to enforce the injunction against the defendant. In the instant case, ASAP Solutions of California, U.S.A., registered the domain name tatagroup.com with NSI and on receipt of a cease and desist notice from the plaintiffs, the owner of the trademark TATA, transferred the same to the Tatagroup located in New York. The plaintiff filed a suit for injunction restraining passing-off and dilution of its well-known trademark TATA, against both ASAP Solutions and Tatagroup. The court granted an ex-parte interim injunction against the defendants restraining them from using and transferring the infringing domain name."

[109] 2004 (29) PTC 522 (Del).*Available at:* https://indiankanoon.org/doc/929430/ (Accessed on 05.11.2016).

The issue of jurisdiction in domain name cases was taken up by the Delhi High Court in *Banyan Tree Holding (P) Ltd. v. A. Murali Krishna Reddy*[110]. In this case, neither the defendant nor the plaintiff is located within the territorial jurisdiction of the Delhi High Court. The plaintiff, part of a group of companies involved in the hospitality business, claimed that since 1994, it adopted and used the word mark "Banyan Tree" and also the Banyan Tree device.

The application for registration of trademark is pending. It is further claimed that on account of the extensive and continuous use by the plaintiff of the said mark and device in relation to its business, they have acquired secondary meaning, have become highly distinctive, and have come to be associated with the plaintiff and its sister concerns. The plaintiff maintains the websites banyantree.com and banayantreespa.com since 1996 and the said websites are accessible in India. Since 2002, the plaintiff has, in collaboration with the Oberoi Group, been operating 15 spas across India. However, in October, 2007, the plaintiff learnt that the defendants had initiated work on a project under the name "Banyan Tree Retreat." The plaintiffs contentions include: (a) the word mark and the device adopted by the defendants in relation to their retreat is deceptively similar to that of the plaintiff; (b) the defendants have advertised their project on their website makprojects.com/banyantree, which the plaintiff alleged that the use of the said mark and device by the defendants was dishonest, and an attempt to encash on the reputation and goodwill of the plaintiff, and was calculated to cause confusion and deception among the public by passing-off the services of the defendants as that of the plaintiff. Dealing with the issue of jurisdiction first, the court observed that the present suit is an action for passing-off in which neither the plaintiff nor any of the defendants voluntarily resides or carries on business within the local limits of Delhi. Consequently, neither Section 20(a) nor Section 20(b), CPC applies. The plaintiff, however, contended that the court had jurisdiction under Section 20(c), CPC, as the cause of action, wholly or in part, arises within the jurisdiction of this court because;

(i) the website of the defendants is accessible in Delhi; and it is not a passive website but used for soliciting business in Delhi; and

[110] 2004 (29) PTC 522 (Del).*Aavilable at:* https://indiankanoon.org/doc/151685239/ (accesses on 06.11.2016)

(ii) there was at least one instance of the defendants' brochure being sent to a Delhi resident for the purposes of sale of property.

In determining jurisdiction, the court extensively relied on the decisions by the courts in U.S.A., namely *International Shoe Co. v. Washington*[111].

The court also referred to an earlier decision by the Delhi Court in (India TV) « A Independent News Service Pvt Limited v. India Broadcast Live, LLC, where the plaintiff company ran a Hindi news channel INDIA TV, which was launched in March 2004. The plaintiff claimed to have adopted the mark INDIA TV since December 1, 2001, and had applied for its registration, and the said applications were published in the trademarks journal. The plaintiff was also the owner of the domain name INDIA TV, which was registered on November 18, 2003. The channel was made available for live viewing on the said website. Defendants hosted a website indiatvlive.com that contained the words INDIA TV, which were displayed prominently inside the sketch of a television. A passing-off action was initiated to injunction the defendants from using the domain name indiatvlive.com. While the suit was pending, the defendant was proceeding with the action instituted by it in the Arizona District Court in U.S.A., where the defendants were located, against the plaintiff in respect of "reverse domain name hijacking" seeking a declaration of non-infringement of the plaintiffs mark by the defendant. The plaintiff then applied to Delhi High court stating that the defendant had suppressed the fact of having filed the aforesaid action in Arizona and prayed for an injunction against defendant from proceeding with the said action in the Arizona courts particularly since the suit of Delhi High court was prior action. In resisting the application, the defendant argued that Delhi High court was not a court of competent jurisdiction not being the appropriate forum / forum conveniens. Inasmuch as defendants did not reside or work for gain in India, it was only the District Court, Arizona that was the appropriate forum / forum conveniens to decide the dispute. After referring to the articles posted on defendant's website, the court concluded that the defendant intended to target expatriate Indians as well as Indians within the country. Further, the stand taken by defendant in its written statement was that it had a global presence, including in India.

[111] 326 U.S. 340(1945).Full text *Available at*: https://supreme.justia.com/cases/federal/us/326/310/case.html (Accessed on 07.11.2016).

It claimed to be the first IPTV delivery system of Indian content from India. The website of defendant was launched in India as well as in Los Angeles. It was accordingly held that defendant has sufficient connection with India. It was further held that "the defendant is carrying on activities within the jurisdiction of this court; has sufficient contacts with the jurisdiction of the court and the claim of the plaintiff has arisen as a consequence of the activities of defendant within the jurisdiction of this court." Upholding the plaintiffs contention, the court summarised the law pertaining to jurisdictional aspect in Internet cases in India by observing that:

(i) Mere accessibility of the defendants' website in Delhi would not enable Delhi High Court to exercise jurisdiction;

(ii) A passive website, with no intention to specifically target audiences outside the State where the host of the website is located, cannot vest the Forum Court with jurisdiction;

(iii) For the purposes of a passing-off action or an action for infringement where the plaintiff is not carrying on business within the jurisdiction of the Forum Court, and where there is no long arm Statute, the plaintiff would have to show that the defendant purposefully availed itself of the jurisdiction of the forum court;

(iv) It is not enough merely to show that the website hosted by the defendant is an interactive one. It would have to be shown that the nature of the activity indulged in by the defendant by the use of the website was with an intention to conclude a commercial transaction with the website user;

(v) The issue of incorporating filters to block access to the website by viewers located outside the Forum State will have to be considered while deciding if the defendant had "purposefully avoided" the Forum State. However, that question will arise only if the plaintiff has been able to show that the website of the defendant is interactive and permits commercial transactions to be concluded by the defendant with a user of the website;

(vi) Jurisdiction of the Forum Court does not get attracted merely on the basis of interactivity of the website, which is accessible in the Forum State. The degree of the interactivity apart, the nature of the activity permissible and whether it results in a commercial transaction has to be examined;

(vii) For the "Effects" test to apply, the plaintiff must necessarily plead and show *prima facie* that the specific targeting of the forum state by the defendant resulted in an injury or harm to the plaintiff within the Forum State;

(viii) For the purposes of a passing-off or an infringement action (where the plaintiff is not located within the jurisdiction of the court), the injurious effect on the plaintiffs business, goodwill or reputation within the Forum State as a result of the defendant's website being accessed in the Forum State would have to be shown. This would require the presence of the plaintiff in the Forum State and not merely the possibility of such presence in the future;

(ix) To show that an injurious effect has been felt by the plaintiff, it would have to be shown that viewers in the Forum State were specifically targeted. Therefore, the "Effects" test would have to be applied in conjunction with the "Sliding Scale" test to determine if the Forum Court has jurisdiction to try a suit concerning Internet based disputes;

(x) The commercial transaction entered into by the defendant with an Internet user located within the jurisdiction of the Forum Court cannot possibly be a solitary trap transaction since that would not be an instance of "purposeful availment" by the defendant. It would have to be a real commercial transaction that the defendant has with someone not set up by the plaintiff itself. If the only evidence is in the form of a series of trap transactions, they have to be shown as having been obtained using fair means. The plaintiff seeking to establish jurisdiction on the basis of such trap transactions would have to aver unambiguously in the plaint, and also place along with it supporting material, to *prima facie* show that the trap transactions relied upon satisfy the above test.

6.5. Some recent cases

Coca Cola Company and anr. v. Rajesh[112]

Plaintiff has filed for injunction and damages for infringement of registered trademarks (COKE and COKE STUDIO), passing off and unfair competition. High Court Of Delhi while quoting *Info Edge (India) Pvt. Ltd. & Othr. vs. Shailesh Gupta & Anr*[113]., where the court has held

> *"Both the domain names "Naukri.com" of the plaintiff and "Naukari.com" of the defendant, depicting the nature and type of business activity they carry on are identical or confusingly similar trade mark or service marks. It is also a possibility for an internet user while searching for the website of the plaintiff to enter into the website of the defendant through only a small misspelling of the domain name and, in fact, such incident has occurred in the case of the plaintiff itself vis a vis the defendant in proof of which a document is also placed on record. Such diversion of traffic with the sole intention of ulterior gain in the similar business activity by a competitor, requires protection. A Court discharging equitable justice should come in aid and for protection of the honest user as opposed to a dishonest user acting on bad faith."*

Court further held that defendant's adoption and registration of the domain name www.cokestudio.in being identical to plaintiff's registered trade marks COKE and COKE STUDIO is dishonest and infringes the plaintiff's registered trade marks. Court also issued a direction to the National Internet Exchange of India c/o ISPAI (Internet Service Providers Association of India) 612A, Chiranjiv Tower, 43, Nehru Place, New Delhi110019 as also to the Registrar of domain name M/s A to Z Domains Solutions Pvt. Ltd. to transfer the domain name cokestudio.in to plaintiff.

Dr. Reddy'S Laboratory Ltd. v. Reddy Pharmaceuticals Ltd[114].

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[112] The High Court Of Delhi At New Delhi, Date of Decision: 08th May, 2013Full text *available at:* https://indiankanoon.org/docfragment /58617840 /?formInput=cases%20on% 20domain%20names% 20%20%20%20fromdate%3A%20112013%20todate%3 …(Accessed on 25.10.2016).

[113] 98 (2002) DLT 499.

[114] The High Court Of Delhi At New Delhi , *available at:* https://indiankanoon.org/doc/ 50249485/(Accessed on 25.10.2016).

In this case the plaintiff, Dr. Reddys Laboratories Ltd., is a company incorporated under the provisions of the Companies Act, 1956, having its registered office at Ameerpet, Hyderabad, set up in the year 1993 and since then has filed various patents in India and abroad in the course of cancer, diabetes and other areas of research, thereby achieving a recognition and esteem for its research and development in the field of pharmaceuticals. Plaintiff also submitted that it has presence on the internet through websites having the domain names, www.drreddys.com, www.myreddys.com, www.reddyus.com and www.drreddys.ru. The plaintiff contends that the defendant has adopted the domain name www.ReddyLimited.com. Though the abovementioned website does not appear to be in operation, the plaintiff claims that it is clear that the defendant is trying to adopt a deceptively similar domain name with a view to promote its pharmaceutical products as those of the plaintiff's.

In response, the defendant has contended that it is entitled to use its corporate name „REDDY as a part of its domain name, and that it had been using „REDDY as a part of its electronic mail address for the past several years, such as Reddy@bol.net.in and Reddy@satyam.net.in. The defendant has also contended that the plaintiff has been interacting with them on the said email id's without raising any objection, thereby constituting an acquiescence on their part.

The Court held that position of law regarding the issue at hand is well settled by the Supreme Court in the case of *Satyam Infoway Ltd. v. Sifnet Solutions Pvt. Ltd.*,[115], in which the Hon'ble Court considered the question whether the legal norms applicable to other intellectual properties such as trademarks also applicable to internet domain names and be regarded as trade names which are capable of distinguishing the subject of trade or service made available to prospective consumers of the internet and held that-

> *"The use of the same or similar domain name may lead to a diversion of users which could result from such users mistakenly accessing one domain name instead of another. This may occur in ecommerce with its rapid progress and instant (and theoretically limitless) accessibility to users and*

[115] AIR 2004 SC 3540.

potential customers and particularly so in areas of specific overlap. Ordinary consumers/users seeking to locate the functions available under one domain name may be confused if they accidentally arrived at a different but similar web site which offers no such services. Such users could well conclude that the first domain name owner had misrepresented its goods or services through its promotional activities and the first domain owner would thereby lose their custom. It is apparent therefore, that a domain name may have all the characteristics of a trademark and could found an action for passing off.[116] "

Court granted an interim injunction under Order XXXIX Rule 1 and 2, in favour of the plaintiff, restraining the defendant from using the trademark or name "REDDY" on their pharmaceutical preparations. The defendant was also restrained from copying the getup and the layout of the plaintiff's product, and also from using the plaintiff's logo. The defendant was also restrained from using any domain name which contains the word "REDDY" for marketing and sale of its pharmaceutical preparations.

Microsoft Corporation & Anr. v. Kurapati Venkata Jagdeesh Babu & Anr[117]

In the present case, plaintiff No.1 Microsoft Corporation has been in existence since the year 1975 and has made extensive sales, advertised so heavily that the relevant section of the public clearly immediately associates goods/services bearing the trademark MICROSOFT as belonging to the Plaintiffs.

It is stated that the trademark "MICROSOFT" is one of the most famous and well known trademarks in the world and is exclusively identified and recognized by the purchasing public as relating to the goods and services of the Plaintiffs and no one else. In addition to the common law rights that have accrued to the Plaintiffs, they are also the registered proprietors, in India of the trademark "MICROSOFT" in Classes 9 and 16. The original trademark certificates for use in legal proceedings in relation to the abovementioned registrations have been filed in the present proceedings and are bearing registration Nos. 1399978, 1401949, 1537799 & 747167.

[116] *Available at:* https://indiankanoon.org/doc/1630167/ (Accessed on 26.10.2016).
[117] Delhi High Court, Order delivered on: February 3, 2014 , CS(OS) 2163/2010 & I.A. No.14225/2010 *available at:* https://indiankanoon.org/doc/156976008/(Accessed on 26.10.2016).

In the month of July 2010, the plaintiffs received information about an impugned trade mark application for "MICROSOFT MULTIMEDIA" bearing No. 1809699 dated 22nd April, 2009 in class 41 for services in relation to educational and training. The Plaintiffs then conducted an online search on Google and found out that the defendants have also wrongly registered a domain name www.microsoftmultimedia.com in the name of defendant.

It was prayed that the plaintiff companies would suffer irreparable loss, damage and injury to its business and goodwill and reputation if the defendants are not permanently restrained from resuming its illegal activities.

Court issued an ex parte ad interim injunction in favour of the plaintiff and against the defendant restraining them from using the mark 'MICROSOFT' in relation to services or products given or offered by them to the public. The defendants were also restrained from using 'Microsoft' in any manner in their domain name.

Times Internet Ltd. v. Time Broadband Services Pvt.Ltd.[118]

In this case Plaintiff was shocked when it found that the defendant on 11th January, 2005 at Mumbai, has with mala fide intention and unlawfully registered a company in the name of M/s Time Broadband Services Pvt. Ltd., which apparently confusingly similar to the name of the plaintiff's company. The defendant has also registered a domain name "timebroadbandindia.co" on 15.11.2005 with M/s Network Solutions Inc. and created a website namely www.timebroadbandindia.com on the internet. The defendant has not only used the identical name as of the plaintiff's company but the services offered by the defendant were also similar to the plaintiff's services. The intention of the defendant was to take benefit of the goodwill of the plaintiff's company. Registration of the defendant is not only unauthorized and illegal but has a potential to create confusion in the consumers mind and affect the goodwill and business of the plaintiff.

Plaintiff requested in the suit for permanent injunction. So that the defendant may be restrained from infringing the trademark, copyright, further damage and

[118] Delhi High Court, CS(OS) 2004/2006 & IA Nos.2620/2007 (u/O 6 R 17) &11806/2006 (u/O 39 R 1 & 2) *available at*: https://indiankanoon.org/doc/148789658/ (Accessed on 28.10.2016).

domain name. The plaintiff stated that M/s Times Internet Ltd. (hereinafter referred to "TIL") is a registered company under the Companies Act, 1956. Its promoter company is M/s Bennett Coleman & Co. Ltd. (hereinafter referred to "BCCL"). BCCL has started ecommerce business ten years back, under the Trademark "indiatimes" and has a website "indiatimes.com". Its website was registered as a domain name with the Registrars "Network Solutions Inc.". Using this site, BCCL was dealing in large variety of services and goods to the public at large. The word "indiatimes" were invented by BCCL as BCCL is the owner of various publications including Navbharat Times, Times of India, The Economic Times, etc. commonly known as the Times Group Publications.

BCCL became the lawful and beneficial owner of intellectual property rights, copyrights, trademarks and design rights in the alleged mark and logo "indiatimes" including the domain name i.e., "indiatimes.com". Moreover the case of the plaintiff is that BCCL usually carry out its internet business as well as its website/portal "indiatimes.com" to the plaintiff company through an agreement dated 1st April, 2000. The plaintiff extended its services by stepping into the area of radio and television broadcasting and started to offer broadband service to the public at large via its flagship portal www.indiatimes.com. The said service is displayed and marketed through a radio button on the aforementioned portal which leads to http://broadband.indiatimes.com. On 19.04.2004, the plaintiff also registered two domain names i.e. "indiatimesbb.com" and "indiatimesbroadband.com" devoted for providing the broadband service in addition to its portal "indiatimes.com" with the Registrars Network Solution Inc.. The plaintiff has put huge money and made investment for designing and development of the aforesaid websites. Millions of people in order to avail various internet shopping / services started visiting the plaintiff's website. The plaintiff company has ten million registered users and does a business of eighty million worth of online shopping every month and received more than thirty million SMSs and a hundred billion eyeballs in a month.

Court held that it is proved that the registration and adoption of the defendant's website www.timebroadbandindia.com and domain name "timebroadbandindia.com" on the internet amounts to passing off and amounts to violation of plaintiff's registered trademark. It is beyond doubt that the name "timebroadbandindia.com" adopted by the defendant is confusingly similar to the name of "indiatimesbb.com" and "indiatimesbroadband.com" of the plaintiff. There is a possibility of confusion."

Raymond Ltd v. Raymond Pharmaceutical Pvt. Ltd[119]

In this case the Plaintiffs seek injunctions restraining the Defendants, their Directors, proprietors, servants, subordinates, representatives, stockists, dealers and agents and other persons under them, from infringing the Plaintiffs' registered mark 'Raymond' ("the Mark") in any manner including by using the Mark or any similar mark in the domain name www.raymondpharma.com any other similar mark as a part of the Defendants' website, Email address or otherwise. The Plaintiffs also seek to restrain the Defendants from passing off the Defendants' goods or website as that of the Plaintiffs.

Court held that:-

> *it feels that it will be appropriate to consider the nature of the domain name system before proceeding to decide the Motion. Since inception of the domain name system, a domain name has been the identifier of an individual or entity operating within the World Wide Web comprising cyberspace. There have been various examples in which several parties with legitimate trade mark rights make claims to the same or similar domain names. In the American experience delta.com is one name in which many trademark holders claimed interest including the well known airlines and some manufacturers of other products. Multiple trademark holders across geographical regions claimed use of the name. The registration of the corresponding domain name by one of these players was found unlikely of trigger bad faith requirements. Domain name registration has always been subjected to the first come first serve test and hence a registrant will obtain registration on application and subsequent applicants for the same name may find themselves in a complex situation where each of them have an interest corresponding with the domain name in question. The first applicant's registration will generally prevail unless there*

[119] Bombay High Court, SUIT (L) NO.957 OF 2014, Decided on 20 July, 2016 *available at:* https://indiankanoon.org/doc/101010088/(Accessed on 28.10.2016).

are an agreement inter se these parties claiming the same name. It is always open to all persons to appropriate specific domain names in agreement with another. Multiple applicants for the same domain name alludes to prospective rivalry. The trade mark system allows multiple parties to hold the same mark provided they operate in different product categories or geographical areas whereas the domain name system by its very nature permits only one applicant to register a particular domain. Once registered such registration inures for the benefit of the registrant for the contracted period of time after which such registration is required to be renewed failing which it may lapse... Unfortunately the law has not kept abreast with these technological developments and the use of domain names has often seen required Courts to deal with traditional contractual law, trademark law etc. in an attempt to consider whether domain names constituted property... The underlying test of trademark infringement is confusion amongst customers about the source of products or services. In relation to domain name disputes use of a trademark in a domain name might confuse consumers about the source of product or services marketed on website. The expression "initial interest confusion" does not find any expressive description; however, the same is being developed into a doctrine in the United States. Applying this concept to the instant case we are required to consider whether a use of the mark "Raymond" by the defendants in its domain name "raymondpharma.com" would necessarily lead to "initial interest confusion" inasmuch as would a netizen who comes across the domain name "www.raymondpharma.com" be so confused initially that she or he would mistake the site as that of the plaintiff. I think not. As has been the experience usage of a mark may result in dilution of the mark and this can take the form of blurring or tarnishment. Blurring of the mark is said to occur as a result of similarity between the offending mark and famous mark, as a result of which the distinctiveness of the famous mark is affected. In the present case I do not find any evidence of an attempt of cause "initial interest confusion ... The defendant company has succeeded in continuing to use its corporate name and now uses a slightly shorter form of its corporate name as its domain name. This, in my view is unlikely to cause any initial interest confusion since the domain name of the defendants very *clearly indicates that the website "www.raymondpharma.com" is clearly intended to be the domain name of the defendant engaged in a business which is not carried on by the plaintiffs since the plaintiffs are admittedly not in the business of pharmaceuticals*"

6.6. Concluding Remarks

A careful reading of above discussion 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.

Chapter-7

Role of Alternative Dispute Resolution Mechanism in Addressing Domain Name Disputes

7.1. Introduction

In view of a global character of the Internet and the fact, that trademark law could be applied only in the narrow context; traditional legal processes do not provide any longer effective and convenient litigation in resolving international disputes regarding Internet domain names.

It is right that judiciary, around the world, has played a pivotal role in resolving the domain name disputes. As discussed in the preceding chapter, judiciary, especially in the India, United States of America (U.S.A.) and United Kingdom (U.K.), is breaking new grounds and formulating novel concepts that are stretching the horizons of existing laws and laying a strong foundation for the new ones. As far as legislative measures are concern barring U.S.A., and few countries, there is a vacuum.

However, judiciary alone not able to provide quick and adequate protection, which is very much crucial for a commercial entity.

Thus, 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.

As already highlighted in the preceding chapters, most of the cases pertaining to domain name disputes relate to the misuse and abuse of Domain Name System (DNS) registration process. Since Internet Corporation for Assigned Names and Numbers (ICANN)[1] assumed management of the DNS from Network Solutions Inc. (NSI) in 1999 at international level, it was natural that ICANN also initiated an alternative dispute resolution mechanism for all domain name registrants.

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[1] A non-profit, private sector corporation based in Marina del Rey, California, USA. Official Website: http://www.icann.org/ discussed earlier.

In its endeavors to provide an administrative-level solution to the disputes relating to domain name, ICANN has devised a number of policies and associated rules. The major ICANN policies and rules concerning dispute resolution include:

- "Uniform Domain Name Dispute Resolution Policy" (UDRP)[2], which permits service mark and trademark holders to arbitrate certain issues against a domain name registrant before an approved dispute resolution service provider.
- "Uniform Domain Name Dispute Resolution Policy" - the "Rules[3], which sets out the procedure to be adopted during administrative proceedings for the resolution of domain name disputes under the ICANN UDRP. Furthermore, such procedures are additionally represented by the Supplemental Rules of the Provider managing the procedures, as posted on its site. To the degree that the Supplemental Rules of any Provider strife with these Rules, these Rules supersede.

Beside the above alternative disputes redressal mechanism, there are four ICANN-Approved Dispute Resolution Providers:

1. "Asian Domain Name Dispute Resolution Centre" (ADNDRC)[4]
2. "National Arbitration Forum" (NAF or FORUM)[5]
3. "WIPO Arbitration and Mediation Center"
4. "Arbitration Centre for Internet Disputes" (Czech Arbitration Court)[6].

As far as India is concern, trademark jurisprudence was already vibrant with judiciary lending legal protection to registered and unregistered trademarks through Trade and Merchandise Marks Act, 1958 and the English Common Law of passing-off, respectively. However, with newer challenges posed by technology, there has been a constant tussle among the advocates of a *sui generis* mechanism to deal with cases pertaining to domain name disputes on the one hand; and the *status quoists* on the other, who prefer application, suitable interpretation, and extension of existing laws to deal with new challenges.

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[2] See, Appendix 1.
[3] See, Appendix 2.
[4] Official Website: https://www.adndrc.org/index.html (Accessed on 10.11.2016).
[5] Official Website: http://www.adrforum.com/ (Accessed on 10.11.2016).
[6] Official Website: http://www.adr.eu/index.php (Accessed on 10.11.2016).

To overcome the above problem, an alternative dispute redressal mechanism at national level was devised. In India, the registrants are required to submit to a compulsory arbitration proceeding under the **.IN** Domain Name Dispute Resolution Policy (INDRP)[7]. In India **.in** ccTLD registration is managed by INRegistry, which was formed by National Internet Exchange of India (NIXI)[8], a Government of India undertaking.

This chapter will solely focus on the alternative mechanism devised for the proper resolution of domain name disputes. In the coming paragraphs all above mentioned dispute resolution providers will be discussed in detail. Researcher will also try to find out how far these alternative mechanisms are successful in resolving the domain name disputes.

7.2. ICANN's Uniform Domain Name Dispute Resolution Process

The Uniform Dispute Resolution Policy ('UDRP') provides, through a purely administrative procedure, a system intended for the determination of domain name disputes between trade mark proprietors and domain name owners who assert that a particular domain name infringes the rights of the trade mark owner in his or her trade mark. It was designed to provide a quick resolution to these types of disputes. The main consideration in the design of the UDRP was to create a convenient, cost-effective and fast procedure to combat cybersquatting[9].

Since 1999, the evolution of the UDRP had included an emphasis on defining as well as implementing the best methods and ways of reaching solution in the most disputable and challenge domain name issues. The number of registered domain names is steadily growing, and, in general, in years following the creation of UDRP, more than 7,000 cases have been already settled.

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[7] See, Appendix 3

[8] See www.nixi.in/en/abiut-us.

[9] As have been underlined in RFC 1591 on Domain name System structure and delegation: "The registration authority shall have no role or responsibility other than to provide the contact information to both parties in case of a dispute between domain names registrants as to the rights to a particular name. The domain name registration does not have any trademark status. It is up to the person making application to be sure he is not infringing anyone else's trademark" *available at* : http://www.faqs.org/rfcs/rfc1591.html(Accessed on 12.11.2016).

7.2.1. Brief History of UDRP

As has been discussed in chapter -4, the current system of domain name governance, centered on ICAAN, developed from recommendations made in the 1998 National Telecommunication and Information Administration (NTIA) "Statement of Policy on the Management of Internet Domain Names and Addresses" final report (known as the "White Paper")[10], which was published by the United States Department of Commerce, calling upon WIPO to conduct a study and to develop recommendations for a uniform approach to resolving domain name / trademark disputes involving cyber piracy[11].

Final Report of the WIPO Internet Domain Name Process

The negotiation of a new international treaty was also considered to be involved in a process, and due to the dependence of the development of national law, there was no possibility of the result of an effective mechanism suited to the international nature of these disputes. In order to solve domain name disputes, a universally mandatory and uniform procedure to deal with what often developed into transnational disputes in an effective way was required. With the help of its contracting parties, WIPO, which is authorized to promote the protection of intellectual property around the world, led widespread international consultations, resulting in the publication of a Report which addressed domain name issues and made proposals for their resolution[12].

The Final Report of the WIPO Internet Domain Name Process (First WIPO Report) suggested the making of an online administrative dispute resolution procedure, which would have all inclusive application for all .com, .net and .organization enrollments. The method would in this way apply to any name registered in those gTLDs, independent of the registrar through which the registration

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[10] Management of Internet Names and Addresses, Statement of Policy, 63 Fed. Reg. 31, 741,31,746 (June 10, 1998) ("White Paper"), *available at* http://www.ntia.doc.gov/ ntiahome/ domain name/6_5_98dns.htm(Accessed on 12.11.2016).

[11] Torsten Bettinger and Allegra Waddell (eds.), *Domain name law and practice, An international handbook*, 940 (second edition, Oxford University press, 2015).

[12] The Management of Internet Domain Names and Addresses: Intellectual Property Issues, FinalReport of the WIPO Internet Domain Name Process, April 30, 1999; the Report is *available at:* WIPO's web site at http://wipo2.wipo.int/process1/report/finalreport.html (Accessed on 12.11.2016).

was made and regardless of the date of registration. WIPO made the accompanying proposals:

(a) The procedure ought to be controlled by independent dispute resolution bodies, which would be in charge of the appointment of the panel of decision-makers and for the administration of the procedure.

(b) The extent of the procedure ought to be constrained to the abusive registration of trademarks as domain names.

(c) The procedure ought to be efficient, quick, cost-effective and conducted to a large extent online.

(d) Third parties ought to have the capacity to challenge domain name registrations and the dispute ought to be chosen by a panel of independent expert decision-makers.

(e) The accessibility and conduct of the administrative procedure ought not deny the parties to the dispute access to national court proceedings, either before, during or after the procedure.

(f) Registration authorities ought to be obliged to implement decisions made under the procedure ordering the transfer or cancellation of a domain name, without the requirement for a court to survey or affirm such decisions.

(g) The main cures accessible under the procedure ought to be constrained to the transfer or cancellation of the domain name registration (no pecuniary damages).

(h) The lawful foundation for the procedure ought to be the domain name registration agreement through which the registrant assents to present to the procedure.

Adoption of the UDRP

After contemplation and endorsement by the WIPO Member States, the First WIPO Report was submitted to ICANN for its review. In August 1999, ICANN resolved to adopt the Uniform Domain Name Dispute Resolution Policy[13], which, basically, implements the above WIPO recommendations. ICANN also adopted dispute resolution service providers to administer disputes that are brought under the UDRP, the WIPO Arbitration and Mediation Center being the first such dispute resolution service provider.

Entry into effect of the UDRP

On December 1, 1999, the UDRP came into effect. Right from its coming into force, the UDRP has been generally used as a tool to combat the abusive registration of domain names by cybersquatters, with over 10,000 gTLD cases filed under the procedure by the end of 2015[14].

7.2.2. Objectives of UDRP

The statistics which can be taken from ICANN as well from other different sources proves that the results of using the Uniform Domain Name Dispute Resolution Policy in handling cases were assessed quite positively. The UDRP policy is targeted on domain name disputes resolution in a manner which makes this process to be quick, easy and cost effective. In comparison with court litigation, finding solution under the UDRP costs and time is comparatively very less.

In terms of uniform character of UDRP, it lessens all kind of jurisdictional problems which can occur while resolving international issues. Thus, there are three main objectives of the UDRP[15]:

a) to get rid of competition and range amongst the jurisdictions and rule sets applied to domain name-trademark disputes;

b) to decrease the expenses of resolving disputes;

c) to give quick and less expensive way for resolution of the easiest cases.

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[13] Uniform Domain Name Dispute Resolution Policy, adopted on August 26, 1999, *available at* : http://www.icann.org/udrp/udrp-policy-24oct99.htm. (Accessed on 12.11.2016).

[14] See http://www.icann.org/udrp/proceedings-stat.htm (Accessed on 13.11.2016).

[15] Milton Mueller, *Rough justice*, An analysis of ICANN's Uniform Dispute Resolution Policy *available at:* http://ccent.syr.edu/wp-content/uploads/2014/05/roughjustice.pdf (Accessed on 15.11.2016).

7.2.3. UDRP's SCOPE

The UDRP is global in scope, in that it gives a solitary system to settling a domain name dispute regardless of where the registrar, the complaining trademark owner is located or the domain name registrant. Any individual or organization on the planet can file a request for the resolution of a domain name dispute through the UDRP procedure, asserting that each of the UDRP conditions is met in its case. UDRP proceedings administered by the WIPO Center have involved parties from over 109 countries over the world[16].

What disputes are covered?

The UDRP, just, prohibits only single sort of conduct for which the UDRP administrative procedure can be used – the abusive, bad faith, and deliberate registration of domain names (or, 'cybersquatting') with reference only to trade marks[17]. The UDRP administrative procedure is not available in cases where a registered domain name is the subject of a legitimate dispute, or where other intellectual property rights (such as trade names, geographical indications, or personality rights) are violated by a domain-name registration.

The UDRP in this way offers relief to owners of the trademarks who succumbed to to cybersquatting practices[18]. For a complaint to be successful under UDRP, the complainant must show that a respondent has infringed all three of the accompanying elements:

(1) Domain name is confusingly similar or identical to a trademark in which the complainant has rights;

(2) Respondent has no lawful interests in the domain name; and

(3) Respondent has registered the domain name, and is using it in bad faith[19].

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[16] See, http://www.wipo.int/pressroom/en/articles/2017/article_0003.html

[17] ICANN, Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy (October 24, 1999), *available at*: http://www.icann.org/udrp/udrp-second-staff-report-24oct99.htm. (Accessed on 18.11.2016).

[18] Paragraph 4(a),UDRP. Full text *available at:* http://www.icann.org/en/udrp/udrp-policy-24oct99.htm. (Accessed on 18.11.2016). Also see, Appendix 1.

[19] *Ibid*.

With a specific goal to succeed in a UDRP proceeding, the complainant demonstrates respondent's bad faith in domain name registration. The respondent's bad faith can be confirmed by demonstrating any of the accompanying conditions:

(i) indicating circumstances that show that the registration is done mainly for the purpose of renting, selling or otherwise transferring the registration of domain name to the complainant (trademark owner)for cost in excess of the documented out-of-pocket costs directly related to the domain name; or

(ii) the domain name is registered primarily for the purpose of disrupting the business of a competitor; or

(iii) the domain name is registered in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or

(iv) the registrant the domain name, has intentionally attempted to attract, for commercial gain by using the domain name, by creating a likelihood of confusion with the complainant's mark as to the sponsorship, source, affiliation, or endorsement of registrant's website or location or of a service or goods on registrant's website[20].

