

PROPERTISATION OF DOMAIN NAMES, CYBERSQUATTING: A COMPARATIVE STUDY ON THE UDRP AND INDRP

*Komal Kapoor**

*Radhika Dev Varma Arora***

ABSTRACT

Growth of e-commerce has resulted in many complex intellectual property issues like cyber-squatting, domain name disputes, passing-off and dilution of trademarks in cyberspace. Cybersquatters exploit the first-come-first-served registration process to gain unfairly. In India, statutory protection is not granted against Cybersquatting. The Trade Marks Act, 1999, not being extra territorial, does not adequately protect the domain names. Brainchild of ICANN, UDRP provides a mechanism for resolving disputes between domain name owners, trademark holders and the domain name registrants. Prior to UDRP, the domain name disputes were resolved by settlements or litigations. To provide a dispute settlement mechanism for the .in ccTld, the NIXI formulated the INDRP policy on the lines of UDRP. However, both the policies showcase certain differences which have been highlighted by the judiciary. This paper aims, inter-alia, to settle the conundrum between the two policies with the help of mixed research methodology.

Keywords : Intellectual Property Rights, Cybersquatting, Domain Name, Trademark, Settlement Policy

I. Introduction

II. Justification of Protection of Trademark in Cyberspace

III. Domain Names & Their Significance

IV. Cybersquatting

V. Uniform Domain Name Dispute Resolution Policy

VI. .IN Domain Name Dispute Resolution Policy

VII. Differences Between UDRP and INDRP

VIII. Conclusion

* Ph.D Scholar, Rayat Bahra University, Mohali.

** Head of the Department, B.Com. LL.B (H) and Associate Professor, Chandigarh University (UILS), Mohali.

I. Introduction

THE INTERNET has a unique ability to facilitate cross-border commercial transactions using computer networks. Trading through the internet has now become a reality.¹ Initially the internet was used as a tool for communication but over time, people realized the remarkable capacity of the internet to interact and create unlimited opportunities. It is estimated that in 2020 around \$3.914 trillion worth of goods and services have been bought by the consumers in B2C (business to customer) e-commerce sales across the globe.² However, it would not be out of place to mention that the internet also had its share of disputes and legal issues which includes issues relating to the cyber world, domain names etc. It is evidently visible that in a brief period, cases which highlight the conflict between the trademark and domain name have crept up. It won't be hyperbolic to say that such registration of such disputes are going to increase manifold in coming years.

Since time immemorial, people in the society have been using different marks, like name tags, brands etc., in order to indicate their ownership and distinguish their stocks from others.³ In other words, a trademark indicates the source or the trade origin. The importance of protecting trademarks is self-evident due to the fact that in the prevalent competitive environment, trademarks provide exclusivity, indicate the source and quality of goods and services, and serve as a medium to advertise the goods and services of the merchants.

In today's internet age, every commercial entity, in order to survive the cutthroat competition, must have internet presence. The existence over the internet is possible by making a website which requires an address known as a domain name.⁴ Website is hosted over a unique Internet Protocol Address which is made up of complex numbers like 66.220.144.0 which is difficult to memorize.⁵ To solve this problem, the internet Domain Name System (DNS) systematically converts complex



¹ V.K. Unni, *Trademarks and Emerging Concepts of Cyber Property Rightse*, 2 (Eastern Law House, Calcutta, 2002).

² Ethan Cramer – Flood, Global E-Commerce 2020 Report dated 22nd Jun 2020, Ecommerce Decelerates amid Global Retail Contraction but remains a bright spot, *available at*: Global Ecommerce 2020 - Insider Intelligence Trends, Forecasts & Statistics (emarketer.com) (last visited on January 17, 2021).

³ Lionel Bentley and