Nonetheless, the respondent can nullify a bad faith plea of the complainant by showing any of the following:

(i) the respondent was generally known by the domain name, even if he has not registered trademark; or,

(ii) provable preparations to use the domain name or a name similar to the domain name regarding a bona fide offering of services or goods, before any notice of the dispute was received; or

(iii) the respondent is making a lawful non-commercial of the domain name, without intent for: misleadingly diverting consumers or commercial gain, or, to ruining the goodwill of trademark at issue[21].

[20] Paragraph 4(b),UDRP.
[21] Paragraph 4(c), UDRP.

7.2.4. Stages in the procedure

The procedure to be followed in case of a domain name dispute before one of the ICANN-Approved Domain Name Dispute Resolution Providers is laid down under the Rules. The procedure is designed to take a maximum of sixty days to complete from initial submission of the complaint to the final decision rendered:

Stage 1: Filing of a Complaint

The complainant[22] files electronic copies of the complaint, which may relate to more than one domain name provided that the domain names are registered by the same domain name holder, with the Arbitration Forum as well as the respondent. Such complaint may be accompanied by annexes as documentary or other evidence, including a copy of the policy applicable to the domain name(s) in dispute and any trademark or service mark registration upon which the complainant relies, together with a schedule indexing such evidence. The contents of the complaint include[23]:

(a) Request that the complaint be submitted for decision as per the UDRP and the Rules;

(b) Provision of the name, the telephone and tele-fax numbers, and postal and e-mail addresses of the complainant and of any representative authorized to act for the complainant in the administrative proceeding;

(c) Condition of a preferred method for communications directed to the complainant in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy (where applicable) ;

(d) Designation whether complainant chooses to have the dispute decided by a a three-member Panel or single-member and, in the event complainant chooses a three-member Panel, provision of the names and contact details of three candidates to serve as one of the Panellists (these candidates may be drawn from any ICANN-approved Provider's list of Panellists) ;

[22] Paragraph 4(c), UDRP.

[23] Paragraph 1, UDRP Rules see Appendix 2.

(e) Provision of the name of the respondent (domain name holder) and all information (including any addresses and telephone, telefax numbers and postal and e-mail) known to complainant with respect to how to contact respondent or any representative of respondent, including contact details in view of pre-complaint dealings, in adequate detail to allow the Provider to forward the complaint to the respondent ;

(f) Specification of the domain name(s) that is / are the subject of the complaint;

(g) Identification of the Registrar(s) with whom the domain name(s) is / are registered at the time the complaint is filed;

(h) Specification of the trademark(s) or service mark(s) on which the complaint is based and, for each mark, describe the goods or services, if any, with which the mark is used (complainant may also separately describe other goods and services with which it intends, at the time the complaint is submitted, to use the mark in the future.);

(i) Description, in accordance with the UDRP, the grounds on which the complaint is made (in satisfaction of Paragraph 4 of UDRP);

(j) Specification of the remedies sought in accordance with the UDRP;

(k) Identification of any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint;

(l) Statement to the effect that a copy of the complaint, including any annexes, together with the cover sheet as prescribed by the Provider’s Supplemental Rules, has been sent or transmitted to the respondent (domain name holder);

(m) Statement to the effect that complainant will submit, regarding to any challenges to a decision in the administrative proceeding cancelling or transferring the domain name, to the court’s jurisdiction in at least one specified Mutual Jurisdiction. A mutual jurisdiction is either

(a) at the principal office of the Registrar (if the domain name holder has submitted in its Registration Agreement to that jurisdiction for court adjudication of disputes concerning or arising from the use of the domain name) or

(b) at the location of the domain name holder's address as shown for the registration of the domain name in the Registrar's WhoIS[24] database at the time of the complaint (if the domain name holder has not submitted to such jurisdiction in the registration agreement).

(n) Conclusion with the following statement followed by the signature (in any electronic format) of the complainant or its authorised representative: "Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain name holder and waives all such claims and remedies against (a) the dispute resolution provider and Panellists, except in the case of deliberate wrongdoing, (b) the Registrar, (c) the registry administrator, and (d) the Internet Corporation for Assigned Names and Numbers (ICANN), as well as their directors, officers, employees, and agents. Complainant certifies that the information contained in this complaint is to the best of complainant's knowledge complete and accurate, that this complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good faith and reasonable argument."

Stage 2 : Formal commencement of UDRP proceeding

Upon receipt of the complaint, the Provider shall, within 3 days of receipt of applicable fee:

(a) review the complaint for administrative compliance with the UDRP and the Rules;

(b) if the complaint is found to be in compliance with the UDRP and the Rules, Provider shall forward it, including any annexes, electronically to the respondent and shall also send written notice of the complaint (together with the explanatory cover sheet prescribed by the Provider's Supplemental Rules) to the respondent;

(c) if the complaint is found to be administratively incomplete, Provider shall inform the complainant and the respondent of the nature of the deficiencies

[24] See, https://www.whois.com/.

identified. The complainant shall have five (5) calendar days within which to rectify any such lacks, after which the administrative proceeding will be deemed withdrawn without prejudice to submission of a alternate complaint by complainant ;

(d) fix the date of initiation of the administrative proceeding as the date when Step 2 is completed; and

(e) at once inform the complainant, the respondent, the concerned Registrar(s), and ICANN of the date of initiation of the administrative proceeding[25].

Stage 3: Filing of a Response by Respondent

Within twenty (20) days of the date of commencement of the administrative proceeding, the respondent shall electronically submit a response, including any annexes comprising any documentary or other evidence upon which the respondent relies, together with a schedule indexing such documents, to the Provider, detailing:

(a) specific response to the allegations and statements mentioned in the complaint, as well as of any basis for the respondent to keep registration and use of the questioned domain name. The response shall comply with any word or page limit set forth in the Provider's Supplemental Rules;

(b) the name, the telephone and telefax numbers, and postal and e-mail addresses of the respondent and of his authorized representative;

(c) a preferred method for communications directed to the respondent in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy (where applicable);

(d) if the complainant has elected a single-member Panel in the complaint, a statement whether respondent elects instead to have the dispute decided by a three-member Panel;

[25] Rule 4, UDRP Rules see Appendix 2.

(e) if either complainant or respondent elects a three-member Panel, the names and contact details of three candidates to serve as one of the Panellists (these candidates may be drawn from any ICANN-Approved Provider's list of Panellists);

(f) identity of any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint;

(g) a statement to the effect that a copy of the response, including any annexes, has been sent or transmitted to the complainant;

(h) Conclusion with the following statement followed by the signature (in any electronic format) of the respondent or its authorised representative: "Respondent certifies that the information contained in this response is, to the best of respondent's knowledge, complete and accurate, that this response is not being presented for any improper purpose, such as to harass, and that the assertions in this response are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good faith and reasonable argument."

(i) in case the complainant has elected to have the dispute decided by a single-member Panel and respondent elects a three-member Panel, the respondent shall be required to pay one half of the applicable fee for a three-member Panel as set forth in the Provider's Supplemental Rules. This payment shall be made together with the submission of the response to the Provider. In the event that the required payment is not made, the dispute shall be decided by a single-member Panel. At the request of the respondent, the Provider may, in exceptional cases, extend the period of time for the filing of the response. The period may also be extended by written stipulation between the parties, provided the stipulation is approved by the Provider. If a respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint[26].

[26] Rule 5, UDRP Rules.

Stage 4: Appointment Administrative Panel of one or three members

The Panellist(s) for the case will be appointed by the Provider from among the publicly available list of Panellists and their qualifications under the following circumstances:

(a) If neither the complainant nor the respondent has elected a three-member Panel, the Provider shall appoint a single Panellist within five (5) calendar days following receipt of the response by the Provider, or the lapse of the time period for the submission thereof. The fees for a single-member Panel shall be paid entirely by the complainant.

(b) If either the complainant or the respondent elects to have the dispute decided by a three member Panel, the Provider shall appoint three Panellists. The fees for a three-member Panel will be completely paid by the complainant, aside from where the election of the three-member Panel was made by the respondent; in that case the applicable fees will be shared equally among the parties.

(c) Unless it has already chosen a three-member Panel, the complainant shall submit to the Provider, within five (5) calendar days of communication of a response in which the respondent elects a three-member Panel, the names and contact details of three candidates to serve as one of the Panellists. These candidates may be drawn from any ICANN Approved Provider's list of Panellists.

(d) If either the complainant or the respondent chooses a three-member Panel, the Provider might attempt to designate one Panelist from the list of candidates gave by each of the complainant and the respondent. In the occasion, the Provider is unable within five (5) timetable days to secure the arrangement of a Panelist on its standard terms from either party's list of candidates; the Provider might make that arrangement from its list of Panelists. The third Panelist should be appointed by the Provider from the list of five candidates selected by the Provider to the Parties, the Provider's determination from among the five being made in a way that sensibly adjusts the inclinations of the two Parties, as they may indicate to the Provider within five (5) calendar days of the Provider's submission of the five-candidate list to the parties.

(e) Upon finalization of entire Panel, the Provider shall inform the parties about the Panellists selected and the date by which the Panel shall started its decision on the complaint to the Provider[27].

Satge 5: Issuance of the Administrative Panel decision

The Arbitration Panel submits its decision to the Forum within fourteen (14) days of its appointment[28]. Paragraph 3, UDRP[29] stipulates that the Arbitration Panel can make any of the following decisions pursuant to the conclusion of arbitration proceedings:

(a) Make a decision in favour of the domain name registrant (i.e., reject the requested remedy); or

(b) Transfer registration of domain name; or

(c) Cancellation registration of domain name.

By the way, if the Panel decided that the dispute does not fall within the scope of Paragraph 4(a) of the UDRP, it must state this in its decision. Also, if after considering the submissions of the parties, the Panel finds that the complaint was brought in bad faith, the Panel is required to declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. However, the arbitration proceedings are liable to be terminated under any of the following circumstances:

(i) If, before the Panel's decision, the parties agree on a settlement, or

(ii) If, before the Panel's decision, it becomes unnecessary or impossible to continue the administrative proceeding for any reason, unless a party raises justifiable grounds for objection within a period of time to be determined by the Panel, or

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[27] Rule 6, UDRP Rules.

[28] Rule 15, UDRP Rules.

[29] *Ibid.*

(iii) In the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain name dispute that is the subject of the complaint.

The party initiating the legal proceeding shall promptly notify the Panel and the Provider. In this case, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision[30].

Within three (3) days after receipt of the decision, the Arbitration Forum notifies the parties, ICANN, and the respective Internet domain name Registrar(s)[31]. Paragraph 4(f) of UDRP provides for consolidation of multiple disputes among the parties by petitioning before a single Administrative Panel. The Panel may consolidate such disputes provided that the disputes being consolidated are governed by ICANN UDRP.

Stage 6: Without Prejudice to Court Adjudication

Once a UDRP proceeding is initiated by the complainant, the registrant of a domain name must submit to the process. Be that as it may, in accordance with its administrative nature, the UDRP cannot prevent the trademark holder or the domain name registrant from presenting the issue to a court for independent resolution; either party may start a suit in court before, during, or after a UDRP proceeding. Paragraph 4(k) of the UDRP additionally permit a losing registrant of domain name to challenge the administrative panel's decision by filing a suit in a competent court and thereby suspend the execution of the panel decision.

In case the Panel decides that a domain name registration should be cancelled or transferred, upon the information by the Provider to ICAAN, the latter will wait ten (10) business days before implementing that decision. The resolution offered under UDRP is mandatory in the sense that the accredited Registrars are bound to take the necessary steps to enforce a decision. However, either party retains the option to take the dispute to a court of competent jurisdiction for independent resolution[32]. If during this duration of ten (10) days, the respondent submits official documentation (like a copy of a complaint, file-stamped by the clerk of the court) to the effect that a lawsuit

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[30] Rule 18, UDRP Rules.

[31] Rule 16, UDRP Rules.

[32] Hemant Goel, *Law & Emerging Technology* 112 (Jain Book Depot, 2010).

against the complainant is initiated in a jurisdiction to which the complainant has submitted under the Rules, the implementation of the decision will be stayed, until the complainant delivers (i) satisfactory evidence of a resolution between the parties; (ii) satisfactory evidence that the lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing the lawsuit or ordering that respondent does not have the A right to continue to use complainant's domain name[33].

Paragraph 8(a)[34] of UDRP expressly prohibits transferring domain name registration to another holder during a pending administrative proceeding; or for a period of fifteen (15) business days after such proceeding is concluded; or during a pending court proceeding or arbitration commenced regarding the domain name. All such transfers are liable to be cancelled unless the party to whom the domain name registration is being transferred agrees, in writing, to be bound by the decision of the arbitrator or court.

Further, Paragraph 8(b) prohibits transferring domain name registration to another Registrar during a pending administrative proceeding; or for a period of fifteen (15) business days after such proceeding is concluded. However, administration of the domain name registration may be transferred to another Registrar during a pending court action or arbitration, provided that the domain name shall continue to be subject to the proceedings commenced against the respondent in accordance with the terms of UDRP.

7.3. Major advantages of UDRP Mechanism

Proceedings under ICANN UDRP are propagated as arbitration process that has several advantages over traditional litigations. Some of these advantages include:

1. Advantage of the UDRP is that, as opposed to decisions of national court, which involve time-consuming enforcement procedures, a UDRP decision simply requires to be informed to the registrar, which is then required to apply the Administrative Panel finding. Practice reveals that in the absence of

[33] Paragraph 4(k), UDRP see Appendix 1.

[34] Full text *available at:* http://www.icann.org/en/udrp/udrp-policy-24oct99.htm. (Accessed on 20.11.2016). Also see, Appendix 1.

exceptional circumstances it takes not more than two months to resolve a UDRP dispute on average.

2. Another favorable position of the UDRP technique is that it commonly gives a less expensive method for settling a dispute with respect to the registration and utilization of an Internet domain name. The strategy is significantly more casual than normal litigation and the decision-makers are experts in such areas as domain name issues, e-commerce, and Internet dispute resolution and trademark law[35].

3. UDRP consists of one single procedure, as opposed to several court actions in different countries, which consists of a number of different procedures.

4. The process followed by UDRP is transparent. The WIPO Center posts full-text of decisions, case statistics, case status and all disputed domain names on its web site. Also, the WIPO Center's online Index of WIPO UDRP Panel Decisions, and its jurisprudential overview of key issues offer free and easy access to the jurisprudence developed under the UDRP.[36]

5. The scope of UDRP is universal, as it provides a single method for resolving a domain name dispute regardless of where the complaining trademark owner, the domain name registrant, or the registrar is located[37].

6. An important advantage of the UDRP procedure is the compulsory execution of the subsequent decisions. There are no international enforcement issues, as registrars are under duty to take the essential steps to implement any UDRP decisions regarding transfer, subject to the rights of losing party to approach court proceedings and suspend the implementation of the decision.

7. In contrast with the courts, the hearing in UDRP cases is conducted by experts in the field. In fact, one of the problems with traditional litigation is the lack of sufficient number of experts in the judiciary. Most judges that are faced with

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[35] Jay P. Kesan & Andres A. Gallo, Market for Private Dispute Resolution Services - An Empirical Re-Assessment of ICANN-UDRP Performance, The, 11 Mich. Telecomm. & Tech. L. Rev. 285 (2005). *Available at:* http://repository.law.umich.edu/mttlr/ vol11/iss2/4(Accessed on 25.11.2016).

[36] See, http://www.wipo.int/amc.

[37] *Ibid.*

domain name issues know little about the domain name system and the actual commercial importance of the domain name in today's economy.

8. UDRP proceedings are conducted primarily by e-mail without the burdens of traditional litigation procedure, such as discovery[38].

9. In pursuance of its validation agreement with ICANN, all gTLD registrars agree to implement and abide by the UDRP. As a result, the UDRP proceeding is applicable to all gTLDs introduced by ICANN. The UDRP has been included into the standard dispute resolution clause of all gTLD domain name registration agreements. Therefore, the registrant of a gTLD domain name will have to submit to any proceeding that is brought under the UDRP, regardless of the possibility that the domain name registration was affected before the entry into force of the UDRP. Apart from the gTLDs, certain ccTLDs have also adopted the UDRP on a voluntary basis.

10. The remedies available under the UDRP consist of the transfer or cancellation of the domain name in dispute. No monetary remedies are available. The only award is the right to use a domain name. An UDRP proceeding is that Internet domain name arbitration involves trademarks - intellectual property. Most other international arbitration cases involve disputes over goods or services[39].

7.4. Shortcomings of the UDRP

As many researchers have noted, the UDRP as a relatively new policy has been object of much discussion and critical remarks concerning it cover not only organizational structure and procedural practice of the system, but also consider efficiency of the cases settled out of the courts in the scope of the UDRP. Although the bulk of given remarks and comments on the efficiency of the UDRP are generally

[38] David W. Maher, The UDRP: The Globalisation Of Trademark Rights, IIC - International Review Of Intellectual Property And Copyright Law, Max Planck Institute for Intellectual Property, Competition and Tax Law, Vol. 33, 8/200, pp. 924-940, at 925, *available at*: http://dmaher.org/Publications/globaliz.pdf. (Accessed on 25.11.2016).

[39] Christopher S. Lee, The Development Of Arbitration In The Resolution Of Internet Domain Name Disputes, 7 RICH. J.L. & TECH. 2 (Fall 2000), *available at*: http://jolt. richmon.edu /v7il/article 2.html.mu. (Accessed on 25.11.2016).

positive[40], there are still many unresolved issues in the system that may cause serious obstacles. Basing on the miscellaneous facts and documents of renowned authors in discussed area, researcher would like to figure out and analyze the most important problems.

1. First of all, UDRP proceedings cannot be classified as 'arbitration' in the strict sense of the term, For instance, in U.S.A, the Third Circuit ruled that a domain name dispute decided compliant to the ICANN UDRP is not arbitration under the U.S. Federal Arbitration Act (FAA) and, therefore, is not qualified to the respectful standard of judicial review afforded by the FAA. In *Dluhos v. Strasberg,* the plaintiff, Dluhos, registered the domain name "leestrasberg.com", based on the name of famous acting mentor "Lee Strasberg". Defendant, widow of Strasberg and estate brought a complaint with National Arbitration Forum against Dluhos in pursuant to the ICANN UDRP. The UDRP Panel ordered that the domain name be transferred to the Strasbergs. Plaintiff, in turn, filed a complaint in Federal Court seeking, among other things, restoration of his right in the domain name. The District Court reviewed the UDRP decision under the FAA's extremely deferential standard of review, under which a District Court may only vacate an arbitration award when the arbitrators were guilty of misconduct, or when the evidence demonstrates a 'manifest disregard of the law. Applying these highly deferential standards, the District Court granted the Strasberg motion to dismiss Dluhos complaint. However, on appeal to the U.S. Court of Appeals for the Third Circuit, the decision was reversed and remanded, holding that a non-binding ICANN UDRP decision is not an *"arbitration under the FAA, which only applies to 'contracts...to settle disputes by arbitration.*[41]*"*

[40] The International Trademark Association (INTA) has released two responses, one to Mueller's study (UDRP-A Success Story: A Rebuttal to the Analysis and Conclusions of Professor Milton Meuller in "Rough Justice" (May 6, 2002)), *available at* http://www.inta. org/ downloads /tap_udrp_1paper2002.pdf, and one to Giest's Study (The UDRP By All Accounts Works Efficiently: Rebuttal to the Analysis and Conclusions of Professor Michael Giest In "Fair.Com?" and in "Fundamentally Fair.com" (May 6, 2002)), at http://www.inta.org/ downloads /tap_udrp_2paper2002.pdf). These responses criticize the studies conclusions, mostly relying on methodological reasons and mere supportive manifestations in favour of the UDRP. Nevertheless, both responses failed to rebut or to provide plausible alternative explanation to the striking statistical data.

[41] Case No. 01-3713, 2003 U.S. App. LEXIS 3014 (3rd Cir. February 20, 2003). *available at :* www.finnegan.com/publications/updatenewsletters/pubdetail.aspx?pub=1d362e7f... (Accessed on 30.11.2016).

Unlike dispute resolution mechanisms covered by the FAA, the UDRP was not intended to replace formal litigation; the unique contractual arrangement under the UDRP contemplates the possibility of judicial intervention by either party at any time, including before, during, or after the UDRP process[42]. The Third Circuit further reasoned that since the trademark holder is not required to participate in a UDRP proceeding before moving to court, the UDRP proceedings do not qualify as the type that would entail a court's compelling parties' participation prior to independent judicial review - a power that is granted to Federal Courts under the FAA. Accordingly, the Third Circuit held that judicial review of UDRP decisions is not restricted to a motion to vacate an arbitration award under the FAA, which applies only to binding proceedings likely to realistically settle the dispute[43].

In *Strick Corp. v. Strickland*[44], the court observed that UDRP decisions are subject to *de novo* review. The domain name owner prevailed in a UDRP proceeding and subsequently won on summary judgment in court.

2. Another shortcoming of UDRP is that it applies only to limited variety of TLD, leaving about approximately 150 ccTLDs out of its influence. For the disputes over ccTLDs, World Intellectual Property Organization has launched its own ccTLD program which encompasses the following areas:

a) the design of appropriate domain name registration practices aimed at preventing friction between domain names and intellectual property rights;

b) the design of appropriate dispute resolution procedures, to complement traditional court litigation, aimed at resolving domain name disputes expeditiously and at moderate costs; and

c) the provision of dispute resolution services through the WIPO Arbitration and Mediation Center to any ccTLD administrator who wishes to retain it for that

[42] *Ibid.*
[43] *Ibid.*
[44] 162 F. Supp.2d 372 *available at:* www.wipo.int/amc/en/domains/decisions/html/ 2002/d2002-0184.html(Accessed on 01.01.2017).

purpose[45]

3. One more argument of prejudice against the UDRP system is the proved fact that the majority of the cases have been handled in favor of complainants, exactly trademark owners. This theory is supported by ICANN's own figures, which show that complainants win approximately eighty percent of all UDRP disputes [46]. In many science works on domain name dispute resolution, authors point out vulnerable and weak position of respondents in relation to complainants. The situation gets aggravated when the success ratio in case of respective Providers is taken into account. The Panels generally consist of IP lawyers who sympathies with trademark owner' interests[47].

4. Since the UDRP has been designed as a non-binding process[48], it simultaneously demonstrates further privilege for a complainant. To be concrete, the complainant can bring the case for the court consideration if he is not successful in the process. It is often pointed out that the respondent will in most cases be a weaker party than the complainant; how would then, in practice, establishing a regime for calculating and attributing compensation make it fairer for the respondent? Wouldn't be making it mandatory for the respondent to resort to courts to avoid complying with a compensation ruling, having to stand costly and long procedures? The complainant seems satisfied in most cases for having the domain abuse stopped, not feeling a desire to continue litigating, and the cybersquatters simply lose right to that specific domain name, without extra costs or losses and with nothing stopping him from registering different and legitimate new domains.

5. Because of the non-binding nature of the proceeding there is a most recent trend of commencing further disputes arisen over the same domain name. The Policy and the Rules are silent on guaranteeing prevention of subsequent complaints, although the

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[45] See ccTLDs Best Practices for the Prevention and Resolution of Intellectual Property Disputes (version: February 20, 2001) *available at*: http://www.wipo.int/export/ sites/ www/amc /en/docs/bestpractices.pdf(Accessed on 01.01.2017).

[46] Michael Geist, Fair.*Com: An Examination Of The Allegations Of Systematic Unfairness In The ICANN UDRP*, 27 BROOK. J. INT'L L. 903, at 910 (2002), *available at:* http://www. brooklaw.edU/~/media/PDF/LawJoumals/BJI_PDF/bji_vol27iii.ashx. (Accessed on 01.01.2017). The author concludes that complainants win 79.86% of the disputes according to ICANN's statistics. ((80.6% x 59.2%) = 47.71% + (83.3% x 34.5%) = 28.73% + (61.1% x 5.6%) =3.42%) = 79.86%.(Accessed on 01.01.2017).

[47] Richard Poynder (ed.), *Caught In A Web: Intellectual Property In Cyberspace*, 78 (Derwent Information, Thomson Scientific, 2001).

[48] See Paragraph 4(k), UDRP.

results derived from the first made motivate decision seems to lessen the chances of success in a second or third process.

6. While the UDRP Panels are able to use previous decisions to guide them to a resolution, these decisions do not serve as binding precedent. The Panels are not bound by previous decisions, regardless of the similarity between the past and present cases[49]. This results in inconsistencies in the decisions of the Panellists. For instance, in *General Machine Products Co., Inc. v. Prime Domains*[50], a unanimous arbitration Panel concluded that registration of craftworks.com did not violate the UDRP even though the registrant was in the business of registering generic domains for sale. The Panel based its decision in part on the fact that Prime Domains had never registered any other distinctive common law or registered trademarks, and did not solicit General Machines to purchase the name.

However, in another case, *3636275 Canada, dba eResolution v. eResolution.com*[51], this decision is in direct clash with the General rule and is by all accounts an improper utilization of the UDRP. It is a stretch, to say the least, to impute constructive knowledge of a trademark to a registrant to find bad faith where the mark did not exist at the time of registration. In this case the Panel transferred the domain name to the despite the fact that the domain name was enrolled before the complainant started business under the name "eResolution" or even making an application for trademark registration. In other words, not only was the registrant unaware that the domain name contained another's trademark, but notice, constructive or otherwise, would have been impossible because no trademark existed at the time of registration.[52]

7. The next issue that emerges is that the Policy does not implement an appeal mechanism of the panel's decision nor a compensation system within its proceedings.

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[49] Henry M. Abromson, The Uniform Domain Name Dispute Resolution Policy: Will Alternative Dispute Resolution Succeed Where The Courts Have Not? A Proposed Solution to An Imperfect System, at 19-20, *available at*: http://pegasus.rutgers. edu/~rcrlj/ articlespdf/abromson.pdf. (Accessed on 03.01.2017). 100 NAF Case No. FA 92531, Jan. 26, 2000.

[50] NAF Case No. FA 92531, Jan. 26, 2000 *available at :* www.wipo.int/amc/en/domains /decisions/ word/2005/d2005-1083.doc(Accessed on 03.01.2017).

[51]WIPO Case No. D2000-0110, April 10, 2000, *available at:* http://www. wipo.int/ amc/en/domains/ decisions/htmF2000/d2000-0110.html. (Accessed on 03.01.2017).

[52] *Ibid.*

Consequently, it means that when parties dissatisfied with the decision reached, they have to take their cases to the courts through its costly and time-consuming proceedings. But here comes the paradox – parties tried to avoid complex, long proceedings and wasted money still face with the difficulties while seeking for compensation and protection of their rights. For instance, small businesses can not afford to cover all the costs for the court proceedings[53].

8. The UDRP has not accomplished ICANN's goal of creating uniform international standards, partly because it does not extend to disputes over all domain names[54].

9. The UDRP does not ensure that domain owners actually receive notice that a complaint has been filed against them[55].

10. The proceedings under UDRP are voluntary for owners of trademark but obligatory for domain name registrants. They are obligatory not because registrants have chosen to participate in mandatory dispute resolution, but due to an adhesion contract, all ICANN approved domain name Registrars impose a similar obligation. The owner of trademark chooses the Provider and the timing, and has a much superior authority than the domain name registrant over the choice of the Panel as well. If the decision is against the trademark owner, he can seek a legal action at will, as an unfavorable decision just maintains the *status quo*. On the other hand, if the decision is against the domain name registrant, he has only ten business days after the decision to prepare and file a lawsuit, possibly in a remote jurisdiction, in order to prevent the immediate loss of its domain name.[56]

11. Comparison to preciously been discussed the ACPA, the UDRP requires a showing of bad faith registration and bad faith use, while the ACPA requires only a bad faith registration or bad faith use.

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[53] Lisa M. Sharrock, The Future Of Domain Name Dispute Resolution: Crafting Practical InternationalLegal Solutions From Within The UDRP Framework, Duke Law Journal, Vol. 51, 2001, at 834, *available at:* http://www.law.duke.edu/shelLcite.pl?51+Duke4-L.-KL+817+pdf. (Accessed on 05.01.2017).

[54] *Id*. at 831.

[55] Henry M. Abromson, *Supra* note 49.

[56] David E. Sorkin, Judicial Review Of ICANN Domain Name Dispute Decisions, Computer & High Technology Law Journal, Vol. 18, at 54, available athttp://chtlj.com/sites/default/files/media/articles /v018/v018.iLSorkin.pdf. (Accessed on 05.01.2017).

12. Inconsistency in deciding cases within the UDRP procedure can occur particularly where there is no guideline on the choice of law[57]. As the WIPO Final Report indicates that the applicable law should be settled by the panel according to traditional choice of law concepts, namely "in applying the definition of abusive registration, the panel of decision-makers shall, to the extent necessary, apply the law or rules of law that it determines to be appropriate in view of all circumstances"[58]. In addition, under para 5(a) of the UDRP Rules application of national legal principles depends on a panel which decides a complainant in concurrence with the Policy and the Rules and principles of any law that it deems applicable.

7.5. Asian Domain Name Dispute Resolution Centre (ADNDRC)

The ADNDRC[59] is a joint undertaking by the China International Economic and Trade Arbitration Commission (CIETAC) and the Hong Kong International Arbitration Centre (HKIAC). The ADNDRC currently operates out of the four international offices - the Beijing Office operated by CIETAC, the Hong Kong Office Operated by HKIAC, the Seoul Office operated by Korean Internet Address Dispute Resolution Committee (KIDRC), and the Kuala Lumpur Office operated by the Kuala Lumpur Regional Centre for Arbitration (KLRCA). ADNDRC adopted its Supplemental Rules on February 28, 2002[60].

7.5.1. China International Economic and Trade Arbitration Commission (CIETAC)

CIETAC's headquarter is in China, was actually established for the Promotion of International Trade in April 1956 within the China Council. Keeping the modernisation of trade development and China's economic in mind, it was reorganised and re-named as CIETAC in 1988. CIETAC established a Sub-Commission in Shenzhen in 1989, and a Sub-Commission was established in Shanghai in 1990. Its current Panel of over 500 Arbitrators drawn from over 30 countries and regions around the world has practical experience and special

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[57] *Compagnie de Saint Gobain v. Com-Union Corp.* (saint-gobain.net),Case No. D2000-0020. www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0020.html (Accessed on 05.01.2017).

[58] WIPO, Final Report of the WIPO Internet Domain Name Process, "The Management of Internet Names and Addressed: Intellectual Property Issues" (April 30, 1999).

[59] Official Website: https://www.adndrc.org/index.html(Accessed on 05.01.2017).

[60] See, Appendix 5.

knowledge in technology, law, trade, economics, science and other fields. Till date, CIETAC has decided over 10,000 cases, and is one of two, the other being HKIAC, domain name dispute resolution providers for .cn ccTLD.[61]

7.5.2. Hong Kong International Arbitration Centre (HKIAC)

Established in 1985 as an independent non-profit organisation, primarily, to aid disputing parties to resolve disputes by arbitration and by other means of alternate dispute resolution, HKIAC has emerged as a leading Asian international dispute resolution centre. It has co-operation agreements with 18 ADR bodies and international arbitral all over the world, including, the International Chamber of Commerce, the American Arbitration Association, and the International Court of Arbitration. Besides resolving gTLD domain name disputes under ICANN UDRP[62] in conjunction with the Rules for UDRP[63] and ADNDRC Supplemental Rules[64], HKIAC has also been named as the domain name dispute resolution provider for the following ccTLDs: .hk (Hong Kong), .cn (the Mainland of China), .ph (Philippines), and.pw (Palau). Additionally, in April 2005, it was also accepted by China Internet Network Information Centre (CNNIC) to handle the Internet important Disputes under the CNNIC Internet Keyword Dispute Resolution Policy (IKDRP)[65] in conjunction with the HKIAC Rules for CNNIC Internet Keyword Resolution Policy[66]. CNNIC has also entrusted HKIAC to resolve wireless keyword issues using CNNIC Wireless Keyword Dispute Resolution Policy (WKDRP)[67] and the HKIAC Rules for Wireless Keyword Dispute Resolution Policy[68].

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[61] *Ibid.*

[62] See, Appendix 1.

[63] See, Appendix 2.

[64] See, Appendix 5.

[65] *Available at*: http://www.cnnic.net.cn/html/Dir/2003/ll/27/1513.htm. (Accessed on 09.01.2017).

[66] *Available at* : http://www.hkiac.org/ODRyKeywords/EN/cne_rules_procedure.htm. (Accessed on 10.01.2017).

[67] *Available at*: http://www.cnnic.net.cn/html/Dir/2007/06/04/4626.htm. (Accessed on 10.01. 2017).Chinese version available at http://www.hkiac.org/odrAVireless%20 Keywords /EN/ cne _ policy.htm. (Accessed on 01.01.2017).

[68] *Available at*: http://www.hkiac.org/odr/Wireless%20Keywords/EN/ cne_rules_procedure .htm. (Accessed on 01.01.2017).

.cn ccTLD domain name disputes are resolved with the help of CNNIC Domain Name Dispute Resolution Policy[69], CNNIC Domain Name Dispute Resolution Policy, the Rules[70], and CNNIC Domain Name Dispute Resolution Policy-Supplemental Rules [71].

Similarly, .hk ccTLD domain name disputes are resolved with the help of Hong Kong Domain Name Registration Company Limited (HKDNR) Domain Name Dispute Resolution Policy[72], Rules of Procedure -HKDNR Domain Name Dispute Resolution Policy[73], and Supplemental Rules- HKIAC Domain Name Dispute[74]. As for the .hk Individual domain name, the dispute resolution services are governed by HKDNR Domain Name Dispute Resolution Policy - Individual Domain Name[75] and HKDNR Domain Name dispute Resolution Policy – Individual Domain Name Rules of Procedure[76], as well as the HKIAC Supplemental Rules to the HKDNR Domain Name Dispute Resolution Policy - Individual Domain Name[77], adopted by the HKIAC with effect from 21 February 2003.

.ph ccTLD domain name disputes are resolved with the help of the phTLD Dispute Resolution Policy[78], Rules for phTLD Dispute Resolution Policy[79], and Supplemental Rules for phTLD Dispute Resolution Policy[80]. .pw domain name disputes are resolved with the help of the pwTLD Dispute Resolution Policy[81], Rules for pwTLD Dispute Resolution Policy[82], and Supplemental Rules for pwTLD Dispute

[69] *Available at*: http://www.hkiac.org/odr/cndrp/cne_policy.html. (Accessed on 10.01.2017).
[70] *Available at* : http://www.hkiac.org/odr/cndrp/cne_rules_procedure.html. (Accessed on 10.01.2017).
[71] *Available at*: http://www.hkiac.org/odr/cndrp/cne_supplemental_rules.html.(Accessed on 10.01.2017).
[72] *Available at:* https://www.hkirc.hk/dispute_resolution/disputeresolutionpolicy302ndlevel.jsp. (Accessed on 10.01.2017).
[73] *Available at* : https://www.hkirc.hk/dispute_resolution/rules_of_procedure_3_0.jsp. (Accessed on 10.01.2017).
[74] *Available at:* http://www.hkiac.org/show_content.php?article_id=75. (Accessed on 10.01.2017).
[75] *Available at*: https://www.hkirc.hk/dispute_resolution/dispute_resolution _policy_3_0_ IDV. jsp. (Accessed on 10.01.2017).
[76] *Available at*: https://www.hkirc.hk/dispute_resolution/rules_of_procedure30IDV.jsp. (Accessed on 10.01.2017).
[77] *Available at*: http://www.hkiac.org/show_content.php?article_id=:76. (Accessed on 10.01.2017).
[78] *Available at* : http://www.hkiac.org/odr/ph/ph_policy.html. (Accessed on 10.01.2017).
[79] *Available at*: http://www.hkiac.org/odr/ph/ph_rules_procedure.htm. (Accessed on 10.01.2017).
[80] *Available at* :http://www.hkiac.org/odr/ph/ph_supplemental_rules.htm. (Accessed on 10.01.2017).
[81] *Available at:* http://www.hkiac.org/odr/pw/pw_policy.html. (Accessed on 10.01.2017).
[82] *Available at* :http://www.hkiac.org/odr/pw/pw_rules_procedure.html. (Accessed on 10.01.2017).

Resolution Policy[83]. On 21 December 2007, DotAsia Organisation (DotAsia)[84] appointed HKIAC as the global official dispute resolution provider to handle disputes and challenges arising out of the launch of the .Asia domain.

7.5.3. Korean Internet address Dispute Resolution Committee (KIDRC)

KIDRC established in 2002, formerly called as Internet address Dispute Resolution Committee (IDRC). Establish with the motive of resolving disputes on the Internet relating to Internet addresses. The administrative affairs of the KIDRC are managed by the Korea Internet & Security Agency (KISA)[85], which is the only dispute resolution provider for krTLD (Korea). Established on July 23, 2009 as public corporation responsible for managing the Internet of Korea, by merging three institutes, namely National Internet Development Agency of Korea (NIDA), Korean Information Security Agency (KISA), and Korea IT International Cooperation Agency (KIICA), KISA has emerged as an improved public agency that plays a major role in developing and researching the Internet in Korea, in addition to managing the Internet address resources, such as IP address and .kr domain name as the national NIC (Network Information Centre). The .kr ccTLD domain name disputes are resolved with the help of .kr Domain Name Dispute Resolution Policy[86] and Rules for .kr Domain Name Dispute Resolution Policy.[87]

7.5.4. Kuala Lumpur Regional Centre for Arbitration (KLRCA)

Established in 1978 under the auspices of the Asian-African Legal Consultative Organisation (AALCO), the Kuala Lumpur Regional Centre for Arbitration (KLRCA) was the first regional centre established by AALCO in Asia to provide institutional support as a neutral and independent venue for the conduct of domestic and international arbitration proceedings in Asia. Administered by a Director under the supervision of the Secretary General of AALCO, KLRCA is a non-profit non-governmental international arbitral institution. Section 34 was added in

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[83] *Available at* :http://www.hkiac.org/odr/pw/pw_supplemental_rules.html. (Accessed on 10.01.2017).
[84] Official Website: http://www.dotasia.org/. (Accessed on 10.01.2017).
[85] Official Website: http://www.kisa.or.kr/eng/. (Accessed on 10.01.2017).
[86]*Available at*: http://www.idrc.or.kr/english/sub05_view.jsp?kinds=ddrc_erel&rownum =3&pagelndexl.Last (Accessed on 10.01.2017).
[87] *Available at*: http://www.idrc.or.kr/english/sub05_view.jsp?kinds^ddrc_ erel&rownum=2& pagelndex= l.(Accessed on 10.01.2017).

1980 by the Amendment to Malaysian Arbitration Act 1952, which provides that any arbitration conducted under the Rules of the Centre is barred from the intervention or supervision of the Courts of Malaysia. Section 34 includes domestic arbitration as well as international arbitration. KLRCA is presently the only dispute resolution provider for .my ccTLD domain names. .my DOMAIN REGISTRY (MYNIC) is the sole administrator for web addresses that end with .my in Malaysia. MYNIC is an agency under the Ministry of Science, Technology and Innovation (MOSTI) and is regulated by the Malaysian Communications and Multimedia Commissions (MCMC) .my ccTLD domain name disputes are resolved using MYNIC's (.my) Domain Name Dispute Resolution Policy[88] and the Rules for MYNIC's (.my) Domain Name Dispute Resolution Policy[89].

Let us now go through some of the cases decided by ADNDRC in order to understand the view of this arbitral panel.

In *Wal-Mart Stores, Inc. & Wal-Mart (China) Investment Co., Ltd. v. Liuhui*[90], the complainant is registered trademark holder of the mark WAL-MART in over 95 countries, objected to the respondent's use of this mark in the domain name walmart.cc, the use of which was being made to sell watches, which was also one of the businesses of the complainant. Here, the .cc is the Country Code TLD for Cocos Islands. Finding merits in the global trademarks of the complainant, the Panel transferred to disputed domain to the complainant.

In *Weight Watchers International Inc. v Troy Zhu*[91] the complainant claimed that its trade name rights should be taken as basis for other corresponding rights in the disputed domain name showpoints.com. Unlike in Parker Pen case, the ADNDRC

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88 *Available at*: http://www.bmthost.com/rcakl/upload/MYDRP_POLICY.pdf.(Accessed on 10.01. 2017).

89 *Available at*: http://www.bmthost.com/rcakl/upload/MYDRP_RULES.pdf. (Accessed on 10.01. 2017).

90 ADNDRC Case No. HKcc - 0800009, December 19, 2008, available in Chinese *available at:*http://www.adndrc.org/hk/CaseStorage/HKcc-0800009%20/Decision/HKcc-0800009_ Decision .pdf. (Translated using Translate tool from Google.) (Accessed on 11.01.2017).

91 ADNDRC Case No. HK-0900265, available in Chinese *available at* http://www.adndrc.org/hk /CaseStorage/HK-0900265/Decision/HK-0900265_Decision. pdf. (Accessed on 11.01.2017). As analysed by ShiYusheng and Gui Jia, Can Trade Name Rights Be Rights Basis For Disputes Over Internet DomainNames? - A Review Of Relevant Legal Precedents Established By ADNDRC, *available at:*http://www.kingandwood.com/article.aspx?id=Can-Trade-Name-Rights-Be-Rights-Basis-for-Disputesover-Internet-Domain-Names&language=en. (Accessed on 11.01.2017).

took into account the ruling made by the China International Economic and Trade Arbitration Commission (CIETAC) in a domain name dispute, where the Commission ruled that "the complainant claims that its trade name should be protected in accordance with Article 8 of the Paris Convention for the Protection of Industrial Property, 1883. However, the trade name must simultaneously satisfy another condition that the trade name has been used and has certain effect in the member country through advertisement or other means of publication." Even though the Commission decided that case in the light of Paragraph 4(a)(i) of the UDRP, it also clearly show that while deciding whether the trade name are to be protected in domain name dispute, the rights basis is not strictly limited to trademark rights, and the trade name rights should be taken into consideration. [92]

In *Mercer (US) Inc. v. Tianjin Hao Yuan Talent Development Co. Ltd*[93]., the dispute pertains to the disputed domain name tjmercer.com. The ADNDRC Panel observed that "although the term 'trade name' is not defined by the existing Chinese laws, China, as a member country of the Paris Convention, 1883, has the obligation to provide the same protection for the trade names that have been used in the business activities in China as the trademarks." In the present case, although the ADNDRC upheld the complainant's claims mainly based on the complainant's rights to the registered trademark in a territory other than its registration country, it referred to the Paris Convention definition of "trade name right" and regarded it as basis for the domain name in issue. On the other hand, the ADNDRC didn't give its own meaning of the "trade name right" in its ruling or provide any guidance regarding the ways to secure the trade names already used in business activities in China. Notably, the ADNDRC explained how to protect the "trade name rights" by referencing the ruling in Gea Group Aktiengesellschaft, "A trade name, like a trademark, is a business symbol. Business symbols are legally protected by the laws of all countries either as:

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[92] ADNDRC Case No. HK-0900265, available in Chinese at http://www.adndrc.org/hk /Case Storage/HK-0900265/Decision/HK-0900265_Decision. pdf. (Accessed on 11.01.2017). As analysed by ShiYusheng and Gui Jia, Can Trade Name Rights Be Rights Basis For Disputes Over Internet DomainNames? - A Review Of Relevant Legal Precedents Established By ADNDRC, *available at:*http://www.kingandwood.com/article.aspx?id=Can-Trade-Name-Rights-Be-Rights-Basis-for-Disputesover-Internet-Domain-Names&language=en. (Accessed on 11.01.2017).

[93] ADNDRC Case No. CN-0900265, June 22, 2009, available in Chinese *available at:*http:// www.adndrc.org/cn/CaseStorage/CN-0900265/Decision/CN-0900265_Decision.pdf. (Accessed on 11.01.2017).

(a) a registered trademark or the rights to a registered trademark, after it goes through the formalities of legal registration; or (b) an unregistered famous trademark or trade name which generates goodwill for its direct or indirect use or promotion. As such, the law intends to protect the goodwill of the business symbols. In general, the law protects a business symbol which involves both circumstances."

7.6. National Arbitration Forum (FORUM)

The FORUM[94] is a national and international administrator of alternative dispute resolution (ADR) services, including mediation and arbitration. Founded in 1986, the FORUM is based in Minneapolis, USA, and since 1999, the FORUM's Domain Name Dispute Program has handled over 14,000 disputes worldwide[95]. The FORUM gained approval as a dispute resolution service provider by ICANN on December 23, 1999. FORUM also follows Supplemental Rules[96] to ICANN UDRP while adjudicating domain name disputes. The FORUM has been accredited by ICANN to administer disputes that arise from the registration of gTLD domain names, as well as restricted or sponsored top level domains (such as .name, .mobi, and .pro). The FORUM has also been accredited by NeuStar[97] to administer disputes that arise from the registration of domain names in the .us (ccTLD)[98], and .biz[99] top level domains.

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[94] Official Website: http://www.adrfomm.com/. (Accessed on 14.01.2017).

[95] See, http://domains.adrfomm.com/ (Accessed on 14.01.2017).

[96] See, Appendix 6.

[97] Official Website: http://www.neustar.biz. (Accessed on 14.01.2017).

[98] (i) The usTLD Dispute Resolution Policy (usDRP) and usDRP Rules, *available at:*http:// www.neustar.us/content/download/2665/32889/usdrp.pdf (Accessed on 14.01.2017).apply to disputes involving a claim that .us domain name is registered and/or used in abusive bad faith and violates trademark rights.

(ii) The usTLD Nexus Dispute Policy (usNDP) and Rules for usNDP, *available at:*http://www .neustar.us/content/download/2666/32893/nexus_ dispute_policy.pdf (last Accessed on January 14, 2017), apply specifically to disputes involving a complaint that a .us TLD name is not registered by a United States entity and is in violation of the Nexus Requirements for .us TLDs. A domain name that features .us in its name but does not terminate in .us is not subject to the usNDP.

(iii) FORUM's usDRP Supplemental Rules *available at:*http://domains.adrfomm.com/main. aspx?itemID=644&hideBar=False&navID=256&news=26 (Accessed on 14.01.2017).and usNDP Supplemental Rules *available at:*http://domains.adrfomm.com/main.aspx?itemID =646&hide Bar=False&navID=262&news=26 (Accessed on 14.01.2017), also apply in respective domain name disputes.

[99] ICANN's Restrictions Dispute Resolution Policy (RDRP) Supplemental Rules *available at:*http://www.icann.org/en/udrp/rdrp-mles.html (last Accessed on January 14, 2017), and FORUM's

In one of the cases, *Hennessy Industries, Inc. v. Private Whois Service c/o ammco.com*[100], complainant, owner of the registered mark AMMCO in the U.S.A., objected to the respondent's use of domain name ammco.com, which resolves to a Pay-Per-Click (PPC) page featuring under the heading "Sponsored Listings for AAMCO" several hyperlinks to the websites of parties who are not affiliated with complainant. The respondent, however, argued to the effect that "AMMCO is a generic term composed of the three alphabets "amm" and "co", which is an abbreviation for the common generic word "company". "Just the registration of domain names having generic words establishes a rightful interest under UDRP, provided the domain was not registered with a trademark in mind." Respondent also hosts the disputed domain with "HitForm.com", a domain name monetisation service, which displays PPC advertising links on hosted domain names and shares advertising revenues earned from the advertisements with the domain name owners. HitFarm populates the links on the domain names it hosts with a sponsored advertising feed from Yahoo. The links are generated automatically by Yahoo and HitFarm's technology based on the contextual meaning of the terms within the domain name. After respondent became aware of the links from this complaint, it took action to have them removed by converting the site to a generic search page. Transferring the disputed domain name to the complainant, the Panel observed that the disputed domain name was identical to the complainant's trademark (the only difference being the addition of gTLD .com to the mark). The Panel further observed that "the respondent placed the (disputed) domain name with a parking company in circumstances where it would have been aware that those using the domain name were likely to have mistyped the complainant's name...respondent is responsible for the content found on the resolving website". The Panel found bad faith in respondent's actions by observing "*respondent has a choice to resolve the domains to blank or non-commercial pages and has chosen not to do so. In doing so, respondent*

RDRP Supplemental Rules *available at:* http://domains.adrforum.com/main.aspx?itemID= 642& hideBar=False&navID=241 &news=26 (Accessed on 14.01.2017).apply to disputes in which one party claims that a .biz domain name "is not being or will not be used primarily for a bona fide business or commercial purpose." An RDRP Complaint may be brought in conjunction with a UDRP Complaint against the same domain name.233 NAF Case Number: FA1360143, January 17, 2011, *available at:* http://domains.adrforum.com/domains/decisions/1360143.htm.(Accessed on 14.01.2017).

[100] NAF Case Number: FA1360143, January 17, 2011, *available at:* http://domains.adrforum.com/ domains/decisions/1360143.htm. (Accessed on 14.01.2017).

is spared the cost of website hosting fees, which inures to respondent's commercial benefit. Therefore, [the] respondent has allowed the domains to be used to attract, for commercial gain, Internet users who may be confused as to [the] complainant's affiliation with those sites.[101]"

7.7. World Intellectual Property Organisation (WIPO)

Established by the WIPO Convention in 1967 with a mandate from its Member States to promote the protection of Intellectual Property (IP) throughout the world through cooperation among States and in collaboration with other international organisations, WIPO[102] has emerged as a specialised agency of the United Nations (UN) for the achievement of these objectives. It is based in Geneva, Switzerland and a favourite among the domain name registrants to get their disputes settled through WIPO Arbitration and Mediation Centre. WIPO has adopted its Supplemental Rules[103] on December 1, 1999 and has recently amended these with effect from December 14, 2009. Of all the ICANN-Approved Dispute Resolution Providers, WIPO is the most popular among the domain name disputants to get redressal of their grievance. The contribution of WIPO with regard to the success of ICANN UDRP can never be over emphasised[104].

7.8. Czech Arbitration Court (CAC)

The Czech Arbitration Court (CAC)[105] is a not-for-profit organisation based in Prague, Czech Republic, and attached to the Economic Chamber of the Czech Republic and Agricultural Chamber of the Czech Republic. Established in 1949, CAC's services include the resolution of domestic and international commercial disputes related to IP and technology matters. In January 2008, ICANN approved the CAC to be the fourth international provider of UDRP services, and as of 6 May, 2009, the CAC operates as a .co.nl domain name dispute resolution provider appointed by EuroDNS S.A., the .co.nl operator. The CAC also follows Supplemental Rules[106] to ICANN UDRP while adjudicating domain name disputes. The CAC resolves domain

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[101] *Ibid.*
[102] Official Website: http://www.wipo.int/. (Accessed on 14.01.2017).
[103] See, Appendix 7.
[104] For detailed discussion on WIPO's contribution to the success of ICANN UDRP.
[105] Official Website: http://www.adr.eu/index.php. (Accessed on 16.01.2017).
[106] See, Appendix 8.

name disputes with .eu TLD with the help of .eu ADR Rules[107] and .eu Supplemental ADR Rules[108].

Few cases decided by CAC are being discussed in the next few paragraphs in order to understand the CAC Panel's bent of mind while arbitrating domain name disputes.

In *Accor v. VNT Corporation*[109], complainant, operator of hotels worldwide under the NOVOTEL brand including four hotels in Vietnam, is the owner of a number of registered trademarks consisting of the word NOVOTEL, in a number of countries throughout the world, including Vietnam. The Complainant, registrant of the domain names novotel.com, novotelhotels.com, and novotelresort.com, disputed the domain name registration of novotelvietnam.com by the respondent. Agreeing with the complainant's contention, the CAC Panel observed that "the addition of a geographic locator to a trademark is a common way of indicating the geographic area in which goods and services are offered under that brand. It does not alter the underlying mark to which it is added, and does not stop the domain name being confusingly similar to the trademark."

In *Mr. Salman Ashraf v. Internet Commerce Services, Inc*[110]., complainant asserted that the respondent's domain name folderlock.com is identical to complainant's registered trademark "FOLDER LOCK" used with software relating to computer security that can password protect personal computer files and folders from others. The Panel found the mark confusingly similar as well as the lack of legitimate right of respondent in the disputed domain name. However, the Panel failed to find bad faith in respondent's domain name registration and rejected the complaint, observing that "the complainant has only pointed to respondent's passive holding of the domain name for eight years, and one prior UDRP complaint resulting in transfer of two domains from respondent, in 2001. The respondent has not appeared to contest

[107] *Available at*: http://eu.adr.eu/htmLen/adr/adr_rules/eu%20adr%20rules.pdf.(Accessed on 16.01.2017).

[108] *Available at:* http://eu.adr.eu/html/en/adr/adr_rules/eu%20Supplemental%20Rules.pdf. (Accessed on 16.01.2017).

[109] CAC Case No. 100004, March 2, 2009, *available at:* http://www.adr.eu/adr/decisions/ decision .php?dispute_id= 100004 (Accessed on 16.01.2017).

[110] CAC Case No. 100191, October 13, 2010, *available at*: http://www.adr.eu/adr/decisions /decision .php?dispute_id=100191(Accessed on 16.01.2017).

the allegations of bad faith, nor the prior UDRP precedents cited in support of the complaint. Yet, the complainant's trademark application was not filed until three months after the disputed domain name was registered, and complainant has not provided any evidence that its trademark was in use prior to that time. Thus, complainant has not proved that respondent had any opportunity to know of complainant or its mark at the time the registration of disputed domain name."[111]

7.9. Indian Position

7.9.1. Domain Names Registration in India

India has been assigned .in ccTLD by the ICANN, which is managed by The National Internet Exchange of India (NIXI)[112]. The Government of India set up NIXI, a not-for-profit organisation established under Section 25 of the Companies Act, 1956, promoted by the Department of Information Technology (DIT) in association with the Internet Service Providers Association of India (ISPAI), on July 19, 2003. The primary objective of creation of NIXI was to offer a set-up for peering of Internet Service Providers (ISPs) among themselves for the purpose of routing the domestic traffic within the country, instead of taking it all the way to other countries, like USA. This will help in achieving better quality of service in the form of reduced latency and reduced bandwidth charges for Internet Service Providers (ISPs) by saving on International Bandwidth[113].

Since 2005, NIXI is also managing the .in ccTLD Registry on behalf of Government of India. For this purpose, NIXI created INRegistry[114], which functions as an autonomous body with the primary responsibility for maintaining the .in ccTLD and ensuring its operational stability, reliability, and security. The INRegistry is responsible for implementing various elements of the new policy set out by the Government of India, Department of Information Technology and Ministry of Communications and Information Technology[115].

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[111] *Ibid.*

[112] http://www.nixi.in/en/rti-act-2005 (Accessed on 19.01.2017).

[113] See, http://nixi.in/index.php?option=com_content&task=view&id=28&Itemid=71. (Accessed on 19.01.2017).

[114] Official website: http://www.registry.in/. (Accessed on 19.01.2017).

[115] *Ibid.*

With a Sunrise Period the new era for .in began. Proprietors of registered service marks or Indian trademarks, who wanted to protect their marks, were given the chance to apply for .in domain names before the general public. Sunrise applications were taken from January 1 to January 21, 2005. During this period, Indian citizens and entities were given preference over the foreign ones[116]. The date for the opening of real-time, open registration for the general public on first-come-first-served basis was February 16, 2005[117].

.in domain names are available to anyone - companies, individuals, and organisations in India and abroad, .in Registry does not carry out registrations itself. Instead, it accredits Registrars to register .in domain names. The accredited Registrars authorised to register .in domain names include[118]:

7.9.2. Accredited Registrars

The below registrars are fully accredited, and are authorized to register .IN domain names.

Registrars with Indian Presence (Top Performers)

1. Silicon House
2. Netlynx Technologies Pvt. Ltd.
3. Webiq Domains Solutions Pvt. Ltd.
4. Rediff.com
5. ERNET India
6. Tucows Inc.
7. Hostin Services Private Limited d.b.a. HostIndia.net
8. Web Werks India Pvt. Ltd. dba DforDomains.com
9. IN Registrar d.b.a. inregistrar.com

[116]See,http://www.registry.in/Policies/Sunrise%20Policy. For .in Sunrise Rules, see,http://www .registry.in/system/files/rN_Sunrise_Rules-20_Dec_2004_0.pdf.(Accessed on 19.01. 2017).

[117] See, http://www.registry.in/About%20.IN. (Accessed on 19.01.2017).

[118] Source: https://registry.in/Accredited_Registrars. (Accessed on 19.01.2017).

10. ZNet Technologies Private Limited
11. IndiaLinks Web Hosting Pvt Ltd d.b.a. IndiaLinks.com
12. Business Solutions
13. Infocom Network Ltd
14. GoDaddy.com, LLC
15. Net4India Limited, dba Net4Domains
16. Good Domain Registry Private Limited

Registrars with Indian Presence (Other registrars)

1. IKON Marketing
2. CSC e-Governance Services India Limited
3. Mitsu Inc
4. Aapkadomain.com (BE Software Solutions)
5. Basis Technologies Pvt. Ltd
6. Dotcom Services (India) Pvt Ltd, dba WorldIndia.com
7. Suryanandan.net
8. Kayz Infotech Pvt. Ltd.
9. Pioneer Elabs Limited
10. Bruwink
11. Art Anthem India Pvt. Ltd d/b/a Zeronweb
12. GoodLuckDomains
13. Sify Ltd.
14. Netandhost.com (S.G.S. Technologie Private Limited)
15. Micro Hosting Private Limited
16. Data Infosys Limited

17. IDEAA BIZ SOLUTIONS
18. Transecute Solutions Pvt. Ltd.
19. BigRock Solutions Ltd.
20. Alankit Technologies Ltd
21. BiznetIndia Dot Com Private Limited
22. Spectra Isp Networks Pvt Limited
23. Times Internet Limited
24. Bharat Domains d.b.a. Bharat.in
25. Visesh Infotecnics Ltd., dba Signdomains.com
26. Trunkoz Technologies Private Limited. d/b/a OwnRegistrar.com
27. Adodis Technologies Pvt. Ltd.
28. Cybersites India Technologies Pvt, Ltd.
29. Endurance Domains Technology Pvt. Ltd
30. Space2Let.com Services Pvt Ltd
31. Sree Jain Infotech dba Book and Host Online Services
32. Magnum International Ltd.
33. V2 Technosys DBA BookYour.IN
34. 101Domain, Inc.
35. Software Technology Parks of India (STPI)
36. Nihar Info Global Limited
37. #1 IndianDomains d.b.a. Mitsu.in
38. Enames.IN dba Pearl Infocom Media (P) Ltd.
39. PDR Ltd. dba PublicDomainRegistry.com
40. InCyber Advertising

Registrars Located Outside of India (Top Performers)

1. Web Commerce Communications Limited
2. Crazy Domains FZ-LLC
3. Key-Systems GmbH
4. ENom
5. Name.com LLC
6. Ascio Technologies
7. 1&1 Internet AG
8. Realtime Register B.V.
9. Gandi SAS
10. Dynadot LLC
11. Wild West Domains, LLC

Registrars Located Outside of India (Other registrars)

1. TLD Registrar Solutions Ltd
2. CORE Internet Council of Registrars
3. Network Solutions, LLC
4. Webair Internet Development Inc.
5. Internet.bs Corp
6. Domainming
7. Soluciones Corporativas IP, S.L.
8. Domain Research, LLC
9. united-domains AG
10. BB Online UK Ltd.
11. Uniregistrar Corp

12. Mobile Name Services, Inc.
13. NETIM SARL
14. SafeBrands
15. EPAG Domainservices GmbH
16. Netregistry Pty Ltd.
17. Lime Labs LLC
18. Mark Monitor
19. 1API GmbH
20. SparkHost Web Solution Ltd.
21. Documentdata Anstalt
22. Net Chinese Co. Ltd.
23. OnlineNIC Inc
24. OVH
25. TierraNet Inc DBA DomainDiscover
26. CSC Corporate Domains, Inc.
27. AB Name ISP
28. PlanA Corp. dba INdomains.net
29. YesNic Co. Ltd
30. Instra Corporation Pty Ltd.
31. Gabia Inc
32. Sipence, Inc.
33. Dinahosting SL
34. Secura Gmbh
35. Mesh Digital Ltd. d/b/a Domainmonster.com
36. Melbourne IT Ltd.

37. Domain People, Inc.
38. Global Village GmbH
39. CPS-Datensysteme GmbH
40. Aust Domains International Pty Ltd.
41. InterNetworX Ltd. & Co. KG
42. Mr. Site Takeaway Website Pvt. Ltd.
43. IP Mirror
44. Safenames Ltd.
45. Variomedia AG dba puredomain.com
46. Hosting Concepts B.V. d/b/a Openprovider
47. Nom-IQ Ltd dba Com Laude
48. InterNetX

7.9.2. Government Registrars

1. gov.in, mil.in: National Informatics Centre (NIC) is the exclusive registrar for gov.in and mil.in domain names.
2. ac.in, edu.in, res.in: ERNET is the exclusive registrar for ac.in, edu.in, and res.in domain names.

A note to parties who registered domain names at C-DAC:C-DAC has ceased to provide domain services. If you registered your name at C-DAC, please click here to read about the C-DAC shutdown and what it means to you.

IDN Accredited Registrars

- GoodLuckDomains
- PDR Ltd. dba PublicDomainRegistry.com
- BB Online UK Ltd.
- Data Infosys Limited

- Hostin Services Private Limited d.b.a. HostIndia.net
- Bharat Domains d.b.a. Bharat.in
- IN Registrar d.b.a. inregistrar.com
- SafeBrands
- Dotcom Services (India) Pvt Ltd, dba WorldIndia.com
- Key-Systems GmbH
- 1API GmbH
- Mark Monitor
- Net4India Limited, dba Net4Domains
- Instra Corporation Pty Ltd.
- Rediff.com
- Ascio Technologies
- Suryanandan.net
- Realtime Register B.V.
- Dynadot LLC
- V2 Technosys DBA BookYour.IN
- Business Solutions
- #1 IndianDomains d.b.a. Mitsu.in
- Basis Technologies Pvt. Ltd
- IP Mirror
- Netlynx Technologies Pvt. Ltd.
- Netandhost.com (S.G.S. Technologie Private Limited)
- 101Domain, Inc.
- Cybersites India Technologies Pvt, Ltd.

- Mitsu Inc
- ZNet Technologies Private Limited
- Bruwink

Policies

The registry has devised new policies for the administration and registration of .IN domain names. The objective is to make .IN domain names easier to use, and a method of making the Internet access to maximum number of Indian citizens. These policies came into effect on January 1, 2005. *General policies are listed below*[119].

PRICES

Below prices are wholesale prices to Registrars in INR per domain year (Registration, Transfer and (Auto-) Renewal). Registrars are free to set whatever retail prices they wish for new creates, renewals or RGP restore. Please see the site of each accredited registrar.[120]

These pricing are applicable to the .IN as well as all the Internationalized Domain Names (IDNs) managed by IN Registry. Second level domain, e.g. .IN: 350 Third level domain, e.g. co.in, net.in, org.in: 250 RGP Restore Fee: 1000.[121]

AVAILABLE NAMES

In the below mentioned zones unlimited registrations are available. Registration is available freely to all parties all over the world, and there are no nexus or different capabilities:

- .in
- org.in
- co.in
- firm.in

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[119] *Available at:* https://registry.in/Policies
[120] *Ibid.*
[121] *Ibid.*

- net.in
- ind.in (individuals)
- gen.in (general).[122]

However the subsequent zones are reserved for qualified organizations only in India.

- "gov.in" (Indian government)
- "ac.in" (Academic)
- "edu.in" (Indian colleges and universities)
- "mil.in" (Indian military)
- "res.in" (Indian research institutes)

7.10. GENERAL REGISTRATION POLICIES[123]

- **Domain length:** .IN domain names may be between 3 and 63 characters in length.
- **Term:** Effective 15:00 UTC on 16 October 2008 domain names may be registered for a minimum of one (1) year, and a maximum of ten (10)years.
- **Allowable characters:** Only letters, digits, and hyphens will be accepted in a domain name. Names cannot begin or end with hyphens.
- **Autorenewal:** Domains automatically renew at the end of their term (the expiration date). Please contact your registrar for details.
- **Contact information:** Registrants are required to give accurate and true contact information. The following contact types are required: Registrant, Administrative, Technical, Billing. As per standing policy, the contact data will display in the .IN WHOIS, except for the Billing contact data, which is not displayed.
- **Transfers:** For names in the unrestricted zones mentioned above, registrants are allowed to transfer their domains to the registrar of their choice. Registrants should contact their registrar of choice to learn about transfer

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[122] *Available at:* https://registry.in/Policies

[123] See, https://registry.in/Policies (Accessed on 20.01.2017).

procedures. Registrar-to-registrar transfers are not allowed in the 60 days following the creation of a domain name. A registrar-to-registrar transfer adds one year to the term of the domain name, charged to the gaining registrar. Registrars may therefore charge the registrant for the domain year.

- **Grace periods:** certain grace periods exist to allow for the cancellation of transactions by registrars within certain time periods. Please contact your registrar for details.

- **Nameservers:** to register a .IN domain, the registrant does not need to provide nameservers. In order to appear in the zone file and resolve on the Internet, at least one (1) valid IPv4 or IPv6 nameserver must be associated with the domain name. The use of at least two valid nameservers is highly recommended.

- **Internationalized domain names (IDNs):** The registry plans to accept IDN registrations in the future, including IDN registrations in Hindi, Tamil, and other Indian languages. Until further announcements, no applications for domain names in internationalized script (including diacritical marks) shall be accepted. Domains with hyphens in the third and fourth positions will be rejected.

- The registry has the authority to deny or suspend a registration if it conflicts with the sovereign national interest or public order.

- The Registry Operator reserves the right the adjust the allocated bandwidth and connections allotted to the registrars[124].

In order to prevent the abuse of .in ccTLD registration process, the a list of names for government and registry use is reserved with Government of India. These include the names related to ICANN, I AN A, Internet bodies, TLDs, States and Union Territories, Indian constitutional authorities, names of countries, and certain additional names[125].

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[124] *Available at:* https://registry.in/Policies

[125] For a complete list of reserved names, see, https://registry.in/Policies/Dispute CaseDecisions. (Accessed on 20.01.2017).

7.11. National Non-Judicial Response in Addressing Domain Name Disputes

As mentioned in the preceding paras, .in ccTLD registration is administered by INRegistry, which was created by NIXI, a Government of India undertaking. As part of registration, the registrants are required to submit to a mandatory arbitration proceeding under the .IN Domain Name Dispute Resolution Policy (INDRP)[126].

In pursuance of Policy Framework & Implementation by the Government of India this Policy was enacted[127], which, inter alia, requires the appropriation of a comprehensive Dispute Resolution Policy (DRP) in accordance with globally acknowledged rules endorsed by the World Intellectual Property Organization (WIPO) and Universal Dispute Resolution Policy (UDRP) received by the ICANN. Further, this Policy will be in accordance with the significant arrangements of the Indian IT Act 2000 . It was additionally required that any question including the .IN Registry will be considered by an appropriately named Dispute Resolution Committee. The .IN Registry would likewise designate Arbitrators, through a procedure of open determination, which can be drawn nearer by any aggrieved party for redressal of grievance with the Registrars. The decision of the Arbitrator(s) should be authoritative on both the parties. For this reason, a Service Fee will be endorsed which will be required to be paid to the Arbitrator by the aggrieved party for such arbitration.

In pursuance thereof, INDRP was drafted and posted on the INRegistry website on June 28, 2005[128]. The types of disputes that can be brought before arbitration, and the principles that will be followed by the arbitrators is explained in the Policy. The INDRP is supplemented by Rules of Procedure[129], which describe the fees, communications, how to respond to a complaint, how to file a complaint, and the other procedures that can be used in processing a complaint.

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[126] See, Appendix 3.

[127] Government of India, Ministry of Communications & Information Technology, Department ofInformation Technology, (www.mit.gov.in and nixi.org), .IN Internet Domain Name: Policy Framework & Implementation, October 28, 2004, *available at*: http://www. registry.in/system/ files/inpolicy_0.pdf. (Accessed on 20.01.2017).

[128] See, www.registry.in/.IN%DOMAIN%20NAMEI%20DSPUTE%20RESOLUTION% 20 POLICY %28 INDRP%29 (Accessed on 20.01.2017).

[129] *Available at* : http://www.registry.in/Policies/Dispute%20Resolution.(Accessed on 20.01.2017). Also see, Appendix 4.

Under INDRP, a complaint can be made on three grounds, which are identical to those set out in the ICANN UDRP, i.e.,

(1) The domain name of the registrant is confusingly similar or identical to a trademark in which the complainant has rights;

(2) The registrant of the domain name has no legitimate interests or rights in domain name;

(3) The registration of domain name is done in bad faith.

The INDRP laid down the rules for determining the issues. These rules are alike to the provisions of the ICANN, UDRP, there is only one exception in the INDRP that is the burden of proof is not imposed on the complainant. However, in the case of *Monster.com (India) Pvt. Ltd v Domain Leasing Company*[130], the Arbitral Tribunal said that this omission does not mean that the burden to contradict the complainant's assertions is on the respondent. The Arbitral Tribunal further held that the complainant would still have to prove these matters in accordance with the Evidence Act, 1872.

In the same vein, in *Jagdish Purohit v Stephen Koeing*[131], the Arbitral Tribunal observed that according to the Evidence Act a party is required to prove the facts on which it desires to rely to get a judgment. In the same case, the Arbitral Tribunal made it clear that there is no restriction on attaining *ex parte* orders in cases where the registrant of domain name resides in a country other than India and fails to answer the notices sent to the address maintained mentioned in the registry office[132].

The natures of the INDRP Proceedings are quasi-judicial and are legally recognised arbitrations under the Arbitration and Conciliation Act, 1996. Thus, enforceability of its judgment is same as of a civil court decree. However, even in the absence of enforcement of the award in accordance with civil procedure due to the

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[130] INDRP/002, May 20, 2006, *available at* :https://registry.in/Policies/DisputeCaseDecisions. (Accessed on 20.01.2017).

[131] INDRP/006, July 5, 2006, *available at* : https://registry.in/Policies/DisputeCaseDecisions. (Accessed on 20.01.2017).

[132] As analysed by Monica Datta, Securing Domain Name Protection In India - International Report, Intellectual Asset Management, 26 May 2010, *available at* ; http://www.ian> magazine .com/reports /Detail.aspx?g=4ce41el2-09fl-4c0b-99ab-4bc6ac75 cde 4 . (Accessed on 20.01.2017).

contractual provisions that allow cancellation of the domain in the event of an arbitral decision enables the .INRegistry to implement effectively an arbitral award. It is to be kept in mind that the INDRP is neither an Act nor, a Statute and status of arbitrator under the INDRP is that of neither a judicial officer nor a judge [133]; arbitrator has only a restricted power to adjudicate on the three questions mentioned in the INDRP.

Rediff.com India Ltd. v. Abhishek Verma and iAdvance Media was the first case that came up before the INDRP arbitral tribunal for adjudication[134]. The complainant, an online media company, protested to the use of domain name "rediff.in" by the respondents. The complainant argued:

(i) The domain name rediff.in is confusingly similar or identical to the complainant's trademark.

b) The complainant has also applied for registration in India and several other countries of the world, for the trademark 'Rediff' and other marks with prefix 'Rediff such as "Rediffmail, Rediff Bol, Rediff.com".

c) Rediff is a part of corporate name of the complainant.

d) The respondent has no legitimate interests or rights with regard to disputed domain name.

e) The domain name has been registered in bad faith.

f) The word REDIFF has no dictionary meaning or equivalent and is coined by the complainant

(g) The domain names with the prefix 'Rediff such as rediffindia.com, rediff.co.in, rediff.com, etc. are registered with the complainant

(h) Over the years the name REDIFF has built up good and valuable reputation and goodwill in the market including Internet.

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[133]*Ibid.*

[134]INDRP/001, April 3, 2006, *available at* ; https://registry.in/Policies/DisputeCaseDecisions. (Accessed on 20.01.2017).

(i) The respondent's domain name is confusingly similar to the trademark of the complainant; thereby, dishonestly, dishonestly, and wrongfully doing business using the goodwill of the complainant.

(j) When contacted, the respondent showed readiness to handover the domain name to the complainant only on payment of money.

The respondent contended to the following effect:

(i) Following the Sunrise policy published by the Department of Information Technology, the complainant should have registered the domain name within time stipulated in Sunrise Policy. Since, the complainant did not register the domain name within the aforesaid period. It shows lack of interest on the part of complainant in the registration of domain name in its own name.

(ii) Further respondent contested that the word REDIFF is a combination of two words RED and IFF in accord to dictionary.com and American Heritage Dictionary by Houghton Miffin Company, which means "smart identification of friend or foe" and that he has coined the word by joining the two words. Thus, it is his innovative term and exclusive business idea.

(iii) He chose .in TLD because he wanted users to know that people behind the website are from India.

(iv) There are other persons, other than the complainant, have registered domain names using the word REDIFF not only in India but all over the world.

(v) The respondent idea is to start a website for discussion, where peoples can register themselves and also upload their real stories which they had experienced with a person. The other registered members on this website would put their comment and views on uploaded story that would help author to make a decision whether the person behaved like a friend or a foe in the story. In other words, he contended that he is entitled to the domain name as it is his innovation in respect of the word REDIFF as also the business venture and therefore.

In response to respondent's averments, the complainant submitted that:

(a) The Department of Information Technology or law puts no restriction in the policy, to apply for registration of the domain names by the trademark holders (which were reserved for 90 days under Sunrise policy for holders of trademarks) even after they were opened for registration by the general public. Moreover, complainant had actually started procedure to register the said domain name well inside the period stipulated in Sunrise Policy with Net4India Ltd.

(b) Further delay in domain name's registration does not mean waiver of interests, rights, or claims in it, nor does it mean that the complainant is disallowed from preserving Intellectual Property rights.

(c) The respondent's offer to transfer the domain name shows his intention to make monetary gain and not to commence any business.

(d) The respondent's claim about proposed initiation of a discussion board on the domain name is bogus and moreover, a copy of the service which the complainant has been offering through its website.

(e) From the time of registering domain name, till date the respondent has not use the domain name.

(f) The respondent with bad intention attempted to create a domain name whereby he can catch the attention of Internet users to his website, for commercial gain, by creating a likelihood of contusion with the complainant's trademark.

(g) The term REDIFF forms vital part of the complainant's various services and products. For example, Redifftmail Pro , Rediffimail Mobile, Rediff Connexions, Rediff Bol, Rediff Matchmaker, Rediff India Abroad, Rediffmail etc.

(h) Merely because the other persons are also using the word "Rediff" does not by itself confer any right to the respondent to make use of it. A delay in taking proper lawful action against these parties doesn't mean that the complainant agrees, endorses, or supports such usage. A violation of the Intellectual Property rights of the complainant by third parties cannot grant a vested right in the respondent to violate the same.

In response to complainant's reply, the respondent contended:

(i) The complainant falsely stated that they had started registration procedure of domain within the stipulated time under Sunrise policy. If at all it is believed that they had started the process of domain name registration, the fact that they were not allotted the domain name, means they were not entitled for the domain name.

(ii) On the website of the complainant, there is no Message Board facility.

(iii) Further complainant has not even try for the transfer of domain name from the respondent during this entire period except discussion for the same.

(iv) Due to the dispute raised by the complainant the investors put on hold the matter due to which the respondent could not begin use of domain name during the year.

(v) Notwithstanding benevolent offer by the respondent to exchange the domain name, no positive strides were taken by the complainant to that impact.

(vi) The complainant’s legal action is subject to Limitation Act.

(vii) In short, the complaint is arbitrary, discriminatory, unjustified, and bad.

After assessing the Sunrise Policy, the Arbitral Tribunal concluded that “as the complainant made no suitable application during the stipulated period, the domain name consequently became open to all from February 16, 2005.” After examining the letter from the respondent to the complainant, the Arbitral Tribunal held that the respondent registered alleged domain name mainly with the intention of selling or otherwise transferring it to the complainant. Further, the Tribunal held that there is no nexus between the word ‘rediff’ and respondent’s firm’s name. Without any such proof, it can be deduced that the respondent deliberately endeavoured to draw in Internet users to the proposed site by making confusion regard of the complainant's name. After going through the fact that “the purpose of registering the domain name by the registrant is renting, transferring or otherwise selling the domain name registration, to the complainant who is the owner of trademark, for monetary consideration in excess of the expenses made directly related to the domain name,”

The Arbitral Tribunal ordered the transfer of alleged domain name to the complainant.

In *Google Inc. v. R. Jain*[135], In this case the complainant was Google Inc.. Who is the owner of the mark ORKUT, which is popular social networking website provides video sharing facilities. The complainant also made an application for trademark registration for ORKUT in India. Complainant also possesses a number of domain names consisting of the trademark ORKUT, like orkut.com, orkut.nz, orkut.ca, orkut.com.au, orkut.co.il, orkut.pt, orkut.de, and orkut.co.uk. The complainant objects to the use of domain name "orkut.in" by the respondent. The Tribunal in the absence of any response from the respondent, resolved the disputes forwarded by the complainant and ordered the complainant to transfer the disputed domain name.

In *Shevaldas C. Raghani v. Stephan Koenig*[136], The complainant alleges that the respondent has registered "Computer.in" which is confusingly similar to his trademark and the respondent is a well known speculator and has registered the disputed domain name for selling purpose only. The complainant also alleges that the respondent has parked the domain and he is earning revenue by luring visitors to his parked page. The respondent denies the allegations and submitted that the complainant has failed to establish any contentions and has failed to produce any document which could prove any use of the trademark. The respondent also states that "Computer" is a highly generic term and the complainant has failed to prove if the word has acquired any secondary meaning. Further the respondent stated that the dispute was filed to harass the him which is a blatant abuse of proceedings. The court held that the since the complainant failed to prove his entitlement over the disputed domain hence the respondent has emerged as the decree holder. It was also held that the act of complainant will be considered as an act of "reverse domain hijacking".

The Arbitral Tribunal additionally ordered the complainant to deposit Rs.10, 000 in the registry of NIXI as a cost of this case and burdening the administration to fulfil his hidden motives. Further, the Arbitral Tribunal instructed the registry of NIXI to "(a) take proper safety measure in entertaining such complaints; and (b) send a copy of this decision to the Hon'ble High Court of Delhi at New Delhi to take further

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[135] INDRP/070, September 11, 2008, *available at*: https://registry.in/Policies/Dispute Case Decisions (Accessed on 21.01.2017).

[136] INDRP/008, March 31,2006, *available at:* https://registry.in/Policies/Dispute Case Decisions. (Accessed on 21.01.2017).

actions against the complainants, as this Tribunal cannot go beyond its jurisdiction, but at the same time, at pains that the scrupulous persons abusing process of law to harass others".

In *Google Inc. v. Edmunds Gaidis*[137], the complainant objected to the use of domain name "igoogle.co.in" by the respondent. Upholding the contention of the complainant and transferring the disputed domain name to the complainant, the arbitrator observed that "the complainant's trademark GOOGLE is the keyword not only in website but in complainant's other business also. The disputed domain name had been registered intentionally only for the sole purpose to take advantages of the goodwill and the reputation enjoyed by the complainant under the trademark of GOOGLE. Respondent has other intention to register the disputed domain name for making money either from the complainant or from the third party by selling it."

Google domain name is a favourite among bookies. In *Google, Inc., U.S.A. v. Vaibhav Jain* the company challenged an .in domain name, "google-money-system.in"[138]. Here, the complainant alleged confusingly similar or identical trademark being used by the respondent in his domain name "google.money.system.in". The complainant argued that mere addition of letters "money or system" to GOOGLE does not differentiate the two domain names. The Arbitral Tribunal holding the respondent's domain name confusingly similar to the complainant's trademark GOOGLE and ordering transfer of the same to the complainant, observed that "*the complainant's mark and domain name GOOGLE is a coined word and highly distinctive in nature. As such, consumers looking for GOOGLE may instead reach the registrant's website*".

In yet another arbitration case involving world well known fashion house, Armani, the Arbitration Tribunal tried to secure the goodwill and big name privileges of well-known brands. In *G.A. Modefine S.A. v. Naveen Tiwari trading as MKHOJ*[139], the complainant had 263 trademark registrations for the mark ARMANI all over the

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[137] INDRP/080, March 2, 2009, *available at:* https://registry.in/Policies/DisputeCase Decisions. (Accessed on 21.01.2017).

[138] INDRP/132, April 3, 2010, *available at:* https://registry.in/Policies/DisputeCaseDecisions. (Accessed on 21.01.2017).

[139] INDRP/082, February 20, 2009, *available at*: https://registry.in/Policies/DisputeCase Decisions. (Accessed on 22.01.2017).

world, including India, and about 650 domain names registered in its name all over the world, all having ARMANI as a significant part thereof, including several .in registrations. On July 8, 2004 the complainant registered the domain name “armani.co.in”, under the Sunshine policy from C-DAC (which was subsequently transferred to Net4India).

On July 8, 2006 the disputed domain name was renewed for a period of one year. But, on July 8, 2007, on application for further renewal, the Registrar denied to renew the same and issued it to the respondent. On appeal regarding the transfer of the disputed domain name, the Registrar stated that application regarding the renewal of domain name was not timely made. It is obvious that whenever a user types in armani.co.in, user was redirected to the complainant’s international website armani.com. The arbitrator held that the respondent had no right or legitimate interest with regards to the disputed domain name because:

(a) respondent has not come up with any reason and has not filed any reply for adopting the domain name in question;

(b) respondent directed the website under the disputed domain name, to the official website of the complainant till the filing of the complaint; and

(c) after filing of the complaint, respondent has stopped using the disputed domain name.

The Arbitral Tribunal observed that “mere non-renewal of disputed domain name in 2007 by the complainant does not entitle the respondent to adopt the same”. Further finds bad faith in respondent’s conduct.Even in the absence of prior adoption of disputed domain name, the complainant is entitled to take action against the respondent. It is because the domain name in question fully incorporates the prior registered famous trademark ARMANI of the complainant. The Arbitral Tribunal further observed that the respondent has registered the disputed domain name with the intention of renting, transferring, or selling the domain name registration to the complainant, who is the owner of the trade name and trademark ARMANI, or to a competitor of the complainant, for a money. Ordering the transfer of the domain name in question to the complainant, the arbitrator observed that “by using the disputed domain name, the respondent has with bad intent tried to draw Internet users to the respondent's site or other online location, by creating a likelihood of contusion with the complainants' trademark as to the endorsement, affiliation, sponsorship, or source of the respondent's website or of a service or goods on the respondent's website".

The complainant once more had approached the arbitral tribunal to secure another domain name "armaniexchange.in". In *G.A. Modefine S.A. v. Domain Bazaar*[140], here also the Tribunal transferred the domain name in question "armaniexchange.in" to the complainant by finding that the respondent's bad faith is illustrated by them asking for money to transfer the domain name.

Approving the INDRP Arbitral Tribunal's finding in the ARMANI case, another arbitrator, in *Kenneth Cole Productions, Inc. v. Naveen Tiwari*[141], ordered the transfer of domain name in question "kennethcole.co.in" from the respondent to the complainant. In this case too, the complainant was a well known fashion house and the respondent failed to file any reply in response to the allegations of bad faith registration and lacking any right or legitimate interest in the disputed domain name. Kenneth Cole fashion house again had to fight for the domain name "kennethcole.in".

In *Kenneth Cole Productions, Inc. v. Viswas Infomedia*[142], the complainant questioned the utilization of domain name "kennethcole.in" by the respondent, who did not file any respond regardless continual notices from the Arbitral Tribunal requesting the same. Transferring the domain name in question to the complainant, the arbitrator observed that "registration of a famous trademark without legitimate commercial interests in the same is prima facie evidence that the respondent was well aware of the reputation and goodwill attached to the complainant's trademark / name. Thus, the respondent has registered the website in bad faith."

Another major corporation which has repeatedly knocked the doors of INDRP Arbitral Tribunal is Microsoft Corporation. The first case involving Microsoft

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[140] INDRP/115, October 1, 2009, *available at:* https://registry.in/Policies/Dispute CaseDecisions. (Accessed on 22.01.2017).

[141] INDRP/090, April 27, 2009, *available at:* https://registry.in/Policies/Dispute Case Decisions. (Accessed on 22.01.2017).

[142] INDRP/093, April 10, 2009, *available at:* https://registry.in/Policies/DisputeCaseDecisions (Accessed on 22.01.2017).

Corporation was *Microsoft Corporation v. Lhazang Ladenla*[143], Where the dispute was in connection with the domain name microsoft.org.in. The complainant argued that the complainant's trademark Microsoft (which is also registered in India) was adopted in 1975 and has been used extensively and continuously not only as a trademark but also as a leading brand and a promotion key in the cyber world. In addition, the trademark “Microsoft” is famous for its software and services for computer software users, and by this, the total current market of the complainant is $ 254.52 billion worldwide by March 2, 2010. After satisfying itself of all the requirements under the INDRP, the Arbitral Tribunal ordered transfer of the domain name in question to the complainant.

In *Microsoft Corporation v. Chun Man Kant*[144], the complainant possess, among different trademarks, the trademark MSN, and has additionally gotten trademark registration in various nations for the MSN mark in a few classes of services and goods, including India. The complainant additionally offers localised variants of its MSN services, including MSN Messenger and MSN Hotmail, in eighteen languages to more than thirty countries around the world and as a result, MSN has turned out to be one of the world's most prevalent Internet destinations.

The respondent, in any case, contended that he registered the questioned domain msn.in exclusively for upcoming webs extend named "Ms.N" and "Ms." is an English honorific utilized with the last name or full name of a lady, while "N" stands for individuals. The disputed domain name includes the word “msn,” but in fact, the word “msn” is referring to “Ms.N”. Since the respondent was unable to register the domain ms.n.in due to the inherent limitation of a domain structure, the respondent, therefore, omitted the ‘dot’ between “Ms” and “N,” and hence, registered msn.in.

As per respondent, the cases relied on by the complainant in the Annexure may have prejudice, in light of the fact that the respondents in such cases likely did not file any reaction to the (WIPO) Panel. As indicated by the respondent, the domain msn.in never sets out to the complainant's site, and the complainant articulation is

[143] INDRP/134, May 10, 2010, *available at*: https://registry.in/Policies/DisputeCaseDecisions. (Accessed on 22.01.2017).

[144] INDRP/119, January 11,2010, *available at*: https://registry.in/Policies/Dispute CaseDecisions. (Accessed on 22.01.2017).

false and unfounded. The respondent further expressed that the complainant presented the false articulation for some despicable purposes, in order to annoy the respondent. The respondent further expressed that he had conceded the online venture "Ms.N" because of the money related crisis, and the respondent has registered the domain in a *bona-fied* way, despite the fact that the domain still is not settled yet.

The complainant sent a rejoinder to these conflicts and asserted that the denounced domain name is phonetically, outwardly, and fundamentally indistinguishable to complainant's registered trademark msn.in; in this way, not just encroaching the proprietary rights of the complainant over the said mark however thusly, likewise causing a contusion among the general public and the complainant's mark MSN is enrolled in various nations in a few classes of products and services and the MSN's Internet portal msn.com is the sixth most visited to domain name on the Internet. Further, the complainant contended that the cases are decisions given by the WIPO Arbitration and Mediation Center and the way that the choices were made ex parte does not in any way influence the legitimacy and binding nature of the decisions.

In decision against the respondent and ordering transfer of disputed domain name to the complainant, the arbitration contemplated consequently:

(a) the respondent has not delivered any material to support his contention that "N" stands for people and that the respondent has not demonstrated any association or similarity between his upcoming online project and the "Ms.N”;

(b) the respondent endeavors to instruct a reason that because of the inborn impediment of a domain structure, he excluded the "dot" amongst "Ms" and 'N', and enrolled msn.in, which is neither conceivable nor admissible in law;

(c) simply on account of non-accessibility of a specific structure in domain name, nobody can be allowed to infringe upon another's legal domain; and

(d) indeed, even the respondent's confirmation that he has deferred the online project "Ms.N" raises solid suspicious over the respondent's bona fied.

Again, in *Microsoft Corporation v. Yan Wei*[145], the Arbitral Tribunal slanted for the complainant for the disputed domain name "microsoftstore.in". In the present case, the arbitrator transferred the questioned domain name to the complainant because of the popularity and trademark related with the complainant, and without any reply from the respondent to rebut the cases of confusingly similar or identical domain name registration with bad faith having no right or legitimate interest in the disputed domain name.

In a related case related with the proprietor of the Microsoft Corporation, Bill Gates, the Arbitral Tribunal again said something support of the prestige accompanying with the complainants. In *Bill & Melinda Gates Foundation v. Syed Shahzad*[146]," the complainant, a charitable organisation t hat attempts to enable all individuals to lead solid and gainful lives; and in developing nations, it concentrates on enhancing individuals' wellbeing and to lift themselves out of extreme poverty and hunger, objects to the use of domain name gatesfoundation.org.in by the respondent. The complainant has applied for registration of the mark "Bill & Melinda Gates Foundation" in India, which is pending. However the complainant is already registered owner of the service mark in U.S.A.

Further, the complainant possesses a few sites consolidating the words 'gates' and foundation', like gatesfoundation.co.in, gates foundation, in, and gatesfoundation.org. The complainant contended that the logo on the respondent's site is almost same, and the colours and font are also the same. There is also a button provided for 'Apply Now' on the respondent's website by which the clients are coordinated to a page where they are coordinated to fill in a sheet of information about themselves, however it is not clear with reference to how this assembled data is really being utilized by the respondent. The respondent, however, offered unconditional transfer of the disputed domain name and apologised in this case to the complainant. In conclusion, the arbitrator noted that "I must mention and bring on record that an act of the respondent of registering such domain name appears clearly to be with ill-intentions and in bad faith."

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[145]INDRP/145, July 12, 2010, *available at*: https://registry.in/Policies/DisputeCaseDecisions (Accessed on 22.01.2017).

[146]INDRP/143, June 19, 2010, *available at:* https://registry.in/Policies/DisputeCaseDecisions. (Accessed on 22.01.2017).

Again the tribunal was approached for the transfer of domain name einstein.in. In *Yeshiva University v. Liu (Xiong)*[147], the complainant, a research institution situated in the U.S.A. and has its working in some other nations also; and also holds the trademark ALBERT EINSTEIN, ALBERT EINSTEIN COLLEGE OF MEDICINE in U.S.A. The applications of the complainant for the registration of the trademark EINSTEIN is pending in India and European Union. In disputing the respondent's claim over the domain name einstein.com, the complainant submitted:

(a) the complainant's institutions include the Albert Einstein Azrieli Graduate School of Jewish Education and Administration, Bernard Revel Graduate School of Jewish Studies, Sy Syms School of Business, Benjamin N Cardozo School of Law, Wurzweiler School of Social Work, Ferkauf Graduate School of Psychology, College of Medicine, Yeshiva College, Stem College for Women, and Rabbi Isaac Elchanan Theological Seminary, etc.

(b) the respondent (as an business, organisation, or individual) has not been generally known by the mark "Einstein";

(c) the respondent is not making a fair use or legitimate of the disputed domain name for offering services and goods; and

(d) the respondent registered the domain name for the only purpose of misleading and creating confusion the general public;

(e) the primary object of registering the domain name in question by the respondent is to earn money by selling it and to mislead the customers of the complainant and the general public;

(f) the use of a domain name that appropriates a famous service or trademark mark to promote infringing or competing goods cannot be viewed as a "bona fide offering of services and goods."

Maintaining the complainant's contentions and ordering transfer of the disputed domain name to the complainant, the Arbitral Tribunal needed to look at the bad faith as complainant didn't furnish sufficient information of respondent's

[147]INDRP/144, July 12, 2010, *available at*: https://registry.in/Policies/DisputeCaseDecisions. (Accessed on 22.01.2017).

endeavour to sell the domain name in question for benefit. The complainant expressed that during March 2010, one Mr. K. Gogoi had registered the questioned domain name. On March 23, 2010 the complainant sent a Cease and Desist notice to Mr. Gogoi. On March 31, 2010, Mr. Gogoi answered through mail that he had registered the disputed domain on January 19, 2009, and that the registration has expired on January 19, 2010, and he had not renewed it during renewal grace period as well. n this way, inside a brief period (in usual domain cycle of 75 days) the said domain will be liberated by registry for registration. In any case, the complainant did not make any move for the registration of the questioned domain. On April 7, 2010, the respondent procured the same. A visit to the questioned domain name says that "the domain einstein.in may be for sale by its owner". A click at the said statement opens a domain name www.sedo.co.uk, which contains a description that "domain Einstein.in is for sale. Seller's Listing Price: US $3,000." It is, thus, clear that the registrant is using the domain only for sale. The complainant, notwithstanding, didn't give these points to the Arbitral Tribunal.

In transferring the domain name in question to the complainants, the arbitrator made note of a peculiar aspect concerning the registration of the questioned domain name. The arbitrator observed "that the registrant has given his address only as '503 Room, New Delhi and mobile telephone number as 91.12345678.' How a domain could be registered by the Directi Internet Solutions Pvt. Ltd., the Registrars, with these particulars? This requires investigation and appropriate action by the competent authorities."

An arbitrator of INDRP in *Rhodia v. Shi Jing,m*[148] relied on several WIPO and INDRP decisions to transfer the disputed domain name to the complainant. The complainant, a French corporation, is the owner of numerous trademark registrations with the term RHODIA in several countries, including India. The complainant is the world pioneer in the production and development of specialty chemicals. Further, the complainant provides high-performance solutions and added-value products to expanded markets, including industrials goods, flavours and fragrances, consumer and automotive, electronics, health, personal and home care, through its six worldwide

[148]INDRP/178, December 19, 2010, *available at*: https://registry.in/Policies/Dispute CaseDecisions. (Accessed on 22.01.2017).

ventures, including two companies in India, Hindustan Gum & Chemicals (HICHEM), Albright & Wilson Chemicals India Ltd. (AWCI) acquired in 2000, and - a joint venture with one of India's biggest combinations, the MP Birla Group, since 1962. The respondent, failed to file any reply relating to the disputed domain name "rhodia. in". Placing Putting dependence on various choices from WIPO Arbitration and Mediation Center and additionally those chose under INDRP, the arbitrator found the registration of disputed domain name as a case of bad faith registration. The arbitrator observed that "while the overall burden of proof rests with the complainant, Panels have recognised that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. Therefore, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. Thus, it is clear that the respondent is using the disputed domain name in bad faith and has registered the domain name in order to prevent the trademark owner from reflecting the mark in a related domain name."

In *International Amusement Limited v. Manish Kumar*[149], the present Arbitrarion proceedings pertain to dispute regarding the domain name<appughar.in>. The registrar hosting the disputed domain name is Incyber Advertising Incorporation. The Arbitration proceeding is conducted in accord with the .IN Domain Name Dispute Resolution Policy and Rules.

The basis of the present complaint is that the Complainant is the owner of the trademark APPUGHAR that it uses in connection with its services. In order to protect its rights under the APPUGHAR trademark, the Complainant had filed the present dispute. The complainant owns registered trademarks for the APPUGHAR mark and has provided the registration numbers of its registered marks as evidence of its rights in the mark. The respondent registered the disputed domain name <appughar.in> on February 23,2013.

[149] INDRP, June 28, 2013, *available at*: https://registry.in/Policies/Dispute CaseDecisions. (Accessed on 22.01.2017).

On May 17, 2013 the Complainant through their counsel replied stating that the Complainant is willing to settle its claim against the Respondent and listed three points for the Respondent to comply with in order to withdraw its claims. The three points mentioned in the complainants email were:

1. Transfer of the disputed domain name unconditionally and irrevocably by the Respondent in favour of the Complainant.

2. Payment of Rs.five hundred to the respondent towards the costs of procuring the domain name.

3. An unconditional apology by the Respondent to the complainant.

For the reasons discussed, it is ordered that domain name <appughar.in> be transferred to the compalinant.

In *Tata Motor Limited v. Gao Gao*[150], the domain name in the dispute was www.tatamotors.in. According to the WhoIs Search utility of .IN registry, the Registrar of the disputed domain name www.tatamotors.in with whom the disputed domain name www.tatamotors.in is registered is Webiq Domains Solutions Pvt.ltd.

The complainant contends as follows:

1. The domain name in dispute is confusingly similar or identical to a trademark or service mark in which the complainant has rights.

2. The domain name in dispute was registered and is being used in bad faith; and

3. The Respondents has no legal interest, claims or rights with regard to the Disputed Domain name.

The Respondent who also registered a same domain name has not even filed any response to the complaint despite being given an adequate notification and several opportunities by the Arbitrator.

[150]INDRP, December 06, 2014, *available at:* https://registry.in/Policies/DisputeCase Decisions. (Accessed on 22.01.2017).

According to rule 12(a) of INDRP rules the Arbitrator shall decide on the basis of the complainant's assertions and evidence, and inference drawn from the Respondent's failure to reply.

A perusal of the submissions and evidence placed on record by the complainant it is proved that the complainant has statutory and common law rights in the marks "TATAMOTORS" and its other variations.

It was held that Respondent has got registered and used the disputed domain name in bad faith .IN Registry of the NIXI is hereby directed to transfer the domain name of Respondent ie, www.tatamotors.in to the complainant. The Award is accordingly passed.

In *Zippo Manufacturing Company Inc. v. Zhaxi*[151]

The complainant submits that it a world leader in manufacture and trade of lighters under the invented and well known trademark ZIPPO. The complainant submits that ZIPPO trademark was first used in the course of trade in 1933.

The complainant also submits that it has in the past over 80 years, manufactured and sold over 400 million lighters under the trademark ZIPPO, across 120 countries. The complainant submits that the complainant owns and maintains various websites, whose domain name have the word ZIPPO as a prominent part. These websites includes,www.zippo.com,5zippo.com, zippo.gen.in, zippo.in, zippofashion.com, zippogear.in etc. The websites provide exhaustive information on the complainant's business, division and product range under its trademark/trade name ZIPPO.

The respondent who is the owner of domain name **www.zippo.co.in,** in this proceeding is ZHAXIA, has failed to file his say/reply to the complaint of the complainant within the stipulated time nor has he communicated anything on the complaint.

It is held that the respondent domain name is confusingly similar and identical to trademark owned by complainant. The Respondent has no legitimate interest or

[151] INDRP, 27, January, 2017, *available at*: https://registry.in/Policies/Dispute CaseDecisions. (Accessed on 22.01.2017).

right with regards to the domain name. It was also held that respondent is using the domain name in bad faith.

In view of the above facts and circumstances and findings, the complainant has succeeded in his complaint. .IN registry of the NIXI is hereby directed to transfer the domain name of the respondent i.e, www.zippo.co.in to the complainant.

In, *3M Company v. Zhaxia*[152]

A complaint has been filed with the National Internet Exchange of India (NIXI). The complainant has made the Registrar verification in connection with the disputed domain name <future.in>. It is confirmed that at present the respondent is listed as Registrant and provided the administrative details for administrative, billing and technical contact.

The Complainant has registered numerous top level domain names (TLDs) such as 3m-futuro.com, 3m-futuro.net , future.co.nz , future.us etc. The complainant's website is popular and is a valuable source of knowledge with respect to the complainant and its products under the trademark FUTURO.

The Respondent has registered the disputed domain name <future.in> on March 27, 2012 and Complainant has recently become aware of the same. Hence, complainant brought a complaint against the respondent.

The Respondent had adopted the disputed domain name <future.in> on March 27, 2012. The complainant has established that its trademark FUTURO is subject of around 198 trademark registration/ application in about 112 countries worldwide. The complainant's earliest registration for trademark FUTURO in India dates back to the year 1999. The complainant has also produced list of trademarks which are registered or for which it has made applications for registrations.

The Arbitrator finds that the registration of the Trademark FUTURO is *prima facie* evidence of the complainant's Trademark rights for the purpose of the policy. Internet users who enter disputed domain name <future.in> being aware of the

[152] INDRP, 04 Feburary, 2017, *available at*: https://registry.in/Policies/Dispute CaseDecisions. (Accessed on 17.02.2017).

reputation of the complainant may be confused about its association or affiliation with the complainant.

The Arbitrator finds that the disputed domain name <future.in> is confusingly similar to the website and trademark FUTURO of the complainant.

Keeping in view all the facts and circumstances of the matter this complaint is allowed. The disputed domain name <future.in> is similar to the trademark FUTURO in which the complainant has rights. The Arbitrator orders in accordance with the policy and the rule that the domain name <future.in> be transferred.

7.12. Comparison between UDRP and INDRP

The basis of INDRP and the INDRP Rules of Procedure is ICANN UDRP and Rules for UDRP respectively, which provide efficient, inexpensive and quick domain name dispute resolution mechanism. While both the arrangements and related guidelines are comparable, yet there are numerous contrasts between the two, which are featured beneath:

1) The Rules for UDRP and the Supplemental Rules framed by the respective Providers govern the process of initiating and conduction the proceedings and for appointing Panel under the UDRP, while under the INDRP, the Arbitrator has to conduct the proceedings in accordance with INDRP Rules of Procedure and the Arbitration and Conciliation Act, 1996.
2) While INDRP deals only with domain names registered as .in ccTLD, UDRP deals with disputes arising out of the registration of any domain name, including those ccTLDs, the Registries of which have entered into an understanding with ICANN to submit the registrants to ICANN UDRP procedures in case of disputes pertaining to such ccTLDs.
3) Under the UDRP, the complainant in each case selects the Provider from a list of Providers who will administer the proceedings; while under the INDRP, the .IN Registry is the sole Provider for dispute resolution services.
4) The UDRP makes an exception to the general rule that all the fees charged in connection to a dispute are payable by the complainant. It provides that if the Administrative Panel is expanded from 1 to 3 Panellists, then, all the costs arising out of the dispute would be split evenly among the parties.

5) INDRP does not lay down the circumstances when a domain name will be cancelled, transferred, or changed, while UDRP recognises three circumstances when the domain name will be cancelled, transferred, or changed, as follows:

(a) subject to the provisions of Paragraph 8 of UDRP, on receipt of written or appropriate electronic instructions from the registrant or his authorised agent to take such action;

(b) on receipt of an order from a court or Arbitral Tribunal, in each case of competent jurisdiction, requiring such action; and/or

(c) upon receipt of a decision of an Administrative Panel requiring such action in any administrative proceeding to which the registrant was a party and which was conducted under UDRP.

6) The UDRP specifically provides under Paragraph 4(k) that the proceeding under the Policy does not make the parties ineligible from submitting the dispute before a court of competent jurisdiction before the proceeding under the Policy is commenced or after such proceeding is concluded. The INDRP is silent in this regard.

7.13. Concluding Remarks

In conclusion, it can be safely submitted 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.

Chapter-8

Conclusion and Suggestions

8.1. Introduction

Innovation has been making immense progression and now we can do things we couldn't thought of 60 years ago. The Internet has allowed us to connect with any place on the planet, to get or share data/information in just a couple of moments. It appears that we are going beyond the boundaries and we can bring the entire world to our room by Internet. Be that as it may, is the Internet truly one of the best technological upgrades of late, or does it likewise have some negative impacts?

The answer for both is yes! Internet has recently become a problem, too. Internet has presented many challenges to the traditional laws and the legal system of the world. Domain name-trademark Disputes are one of the branches of this techno-legal interface. This domain name dispute is on the top of all the issues regarding Internet. Law has to find a correct harmony between the two clashing interests or rights from perspective of both the domain name holders and the trademark owners. Any hurried conclusion in this area might be dangerous to the interests of one or other field.

Hunt for a balanced approach between the interests and rights of domain name holders and trademark owners has resulted in number of determined attempts both at the global and national levels. Yet, none could able to find a fault free framework, understandably, because of the inborn problem in striking a delicate accord between Domain name rights and the trademark rights.

How to plan the best trademark/domain name policy was the important question in this thesis for exploration. To this end, some analysts recommended that the speeding up of technical change is so immense that the legal system can’t keep pace. This analysis is given in support many propositions: that the patent system should not apply to computer programs that copyright laws should not restrict the copy of Internet posting and that trademark laws ought not to influence domain names. Leaving those discussions aside, the legal system still is the means through which dispute is decided in modern society[1].

Keeping in mind, the flaws of the present system, regarding the above disputes. The thesis's final chapter point out the conclusion of the research and suggestions for a different approach to deal with the domain name disputes.

8.2. Conclusion

In the course of the research work, the researcher has come to the following conclusion.

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[2]. 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.

The address by which business organisation can be located on the web is known as domain names. These domain names are the most recent cause of clash involving trademarks on the cyber world.

The rising number of disputes over electronic addresses exhibits one of the more noticeable instances of a new area that appears to have outpaced settled legal doctrine[3].

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

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[1] *Intermatic Inc. v. Toeppen*, 40 U.S.P.Q.2d (BNA) 1412, 1412 (N.D. Ill.1996) *available at* : www.internetlibrary.com/cases/lib_case98.cfm. (Accessed 14/04/16).

[2] David S. Welkowitz, The Problem of Concurrent Use of Trademarks: An Old/New Proposal, 28 U. Rich. L. Rev. 315 (1994). *Available at*:http://scholarship.richmond. edu/lawreview/vol28 /iss2/4 (Accessed 14/04/16).

[3] As quoted in Mixing Oil with Water: Resolving the Differences Between Domain Names and Trademark Law *Available at:* http://studylib.net/doc/18545407/mixing-oil-with-water--resolving-the-differences-between-... (Accessed 14/04/16).

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 Internet is a global, interlinked computer network that connects millions of computer users and allows them to transfer and share information and services [4]. There is no central authority which controlled or regulated the function of Internet. Every computer connected to the Internet is autonomous in it and is controlled only by its own systems administrator. It was the U. S. Department of Defense which conceive the idea of Internet to link geographically dispersed researchers[5]. Now days Internet links millions of users across the world, providing an efficient, powerful and high-speed communications means by which users can transmit, share and access a huge range of services and information.

In recent years, there is an explosion of Commercial usage of the Internet, which has change the very function internet i.e., from a research tool to a global 'bazaar' with the potential to meets the need of millions of consumers over the globe. Consequently, many business organisations have started to offer their services and goods over the Internet, so to get to a market which has a potential to serve 30 million users[6]. According to reports, in India there are now nearly 74 million Internet users, a 31 % increase over March 2012[7].

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[8].

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[4] Dan L. Burk, Trademarks Along the Infobahn: A First Look at the Emerging Law of Cybermarks, 1 Rich. J.L. & Tech 1 (1995). *Available at:* http://scholarship.richmond.edu /jolt/vol1/iss1/4 (Accessed 14/04/16).

[5] *Ibid*.

[6]International Journal of Retail & Distribution Management *Available at:* http://www.emeralddinsight.com/doi/full/10.1108/09590551011086000(Accessed 18/04/16).

[7] India is now world's third largest Internet user after U.S., China *Available at:* http://www.the hindu.com/sci-tech/technology/internet/india-is-now-worlds-third-largest-internet-user-after-us-china/article5053115.ece (Accessed 14/04/16).

[8] Intellectual Property Rights: Critical Concepts in Law, Volume 4,pg 46,*Available at:* https://books.google.co.in/books?id=_A7Ku9yjKowC&pg=PA46&lpg=PA46&dq=Richard+Raysman+%26+Peter+Brown,+On-line+Legal+Issues,+N.Y.L.J.,+Feb.+15,+1995,+at3.&source=bl&ots=9_OJj54h_p&sig=0xNFxMACYgunag1CHGnZWs8WQpw&hl=en&sa=X&ved=0ahUKEwix69f0q4r UAhVL

An IP address through which an individual or a company can be located by any person having Internet access is called domain name[9]. 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[10]. 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.

Researcher in the course of his research work finds that trademark rights were basically related to:

a) Protection of the consumers from mistake, fraud, deception or confusion as to the quality and origin of services or goods and commercial distinctiveness emerging from the use of a confusingly alike name or mark on the similar or same services / goods;

b) Protection of a proprietors' investment in goodwill connected with the name or mark. Also to defend the proprietors' business identity against use by a beginner of a trademark confusingly similar to the proprietors' well settled mark.

The development of legal system proves that today, trademarks are protected not just to keep away from probable consumer confusion, but also to give sufficient

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KY8KHU_CbQQ6AEIIzAA#v=onepage&q=Richard%20Raysman%20%26%20Peter%20Brown%2C% 20On-line%20Legal%20Issues%2C%20N.Y.L.J.%2C%20Feb.%2015%2C% 201995%2 C%20 at3.&f=false (Accessed 14/04/16).

9 Sally M. Abel and Marilyn Tiki Dare, Trademark Issues in Cyberspace: The Brave New Frontier *Available at:* <http://www.fenwick.com/pub/cyber.html> (Accessed 14/04/16)..

10 Robert J. Raskopf, *Trademarks and the Internet in Intellectual Property law*, 1047 (Patents, Copyrights, Trademarks, and Literary Property Course Handbook, 1995).

return to the makers, who has invested to procure strong trademarks. The liberal approach adopted by the Courts adequately endorses this vision.

Domain names on the other hand simply mean an IP (Internet Protocol) address[11]. It is a technical term and has nothing to do with trademarks or Intellectual property. They are introduced just because to minimise the difficulty to remember these numerical addresses (IP address) became obvious. Thus, for the purpose of convenience, a word / alphabet based system called as Domain Name System (DNS) was introduced.

However the internet has changed equation between trademarks and domain names. Internet resulted in the dawn of Electronic commerce (E-commerce). As E-commerce has grown, the internet has become a virtual space for business. As businesses now turn to Internet because they have found it a convenient medium to sale and purchase. The information regarding products for consumer is available on different websites. These websites have unique addresses called domain names. The information seekers must either know domain name of the site which they are looking for or they have to enter key words in search engines. If they have to enter key words, they will invariably try for the already established trade name of the trader. Businesses would always prefer to have their domain names based on the trade name by which they are known to their consumers. Therefore, domain names are in many ways the sign board of the contemporary organizations; this makes the domain name a valuable asset or property.The first conclusion is that domain names, used for commercial purposes, acquired the characteristics of trademarks. Therefore they are identical to trademarks.

The use of the internet and other electronic means can make the process of starting and doing business a lot speedier, affordable and easier. Gathering information is an expensive affair when it includes gathering information beyond the national boundaries. Indeed, these expenses can high to the point that they can be viewed a significant hindrance to business. To find out the genuine supplier, arranging deliveries of marketing products, negotiating the price and quality and specifying the product’s requirements are also very expensive. With the use of e-commerce and the

[11] Discussed in chapter 4 of this thesis.

Internet, all these activities can be done together, without the close physical proximity of buyer and seller. In this regard, the internet will probably promote business in the same way as lifting other business obstructions would. In this way, it will increase quantity of international business[12]. Particularly, the internet when organized through electronic markets through e-commerce applications, minimises data collection costs and enables the buyers and sellers to interact and be matched electronically, lessening the importance of traditional business networks and geographic proximity [13]. It has been found that there is an ample evidence, to recommend that nations with the least past business links have the maximum gain from the Internet, particularly for developing countries[14].

However there is also grey side of e-commerce. As people become more used to communicating electronically there can be an erosion of social and personal skills which might eventually be harmful to the world where we live, where people instead face to face interaction feel comfortable in communicating through screens. There is also a likely threat of social divide between technical haves and have-nots – therefore, those persons who are not technically sound become incapable to secure better-paid jobs and could shape an underclass with potentially dangerous proposition for social solidity. As latest technology dates quickly how do we dispose of all the old computers, keyboards, monitors, speakers and other hardware or software?[15] Therefore it can be concluded that E-commerce has affected the trade/commerce a lot and has changed the traditional trade very much.

As discussed earlier domain names, when used for commercial purposes, acquire the characteristics of trademarks therefore the question whether infringement of domain names is the infringement of trademarks has been examined in light of the most widely recognized types of utilization of domain names as given below:

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[12] ECLAC. Electronic Commerce, International Trade and Employment: Review of The Issues. UN, Economic commission for Latin America and the Caribbean ECLAS, Washington Office, April 2002, pp 1-30 *available at*: http://www.cepal.org/en/publications/28809-electronic-commerce-international-trade-and-employment-review-issues (Accessed on 12/04/16).

[13] *Ibid*.

[14] Freund, C. and Weinhold, D, "On the effect of the Internet on International Trade" International Finance Discussion Papers, No. 693, December, 1999 *available at*: citeseerx.ist.psu.edu/ view doc/download ?doi=10.1.1.26.6941&rep=rep1...pdf(Accessed on 14/04/16).

[15] *Available at:* http://www.straight-on.com/ecommerce_definition.htm (Accessed 14/04/16).

Using a Domain Name for Commercial Purposes.

Where domain names are used for commercial purposes, they can violate a trademark only if they satisfy the subsequent three conditions. The foremost condition is that the domain name must be exactly similar to the trademark, which can create confusion in the minds of possible consumers. The next condition is that the domain name must show the substance of the site which is fundamentally the services and goods sold by the business organization. The last condition is that the domain name is used for the similar business purposes as that of trademark.

Registered Domain Names

An analysis with regard to registered domain name will lead only to one conclusion which is that the merely the registration of domain names cannot be regarded as violation of a trademark. However, the above conclusion is not true when question concerned with well-known trademarks. Domain names that are identical to any well-known trademarks can be really violating in nature even when they are merely registered. The two conditions for this to happen are firstly, the domain name is identical or similar to the well-known trademark and secondly that this, similarity therefore leads to a likelihood of confusion.

Cybersquatting

Cybersquatting is the act of registering a domain name with bad intention to gain monetary benefit with the knowledge that they valuable to third parties. Cybersquatting (also known as domain squatting), simply means an act of registering a domain name that is Identical, or confusingly similar to, the trademark of another with the intention of selling (at a profit) the domain name to the trademark owner. In other words “registration as domain names of well-known Trademark by non-trademark holders who then try to sell the names back to the trademark owners[16]. Such an act comes close to the definition of violation merely by registering a domain names. The only purpose for registering a domain name is to sell it to a third party.

[16] *Ibid*.

Typosquatting

Typosquatting, literally, means sitting over (squatting) a domain name, which is variation of a famous trademark. Typosquatting is, essentially, a corollary to cybersquatting where the registrant of domain name registers a variant of a well-known trademark[17]. Typosquatting simply means the practice of registering a domain name with a slight variation in the spelling of a trademarked term. Such domain name is slightly different from the actual domain name and is registered with the intention that if the user makes a typing error, he is automatically redirected to the fake website and gets fixed in 'mousetrapping'.

Domain Name Parking

To register a domain name without that domain is associated with any services such as email or an Internet site is known as Domain name parking. The very purpose of doing so may be to reserve the domain name for future development, and to minimising the chance of cybersquatting. As the domain name registrar is having set name servers for the domain, the registrar or reseller potentially has use of the domain name rather than the final registrant[18].

As it has been found in the course of this research that Domain name parking usually took place when a registrant of domain name registered its domain names with a Registrar or Parking Service Provider who "creates placeholder pages and then invites...Internet advertisement networks to fill them with advertisements" as opposed to constructing a functional website[19].

Reverse Domain Name Hijacking

Reverse domain name hijacking is also known as reverse cybersquatting. It occurs where the owner of the trademark, in order to save domain name makes a false

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[17] *Available at*: https://cyber.harvard.edu/property00/domain/CaseLaw.html (Accessed 15/04/16).

[18] *Aavailable at:*https://en.wikipedia.org/wiki/Domain_parking (Accessed on 02.09.2016).

[19] Leslie Walker & Brian Krebs, The Web's Million-Dollar Typos, Washington Post, April 30, 2006, atF01 (relaying a law professor's assertion that "the practice amounts to someone making money off some one else's trademark without permission."). Additionally, when Internet users arrive at the parked sites and click on the advertisements, the Internet advertisement networks receive payment from the advertisers and pass on a portion of the revenue to the domain name registrant *available at:*www.washingtonpost.com › Technology(Accessed on 02.09.2016).

cybersquatting allegation against the rightful owner of the domain name so that domain name owners transfer the ownership of their domain names to trademark owners in order to avoid legal action, especially when the owner of the domain names are individuals or smaller organizations. Reverse cybersquatting is mostly committed by famous individuals and larger corporations.

The overall findings in relation to the question, under which situation domain names can violate trademark rights, is that it can happen with most of the uses of the domain name. However the condition may be different depending on how domain name is used. Basic conditions that are required are at first the domain name must be confusing similar, secondly the domain name demonstrates the substance of the site and thirdly domain name is used for the similar business purpose as the trademark. As far as famous trademarks are concerned violation is possible in all types of domain name use, including when a domain name is only registered. The foremost condition that is required for a domain name to be infringing a famous trademark is less strict. the only condition that is required for a domain name to be violator of famous trade is that it must be confusingly similar to the well known mark.

In view of a global character of the Internet and the fact, that trademark law could be applied only in the narrow context; traditional legal processes do not provide any longer effective and convenient litigation in resolving international disputes regarding Internet domain names.

It is concluded after analysis in the foregoing pages that judiciary, around the world, has played a pivotal role in resolving the domain name disputes. As discussed earlier, judiciary, especially in India, the United States of America (U.S.A.) and United Kingdom (U.K.), is breaking new grounds and formulating novel concepts that are stretching the horizons of existing laws and laying a strong foundation for the new ones. The courts in India have taken law in a right direction in spite of the absence of specific legislation on the subject. As seen in chapter 6 the interpretation accorded by the Indian courts is in line with the opinions expressed by the courts in trans-national jurisdictions. The courts in India have consistently now held that the domain name is not merely an address but an effective source identifier with all the trappings of a trade mark. The courts have likened domain names with trademarks and accorded them trademark protection.

This trend is found in spite of the fact unlike the U.S.A. India is not having separate enactment to resolve the domain name disputes. As in UK, proceedings relating to domain name disputes, in India also are dealt under the following heads; passing off and trademark infringement. While the passing off is invoked in case of unregistered trademarks, the infringement actions are available in case of registered trademarks.

The only legislation relating to cyber space in India is the Information Technology Act, 2000 and it has no provision to deal with the trademark -domain name disputes. Moreover there is not a single provision in Trademark Act, 1999 relating to domain names.

Yet, the courts in India are deciding some of the domain name disputes under the Trademark Act. These disputes include misuse of goodwill, cybersquatting, typosquatting etc. Where the services or information which are provided through a domain name are related to the provisions of services within the meaning of Section 2 (1) (z) of the Trademark Act 1999, the Judiciary usually interceded in such cases.

However, 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.

Resolving disputes relating to domain name in an out-of-court proceeding which can be executed on an international basis is undoubtly an important function of the UDRP. The question is whether the procedure is as effective and fair as it should be, and surprisingly, the answer is a bit elusive.

It is found after the analysis of the UDRP policy in chapter 7 that while this policy was created with the intention of reducing the burden of litigation, and as a system for ensuring fairness for all rights holders, it has somehow evolved and morphed into a system which accords strong privileges to the rights of the trademark holders. Even though the definitions within the policy seem fairly narrow, the ways in which the UDRP panels have adjudicated have expanded the meaning of 'bad-faith' under the policy far beyond its original mandate. It must be kept in mind that the founding rationale behind the creation of the UDRP was to check the offence of malicious cybersquatting. This seems to have somehow given way to an expensive system which is unfavourable to the domain name holder even if he or she has absolutely no mala-fide intention of breaching trademark. The uniqueness of the domain name system does not seem to be guiding the adjudicators of the panels, and any suggestions at reforms must begin with a revamp of the constitution of the panels. Instead of focusing on how the trademark is used, there is a tendency to focus on if the trademark is used at all, and if this is coupled with default on the part of the respondent, his rights are not taken into account most of the time. This is an area within the UDRP that needs reform, and urgently, so that more equitable decisions are brought out to serve the original purpose of this policy. There are certain flaws in UDRP in its current structure and it can be sum up as follows:

- it's important terms are both unfamiliar and vague.
- it is more leaning towards trademark holders,
- it offers no privacy safeguard for the name, phone no. of registrants and address,
- it gives less importance to the evidentiary requirements, which make the system hard to be evaluated,
- it provide a system which is favourable for reverse cybersquatting, thereby creating a type of threat in the minds of genuine domain name registrants to surrender their domain names,
- it gives little direction as to the law to be applied when two parties belong to different jurisdictions,

Apart from these issues that certainly require clarification, one also cannot overlook the fact that the area within which the UDRP works has gone under vital change during the past decade. The progressive and more complex Internet community, a new domain- name practices, more than 649 mature bodies of domain-name law and more over vital change in social values[20] require a more open approach

[20] Lipton Jacqueline, *Can Intellectual Property Survive the Information Age?* 1438 (2003).

to domain-name dispute resolution. May be the time has come for those responsible for the administration, implementation, and formulation of the UDRP, particularly ICANN and WIPO, not only to acknowledge that there is a need of amendment in UDRP, but also that times have changed and that there is again, as it was happened a decade ago, a want for direction.

In India, it is a mandatory part of registration that the registrant is required to submit to a mandatory arbitration proceeding under the .IN Domain Name Dispute Resolution Policy (INDRP)[21].

In pursuance of policy Framework & Implementation by the Government of India the INDRP policy was enacted[22], which among the other things, necessitate the adoption of a comprehensive Dispute Resolution Policy (DRP) in line with internationally acknowledged procedure approved by the Universal Dispute Resolution Policy (UDRP) and World Intellectual Property Organization (WIPO) adopted by the ICANN. Apart from this, the INDRP will be corresponding to the relevant provisions of the Information and Technology Act of 2000[23].

By implementing the .IN Domain Name Dispute Resolution Policy (INDRP) on the same lines of ICANN's UDRP, India has in a very limited way make use of UDRP Policy which is restricted only to the .IN registry disputes[24].

The National Internet Exchange of India (NIXI) is providing the administrative contact for the.IN Registry, and the National Centre for Software Technology is the supporting organization in India for the same. The primary responsibility of the IN Registry (an autonomous body under NIXI) is to maintain the .IN country code top level domain for India. Just as the UDRP, the INDRP also more inclined towards the trademark holders. It has no provision regarding the protection of the domain name holders.

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[21] See, Appendix 3.

[22] Government of India, Ministry of Communications & Information Technology, Department of Information Technology, (www.mit.gov.in and nixi.org), .IN Internet Domain Name: Policy Framework & Implementation, October 28, 2004, *available at*: http://www. registry.in /system/files/inpolicy_0.pdf. (Accessed on 20.01.2017).

[23] *Available at :* https://registry.in/Policies/Dispute%20Resolution(Accessed on 25.01.2017).

[24] *Available at :* https://registry.in/IN%20Domain%20Name%20Dispute%20 Resolution% 20Policy% 20%28INDRP%29 (Accessed on 25.01.2017).

There is a need for every nation, including India, must strive to draft a comprehensive Cyberspace Code, which inter alia also addresses issues pertaining to Domain name disputes. Domain name issue is too technical to be dealt with by simply extending the scope of traditional Trademark laws.

In short it can be said that, despite growing importance and the increasing use of the Internet, the law is still not able to cover all the problems relating to the Internet is also unable to provide adequate protection to owners of domain name. There is legislation in the U.S., directly relating to the domain name disputes with trademarks which are constantly aided by the case facilitating the function of the related rule. While in India, there is an urgent need for the enactment of new law dealing with the issues relating to domain name disputes.

On the basis of research work done in the thesis, hypothesis tested and resulted as under:

1 .The domain names are identical to trademarks.

The first hypothesis, the domain names are identical to trademarks, has been tested based on the most relevant aspects regarding this question. This aspect is to what extent can domain names are identical to trademarks? Based on the analysis made under chapter 5 of this thesis two conclusions can be made with regard to this question. The first conclusion is that a domain name has the potential to comply with the three primary criteria i.e, there needs to be a sign, this needs to be capable of being represented graphically and the sign has to be distinctive, for establishing a trademark. The second conclusion is that domain names, used for commercial purposes, are capable of fulfilling the conditions required by trademark law. This result in domain names used for commercial purposes, have the possibility of being regarded as trademarks. Thus the first hypothesis stands proved and it was established that domain name are identical to trademarks.

2. The evolution of E-commerce has affected the trade and commerce very much.

The Internet and other computerized systems are the main impetuses behind a dramatic change in the way business dealings are done. Increasingly, networks and information technology are being utilized to electronically configured market, purchase, offer, and deliver items and services around the world. Such buying and selling is called Electronic commerce (e-commerce). E-commerce is a new method business is another strategy business that blends the greater part of the earlier techniques and transaction styles. E-commerce have affect on numerous ranges of business for e.g., financial aspect, marketing, computer science, economics and bookkeeping, management information system, production and operation management, human source management, business law, morals and ethics. 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. Thus the related hypothesis is proved and it was established that evolution of E-commerce has affected the trade and commerce very much.

3. The domain names registration often infringes trademarks.

The most common forms of domain name and trademark conflict is merely registering a domain name as it give rise to certain legal disputes between trademarks and domain names The research has analysed in detail to what extent the registration of domain names can infringe registered/ unregistered Trademark. With internet assuming the role of quality e-commerce platform, the concept of domain names also underwent vital change. From just addresses, domain names graduated to online brands that are associated with the goodwill of the owner of domain names. This started the race for getting online brand identity as domain name registration is based on first-come-first-served rule, which could preclude the owner of trademark from claiming first right on the identical domain name. The legal disputes regarding registering trademarks as domain names give rise to domain name and trademark disputes include: Cybersquatting, Typosquatting, Domain Name Parking, Reverse Domain Name Hijacking, Domain Tasting, Domain name front running, Domain Kiting, Gripe / Protest Websites and 'Url' Path. Therefore the third hypothesis stands proved and it was established that the domain name registration often infringes trademarks.

4. Resolution of the domain names disputes is not done appropriately in our country as well as at the world level.

Admittedly, there is no dedicated legislation in countries, like U.S.A., U.K., and India, for the resolution of different aspects of domain name disputes. All that the courts in these countries have done is to extend the scope of existing trademark legislation in their respective countries and also, grant Common Law remedy found in the tort of passing-off. However, Domain name disputes have a number of characteristics that make traditional Court proceedings unsuitable for their resolution: Firstly, the Internet being a global system, there is no settled rule as to where jurisdiction lies, so that a single case may involve several different municipal Courts asserting jurisdiction, with the result that a whole series of actions may have to be brought in relation to trademarks in different countries. Secondly, the speed at which an Internet site can be created, and the ease at which it can be reached, may make the need to resolve a dispute urgent and thirdly, the cost of registering a domain name is extremely low in comparison with the economic damage that it may cause, or the cost of litigation.

In response to such concerns, ICANN was formed, and WIPO was entrusted with developing UDRP. After a series of resolutions and conferences, ICANN adopted the Final Report and approved the UDRP and the accompanying Rules for the UDRP in October 1999

It is an undisputed fact that UDRP serves an important function to resolve domain name disputes in an out-of-court proceeding that can be implemented on an international basis. The question is whether the process is as fair and effective as it should be, and astonishingly, the answer is somewhat elusive. Thus this hypothesis stands proved and it was established that Resolution of the domain names disputes is not done appropriately in our country as well as at the world level.

5. Lack of a separate, direct and comprehensive legislation for the protection of domain names often results in the violation of domain names.

Several countries, including India, have tried to expand the scope of traditional trademark law to the online world through amendments and judicial outreach. Nations trying to address domain name disputes by suitably introducing new legislations and enlarging the scopes of existing ones through judicial activism.

However, still in many countries including India there is no separate legislation directly dealing with the domain name disputes and more over the remedies which are available are more leaning towards the protection of trademarks than the protection of domain names. Therefore the related hypothesis stands proved and it was established that Lack of a separate, direct and comprehensive legislation for the protection of domain names often results in the violation of domain names.

8.3. Suggestions

The question before us is how to create the best trademark domain name law. It is to be borne in mind that legal system is the appropriate mechanism through which disputes in modern society are to be decided[25]. Keeping in mind the flaws of the present policies regarding the above issue, following recommendations are suggested,

- Since the scope of illegal activity on Internet is increasing, there has been a diligent demand from the legal fraternity to have some sort of global course of action. Therefore it is highly recommended to have 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. Further, this treaty should have relevant clauses addressing various jurisdictional issues applicable to all the signatory countries. Any nation's access to Internet should be made contingent upon that country's signing and ratification of such a treaty.

- 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. The overall trend of case law demonstrates that

[25] *Intermatic Inc. v. Toeppen*, 40 U.S.P.Q.2d (BNA) 1412, 1412 (N.D. Ill.1996).As quoted in "Intellectual Property Legal Opinions" book *Available on:* https://books.google.co.in/books?isbn=073556194X (Accessed on 25.01.2017).

trademark law is still in the core and acts as a last resort to solve disputes relating to domain name. As the Internet is a new medium of communication that pushes trademark law to develop therefore the Courts need to consider policy implication. Moreover, the significant differences between the trademark registration requirements and domain name registration make the traditional trademark law as being not appropriate solution for trademark violation in cyberspace. Of course, the central idea of trademark law should not be scarified while drafting specific provisions, rules, and regulations pertaining to trademark violation on the Internet. However, it is also required that the technical aspects must be given appropriate treatment and due weight while enacting the Cyberspace Code.

- 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 subsequent suggestions.

    - While forming a domain name policy, the registration authority must take care of the competing interests of all parties involved.
    - As registration authorities follows a first-come, first-served policy for domain names registration. therefore, it is proposed that registration authorities must place first-level screen before granting registration on such a basis, by requiring the applicant to provide business related papers such as birth certificate, articles of incorporation, doing-business-as statement, which reveals the genuineness to use the applied domain name.
    - Again for first come, first served policy, it is submitted that there should be a provision that requires advance fees before registration of a domain name, hence significantly increasing the cost of mass domain name speculation,
    - The doctrine of interpleader should be use by Registration authorities so as to bring every party to a dispute into court, and enables the court to settle the disputes.

- 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 recommended 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 37,862[26] 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. It is recommended that the following changes be made to the UDRP Rules:
  a) There is a need for maintaining uniformity in UDRP policy and must follow the doctrine of precedent.
  b) The time limit prescribed for the respondent to respond to the notice of complaint must be extended.
  c) There is a need of effective law and non-biased panellists to decide the matters.
  d) Similar to all the courts, the panel is required to make a decision only after giving chance to both the parties.
  e) There is a need to stroke off the provision relating choosing the service provider and panellists.
- 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.
- In competing use cases, another possible solution might be to add a brief description of the different businesses in the domain name. For instance,

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

instead of granting domain name like apple.com to any single entity, it makes sense to have descriptive domain names, like applecomputer.com and apple-grocery.com.

- One of the best examples available for amicable settlement of the disputes by respecting the rights of each party to the dispute is the WTO dispute resolution mechanism[27]. Despite the fact that the WTO mechanism is dealing in resolving the disputes between the states and not between individuals, similarity can be drawn for its application in trademark-domain name disputes resolution[28].
- Certain administrative measures should be taken to arrest the incidents of Domain Name Parking, Domain Tasting, and Domain Kiting. For instance, domain name registration can be made subject to the setting up of fully functional website on that domain in, say, X number of days, failing which the domain name shall be forfeited. The lesser the number of days, the lesser the chances of abuse of domain name registration process via Domain Parking.
- In order to deal with a jurisdictional issue, it is suggested that steps be taken for the formation of global convention like UN so that the member states can enjoy the basic domain name protection. Through the domestic law proper implementation of the protection can be ensured.
- 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)[29]. So it is proposed that a provision relating to choice of law to deal disputes among complainants and respondents of different jurisdictions[30].

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[27] See WTO Dispute Settlement Understanding (DSU).

[28] *Available at :* shodhganga.inflibnet.ac.in/bitstream/10603/71803/5/chapter%201.pdf (Accessed on 25.01.2017).

[29] Rule 15(a) - "A panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the policy, these rules and any rules and principles of law that it deems applicable" *available at:* ICANN, Rules for Uniform Domain Name Dispute Resolution Policy, http://www.icann. org/udrp/udrprules24oct99. htm (Accessed on 25.01.2017).

[30] *Available at:* www.niscair.res.in/.../jipr/.../JIPR-vol%209-September%202004-pp%20424-439.htm (Accessed on 25.01.2017).

- Regarding the problem of Cybersquatting, the courts and the dispute resolution procedures are effective in dealing with cybersquatters only once they have committed their crimes, it still remains that this is not working as the figures are ever-increasing. At this point in the development of cybersquatting, where there is an ever-increasing prevalence of a change in track by cybersquatters to mass automated registrations, it is important to make a concerted effort by registrars to address and curb it at the registration level. This, it is felt, is key to really getting a grip on the situation and as in the ‘ real ’ world squatters have finally been given their marching orders with tough new property laws, so too, must ‘ virtual ’ squatters.
- 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[31] so as to further enhance the development of cyberspace and e-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.

[31] Sheldon Burshtein, “Is a domain name property”, Journal of Intellectual Property Law & Practice 1(1) 59 < http://cjlt.dal.ca/vol4_no3/pdfarticles/burshtein.pdf> (Accessed on 01.03.17).

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ANNEXURE

Annexure 1

ICANN Uniform Domain Name Dispute Resolution Policy[1]

(As Approved by ICANN on October 24, 1999)

1. **Purpose**.

This Uniform Domain Name Dispute Resolution Policy (the "Policy") has been adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN"), is incorporated by reference into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you. Proceedings under Paragraph 4 of this Policy will be conducted according to the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules of Procedure"), which are available at https://www.icann.org/resources /pages/udrp-rules-2015-03-11-en, and the selected administrative-dispute-resolution service provider's supplemental rules.

2. **Your Representations**.

By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights.

3**. Cancellations**.

Transfers, and Changes. We will cancel, transfer or otherwise make changes to domain name registrations under the following circumstances:

a. subject to the provisions of Paragraph 8, our receipt of written or appropriate electronic instructions from you or your authorized agent to take such action;

b. our receipt of an order from a court or arbitral tribunal, in each case of competent jurisdiction, requiring such action; and/or

c. our receipt of a decision of an Administrative Panel requiring such action in any administrative proceeding to which you were a party and which was conducted under this Policy or a later version of this Policy adopted by ICANN. (See Paragraph 4(i) and (k) below.)

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[1] Source: https://www.icann.org/resources/pages/policy-2012-02-25-en (Accessed on 22.01.2017).

We may also cancel, transfer or otherwise make changes to a domain name registration in accordance with the terms of your Registration Agreement or other legal requirements.

4. **Mandatory Administrative Proceeding**.

This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative-dispute-resolution service providers listed at www.icann.org/en/dndr/udrp/approved-providers.htm (each, a "Provider").

a. Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that

(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

(iii) your domain name has been registered and is being used in bad faith.

In the administrative proceeding, the complainant must prove that each of these three elements are present.

b. Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(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.

c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint. When you receive a complaint, you should refer to Paragraph 5 of the Rules of Procedure in determining how your response should be prepared. Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate non commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

d. Selection of Provider. The complainant shall select the Provider from among those approved by ICANN by submitting the complaint to that Provider. The selected Provider will administer the proceeding, except in cases of consolidation as described in Paragraph 4(f).

e. Initiation of Proceeding and Process and Appointment of Administrative Panel. The Rules of Procedure state the process for initiating and conducting a proceeding and for appointing the panel that will decide the dispute (the "Administrative Panel").

f. Consolidation. In the event of multiple disputes between you and a complainant, either you or the complainant may petition to consolidate the disputes before a single Administrative Panel. This petition shall be made to the first Administrative Panel appointed to hear a pending dispute between the parties. This Administrative Panel may consolidate before it any or all such disputes in its sole discretion, provided that the disputes being consolidated are governed by this Policy or a later version of this Policy adopted by ICANN.

g. Fees. All fees charged by a Provider in connection with any dispute before an Administrative Panel pursuant to this Policy shall be paid by the complainant, except in cases where you elect to expand the Administrative Panel from one t o three panelists as provided in Paragraph 5(b)(iv) of the Rules of Procedure, in which case all fees will be split evenly by you and the complainant.

h. Our Involvement in Administrative Proceedings. We do not, and will not, participate in the administration or conduct of any proceeding before an Administrative Panel. In addition, we will not be liable as a result of any decisions rendered by the Administrative Panel.

i. **Remedies**. The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant.

j. Notification and Publication. The Provider shall notify us of any decision made by an Administrative Panel with respect to a domain name you have registered with us. All decisions under this Policy will be published in full over the Internet, except when an Administrative Panel determines in an exceptional case to redact portions of its decision.

k. Availability of Court Proceedings. The mandatory administrative proceeding requirements set forth in Paragraph 4 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. If an Administrative Panel decides that your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the Administrative Panel's decision before implementing that decision. We will then implement the decision unless we have received from you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted under Paragraph 3(b)(xiii) of the Rules of Procedure. (In general, that jurisdiction is either the location of our principal office or of your address as shown in our Whois database. See Paragraphs 1 and 3(b)(xiii) of the Rules of Procedure for details.) If we receive such documentation within the ten (10) business day period, we will not implement the Administrative Panel's decision, and we will take no further action, until we receive (i) evidence satisfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing your lawsuit or ordering that you do not have the right to continue to use your domain name.

5. **All Other Disputes and Litigation**.

All other disputes between you and any party other than us regarding your domain name registration that are not brought pursuant to the mandatory administrative proceeding provisions of Paragraph 4 shall be resolved between you and such other party through any court, arbitration or other proceeding that may be available.

6. **Our Involvement in Disputes**.

We will not participate in any way in any dispute between you and any party other than us regarding the registration and use of your domain name. You shall not name us as a party or otherwise include us in any such proceeding. In the event that we are named as a party in any such proceeding, we reserve the right to raise any and all defenses deemed appropriate, and to take any other action necessary to defend ourselves.

7. **Maintaining the Status Quo.**

We will not cancel, transfer, activate, deactivate, or otherwise change the status of any domain name registration under this Policy except as provided in Paragraph 3 above.

8. **Transfers During a Dispute.**

a. Transfers of a Domain Name to a New Holder. You may not transfer your domain name registration to another holder (i) during a pending administrative proceeding brought pursuant to Paragraph 4 or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded; or (ii) during a pending court proceeding or arbitration commenced regarding your domain name unless the party to whom the domain name registration is being transferred agrees, in writing, to be bound by the decision of the court or arbitrator. We reserve the right to cancel any transfer of a domain name registration to another holder that is made in violation of this subparagraph.

b. Changing Registrars. You may not transfer your domain name registration to another registrar during a pending administrative proceeding brought pursuant to Paragraph 4 or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded. You may transfer administration of your domain name registration to another registrar during a pending court action or arbitration, provided that the domain name you have registered with us shall continue to be subject to the proceedings commenced against you in accordance with the terms of this Policy. In the event that you transfer a domain name registration to us during the pendency of a court action or arbitration, such dispute shall remain subject to the domain name dispute policy of the registrar from which the domain name registration was transferred.

9. **Policy Modifications**.

We reserve the right to modify this Policy at any time with the permission of ICANN. We will post our revised Policy at <URL> at least thirty (30) calendar days before it becomes effective. Unless this Policy has already been invoked by the submission of a complaint to a Provider, in which event the version of the Policy in effect at the time it was invoked will apply to you until the dispute is over, all such changes will be binding upon you with respect to any domain name registration dispute, whether the dispute arose before, on or after the effective date of our change. In the event that you object to a change in this Policy, your sole remedy is to cancel your domain name registration with us, provided that you will not be entitled to a refund of any fees you paid to us. The revised Policy will apply to you until you cancel your domain name registration.

Annexure 2

ICANN Uniform Domain Name Dispute Resolution Policy[1]
(The Rules)

These Rules are in effect for all UDRP proceedings in which a complaint is submitted to a provider on or after 31 July 2015. The prior version of the Rules, applicable to all proceedings in which a complaint was submitted to a Provider on or before 30 July 2015, is at https://www.icann.org/resources/pages/rules-be-2012-02-25-en. UDRP Providers may elect to adopt the notice procedures set forth in these Rules prior to 31 July 2015.

Administrative proceedings for the resolution of disputes under the Uniform Dispute Resolution Policy adopted by ICANN shall be governed by these Rules and also the Supplemental Rules of the Provider administering the proceedings, as posted on its web site. To the extent that the Supplemental Rules of any Provider conflict with these Rules, these Rules supersede.

Definitions

In these Rules:

Complainant means the party initiating a complaint concerning a domain-name registration.

ICANN refers to the Internet Corporation for Assigned Names and Numbers.

Lock means a set of measures that a registrar applies to a domain name, which prevents at a minimum any modification to the registrant and registrar information by the Respondent, but does not affect the resolution of the domain name or the renewal of the domain name.

Mutual Jurisdiction means a court jurisdiction at the location of either (a) the principal office of the Registrar (provided the domain-name holder has submitted in its Registration Agreement to that jurisdiction for court adjudication of disputes concerning or arising from the use of the domain

[1] Source: https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en (Accessed on 22.01.2017).

name) or (b) the domain-name holder's address as shown for the registration of the domain name in Registrar's Whois database at the time the complaint is submitted to the Provider.

Panel means an administrative panel appointed by a Provider to decide a complaint concerning a domain-name registration.

Panelist means an individual appointed by a Provider to be a member of a Panel.

Party means a Complainant or a Respondent.

Pendency means the time period from the moment a UDRP complaint has been submitted by the Complainant to the UDRP Provider to the time the UDRP decision has been implemented or the UDRP complaint has been terminated.

Policy means the Uniform Domain Name Dispute Resolution Policy that is incorporated by reference and made a part of the Registration Agreement.

Provider means a dispute-resolution service provider approved by ICANN. A list of such Providers appears at http://www.icann.org/en/dndr/udrp/approved-providers.htm.

Registrar means the entity with which the Respondent has registered a domain name that is the subject of a complaint.

Registration Agreement means the agreement between a Registrar and a domain-name holder.

Respondent means the holder of a domain-name registration against which a complaint is initiated.

Reverse Domain Name Hijacking means using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.

Supplemental Rules means the rules adopted by the Provider administering a proceeding to supplement these Rules. Supplemental Rules shall not be inconsistent with the Policy or these Rules and shall cover such topics as fees, word and page limits and guidelines, file size and format modalities, the means for communicating with the Provider and the Panel, and the form of cover sheets.

Written Notice means hardcopy notification by the Provider to the Respondent of the commencement of an administrative proceeding under the Policy which shall inform the respondent that a complaint has been filed against it, and which shall state that the Provider has electronically transmitted the complaint including any annexes to the Respondent by the means specified herein. Written notice does not include a hardcopy of the complaint itself or of any annexes.

Communications

(a) When forwarding a complaint, including any annexes, electronically to the Respondent, it shall be the Provider's responsibility to employ reasonably available means calculated to achieve actual notice to Respondent. Achieving actual notice, or employing the following measures to do so, shall discharge this responsibility:

(i) sending Written Notice of the complaint to all postal-mail and facsimile addresses (A) shown in the domain name's registration data in Registrar's Whois database for the registered domain-name holder, the technical contact, and the administrative contact and (B) supplied by Registrar to the Provider for the registration's billing contact; and

(ii) sending the complaint, including any annexes, in electronic form by e-mail to:

(A) the e-mail addresses for those technical, administrative, and billing contacts;

(B) postmaster@<the contested domain name>; and

(C) if the domain name (or "www." followed by the domain name) resolves to an active web page (other than a generic page the Provider concludes is maintained by a registrar or ISP for parking domain-names registered by multiple domain-name holders), any e- mail address shown or e-mail links on that web page; and

(iii) sending the complaint, including any annexes, to any e-mail address the Respondent has notified the Provider it prefers and, to the extent practicable, to all other e-mail addresses provided to the Provider by Complainant under Paragraph 3(b)(v).

(b) Except as provided in Paragraph 2(a), any written communication to Complainant or Respondent provided for under these Rules shall be made electronically via the Internet (a record of its transmission being available), or by any reasonably requested preferred means stated by the Complainant or Respondent, respectively (see Paragraphs 3(b)(iii) and 5(b)(iii)).

(c) Any communication to the Provider or the Panel shall be made by the means and in the manner (including, where applicable, the number of copies) stated in the Provider's Supplemental Rules.

(d) Communications shall be made in the language prescribed in Paragraph 11.

(e) Either Party may update its contact details by notifying the Provider and the Registrar.

(f) Except as otherwise provided in these Rules, or decided by a Panel, all communications provided for under these Rules shall be deemed to have been made:

(i) if via the Internet, on the date that the communication was transmitted, provided that the date of transmission is verifiable; or, where applicable

(ii) if delivered by telecopy or facsimile transmission, on the date shown on the confirmation of transmission; or:

(iii) if by postal or courier service, on the date marked on the receipt.

(g) Except as otherwise provided in these Rules, all time periods calculated under these Rules to begin when a communication is made shall begin to run on the earliest date that the communication is deemed to have been made in accordance with Paragraph 2(f).

(h) Any communication by

(i) a Panel to any Party shall be copied to the Provider and to the other Party;

(ii) the Provider to any Party shall be copied to the other Party; and

(iii) a Party shall be copied to the other Party, the Panel and the Provider, as the case may be.

(i) It shall be the responsibility of the sender to retain records of the fact and circumstances of sending, which shall be available for inspection by affected parties and for reporting purposes. This includes the Provider in sending Written Notice to the Respondent by post and/or facsimile under Paragraph 2(a)(i).

(j) In the event a Party sending a communication receives notification of non-delivery of the communication, the Party shall promptly notify the Panel (or, if no Panel is yet appointed, the Provider) of the circumstances of the notification. Further proceedings concerning the communication and any response shall be as directed by the Panel (or the Provider).

The Complaint

(a) Any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules to any Provider approved by ICANN. (Due to capacity constraints or for other reasons, a Provider's ability to accept complaints may be suspended at times. In that event, the Provider shall refuse the submission. The person or entity may submit the complaint to another Provider.)

(b) The complaint including any annexes shall be submitted in electronic form and shall:

(i) Request that the complaint be submitted for decision in accordance with the Policy and these Rules;

(ii) Provide the name, postal and e-mail addresses, and the telephone and telefax numbers of the Complainant and of any representative authorized to act for the Complainant in the administrative proceeding;

(iii) Specify a preferred method for communications directed to the Complainant in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy (where applicable);

(iv) Designate whether Complainant elects to have the dispute decided by a single-member or a three-member Panel and, in the event Complainant elects a three-member Panel, provide the names and contact details of three candidates to serve as one of the Panelists (these candidates may be drawn from any ICANN-approved Provider's list of panelists);

(v) Provide the name of the Respondent (domain-name holder) and all information (including any postal and e-mail addresses and telephone and telefax numbers) known to Complainant regarding how to contact Respondent or any representative of Respondent, including contact information based on pre-complaint dealings, in sufficient detail to allow the Provider to send the complaint as described in Paragraph 2(a);

(vi) Specify the domain name(s) that is/are the subject of the complaint;

(vii) Identify the Registrar(s) with whom the domain name(s) is/are registered at the time the complaint is filed;

(viii) Specify the trademark(s) or service mark(s) on which the complaint is based and, for each mark, describe the goods or services, if any, with which the mark is used (Complainant may also separately describe other goods and services with which it intends, at the time the complaint is submitted, to use the mark in the future.);

(ix) Describe, in accordance with the Policy, the grounds on which the complaint is made including, in particular,

(1) the manner in which the domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(2) why the Respondent (domain-name holder) should be considered as having no rights or legitimate interests in respect of the domain name(s) that is/are the subject of the complaint; and

(3) why the domain name(s) should be considered as having been registered and being used in bad faith

(The description should, for elements (2) and (3), discuss any aspects of Paragraphs 4(b) and 4(c) of the Policy that are applicable. The description shall comply with any word or page limit set forth in the Provider's Supplemental Rules.);

(x) Specify, in accordance with the Policy, the remedies sought;

(xi) Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint;

(xii) State that Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the jurisdiction of the courts in at least one specified Mutual Jurisdiction;

(xiii) Conclude with the following statement followed by the signature (in any electronic format) of the Complainant or its authorized representative:

"Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain-name holder and waives all such claims and remedies against (a) the dispute-resolution provider and panelists, except in the case of deliberate wrongdoing, (b) the registrar, (c) the registry administrator, and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents."

"Complainant certifies that the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument."; and

(xiv) Annex any documentary or other evidence, including a copy of the Policy applicable to the domain name(s) in dispute and any trademark or service mark registration upon which the complaint relies, together with a schedule indexing such evidence.

(c) The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

Notification of Complaint

(a) The Provider shall submit a verification request to the Registrar. The verification request will include a request to Lock the domain name.

(b) Within two (2) business days of receiving the Provider's verification request, the Registrar shall provide the information requested in the verification request and confirm that a Lock of the domain name has been applied. The Registrar shall not notify the Respondent of the proceeding until the Lock status has been applied. The Lock shall remain in place through the remaining Pendency of the UDRP proceeding. Any updates to the Respondent's data, such as through the result of a request by a privacy or proxy provider to reveal the underlying customer data, must be made before the two (2) business day period concludes or before the Registrar verifies the information requested and confirms the Lock to the UDRP Provider, whichever occurs first. Any modification(s) of the Respondent's data following the two (2) business day period may be addressed by the Panel in its decision.

(c) The Provider shall review the complaint for administrative compliance with the Policy and these Rules and, if in compliance, shall forward the complaint, including any annexes, electronically to the Respondent and Registrar and shall send Written Notice of the complaint (together with the explanatory cover sheet prescribed by the Provider's Supplemental Rules) to the Respondent, in the manner prescribed by Paragraph 2(a), within three (3) calendar days following receipt of the fees to be paid by the Complainant in accordance with Paragraph 19.

(d) If the Provider finds the complaint to be administratively deficient, it shall promptly notify the Complainant and the Respondent of the nature of the deficiencies identified. The Complainant shall have five (5) calendar days within which to correct any such deficiencies, after which the administrative proceeding will be deemed withdrawn without prejudice to submission of a different complaint by Complainant.

(e) If the Provider dismisses the complaint due to an administrative deficiency, or the Complainant voluntarily withdraws its complaint, the Provider shall inform the Registrar that the proceedings have been withdrawn, and the Registrar shall release the Lock within one (1) business day of receiving the dismissal or withdrawal notice from the Provider.

(f) The date of commencement of the administrative proceeding shall be the date on which the Provider completes its responsibilities under Paragraph 2(a) in connection with sending the complaint to the Respondent.

(g) The Provider shall immediately notify the Complainant, the Respondent, the concerned Registrar(s), and ICANN of the date of commencement of the administrative proceeding. The Provider shall inform the Respondent that any corrections to the Respondent's contact information during the remaining Pendency of the UDRP proceedings shall be communicated to the Provider further to Rule 5(c)(ii) and 5(c)(iii).

The Response

(a) Within twenty (20) days of the date of commencement of the administrative proceeding the Respondent shall submit a response to the Provider.

(b) The Respondent may expressly request an additional four (4) calendar days in which to respond to the complaint, and the Provider shall automatically grant the extension and notify the Parties thereof. This extension does not preclude any additional extensions that may be given further to 5(d) of the Rules.

(c) The response, including any annexes, shall be submitted in electronic form and shall:

> (i) Respond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain-name holder) to retain registration and use of the disputed domain name (This portion of the response shall comply with any word or page limit set forth in the Provider's Supplemental Rules.);

(ii) Provide the name, postal and e-mail addresses, and the telephone and telefax numbers of the Respondent (domain-name holder) and of any representative authorized to act for the Respondent in the administrative proceeding;

(iii) Specify a preferred method for communications directed to the Respondent in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy (where applicable);

(iv) If Complainant has elected a single-member panel in the complaint (see Paragraph 3(b)(iv)), state whether Respondent elects instead to have the dispute decided by a three-member panel;

(v) If either Complainant or Respondent elects a three-member Panel, provide the names and contact details of three candidates to serve as one of the Panelists (these candidates may be drawn from any ICANN-approved Provider's list of panelists);

(vi) Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint;

(vii) State that a copy of the response including any annexes has been sent or transmitted to the Complainant, in accordance with Paragraph 2(b); and

(viii) Conclude with the following statement followed by the signature (in any electronic format) of the Respondent or its authorized representative:

"Respondent certifies that the information contained in this Response is to the best of Respondent's knowledge complete and accurate, that this Response is not being presented for any improper purpose, such as to harass, and that the assertions in this Response are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument."; and

(ix) Annex any documentary or other evidence upon which the Respondent relies, together with a schedule indexing such documents.

(d) If Complainant has elected to have the dispute decided by a single-member Panel and Respondent elects a three-member Panel, Respondent shall be required to pay one-half of the applicable fee for a three-member Panel as set forth in the Provider's Supplemental Rules. This payment shall be made together with the submission of the response to the Provider. In the event that the required payment is not made, the dispute shall be decided by a single-member Panel.

(e) At the request of the Respondent, the Provider may, in exceptional cases, extend the period of time for the filing of the response. The period may also be extended by written stipulation between the Parties, provided the stipulation is approved by the Provider.

(f) If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint.

Appointment of the Panel and Timing of Decision

(a) Each Provider shall maintain and publish a publicly available list of panelists and their qualifications.

(b) If neither the Complainant nor the Respondent has elected a three-member Panel (Paragraphs 3(b)(iv) and 5(b)(iv)), the Provider shall appoint, within five (5) calendar days following receipt of the response by the Provider, or the lapse of the time period for the submission thereof, a single Panelist from its list of panelists. The fees for a single-member Panel shall be paid entirely by the Complainant.

(c) If either the Complainant or the Respondent elects to have the dispute decided by a three-member Panel, the Provider shall appoint three Panelists in accordance with the procedures identified in Paragraph 6(e). The fees for a three-member Panel shall be paid in their entirety by the Complainant, except where the election for a three-member Panel was made by the Respondent, in which case the applicable fees shall be shared equally between the Parties.

(d) Unless it has already elected a three-member Panel, the Complainant shall submit to the Provider, within five (5) calendar days of communication of a response in which the Respondent elects a three-member Panel, the names and contact details of three candidates to serve as one of the Panelists. These candidates may be drawn from any ICANN-approved Provider's list of panelists.

(e) In the event that either the Complainant or the Respondent elects a three-member Panel, the Provider shall endeavor to appoint one Panelist from the list of candidates provided by each of the Complainant and the Respondent. In the event the Provider is unable within five (5) calendar days to secure the appointment of a Panelist on its customary terms from either Party's list of candidates, the Provider shall make that appointment from its list of panelists. The third Panelist shall be appointed by the Provider from a list of five candidates submitted by the Provider to the Parties, the Provider's selection from among the five being made in a manner that reasonably balances the preferences of both Parties, as they may specify to the Provider within five (5) calendar days of the Provider's submission of the five-candidate list to the Parties.

(f) Once the entire Panel is appointed, the Provider shall notify the Parties of the Panelists appointed and the date by which, absent exceptional circumstances, the Panel shall forward its decision on the complaint to the Provider.

Impartiality and Independence

A Panelist shall be impartial and independent and shall have, before accepting appointment, disclosed to the Provider any circumstances giving rise to justifiable doubt as to the Panelist's impartiality or independence. If, at any stage during the administrative proceeding, new circumstances arise that could give rise to justifiable doubt as to the impartiality or independence of the Panelist, that Panelist shall promptly disclose such circumstances to the Provider. In such event, the Provider shall have the discretion to appoint a substitute Panelist.

Communication Between Parties and the Panel

No Party or anyone acting on its behalf may have any unilateral communication with the Panel. All communications between a Party and the Panel or the Provider shall be made to a case administrator appointed by the Provider in the manner prescribed in the Provider's Supplemental Rules.

Transmission of the File to the Panel

The Provider shall forward the file to the Panel as soon as the Panelist is appointed in the case of a Panel consisting of a single member, or as soon as the last Panelist is appointed in the case of a three-member Panel.

General Powers of the Panel

(a) The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.

(b) In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

(c) The Panel shall ensure that the administrative proceeding takes place with due expedition. It may, at the request of a Party or on its own motion, extend, in exceptional cases, a period of time fixed by these Rules or by the Panel.

(d) The Panel shall determine the admissibility, relevance, materiality and weight of the evidence.

(e) A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.

Language of Proceedings

(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

(b) The Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.

Further Statements

In addition to the complaint and the response, the Panel may request, in its sole discretion, further statements or documents from either of the Parties.

In-Person Hearings

There shall be no in-person hearings (including hearings by teleconference, videoconference, and web conference), unless the Panel determines, in its sole discretion and as an exceptional matter, that such a hearing is necessary for deciding the complaint.

Default

(a) In the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by these Rules or the Panel, the Panel shall proceed to a decision on the complaint.

(b) If a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, these Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

Panel Decisions

(a) A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

(b) In the absence of exceptional circumstances, the Panel shall forward its decision on the complaint to the Provider within fourteen (14) days of its appointment pursuant to Paragraph 6.

(c) In the case of a three-member Panel, the Panel's decision shall be made by a majority.

(d) The Panel's decision shall be in writing, provide the reasons on which it is based, indicate the date on which it was rendered and identify the name(s) of the Panelist(s).

(e) Panel decisions and dissenting opinions shall normally comply with the guidelines as to length set forth in the Provider's Supplemental Rules. Any dissenting opinion shall accompany the majority decision. If the Panel concludes that the dispute is not within the scope of Paragraph 4(a) of the Policy, it shall so state. If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

Communication of Decision to Parties

(a) Within three (3) business days after receiving the decision from the Panel, the Provider shall communicate the full text of the decision to each Party, the concerned Registrar(s), and ICANN. The concerned Registrar(s) shall within three (3) business days of receiving the decision from the Provider communicate to each Party, the Provider, and ICANN the date for the implementation of the decision in accordance with the Policy.

(b) Except if the Panel determines otherwise (see Paragraph 4(j) of the Policy), the Provider shall publish the full decision and the date of its implementation on a publicly accessible web site. In any event, the portion of any decision determining a complaint to have been brought in bad faith (see Paragraph 15(e) of these Rules) shall be published.

Settlement or Other Grounds for Termination

(a) If, before the Panel's decision, the Parties agree on a settlement, the Panel shall terminate the administrative proceeding. A settlement shall follow steps 17(a)(i) – 17(a)(vii):

> (i) The Parties provide written notice of a request to suspend the proceedings because the parties are discussing settlement to the Provider.
>
> (ii) The Provider acknowledges receipt of the request for suspension and informs the Registrar of the suspension request and the expected duration of the suspension.
>
> (iii) The Parties reach a settlement and provide a standard settlement form to the Provider further to the Provider's supplemental rules and settlement form. The standard settlement form is not intended to be an agreement itself, but only to summarize the essential terms of the Parties' separate settlement agreement. The Provider shall not disclose the completed standard settlement form to any third party.

(iv) The Provider shall confirm to the Registrar, copying the Parties, the outcome of the settlement as it relates to actions that need to be taken by the Registrar.

(v) Upon receiving notice from the Provider further to 17(a)(iv), the Registrar shall remove the Lock within two (2) business days.

(vi) The Complainant shall confirm to the Provider that the settlement as it relates to the domain name(s) has been implemented further to the Provider's supplemental rules.

(vii) The Provider will dismiss the proceedings without prejudice unless otherwise stipulated in the settlement.

(b) If, before the Panel's decision is made, it becomes unnecessary or impossible to continue the administrative proceeding for any reason, the Panel shall terminate the administrative proceeding, unless a Party raises justifiable grounds for objection within a period of time to be determined by the Panel.

Effect of Court Proceedings

(a) In the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision.

(b) In the event that a Party initiates any legal proceedings during the Pendency of an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, it shall promptly notify the Panel and the Provider. See Paragraph 8 above.

Fees

(a) The Complainant shall pay to the Provider an initial fixed fee, in accordance with the Provider's Supplemental Rules, within the time and in the amount required. A Respondent electing under Paragraph 5(b)(iv) to have the dispute decided by a three-member Panel, rather than the single-member Panel elected by the Complainant, shall pay the Provider one-half the fixed fee for a three-member Panel. See Paragraph 5(c).

In all other cases, the Complainant shall bear all of the Provider's fees, except as prescribed under Paragraph 19(d). Upon appointment of the Panel, the Provider shall refund the appropriate portion, if any, of the initial fee to the Complainant, as specified in the Provider's Supplemental Rules.

(b) No action shall be taken by the Provider on a complaint until it has received from Complainant the initial fee in accordance with Paragraph 19(a).

(c) If the Provider has not received the fee within ten (10) calendar days of receiving the complaint, the complaint shall be deemed withdrawn and the administrative proceeding terminated.

(d) In exceptional circumstances, for example in the event an in-person hearing is held, the Provider shall request the Parties for the payment of additional fees, which shall be established in agreement with the Parties and the Panel.

Exclusion of Liability

Except in the case of deliberate wrongdoing, neither the Provider nor a Panelist shall be liable to a Party for any act or omission in connection with any administrative proceeding under these Rules.

Amendments

The version of these Rules in effect at the time of the submission of the complaint to the Provider shall apply to the administrative proceeding commenced thereby. These Rules may not be amended without the express written approval of ICANN.

Annexure 3

.IN Domain Name Dispute Resolution Policy (INDRP)[1]
Posted 28 June 2005

Definitions

Arbitrator refers to the experts who have expertise on computer and/or laws, possess a high sense of professional ethics and are capable of rendering independent and unbiased decisions in domain name disputes.

Complainant refers to the person who has complaint against the Registrant.

.IN Registry: Wherever used in this policy and the rules hereunder .IN Registry refers to the National Internet Exchange of India (NIXI), a company registered under section 25 of the Indian Companies Act 1956.

Person includes an individual, institution, organization, company, partnership or any other legal entity etc.

Registrar shall mean a domain name registrar who is duly accredited with the .IN Registry pursuant to a Registrar Accreditation Agreement and is listed on the website of the .IN Registry, www.registry.in.

"Registrant" is a holder of the .in Internet domain name.

Purpose

This .IN Domain Name Dispute Resolution Policy (the "Policy") sets out the terms and conditions to resolve a dispute between the Registrant and the Complainant, arising out of the registration and use of the .in Internet Domain Name.

The Registrant's Representations

By applying to register a domain name, or by asking a Registrar to maintain or renew a domain name registration, the Registrant represents and warrants that:

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[1] Source:https://registry.in/IN%20Domain%20Name%20Dispute%20Resolution%20Policy%20 (INDRP)

(a) the statements that the Registrant made in the Registrant's Application Form for Registration of Domain Name are complete and accurate;

(b) to the Registrant's knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;

(c) the Registrant is not registering the domain name for an unlawful purpose; and

(d) the Registrant will not knowingly use the domain name in violation of any applicable laws or regulations.

It is the Registrant's responsibility to determine whether the Registrant's domain name registration infringes or violates someone else's rights.

Types of Disputes

Any Person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

(i) the Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;

(ii) the Registrant has no rights or legitimate interests in respect of the domain name; and

(iii) the Registrant's domain name has been registered or is being used in bad faith.

The Registrant is required to submit to a mandatory Arbitration proceeding in the event that a Complainant files a complaint to the .IN Registry, in compliance with this Policy and Rules thereunder.

Procedure of Dispute Resolution

The .IN Registry shall appoint an Arbitrator out of the list of arbitrators maintained by the Registry.

The List of the Arbitrators shall be published on line by the .IN Registry on its website at www.registry.in.

The Arbitrator shall conduct the Arbitration Proceedings in accordance with the Arbitration & Conciliation Act 1996 as amended from time to time and also in accordance with this Policy and rules provided thereunder.

Evidence of Registration and use of Domain Name in Bad Faith

For the purposes of Paragraph 4(iii), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or

(ii) the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or

(iii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

Registrant's Rights to and Legitimate Interests in the Domain Name

Any of the following circumstances, in articular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purposes of Paragraph 4 (ii) :

(i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;

(ii) the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or

(iii) the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Fees

Except as otherwise stated in this policy or the Rules hereunder, all fees charged by the .IN Registry in connection with any dispute pursuant to this Policy shall be paid by the Complainant.

Involvement of Registry and the Registrar in Arbitration Proceedings

The Registry and the Registrars shall not participate in the domain name dispute resolution proceedings in any capacity or manner other than providing the information relevant to the registration and use of the domain name upon the request of the Arbitrator. Neither the Registry nor the Registrar shall be liable for any decisions rendered by an Arbitrator.

Remedies

The remedies available to a Complainant pursuant to any proceeding before an Arbitrator shall be limited to requiring the cancellation of the Registrant's domain name or the transfer of the Registrant's domain name registration to the Complainant. Costs as may be deemed fit may also be awarded by the Arbitrator.

Notification and Publication

All decisions under this Policy will be published in full over the Internet, except when an Arbitration Panel decides in an exceptional case to edit portions of its decision.

Transfers During a Dispute

The Registrant shall not transfer a domain name registration to another holder:

(i) In case an Arbitration proceeding is initiated pursuant to this policy, for a period of fifteen (15) working days ("working day" means any day other than a Saturday, Sunday or public holiday) after such proceeding is concluded; or

(ii) during a pending court proceeding or arbitration commenced regarding the domain name, unless the party to whom the domain name registration is being transferred agrees, in writing, to be bound by the decision of the court or arbitrator.

The Registry reserves the right to cancel any transfer of a domain name registration to another holder that is made in violation of this paragraph.

Policy Modifications

The Government of India reserves the right to add, delete, amend or modify this Policy (and the rules framed thereunder) at any time. The revised policy shall be posted on the website of the registry at www.registry.in at least Fifteen (15) calendar days before it becomes effective. The complaints submitted prior to the date of implementation of the revised policy would be entertained and decided in accordance with the policy in force at the time of filing the complaint. However, with effect from the date the revised policy comes in existence all complaints filed would be dealt with as per the revised policy. The Registrants shall be bound by the terms and conditions of the policy, rules, guidelines, bylaws framed by the .IN Registry from time to time.

Annexure-4

INDRP Rules of Procedure[1]

Posted 28 June 2005

1. Definitions

In these Rules:

Arbitrator refers to the expert who have expertise on computer and/or laws, possess a high sense of professional ethics and are capable of rendering independent and unbiased decisions in domain name disputes.

Complaint means a Complaint referred to in Paragraph 3 of these Rules of Procedure.

Complainant refers to the person who has complaint against the Registrant.

.IN Registry Wherever used in this policy and the rules hereunder .IN Registry refers to the National Internet Exchange of India (NIXI), a company registered under section 25 of the Indian Companies Act 1956.

Dispute Resolution Policy means the version of the .IN Domain Name Dispute Resolution Policy which is in existence on the date of filing of the Complaint.

Respondent means the registered holder of a .IN domain-name against whom a Complaint is initiated.

Response means a Response referred to in Paragraph 5 of these Rules of Procedure.

2. Communications

a. When forwarding a Complaint to the Respondent, .INRegistry shall ensure to employ reasonably available means to serve notice of complaint to the Respondent. Service of notice, or employing the following measures to do so, shall discharge this responsibility:

[1] https://registry.in/INDRP%20Rules%20of%20Procedure

i. sending the Complaint to all postal-mail and facsimile addresses shown in the domain name's registration data through .IN Registry's WHOIS database at www.registry.in ; and

ii. sending the Complaint in electronic form (including annexes to the extent available in that form) by e-mail to:

A. the e-mail addresses shown in the domain name's registration data through .IN REGISTRY's WHOIS function at www.registry.in and

B. postmaster@[the contested domain name]

iii. sending the Complaint to any address the Respondent has notified to the .IN Registry in writing (including email) at which it prefers and, to the extent possible, to all other addresses provided to the .IN Registry by Complainant under Paragraph 3(b)(v).

b. Except the service of the notice of Complaint as provided in Paragraph 2(a), any written communication to Complainant or Respondent provided for under these Rules of Procedure shall be made

i. by facsimile transmission, with a confirmation of transmission; or

ii. by registered post and/or, speed post.

c. Communications shall be made in the language prescribed in Paragraph 10 of these Rules of Procedure.

d. Either Party may update its contact details by notifying to the .IN Registry.

e. Except as otherwise provided in these Rules of Procedure, or decided by an Arbitrator, all communications provided for under these Rules of Procedure shall be deemed to have been made:

i. if delivered through facsimile transmission, on the date shown on the confirmation of transmission; or

ii. if by registered post or speed post, on the date marked on the acknowledgement receipt or on the 3rd day from the date of its dispatch; or

iii. if via the Internet, on the date that the communication was transmitted, provided that the date of transmission is verifiable.

f. Except as otherwise provided in these Rules of Procedure, all time periods calculated under these Rules of Procedure to begin when a communication is made shall begin to run on the earliest date that the communication is deemed to have been made in accordance with Paragraph 2(e) above.

g. Any communication by

i. an Arbitrator to any Party shall be copied to the .IN Registry and to the other Party;

ii. the .IN Registry to any Party shall be copied to the other Party and to the Arbitrator; and

iii. a Party shall be copied to the other Party, the Arbitrator and the .IN Registry.

h. It shall be the responsibility of the sender of a communication to retain records of the fact and circumstances of the sending, which shall be available for inspection by affected parties and for reporting purposes.

i. In the event a sender sends a communication and receives information of non-delivery of the communication, the sender shall promptly inform the Arbitrator, the .IN Registry and the relevant parties about the non delivery of communication and reasons thereof if any. Further proceedings concerning the communication and any response shall be as directed by the Arbitrator, or if no Arbitrator is yet appointed, by the .IN Registry.

3. The Complaint

a. Any person or entity may initiate an arbitration proceeding by submitting a Complaint to the .IN Registry in accordance with the Dispute Resolution Policy and these Rules of Procedure. The envelopes containing the Complaint should be clearly superscribed on the right hand side corner .IN Domain Names Dispute Complaint.

The Complaint should be addressed to:

.IN Registryc/o NIXI (National Internet eXchange of India) Regd. Off.: Flat No. 6B, 6th Floor, Uppals M6 Plaza, Jasola District Centre, New Delhi-110025 Tel.: +91-11-48202011, Tel. : +91-11-48202000,Fax: +91-11-48202013E-Mail: registry@nixi.in Or any other address that may be published on the Registry's website from time to time.

b. The Complaint and the annexures attached to it shall be submitted in three hard copies and one softcopy and shall incorporate the following:

i. A request that the Complaint be submitted to arbitration in accordance with the Dispute Resolution Policy and the Rules framed thereunder,

ii. state the name, postal and e-mail addresses, and the telephone and facsimile numbers of the Complainant and of any representative authorised to act for the Complainant in the arbitration proceeding and also specify a preferred method of communication to it i.e. by email, postal mail or facsimile.

iii. provide the name of the Respondent and all information (including any postal and e-mail addresses and telephone and facsimile numbers) known to the Complainant regarding how to contact the Respondent including contact information based on any pre-Complaint dealings, to allow the .IN Registry to send the Complaint to the Respondent as described in Paragraph 2(a) above;

iv. specify the domain name which is the subject of the Complaint;

v. specify the trademark(s) or service mark(s) on which the Complaint is based and, for each mark, describe the goods or services, if any, with which the mark is used. The Complainant may also separately describe other goods and services with which it intends, at the time the complaint is submitted, to use the mark in the future;

vi. describe, in accordance with the Domain Name Dispute Resolution Policy, the grounds on which the Complaint is made including, in particular,

1. the manner in which the domain name in question is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

2. why the Respondent should be considered as having no rights or legitimate interests in respect of the domain name that is the subject of the Complaint; and

3. why the domain name in question should be considered as having been registered and being used in bad faith.

vii. Specify, in accordance with the Dispute Resolution Policy, the remedies sought;

viii. Identify any other legal proceedings that have been commenced or terminated in connection with or relating to the domain name that is the subject of the Complaint;

ix. Conclude with the following statement followed by the signature of the Complainant or its authorized representative:

"The Complainant, by submitting the Complaint agrees to the settlement of the dispute, regarding the domain name which is the object of the Complaint by final and binding arbitration in India in accordance with the Arbitration and Conciliation Act, 1996 , the .IN Domain Name Dispute Resolution Policy of .IN Registry ; Rules of Procedure and any bye-laws, rules or guidelines framed thereunder."

"Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain-name holder and waives all such claims and remedies against the .IN REGISTRY, as well as their directors, officers, employees, and agents and the arbitrator who will hear the dispute.

"The Complainant by submitting this Complaint agrees that the decision of the Arbitrator to be appointed in this matter may be made public and may be published on the website including without limitation other forms of publication of the .IN REGISTRY. "

"Complainant certifies that the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass the Respondent etc.”

x. Annex any documentary or other evidence, including a copy of the Policy applicable to the domain name in dispute and any trademark or service mark registration upon which the Complaint relies, together with a schedule indexing such evidence.

c. A separate Complaint is required to be filed for dispute relating to each domain name.

4. Notification of Complaint

a. The .IN Registry shall on receipt of the prescribed fees, forward the Complaint to the Respondent, within three (3) working days if it is found in accordance with the Dispute Resolution Policy and Rules of Procedure.

b. If the .IN Registry finds the Complaint to be not in accordance with the Dispute Resolution Policy and the Rules of Procedure, it shall within three (3) working days notify the Complainant of the deficiencies identified. The Complainant shall have five (5) working days within which to correct any such deficiencies, failing which the arbitration proceeding will be deemed withdrawn without prejudice to submission of another Complaint by the Complainant in respect of the same domain name.The .IN Registry on receipt of the complaint after correction of the deficiencies shall appoint an arbitrator from the list of arbitrators and forward the Complaint and documents to the Respondent and to the Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act 1996, Rules framed thereunder, Dispute Resolution Policy & rules framed thereunder.

c. The date of commencement of the arbitration proceeding shall be the date on which the Arbitrator issues notice to the Respondent as stipulated under Paragraph 5 (c) of these Rules of Procedure.

5. Appointment of the Panel and Timing of Decision

a. .IN Registry shall maintain and publish a publicly available list of arbitrators and their qualifications.

b. The .IN Registry shall appoint, within five (5) working days following receipt of the Complaint after removal of objections if any, an Arbitrator from the .IN Registry?s list of Arbitrators and shall forward to him the Complaint and documents annexed thereto . The fees shall be paid entirely by the Complainant.

c. Once the arbitrator is appointed the .IN Registry shall notify the parties of the Arbitrator appointed. The Arbitrator shall pass a reasoned award and shall put forward a copy of it immediately to the Complainant, Respondent and the .IN Registry. The award shall be passed within 60 days from the date of commencement of arbitration proceeding. In exceptional circumstances this period may be extended by the Arbitrator maximum for 30 days. However, the Arbitrator shall give the reasons in writing for such extension.Within 3 days from the receipt of the complaint the Arbitrator shall issue a notice to the Respondent.

d. The Arbitrator shall ensure that copies of all documents, replies, rejoinders, applications, orders passed from time to time be forwarded to .IN Registry immediately for its records and for maintaining the transparency in the proceedings.

6. Impartiality and Independence

(i) An Arbitrator shall be and remain at all times impartial and independent and shall have, before accepting appointment, disclosed to the .IN Registry any circumstance, which could give rise to justifiable doubt as to the Arbitrator's impartiality or independence. If, at any stage during the arbitration proceeding, new circumstances arise which could give rise to justifiable doubt as to the impartiality or independence of the Arbitrator, the Arbitrator shall promptly disclose such circumstances to the .IN Registry. In such event, the .IN Registry shall have the discretion to appoint a substitute Arbitrator from the .IN Registry's list of Arbitrators.

(ii) After an Arbitrator has been appointed, but before rendering a decision, the Arbitrator dies, or is unable to act, or refuses to act, the .IN Registry shall, upon written request by either Party, appoint a replacement Arbitrator from the .IN Registry?s list of Arbitrators.

(iii) A Party may challenge an arbitrator?s impartiality or independence by filing a written request to the .IN Registry within seven (7) calendar days of the date of receipt of the notice of appointment of the Arbitrator in question, stating the circumstances likely to give rise to justifiable doubt as to the relevant Arbitrator?s impartiality or independence, together with specific reasons therefore. The .IN Registry, in its sole discretion, shall decide whether such doubts are justified, and if the .IN Registry so finds, the .IN Registry may remove the Arbitrator against whom the challenge was made and replace such Arbitrator with another arbitrator from the .IN Registry?s list of arbitrators.

7. Communication Between Parties and the Arbitrator

No Party or anyone acting on its behalf may have any unilateral communication with an Arbitrator. All communications between a Party and the Arbitrator, or between a Party and the .IN Registry shall be made in the manner prescribed in these Rules of Procedure.

8. General Powers of the Arbitrator

a. An Arbitrator shall conduct the arbitration proceeding in such manner as it considers appropriate in accordance with the Arbitration and Conciliation Act 1996, Dispute Resolution Policy, the Rules of Procedure and any bye-laws, rules and guidelines framed thereunder.

b. In all cases, the Arbitrator shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

c. Every Arbitrator shall ensure that the arbitration proceedings takes place with due expedition.

9. Language of the Arbitration Proceedings

a. The language of the arbitration proceedings shall be English.

b. Any documents submitted in a language other than English shall be accompanied by a true copy of its translation in English.

10. In-Person Hearings

There shall be no in-person hearings (including hearings by teleconference, videoconference, and web conference), unless the Arbitrator determines, in his sole discretion and as an exceptional matter, that such a hearing is necessary for deciding the Complaint.

11. Default

a. In the event that a Party, in the absence of exceptional circumstances as determined by the Arbitrator in its sole discretion, does not comply with any of the time periods established by these Rules of Procedure or the Arbitrator, the Arbitrator shall proceed to decide the Complaint in accordance with law.

12. Arbitrator Decisions

a. An Arbitrator shall decide a Complaint on the basis of the statements and documents submitted to it and in accordance with the Arbitration and Conciliation Act, 1996, Dispute Resolution Policy, the Rules of Procedure and any bye-laws, rules and guidelines framed thereunder and any law that the Arbitrator deems to be applicable.

b. In the absence of exceptional circumstances as determined by the Arbitrator in its sole discretion, the Arbitrator shall forward its decision on the Complaint to the .IN Registry within Sixty (60) calendar days of commencement of the Arbitration Proceedings.

c. An Arbitrator's decision shall be in writing, provide the reasons on which it is based, indicate the date on which it was rendered and identify the name of the Arbitrator.

13. Communication of Decision to Parties

a. Within five (5) working days after receiving the decision from the Arbitrator, the .IN Registry shall communicate the full text of the decision to each Party and shall also communicate to each Party, the date for the implementation of the decision.

14. Settlement or Other Grounds for Termination

a. If, before the Arbitrator's decision, the Parties agree on a settlement, the Arbitrator shall terminate the arbitration proceeding and enter the settlement as the decision of the Arbitrator.

15. Fees

a. The Complainant shall pay to the .IN Registry the prescribed fee, in accordance with the .IN Registry's schedule of fees, within the time and in the amount required. All cheques/drafts towards the . IN Registry administration charges and payment of the Arbitrator's fee shall be drawn in favour of 'NATIONAL INTERNET EXCHANGE OF INDIA'.

b. No action shall be taken by the .IN Registry on a Complaint until it has received from Complainant the prescribed fee.

c. The fees for adjudication of the dispute shall be payable as per the schedule given below. In case the Arbitrator calls for personal hearings, the fees for personal hearing shall be shared by the parties equally. However if any party requests for personal hearing and that request is allowed by the Arbitrator, the fees for personal hearing shall be payable by the party making such request.

.IN Registry's

Administration Fee 10,000/-

Arbitrator's Fee 20,000/-

Total Amount 30,000/- + Service Tax (14%) *+ Swachh Bharat Cess (SBC) (0.5%) + Krishi Kalyan Cess (KKC) (0.5%) **

For personal hearing 2,000/- + Service Tax (14%) *+ Swachh Bharat Cess (SBC) (0.5%) + Krishi Kalyan Cess (KKC) (0.5%)** per hearing

Maximum TWO hearings

* Upto May 31, 2016 - 14.5% (Total Tax)

**w.e.f. June 01, 2016 - 15% (Total Tax)

d. In case the arbitration proceedings are deemed to be withdrawn as stipulated under Paragraph 4 (b) above, the Registry Administration Fee shall be forfeited by the .IN Registry.

e. No interest whatsoever shall be payable by the .IN Registry in respect to any money deposited with it in accordance with this policy.

f. Venue of personal hearing will be the notified address of the arbitrator.

16. Exclusion of Liability

Neither the .IN Registry nor the Arbitrator shall be liable to a Party for any act or mission in connection with any arbitration proceeding under these Rules of Procedure.

17. Amendments

The version of Dispute Resolution Policy and these Rules of Procedure in effect at the time of the submission of a Complaint to the .IN Registry shall apply to the arbitration proceeding commenced in accordance with such Dispute Resolution Policy and Rules of Procedure.These Rules of Procedure may be amended from time to time by the .IN REGISTRY in its sole discretion.

Annexure-5

THE ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (ADNDRC)[1]
SUPPLEMENTAL RULES TO THE ICANN UDRP AND THE RULES FOR THE UDRP

THE SUPPLEMENTAL RULES
(IN EFFECT AS OF 28TH FEBRUARY 2002)

Article 1. Definitions

1. "The Rules" mean the Rules for the Uniform Domain Name Dispute Resolution Policy as approved by ICANN on 24 October 1999.

2. "The Policy" means the Uniform Domain Name Dispute Resolution Policy as approved by ICANN on 24 October 1999.

3. "The Supplemental Rules" mean these Rules which are Supplemental to the Rules and the Policy and are adopted by the Asian Domain Name Dispute Resolution Centre (ADNDRC) to assess Complaints regarding Domain Name Dispute and administer proceedings in conformity with "the Rules" and where required supplement them.

4. "The Centre" means the Asian Domain Name Dispute Resolution Centre (ADNDRC) jointly established by the China International Economic and Trade Arbitration Commission (CIETAC) and the Hong Kong International Arbitration Centre (HKIAC) on 28 February 2002 with its Beijing Office managed and operated by CIETAC, its Hong Kong Office managed and operated by HKIAC and its Seoul Office managed by IDRC.

5. "Relevant Office of the Centre" shall mean either the Beijing Office of the Centre, the Hong Kong Office of the Centre or the Seoul Office of the Centre as the case may be, or as the context may require.

6. Any terms defined in the Policy and the Rules shall have the same meaning in the Supplemental Rules.

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[1] https://www.adndrc.org/mten/bjen/udrp1.php?st=3

Article 2. Scope

1. The Supplemental Rules are to be read and used in connection with the Policy and the Rules.

2. The Centre shall use the Rules, the Policy and the Supplemental Rules in connection with any Complaint submitted to it.

Article 3. Communications between Parties and the Centre

1. Unless otherwise agreed in writing beforehand with the Centre, any submission that may or is required to be made to the Centre pursuant to the Rules, the Policy and the Supplemental Rules may be made:-

a. by telecopy or facsimile, with a confirmation of transmission; or

b. by postal or courier service, with postage pre-paid and documentary verification of service and, for the purposes of this sub-rule, -double registered post shall constitute good service; or

c. electronically via the Internet, provided that a record of its transmission is available. For any electronic communications to an office of the Centre, the following address shall be used:-

if to the Beijing Office : cietac@adndrc.org

if to the Hong Kong Office: hkiac@adndrc.org

if to the Seoul Office: idrc@adndrc.org

d. All documentation submitted in paper form to the relevant Office of the Centre by the Parties shall be submitted in four (4) sets together with the original copy marked "Original".

2. The relevant Office of the Centre shall maintain an archive of all communications received or required to be made under the Rules and the Supplemental Rules for a period of one year from the date of filing the initial Complaint from the Complainant. Subsequently, all communications and documentation received shall be destroyed.

Article 4. Communications Between Parties and the Panel

1. Where a Party intends to send any communications to the Panellist(s), it shall be addressed through the Office of the Centre which the Complaint has selected to administer the proceedings.

2. Where a Party sends any communications to the relevant Office of the Centre, it shall at the same time send a copy to the other Party with verification of service lodged with the relevant Office of the Centre.

3. The Parties may communicate with the relevant Office of the Centre by phone, fax, email, or in the ordinary course of mail. Any communication by post shall be deemed to be received in four (4) days after posting in the case of local mail or in seven (7) days in respect of overseas mail. While any instantaneous means of communications shall be deemed to be received on the same day as transmitted.

Article 5. The Complaint

1. The Complainant shall have the right to select either the Beijing Office of the Centre or the Hong Kong Office of the Centre, or the Seoul Office of the Centre to administer the domain name dispute administrative proceeding initiated by a Complaint filed by the Complainant. Such choice shall be made by the Complainant at the time the Complainant files a Complaint and such choice shall be final and binding on the Complainant and the Respondent.

2. The Complainant shall be required to send its Complaint to the Office of the Centre which the Complaint has selected to administer the proceedings, using Form C under cover of the "Complaint Transmittal Coversheet" (CTC) which are set out in Appendix 1 hereto and posted on the Web site of the relevant Office of the Centre.

3. In accordance with Paragraph 3(b)(vii) of the Rules, the Complainant shall provide a copy of the Complaint to the concerned Registrar(s) at the same time as it submits its Complaint to the relevant Office of the Centre.

4. In accordance with Paragraphs 4(a) and 19 of the Rules, the relevant Office of the Centre shall forward the Complaint to the Respondent(s) within three (3) calendar days following receipt of the initial fee from the Complainant.

5. The administrative proceedings will be deemed to have commenced on the date that the relevant Office of the Centre forwards the Complaint to the Respondent(s).

Article 6. The Response

1. Within twenty (20) days of the date of commencement of the administrative proceedings, the Respondent shall submit a Response using Form R to the relevant Office of the Centre.

2. In accordance with Paragraph 5(b)(vii) of the Rules, the Respondent shall provide a copy of the Response to the Complainant(s).

Article 7. The Centre's Compliance Review

1. The relevant Office of the Centre shall, within three (3) calendar days of acknowledging the Complaint, examine the Complaint for compliance with the Policy, the Rules and the Supplemental Rules and shall notify the Parties of any deficiencies therein.

2. The Complainant shall remedy any deficiencies identified by the relevant Office of the Centre within five (5) calendar days. Failing this, the administrative proceedings will be deemed withdrawn in accordance with Paragraph 4(b) of the Rules.

Article 8. Panellist(s) Appointment Procedures

1. The Centre shall maintain and publish a list of Panellist(s) and their qualifications. Any Party may refer to the Centre's Web site at http://www.adndrc.org for details. For administrative proceedings, the relevant Office of the Centre shall appoint suitable person(s) from the list, having regard to:

a. the nature of the dispute;

b. the availability of the Panellist(s);

c. the identity of the Parties;

d. the independence and impartiality of the Panellist(s);

e. any stipulation in the relevant Registration Agreement; and

f. any suggestion made by the Parties themselves in accordance with Paragraph 6 of the Rules and if appropriate, Paragraph 8 of the Supplemental Rules.

2. Where the Complainant has initially requested a three-member Panel and no Response was submitted by the Respondent in accordance with Paragraph 8(2) of the Supplemental Rules, the Complainant shall be given the option of converting the three-member Panel to a single Panellist, within seven (7) calendar days after being notified by the relevant Office of the Centre. Failing this, a three-member Panel shall be constituted.

3. If a single Panellist is appointed, the relevant Office of the Centre shall reimburse the Complainant the relevant amount paid by the Complainant less the relevant Office's administrative fee in accordance with Article 15 of the Supplemental Rules.

4. Where a single Panellist is elected and a Response is received, the sole Panellist will be the highest mutually ranked Panellist on the list of five (5) Panellists that will be provided to each Party within three days.

5. Where a single Panellist is elected and no Response is received, the relevant Office of the Centre shall appoint the sole Panellist without regard to the five (5) Panellists on the list.

Article 9. Impartiality and Independence

1. The Panellist(s) shall be and remain at all times wholly independent and impartial, and shall not act as advocate for any Party during the proceedings.

2. Prior to the appointment of any proposed Pa'nellist(s), and after the appointment, the Panellist(s) shall declare in writing to the Parties and the relevant Office of the Centre any circumstances which are likely to create an impression of bias or prevent a prompt resolution of the dispute between the Parties. Except by consent of the Parties, no person shall serve as a Panellist(s) in any dispute in which that person has any interest, which, if a Party knew of it, might lead him/her to think that the Panellist(s) might be biased.

3. After a Panellist(s) has been appointed but before rendering a decision, a Panellist(s) dies, is unable to act, or refuses to act, the relevant Office of the Centre will, upon request by either Party, appoint a replacement Panellist(s).

Article 10. Panel Decision

1. A Panel shall make its decision in writing and shall state the reasons upon which the decision is based. The decision shall be dated and signed by the Panellist(s) according to the requirements set forth in Paragraph 15 of the Rules.

2. The Panel shall forward its decision to the relevant Office of the Centre within fourteen (14) days of its appointment. In exceptional circumstances, the relevant Office of the Centre may extend the time as required for the Panel to forward its Decision.

3. The relevant Office of the Centre shall within three (3) calendar days of its receipt of a decision from the Panellist(s) forwards copies of the decision to the Parties and the concerned Registrar(s).

Article 11. Correction of Panel Decision

1. Within seven (7) days of receiving the decision, a Party may by written notice to the relevant Office of the Centre and the other Party requests the Panel to correct in the decision any errors in computation, any clerical or typographical errors or any errors of a similar nature. Any such corrections shall be given in writing to the Parties and shall become a part of the decision.

2. The Panel may correct any errors on its own initiative of the type referred to in Article 11(1) above within seven (7) days of the date of the decision being rendered.

Article 12. Publication of Panel Decision

The relevant Office of the Centre shall submit the decision of the Panel to the Parties, the Registrar(s) and ICANN as required by the Rules and the Policy. Unless the Panel determines otherwise, the relevant Office of the Centre shall publish the full decision on the Centre's Web site, listing: - Listing:-

1. the Domain Name that is in dispute and is the subject of a Complaint;

2. the case number;

3. the date the administrative proceedings officially began in accordance with Paragraph 4(c) of the Rules;

4. the decision rendered by the Panellist(s) in accordance with Paragraph 15(b) of the Rules.

Article 13. Limits on Description of Written Statements

1. In accordance with Paragraph 3(b)(ix) and 5(b)(i) of the Rules, the (maximum) word limit shall be 3,000 words. Parties are required to observe this as the Panel in their own discretion shall have liberty to ignore those words exceeding the maximum stated limit.

2. In accordance with Paragraph 15(e) of the Rules, there shall be no set word limit in regard to a Panel Decision.

Article 14. Appointment of Case Administrator

1. When the Complaint is sent by the relevant Office of the Centre to the Respondent, the relevant Office of the Centre shall notify the Parties of the name and contact details of the Case Administrator responsible for the administration of the proceedings commenced by the Complaint.

2. Communication between the Panellist(s) and the Parties shall be coordinated through the Case Administrator.

Article 15. Fees (US Dollars)

1. The applicable fees for documents only administrative procedure are specified as follows:-

Number of Domain Name involved in the Complaint	Fee for Panellists		ADNDRC's Administrative Fee	Total Fees	
	Single Panellist	Three Panellists		Single Panellist	Three Panellists
1 to 2 domain names	US$500	Presiding Panellist: US$1,000 Each Co-Panellist: US$500	US$500	US$1,000	US$2,500
3 to 5 domain names	US$600	Presiding Panellist: US$1,200 Each Co-Panellist: US$600	US$600	US$1,200	US$3,000
6 to 9 domain names	US$800	Presiding Panellist: US$1,400 Each Co-Panellist: US$700	US$800	US$1,600	US$3,600
10 domain names or more	US$1,500	Presiding Panellist: US$2,500 Each Co-Panellist: US$1,500	US$1,500	US$3,000	US$7,000

2. If any amendments are required due to deficiencies in the Complaint (Form C), an additional charge of US$150 shall accompany any resubmission.

3. Fees to be paid to the relevant Office of the Centre in accordance with the Supplemental Rules shall be paid by draft made payable to "China International Economic and Trade Arbitration Commission" in the event the proceedings are to be administered by the Centre's Beijing Office , or "Hong Kong International Arbitration Centre" in the event the proceedings are to be administered by the Centre's Hong Kong Office, or "Internet address Dispute Resolution Committee" in the event the proceedings are to be administered by the Centre's Hong Kong Office. All fees to be paid are in US Dollars.

4. The Complainant shall be responsible for paying the total fees provided that the Respondent has to share the fees when the Respondent chooses to have the Complaint decided by three (3) Panellists while the Complainant has chosen a single (1) Panellist.

5. The said fees do not include any payments that might have to be made to a lawyer representing a Party.

6. All bank charges, transfer fees or other amounts that may be levied in connection with a payment made to the relevant Office of the Centre shall be the responsibility of the Party making the payment.

Article 16. Exclusion of Liability

1. Without prejudice to any existing rule of law, no Panellist shall be liable to any Party, a concerned Registrar or ICANN for any act or omission in connection with

the administrative proceedings conducted under the Rules, the Policy and the Supplemental Rules, save in the case of fraud, dishonesty or deliberate wrongdoing.

2. Without prejudice to any existing rule of law, the Centre, its officers and its staff, shall not be liable to any Party, a concerned Registrar or ICANN for any act or omission in connection with any administrative proceedings conducted under the Rules,, the Policy and the Supplemental Rules, save in the case of fraud, dishonesty or deliberate wrongdoing.

Article 17. Miscellaneous

1. Words importing the singular number only shall include the plural and the converse shall also apply.

2. Words importing the masculine gender shall include the feminine gender and the converse shall also apply.

Article 18. Amendments

Subject to the Rules and the Policy, the Centre on ICANN’s consent may amend the Supplemental Rules from time to time.

Annexure-6

THE FORUM'S SUPPLEMENTAL RULES TO ICANN'S UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

(Effective July 1, 2010)[1]

1. Definitions

(a) **The Rules** means the Rules for the Uniform Domain Name Dispute Resolution Policy, approved by the Internet Corporation for Assigned Names and Numbers (ICANN), having an effective date of March 1, 2010.

(b) **The Policy** means the Uniform Domain Name Dispute Resolution Policy approved by ICANN on October 24, 1999.

(c) **The FORUM** also refers to the National Arbitration Forum.

(d) **"The Holder of a Domain Name Registration,"** as used in The Rules (Rule 1), means the single person or entity listed in the WHOIS registration information at the time of commencement.

(i) A Complainant wishing to make an argument for a single Respondent having multiple aliases must comply with Supplemental Rules 4(e) and 17(a)(i).

(e) **"The Party Initiating a Complaint Concerning a Domain Name Registration,"** as used in The Rules (Rule 1), means the single person or entity claiming to have rights in the domain name, or multiple persons or entities who have a sufficient nexus who can each claim to have rights to all domain names listed in the Complaint.

(f) **Submit.** In these Supplemental Rules or in a FORUM or Panel Order, documents are deemed Submitted when received by the FORUM's mail server;(g) **Calendar Days** means that all days, including weekends and international and national holidays, shall be counted in determining all deadlines and due dates.

Exceptions-Deadlines:

(i) In the event that a deadline falls on a United States federal holiday, as defined by 5 U.S.C. §6103, the deadline shall be extended to the following Calendar Day.

(ii) In the event that a Calendar Day deadline falls on a Saturday or Sunday, the deadline shall be extended to the following Calendar Day.

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[1]*Available at:* www.adrforum.com/UDRP

2. Scope

The FORUM will apply the Rules, the Policy and the FORUM’s Supplemental Rules in effect at the time a Complaint is Submitted. The FORUM’s Supplemental Rules may be amended by the FORUM in its sole discretion.

3. Communications

All communications must be directed to the FORUM and not to the Panel.

4. The Complaint

(a) The Complaint must include all elements listed in Paragraph 3(b) of the Rules; and may not exceed fifteen (15) pages.

(b) In accordance with Paragraph 3(b)(xii) of the Rules, the Complainant must send or transmit its Complaint to the Respondent under cover of the Complaint Transmittal Cover Sheet posted on the FORUM's web site.

(c) The Complaint must be sent to the FORUM by e-mail (domaindispute@adrforum.com) or filed online through the FORUM’s online filing platform at http://domains.adrforum.com.

(i) The Complaint (see sub-paragraph (a) above) must be a separate file (file must not include Annexes).

(ii) All documents must be in a format as specified in Annex A to these Supplemental Rules, unless approved by the FORUM in advance.

(iii) Individual files must not exceed the file size restrictions as set forth in Annex A to these Supplemental Rules unless approved by the FORUM in advance. The Annexes may be divided into multiple files as needed.

(iv) No individual email, including attachments, may exceed the email size restrictions set forth in Annex A to these Supplemental Rules unless approved by the FORUM in advance. Multiple emails may be used to transmit a single set of Complaint documents; the subject line of each email relating to a single Complaint must reference the fact that multiple emails have been send (refer to Annex A for suggested wording)

(v) The FORUM may rename electronic files compatible with internal naming conventions, for ease of internal and Panel use.

(d) Notification to Registrar and certification thereof.

(i) The Complainant must provide a copy of the Complaint to the registrar of the disputed domain name at the same time the Complaint is sent to the FORUM.

(ii) The Complainant must certify in the Complaint that Complainant has complied with Supp. Rule 4(d)(i).

(e) Any arguments alleging Respondent aliases must be included in the Complaint for Panel consideration.

(i) All Complaints alleging multiple aliases will be subject to an increased filing fee (see Supp. Rule 17 (a)(i)).

(ii) If the Panel determines that insufficient evidence is presented to link the alleged aliases, the domain names held by the unrelated registrants will not be subject to further consideration by that Panel; no portion of the filing fee will be refunded.

5. The Response

(a) The Response must include all elements listed in Paragraph 5(b) of the Rules and may not exceed fifteen (15) pages.

(b) The method used by the FORUM to communicate to the Respondent will be:

(i) the e-mail address Respondent provided in the Response;

(ii) if no Response is Submitted or if no e-mail address is provided in the Response, the e-mail address of the Respondent in the WHOIS on the date the Complaint was filed or as provided to the FORUM by the Registrar.

(c) The Response must be sent to the FORUM by e-mail (domaindispute@adrforum.com) or filed online through the FORUM's online filing platform at http://domains.adrforum.com.

(i) The Response (see sub-paragraph (a) above) must be a separate file (file must not include Annexes).

(ii) All documents must be in a format as specified in Annex A to these Supplemental Rules, unless approved by the FORUM in advance.

(iii) Individual files must not exceed the file size restrictions as set forth in Annex A to these Supplemental Rules unless approved by the FORUM in advance. The Annexes may be divided into multiple files as needed.
(iv) No individual email, including attachments, may exceed the email size restrictions set forth in Annex A to these Supplemental Rules unless approved by the FORUM in advance; multiple emails may be used to transmit a single set of Response documents.
(v) The FORUM may rename electronic files compatible with internal naming conventions, for ease of internal and Panel use.

6. Extensions and Stays
(a) Extensions for Filing a Response

(i) Paragraph 5(d) of the Rules provides that the Respondent may request additional time to Submit a Response, or may be given additional time if the parties stipulate to an extension and the FORUM approves. Any request by the Respondent for an extension or any joint request by the parties for an extension must:

(A) be Submitted after the parties have first conferred with each other to see if they could reach an agreement concerning the requested extension;

(B) be Submitted in writing to the FORUM and the parties within the time for the Response to be Submitted;

(C) state the exceptional circumstances warranting the request for an extension;

(D) state the length of the extension being requested (no more than twenty (20) additional Calendar Days); and

(E) be Submitted with an extension fee of $100.

(ii) The FORUM may exercise its discretion in determining whether exceptional circumstances exist warranting an extension and if so, the length of the extension. No request for an extension will be approved if any of the conditions set forth in Paragraph 6(a) have not been performed.

(b) Stays of the Administrative Proceeding

(i) If a Panel has not been appointed by the FORUM, parties may jointly request a stay for a one-time period of forty-five Calendar Days, provided that both parties have agreed to the stay in writing and that the parties Submit the signed agreement to the FORUM; an electronic signature (refer to Annex A) will be accepted. A Model Form is available on the FORUM's website: http://domains.adrforum.com.

(ii) Prior to expiration of the Stay, at least one party must request in writing that the case be reinstated. Absent this written request, the

FORUM will automatically dismiss the case without prejudice.

(iii) If a Panel has been appointed by the FORUM, a request that the administrative proceeding be stayed shall be granted at the discretion of the appointed Panel.

7. Submission of other Written Statements and Documents; No Amendment to the Complaint

(a) A party may Submit additional written statements and documents to the FORUM and the opposing party(s) within five (5) Calendar Days after the date the Response was received by the FORUM, or, if no Response has been filed, the last date the Response was due to be received by the FORUM.

(b) Each additional submission pursuant to Supplemental Rule 7(a) must:

(i) be timely received by the FORUM;

(ii) be accompanied by an additional submission fee of $400;

(iii) include proof of service of these submissions upon the opposing party(s); and

(iv) be Submitted electronically via email to the case coordinator and/or to domaindispute@adrforum.com.

(c) The party(s) not filing the original additional submission under 7(a) may file additional written statements and documents to the FORUM within five (5) Calendar Days after the date the original additional submission was received by the FORUM.

(d) Each additional submission pursuant to Supplemental Rule 7(c) must:

(i) be timely received by the FORUM;

(ii) include proof of service of these submissions upon the opposing party(s); and

(iii) be Submitted electronically via email to the case coordinator and/or to domaindispute@adrforum.com.

(e) Each party is limited to one additional submission under either 7(a) or 7(c), but not both.

(f) Additional submissions must not amend the Complaint or Response.

8. The Record of the Administrative Proceeding.

The Complaint, Response, and additional written statements and documents provided in Paragraph 12 of the Rules and Paragraph 7 of the Supplemental Rules constitute the complete record to be considered by the Panel.

9. Appointment of the Panel and Timing of Decision

(a) The FORUM will maintain and publish a list of Panelists and their qualifications to which any party will be directed on the FORUM's web site, http://domains.adrforum.com. The FORUM will appoint a Panelist from this list to serve as a single-member Panel.

(b) In cases involving a three-member Panel, the FORUM will select a Chair for the three-member Panel and will endeavor to select a Chair who was not from the list of Panelist candidates provided by the parties pursuant to Paragraph 6(e) of the Rules. The Chair will sign all Orders and the Decision, coordinate and preside over the proceeding, and forward to the FORUM the Panel's decision, including any concurring or dissenting opinion as required by Paragraph 15 of the Rules.

(c) In cases where the Complainant requested a three-member Panel and no Response was Submitted as required by Rule 5(a), the Complainant may be given the option of converting the three-member Panel to a single-member Panel:

(i) After the time for the Response has expired, the FORUM will notify the Complainant that no response was Submitted and that the Complainant may convert its three-member Panel request to a single-member Panel request;

(ii) Within five (5) Calendar Days of this notification, the Complainant, by e-mail to the FORUM (domaindispute@adrforum.com), may request that the three-member Panel be converted to a single-member Panel;

(iii) If a single-member Panel is requested, the FORUM will select a Panelist from its list of Panelists, not on the list of Panelists Submitted by the Complainant; and

(iv) If a single-member Panel is appointed to decide the case, the Complainant will be reimbursed $1,000 of its fee.

(d) If the Complainant fails to request that the three-member Panel be converted to a single-member Panel as provided in paragraph 9(c)(ii) above, the selection of the three-member Panel will be as follows:

(i) The Complainant must provide a list of three candidates and the FORUM will endeavor to select a Panelist from that list as provided in Rule 6(e);
(ii) The FORUM will select a Panelist from its list of Panel members; and
(ii) The FORUM will supply to the parties a list of five candidates and will select a Panelist as provided in Rule 6(e).

(e) In cases where the Respondent requested a three-member Panel and the Complaint is withdrawn prior to the appointment of a Panel, the Respondent will be reimbursed $1,000 of its fee.

10. Impartiality and Independence

(a) All FORUM Panelists will take an oath to be neutral and independent.

(b) A Panelist will be disqualified if circumstances exist that create a conflict of interest or cause the Panelist to be unfair and biased, including but not limited to the following:

(i) The Panelist has a personal bias or prejudice concerning a party or personal knowledge of disputed evidentiary facts;

(ii) The Panelist has served as an attorney to any party or the Panelist has been associated with an attorney who has represented a party during that association;

(iii) The Panelist, individually or as a fiduciary, or the Panelist's spouse or minor child residing in the Panelist's household, has a direct financial interest in a matter before the Panelist;

(iv) The Panelist or the Panelist's spouse, or a person within the third degree of relationship to either of them, or the spouse of such a person:

(1) Is a party to the proceeding, or an officer, director, or trustee of a Party; or

(2) Is acting as a lawyer or representative in the proceeding.

(c) A party may challenge the selection of a Panelist, provided that a decision has not already been published, by filing with the FORUM a written request stating the circumstances and specific reasons for the disqualification.

(d) A request to challenge must be filed in writing with the FORUM within five (5) Calendar Days of the date of receipt of the notice of the selection.

(e) Provided a decision has not already been published by the selected Panelist, the FORUM will promptly review the challenge and determine whether circumstances exist requiring Panelist disqualification in accord with this rule.

11. Communications Between Parties and the Panel

(a) No party may directly communicate with a Panelist.

(b) The parties may communicate with the Case Coordinator assigned to their proceeding by phone or e-mail.

(c) Any request by a party for any type of action by the FORUM or Panel must be communicated in writing to the FORUM and the opposing party(s).

12. Withdrawal

(a) Prior to Commencement

(i) Before the five (5) Calendar Day deficiency period described in Rule 4(b) expires, the Complainant may withdraw the Complaint without prejudice. A withdrawal request must be Submitted to the FORUM in writing and signed by the Complainant; an electronic signature complying (refer to Annex A) will be accepted. Upon the FORUM's receipt of the withdrawal request, the Complaint will be withdrawn without prejudice and the administrative proceeding will be terminated.

(ii) The Complainant may re-initiate a proceeding, which was properly withdrawn pursuant to Supplemental Rule 12(a)(i), within thirty (30) Calendar Days. A re-initiation fee of $100 must accompany the request to re-initiate the proceeding.

(iii) If the Complaint was withdrawn pursuant to Supplemental Rule 12(a)(i) and if the Complainant does not re-initiate the Complaint at the end of thirty (30) Calendar Days, a subsequent Complaint will be treated as a new Complaint and must be accompanied by payment of the appropriate fees.

(b) After Commencement and Prior to Response:

(i) After commencement, but before the FORUM has received a Response that complies with Supplemental Rule 5, the Complaint may be withdrawn by the Complainant. A withdrawal request must be Submitted to the FORUM in writing and signed by the Complainant; an electronic signature (refer to Annex A) will be accepted. A Complaint dismissed by the FORUM pursuant to Supplemental Rule 12(b)(i) will be dismissed without prejudice.

(ii) After commencement, but before the FORUM has received a Response that complies with Supplemental Rule 5, the Complaint may be withdrawn pursuant to a joint request made by both parties. A withdrawal request must be Submitted to the FORUM in writing and signed by both Parties; electronic signatures (refer to Annex A) will be accepted. A Complaint dismissed by the FORUM pursuant to Supplemental Rule 12(b)(ii) will be dismissed with prejudice.

(c) After Response is Received: After a Response that complies with Supplemental Rule 5 has been received by the FORUM, but before a Panel decision is published, the Complaint may be withdrawn if both parties agree to the withdrawal. A withdrawal request must be Submitted to the FORUM in writing and signed by both parties; electronic signatures (refer to Annex A) will be accepted. A Complaint dismissed by the FORUM pursuant to Supplemental Rule 12(c) will be dismissed with prejudice.

(d) The Complaint cannot be withdrawn after a Panel decision is published.

13. Panel Decisions

Panel decisions will meet the requirements set forth in Paragraph 15 of the Rules and will be of a length that the Panel deems appropriate.

14. Correction of Clerical Mistakes.

Clerical mistakes or clerical errors in the Panel's decision arising from oversight or omission by the Panel may be corrected by the Director of Arbitration for the FORUM.

15. Communication of Decision to Parties; Publication of Decision.

(a) The FORUM will publish the decision by submitting the Panel's decision to the parties, ICANN, and the Registrar as required by the Rules, and by publishing the full decision on a publicly accessible web site.

(b) All requests pursuant to Policy paragraph 4(j) and Rule 16(b) to have a portion of the decision redacted, must be made in the Complaint, the Response, or an Additional Submission that is Submitted before the Panel's decision is published.

16. Conclusion of the Proceedings.

Once the Panel's decision is issued, the case is closed with the FORUM. No further submissions or requests will be considered.

17. Fees (U.S. Dollars)

(a) Fees:

Number of Disputed Domain Names	**Single-Member Panel**	**Three-Member Panel**
1 – 2	$1,300	$2,600
3 – 5	$1,450	$2,900
6 – 10	$1,800	$3,600
11 – 15	$2,250	$4,500
16 or more	Please contact the FORUM for a fee quote.	Please contact the FORUM for a fee quote.

(i) If a Complainant alleges that a single Respondent is using multiple aliases and makes such arguments in the Complaint for Panel consideration per Supplemental Rule 4(e), the filing fee shall be increased proportionately to the number of aliases involved. Please contact the FORUM at domaindispute@adrforum.com with the number of domain names and the number of aliases to obtain a fee quote.

(b) Participatory hearings:

As stated in the Rules, in exceptional circumstances (for example, in the event an in-person hearing is held), the FORUM may require the Parties to pay additional fees, which will be established by agreement of the Parties and the Director of Arbitration for the FORUM prior to the appointment of the Panel.

(c) Non-refundable fees:

Fees to be paid to the FORUM as provided in these Supplemental Rules must be paid in U.S. Dollars and are non-refundable, except as provided in Supplemental Rule 9(c)(iv) and 9(e).

(d) Forms of payment

Payment shall be made in one of the following forms:

(i) Credit card;

(ii) Certified check; or

(iii) Personal/business check.

(e) If any form of payment is cancelled, stopped, returned unpaid or dishonored, without prior written authorization from the FORUM, the FORUM reserves the right to charge a service fee of $50 for each cancelled, stopped, returned or dishonored payment.

18. Effective Date

These Supplemental Rules apply to all cases filed on or after July 1, 2010.

ANNEX A TO FORUM'S SUPPLEMENTAL RULES

The purpose of this annex is to define technical requirements for electronic submissions.

1. Types of Files Supported

The FORUM will accept files having the following extensions. If you have a file in a format not specified, you must have advance permission from the FORUM or your submission may be rejected.

(a) .pdf (preferred)

(b) .doc [Microsoft Word document]

(c) .rtf

(d) .jpg

(e) .tiff

(f) .xls [Microsoft Excel spreadsheet]

(g) .htm/.html

2. File Size Restrictions

(a) No individual file may exceed 10 MB; a preferred file size limitation is 5 MB.

(b) No party may submit electronic case documents in excess of 50MB, in the aggregate, per case number, without advance approval from the FORUM (such approval will be limited to very large or complex cases).

3. Email Size Restrictions

(a) No individual email may exceed 10 MB.

(b) The documents for a single case number may be sent in multiple emails, subject to the limitations in 2(b), above.

SUGGESTIONS AND REMINDERS

Multiple Email Suggestions

(a) The FORUM suggests that each email relating to a single case be notated in the subject line with a single representative domain name by which all of the emails can be linked; if an FA number has already been assigned, the FORUM requests that the parties use that number in the subject line of all correspondence.

(b) The FORUM suggests that each email relating to a single case bear a notation in the subject line indicating the number of emails in the batch.

(c) The FORUM suggests that each email relating to a single case indicate what the party is filing.

Example : COMPLAINT regarding <domain.com> 1 of 3

Example: RESPONDENTS ADDITIONAL SUBMISSION FA####### 1 of 1

Electronic Signatures

The UDRP permits "any electronic signature." The FORUM recommends the following:

(a) A scanned signature inserted into the appropriate place in a document.

(b) The use of /s/ to indicate an electronic signature (i.e. /s/ John Doe)

The FORUM does not accept links to files located on external servers and is not responsible for gathering electronic files. All files must be sent to the FORUM following the UDRP Rules and Supplemental Rule.

Annexure 7

World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy[1]
(the WIPO "Supplemental Rules")
(In effect as of July 31, 2015)

1. Scope

(a) Relationship to Rules. These Supplemental Rules are to be read and used in connection with the Rules for Uniform Domain Name Dispute Resolution Policy, approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on September 28, 2013 (the "Rules").

(b) Version of Supplemental Rules. The version of these Supplemental Rules as in effect on the date of the submission of the complaint shall apply to the administrative proceeding commenced thereby.

2. Definitions

Any term defined in the Rules shall have the same meaning in these Supplemental Rules.

3. Communications

(a) Modalities. Subject to Paragraphs 3(b) and 5(c) of the Rules, except where otherwise agreed with the WIPO Arbitration and Mediation Center (the "Center"), any submission that may or is required to be made to the Center or to an Administrative Panel pursuant to these Rules, shall be made either:

(i) by electronic mail (email) using the address specified by the Center; or

(ii) through the Center's Internet-based case filing and administration system.

(b) Archive. The Center shall maintain an archive of all communications received or required to be made under the Rules.

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[1] www.wipo.int/amc/en/domains/rules/supplemental/

4. Submission of Complaint and Annexes

(a) Complaint Including Annexes. The complaint including any annexes shall be submitted electronically in complete form (in accordance with Paragraph 12(a) below).

(b) Complaint Transmittal Coversheet. The Complainant shall be required to send or transmit its complaint under cover of the Complaint Transmittal Coversheet set out in Annex A hereto and posted on the Center's website. Where available, the Complainant shall use the version that is in the same language(s) as the registration agreement(s) for the domain name(s) that is/are the subject of the complaint.

(c) Registrar Notification. The Complainant shall provide a copy of the complaint to the concerned Registrar(s) at the same time as it submits its complaint to the Center.

(d) Complaint Notification Instructions. In accordance with Paragraph 4(c) of the Rules, the Center shall forward the complaint electronically to the Respondent together with the instructions set out in Annex B hereto and posted on the Center's website. In accordance with Paragraph 2(a)(i) of the Rules the Center shall also forward Written Notice of the complaint to the Respondent.

5. Formalities Compliance Review

(a) Deficiency Notification. The Center shall, within five (5) calendar days of receiving the complaint, review the complaint for compliance with the formal requirements of the Policy, Rules and Supplemental Rules and notify the Complainant and Respondent of any deficiencies therein.

(b) Withdrawal. If the Complainant fails to remedy any deficiencies identified by the Center within the time period provided for in Paragraph 4(d) of the Rules (i.e., five (5) calendar days), the Center shall notify the Complainant, the Respondent and the concerned Registrar(s) of the deemed withdrawal of the complaint.

(c) Fee Refunds. Unless the Complainant confirms its intention to re-submit a complaint to the Center following a deemed withdrawal, the Center shall refund the fee paid by the Complainant pursuant to Paragraph 19 of the Rules, less a processing fee as set forth in Annex D.

6. Appointment of Case Administrator

(a) Notification. The Center shall advise the Parties of the name and contact details of a member of its staff who shall be the Case Administrator and who shall be responsible for all administrative matters relating to the dispute and communications to the Administrative Panel.

(b) Responsibilities. The Case Administrator may provide administrative assistance to the Administrative Panel or a Panelist, but shall have no authority to decide matters of a substantive nature concerning the dispute.

7. Submission of a Response

The response including any annexes shall be submitted electronically in complete form (in accordance with Paragraph 12(b) below).

8. Panelist Appointment Procedures

(a) Party Candidates. Where a Party is required to submit the names of three (3) candidates for consideration for appointment by the Center as a Panelist (i.e., in accordance with Paragraphs 3(b)(iv), 5(c)(v) and 6(d) of the Rules), that Party shall provide the names and contact details of its three candidates in the order of its preference. In appointing a Panelist, the Center shall, subject to availability, respect the order of preference indicated by a Party.

(b) Presiding Panelist

(i) The third Panelist appointed in accordance with Paragraph 6(e) of the Rules shall be the Presiding Panelist.

(ii) Where, under Paragraph 6(e) of the Rules, a Party fails to indicate its order of preference for the Presiding Panelist to the Center, the Center shall nevertheless proceed to appoint the Presiding Panelist.

(iii) Notwithstanding the procedure provided for in Paragraph 6(e) of the Rules, the Parties may jointly agree on the identity of the Presiding Panelist, in which case they shall notify the Center in writing of such agreement no later than five (5) calendar days after receiving the list of candidates provided for in Paragraph 6(e) of the Rules.

(c) Respondent Default

Where the Respondent does not submit a response or does not submit the payment provided for in Paragraph 5(d) of the Rules by the deadline specified by the Center, the Center shall proceed to appoint the Administrative Panel, as follows:

(i) If the Complainant has designated a single member Administrative Panel, the Center shall appoint the Panelist from its published list;

(ii) If the Complainant has designated a three member Administrative Panel, the Center shall, subject to availability, appoint one Panelist from the names submitted by the Complainant and shall appoint the second Panelist and the Presiding Panelist from its published list.

9. Declaration

In accordance with Paragraph 7 of the Rules, prior to appointment as a Panelist, a candidate shall be required to submit to the Center a Declaration of Independence and Impartiality using the form set out in Annex C hereto and posted on the Center's web site.

10. Fees

The applicable fees for the administrative procedure are specified in Annex D hereto and posted on the Center's web site.

11. Word Limits

(a) The word limit under Paragraph 3(b)(ix) of the Rules shall be 5,000 words.

(b) The word limit under Paragraph 5(c)(i) of the Rules shall be 5,000 words.

(c) For the purposes of Paragraph 15(e) of the Rules, there shall be no word limits.

12. File Size and Format Modalities

(a) The file size and format modalities under Paragraph 3(b) of the Rules shall be as set forth in Annex E hereto and posted on the Center’s website.

(b) The file size and format modalities under Paragraph 5(c) of the Rules shall be set forth in Annex E hereto and posted on the Center’s website.

13. Settlement

In accordance with Paragraph 17 of the Rules, if before Panel appointment the Parties agree on a settlement, the Parties shall notify the Center, for example by submitting the Standard Settlement Form as set forth in Annex F hereto and posted on the Center's website. An email version of the Center's Standard Settlement Form is also available upon request by the Parties.

14. Amendments

Subject to the Policy and Rules, the Center may amend these Supplemental Rules in its sole discretion.

15. Exclusion of Liability

Except in respect of deliberate wrongdoing, an Administrative Panel, the World Intellectual Property Organization and the Center shall not be liable to a party, a concerned registrar or ICANN for any act or omission in connection with the administrative proceeding.

Annexure-8
CAC‘s UDRP Supplemental Rules of the Czech Arbitration Court[1]

1. Scope

a. Relationship to Rules. These Supplemental Rules are to be read and used in connection with the Rules for Uniform Domain Name Dispute Resolution Policy, approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on September 28, 2013 (the "Rules").

b. Version of Supplemental Rules. The version of these Supplemental Rules in effect on the date of the submission of the Complaint shall apply to the administrative proceeding commenced thereby.

2. Definitions

Class Complaint means a single Complaint filed against a single domain name holder in regard to multiple disputed domain names with the same language of UDRP proceeding filed by a single person acting on behalf of two or more Complainants and requesting separate relief for each Complainant for different disputed domain names than for the other Complainants joined in the Class Complaint.

Provider means the Arbitration Court attached to the Economic Chamber of the Czech Republic and Agricultural Chamber of the Czech Republic.

Time of Filing means a point in time when the following conditions are fulfilled:

a. a Complaint has been properly filed with the Provider; and

b. the appropriate fee for the proceeding is received by the Provider.

Business Days mean all days falling between Monday and Friday other than those which are public holidays in the country or the state where the Provider or either of the Parties, as the case may be, is subject to an obligation to adhere to a period of time as specified under these Supplemental Rules.

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[1] https://udrp.adr.eu/arbitration_platform/udrp_supplemental_rules.php

Any other term defined in the Rules shall have the same meaning when used in these Supplemental Rules.

3. Art. 2 of the Rules: Communications

a. The Parties shall be required to adhere to communication instructions contained in Annex C hereto.

b. The Parties shall be required to use for their other communication during the proceeding form documents set out in Annex B hereto and posted on the Provider's web site.

c. A system log of data messages of the Provider shall be considered as valid records in the absence of any evidence of malfunction of the Provider's system.

d. At the request of a Party filed before the expiration of the relevant period(s) of time, the Provider and, after its appointment, the Panel, may – in its sole discretion extend the periods of time laid down in these Rules which are applicable to the Parties in exceptional circumstances or upon agreement by both Parties. The Provider and, after its appointment, the Panel, shall decide on any such limited period of extension.

e. The expiration of any given time period occurs at midnight (24.00) of the final day of that respective time period, based on the time observed in the location of the Provider or either of the Parties, as the case may be, which are subject to an obligation to adhere to a period of time as specified under these Supplemental Rules. When the last day of a deadline prescribed by the Rules and/or ADR Supplemental Rules is not a Business Day, the time period shall be extended automatically to include the next Business Day following the last day of the deadline.

f. When a hardcopy submission is to be made to the Provider by a Party, it shall be submitted in three (3) copies together with one (1) original of such submission.

4. Art. 3 of the Rules: The Complaint

a. It is possible to file a Class Complaint provided the following conditions are met: The Class Complaint is based on legal arguments applicable equally, or substantially in the same manner, to all the disputed domain names; the person representing several different Complainants joined in the Class Complaint must provide evidence that it is authorized to act on behalf of each of the Complainants; and for the avoidance of doubt, the Panel can order transfer of any of the disputed domain name(s) only to the individual Complainant on which behalf such transfer was requested in the Class Complaint, in accordance with the Policy.

b. The Provider shall advise the Parties of the name and contact details of a member of its staff who shall be the Case Administrator and who shall be responsible for all administrative matters relating to the dispute and communications to the ADR Panel. The Case Administrator may provide administrative assistance to the Panel or Panellist(s), but shall have no authority to decide matters of a substantive nature concerning the dispute.

c. Any proceeding(s) against a domain name holder with a later Time of Filing with respect to the same domain name(s) shall be suspended pending the outcome of the proceeding initiated by the Complaint with the earliest Time of Filing. If in such proceeding the Panel decides to grant the Complainant the remedies requested, all suspended proceedings will be terminated and any fees paid shall be reimbursed. If in the proceeding the Panel rejects the Complaint, the Provider shall activate the Complaint next in time to the Time of Filing. The Providershall notify the respective Complainant(s) of the termination, activation, or continued suspension of their Complaint(s) in writing within five (5) days from the date the Panel decision related to the prior Complaint is issued.

5. Art. 4 of the Rules: Notification of Complaint

a. Complainant has the option to request that the Provider review its decision to withdraw the Complainant’s Complaint due to administrative deficiency pursuant to Art. 4(b) of the Rules. The procedure related to such a request shall be as follows:

1. The request shall be submitted to the Provider within 5 days from receiving the information about the withdrawal and shall:

i. specify the information under Art. 3 (b) (ii), (iii) and (vi) of the Rules; and

ii. specify the Complainant’s arguments why the Provider’s decision to withdraw the Complaint is deemed incorrect.

2. The Provider will acknowledge receiving the request from the Complainant, subject to the receipt of the fees due and will appoint a single expert from its list of Panellists to provide the requested review of its decision.

3. The appointed expert shall finalize the review within twelve (12) days from the date of its appointment. The results of the review shall be communicated to the Complainant and Respondent without delay.

4. In the event, the expert review finds in favor of the Complainant’s arguments, the sole right of the Complainant is that the Provider will return the UDRP fees for filing the Complaint and will return the fee applicable for filing the request to review the Provider’s decision to withdraw the Complaint due to its administrative deficiencies.

6. Art. 6 of the Rules:

Appointment of the Panel and Timing of Decision The Panellist appointed in accordance with Art. 6 (e) of the Rules from the Provider’s list of Panellists shall be the Presiding Panellist, coordinating the Panel.

7. Art. 7 of the Rules: Impartiality and Independence

Prior to appointment as a Panellist, a candidate shall be required to submit to the Provider a Declaration of Independence and Impartiality using the form included in the list of Forms contained in Annex B hereto and posted on the Provider’s web site.

8. Art. 11 of the Rules: Language of Proceedings

All documents including communications made as part of the proceeding shall be made in the language of the proceeding. The Panel may disregard documents submitted in other languages than the language of the proceeding without requesting their translation. Any communication by the Provider which, from its content, cannot be regarded as amounting to procedural documents (such as cover letters with which the Provider sends procedural documents or automatic system notifications generated by the Provider's application) shall be made in the language of the proceeding or in English.

9. Art. 15 of the Rules: Panel Decision

a. The Panel decisions will meet the requirements set forth in Art. 15 of the Rules and will comply with all formal requirements contained in these Supplemental Rules. Each Panel decision shall contain a brief summary in English.

b. Within seven (7) days of receiving the decision, a Party may, by written notice to the Panel and the other Party, request the Panel to correct in the decision any errors in computation, any clerical or typographical errors, or any errors of a similar nature. Any such corrections shall be given in writing to the Parties and shall become a part of the decision. The Panel may correct any errors on its own initiative of the type referred to in the preceding Art.

within seven (7) days of the date of the decision being rendered.

10. Art. 16 of the Rules: Communication of Decisions to Parties

The Provider shall inform the Parties and the concerned Registrar(s) of the Panel's decision. ICANN shall be informed of the Panel's decision through its publication. The Provider shall publish the full decision on his website, listing at least the following:

a. The domain name which is in dispute and is the subject of a Complaint;

b. The case number;

c. The Complainant and the Respondent.

The decision shall be published in the language of the proceeding. With respect to proceedings which are not conducted in English, the Provider shall also publish accompanying unofficial English translations of selected decisions.

11. Art. 17 of the Rules: Settlement or Other Grounds for Termination

a. If the Parties negotiate a settlement, each of them may submit a written notice to the Provider to request a suspension of the proceeding for a limited period of time that is no longer than 14 days. The suspension commences only after the other Party confirms it within 3 business days. The suspension period may be extended upon the request of any of the Parties up to 14 days. An extension of the suspension shall be requested no later than the last day of the suspension period. Suspension and extension of suspension can be requested no more than three times during a single proceeding. Any such suspension shall be without prejudice to the obligation of the Panel to forward its decision on the Complaint to the Provider within the time period specified by the Provider. Resumption of the proceeding shall take place automatically upon receipt of a request thereto from either the Respondent or the Complainant or upon the expiration of such limited and specified time period.

b. The Parties can reach a settlement that results into a revocation, or a transfer of the disputed domain name(s), or a termination of the proceeding without a revocation or a transfer of the disputed domain name(s). Any of the Parties can announce the Provider the achieved settlement via the Standard settlement form. The announcement comes into effect when the other Party confirms it within 3 business days.

c. The Complainant shall confirm to the Provider the implementation of the settlement within 2 weeks beginning with confirmed announcement of the settlement. The Provider dismisses the proceeding after receiving the confirmation of the implementation from the Complainant or after a lapse of this time period.

d. The Panel shall terminate the proceeding if it becomes aware that the dispute that is the subject of the Complaint has been finally decided by a court of competent jurisdiction or an alternative dispute resolution body.

12. Art. 19 of the Rules: Fees

The fees applicable for administrative procedures and obligatory payment instructions are specified in Annex A hereto and posted on the Provider's website. The Provider may grant discounts on the applicable fees in justified cases. The conditions for obtaining discounts shall be published on the Provider's website.

13. Word Limits

The following limitations shall apply as to length of the Complaints and Responses:

a. The word limit under Art. 3 (b) of the Rules shall be 5,000 words.

b. The word limit under Art. 5 (b) of the Rules shall be 5,000 words.

14. Amendments

Subject to the Rules, the Provider may amend these Supplemental Rules in its sole discretion.

15. Effective date

These Supplemental Rules apply to all cases filed on or after 31 July 2015.

16. List of Annexes

Annex A: Fee Schedule;

Annex B: List of Forms;

Annex C: Communication Instructions

Annex A: Fee Schedule

Fees of the Czech Arbitration Court (CAC)

Annexure 9

Network Solutions, Inc. ("NSI") is responsible for assigning domain names on the Internet. This Policy Statement ("Policy Statement") will clarify NSI's policies regarding the use and registration of domain names ("Domain Name(s)").

1. NSI is responsible for the registration of domain names on the Internet. NSI registers these Domain Names on a "first come, first served" basis. NSI has neither the resources nor the legal obligation to screen requested Domain Names to determine if the use of a Domain Name by an Applicant may infringe upon the right(s) of a third party. Consequently, as an express condition and material inducement of the grant of an applicant's ("Applicant") request to register a Domain Name, Applicant represents and warrants as follows:

(a) Applicant's statements in the application are true and Applicant has the right to use the Domain Name as requested in the Application;

(b) Applicant has a bona fide intention to use the Domain Name on a regular basis on the Internet;

(c) The use or registration of the Domain Name by Applicant does not interfere with or infringe the right of any third party in any jurisdiction with respect to trademark, service mark, tradename, company name or any other intellectual property right;

(d) Applicant is not seeking to use the Domain Name for any unlawful purpose, including, without limitation, tortious interference with contract or prospective business advantage, unfair competition, injuring the reputation of another, or for the purpose of confusing or misleading a person, whether natural or incorporated.

2. Applicant acknowledges and agrees that this Policy Statement on the registration and use of Domain Names may change from time to time and that, upon thirty (30) days posting on the Internet at ftp://rs.internic.net/policy/internic.domain.policy, NSI may modify or amend the terms of this Policy Statement.

3. At the time of the initial submission of the Domain Name request, the Applicant is required to have operational name service from at least two operational Internet servers for that domain name. Each server must be fully connected to the Internet and capable of receiving queries under that Domain Name and responding thereto. In the event that Applicant does not make regular use of its assigned Domain Name for any a period of 90 days or more, Applicant agrees that he or she shall, upon request of NSI, relinquish that Domain Name to NSI, making that Domain Name available for registration and use by another party.

4. Applicant is responsible for its selection of the Domain Name. Consequently, Applicant shall defend, indemnify and hold harmless (i) NSI, its officers, directors, employees and agents, (ii) National Science Foundation ("NSF"), its officers, directors, employees and agents, (iii) the Internet Assigned Numbers Authority ("IANA"), its officers, directors, employees and agents, and (iv) the officers, directors, employees and agents of NSI's parents and subsidiaries (collectively, the "Indemnified Parties") for any loss, damage, expense or liability resulting from any claim, action or demand arising out of or related to the use or registration of the Domain Name, including reasonable attorneys fees. Such claims shall include, without limitation, those based upon trademark or service mark infringement, tradename infringement, dilution, tortious interference with contract or prospective business advantage, unfair competition, defamation or injury to business reputation. The Indemnified Parties agree to give Applicant written notice of any such claim, action or demand within a reasonable time. Applicant agrees that the Indemnified Parties shall be defended by attorneys of their choice at Applicant's expense, and that Applicant shall advance the costs of such litigation, in a reasonable fashion, from time to time. The failure to abide by this provision shall be considered a material breach of this Agreement and permit NSI to immediately withdraw the use and registration of Domain Name from Applicant.

5. Applicant agrees that NSI shall have the right to withdraw a Domain Name from use and registration on the Internet upon thirty (30) days prior written notice (or earlier if ordered by the court) should NSI receive an order by a United States court or arbitration panel of the American Arbitration Association (hereinafter "AAA") that the Domain Name in dispute rightfully belongs to a third party.

6.(a) In the event that the Applicant breaches any of its obligations under this Policy Statement, NSI may request that Applicant relinquish the Domain Name in a written notice describing the alleged breach. If Applicant fails to provide evidence that it has not breached its obligations which is reasonably satisfactory to NSI within thirty (30) days of the date of receipt of such notice, then NSI may terminate Applicant's use and registration of the Domain Name.

(b) Applicant acknowledges and agrees that NSI cannot act as an arbiter of disputes arising out of the registration and use of Domain Names. At the same time, Applicant acknowledges that NSI may be presented with evidence that a Domain Name registered by Applicant violates the rights of a third party. Such evidence includes, but is not limited to, evidence that the Domain Name is identical to a valid and subsisting registration of a trademark or service mark that is in full force and effect and owned by another person or entity. In those instances where the basis of the claim is other than a registered trademark or service mark, Applicant shall be allowed to continue using the contested Domain Name, unless and until a court order or arbitrator's judgment to the contrary is received by NSI as provided in Paragraph 5.

(c) In those instances when the claim is based upon a trademark or service mark:

(1) Without prejudice to the ultimate determination and with recognition that trademark or service mark ownership does not automatically extend ownership to a Domain Name, NSI shall request from the Applicant a certified copy of a trademark or service mark registration (copies certified in accordance with 37 CFR 2.33(a)(1)(vii) or its successor will meet this standard for registrations in jurisdictions other than the United States) owned by the Applicant that is in full force and effect and that is the same as the Domain Name registered to Applicant.

(2) In the event that Applicant provides evidence of ownership of a trademark or service mark as provided in Paragraph 6(b), Applicant shall be allowed, subject to Paragraph 6(c)(4), to continue using the contested Domain Name, unless and until a court order or arbitrator's judgment to the contrary is received by NSI as provided in Paragraph 6(c)(5). In the event the Applicant fails to provide evidence of a trademark or service mark registration to NSI within fourteen (14) days of NSI's request, NSI will assist Applicant with assignment of a new Domain Name, and will allow Applicant to maintain both names simultaneously for up to ninety (90) days to allow

an orderly transition to the new Domain Name. At the end of the transition period, NSI will place the disputed Domain Name on "Hold" status, pending resolution of the dispute. As long as a Domain Name is on "Hold" status, that Domain Name registered to Applicant shall not be available for use by any party.

(3) If Applicant fails to provide evidence of a trademark or service mark registration to NSI within fourteen (14) days and will neither accept the assignment of a new Domain Name nor relinquish its use of the Domain Name, NSI will place the disputed Domain Name on "Hold" status, pending resolution of the dispute. As long as a Domain Name is on "Hold" status, that Domain Name registered to Applicant shall not be available for use by any party.

(4) If Applicant provides the evidence described in Paragraph 6(b), and wishes to continue use of the contested Domain Name registered by Applicant, Applicant agrees to indemnify NSI on the terms stated in Paragraph 4 from any liability relating to the registration or use of the Domain Name registered by Applicant and post a bond in an amount sufficient to meet the damages sought, or if no specific amount of damages is sought, in an amount deemed reasonable in NSI's sole discretion within fourteen (14) days of NSI's request. Without such agreement and the posting of the bond, NSI may, notwithstanding any trademark or service mark registration presented to it, place the use of the Domain Name in "Hold" status pending resolution of the dispute.

(5) NSI will reinstate the use and registration of a Domain Name placed in "Hold" status when and if it receives an order by a United States court or arbitration panel of the American Arbitration Association stating which party to the dispute is entitled to use and register the Domain Name or if NSI receives satisfactory evidence of the resolution of the dispute.

7. NSI will not be liable for any loss of use, interruption of business, or any indirect, special, incidental, or consequential damages of any kind (including lost profits). Regardless of the form of action, whether in contract, tort (including negligence), or otherwise, even if NSI has been advised of the possibility of such damages. In no event shall NSI’s maximum liability under the policy exceed five hundred ($500.00) dollars.

8. Any dispute arising out of this Agreement or, at the request of NSI and upon the agreement of the challenging party, a dispute regarding the right to register or use Domain Name shall be resolved by binding arbitration by the AAA under its commercial rules then in effect in San Diego, California. A single arbitrator shall be selected according to AAA rules within thirty (30) days of submission of the dispute to AAA. The arbitrator shall conduct the arbitration in accordance with the California Evidence Code and shall apply the substantive laws of the State of California, without regard for California's choice of law rules. Except as expressly provided in the Agreement, no discovery of any kind shall be taken by either party without the written consent of the other party, provided, however, that either party may seek the arbitrator's permission to take any deposition which is necessary to preserve the testimony of a witness who either is, or may become, outside the subpoena power of the arbitrator or otherwise unavailable to testify at the arbitration. The arbitrator shall have the power to enter any award that could be entered by a Judge of the Superior Court of the State of California sitting without a jury, and only such power, except that the arbitrator shall not have the power to award punitive damages, treble damages, or any other damages which are not compensatory against NSI, NSF or IANA, even if permitted under the laws of the State of California or any other applicable law. Within twenty (20) days of the close of arbitration hearings, the arbitrator shall submit a written arbitration award to the parties, stating the basis for each decision made by the arbitrator and the amount of each arbitration award. The arbitrator shall award the prevailing party its costs and its reasonable attorneys' fees, and the losing party shall bear the entire cost of the arbitration, including the arbitrator's fee. The arbitration award may be enforced in any court having jurisdiction over the parties and the subject matter of the arbitration. Notwithstanding the forgoing, the parties irrevocably submit to the non-exclusive jurisdiction of the Superior Court of the State of California, San Diego County, and the United States District Court for the Southern District of California, in any action to enforce an arbitration award.

9. All notices or reports permitted or required under this Agreement shall be in writing and shall be delivered by personal delivery, facsimile transmission or by certified or registered mail, return receipt requested, and shall be deemed given upon personal delivery, seven (7) days after deposit in the mail, or upon acknowledgment

of receipt of electronic transmission. Notices shall be sent to the Domain Administrative Contact listed in the InterNIC Registration Services database or such other address as either party may specify in writing. This Policy Statement can only be amended by NSI as provided in Paragraph 2. Nothing contained in this Policy Statement shall be construed as creating any agency, partnership, or other form of joint enterprise between the parties. The failure of either party to require performance by the other party of any provision hereof shall not affect the full right to require such performance at any time thereafter; nor shall the waiver by either party of a breach of any provision hereof be taken or held to be a waiver of the provision itself. In the event that any provision of this Agreement shall be unenforceable or invalid under any applicable law or be so held by applicable court decision, such unenforceability or invalidity shall not render this Agreement unenforceable or invalid as a whole. The parties agree to amend or replace such provision with one that is valid and enforceable and which achieves, to the extent possible, the original economic objectives and contractual intent of NSI as reflected in the original provision. This Policy Statement, as amended, and the Registration Agreement together constitute the complete and exclusive agreement of the parties regarding Domain Names. It supersedes and its terms govern all prior proposals, agreements or other communications between the parties.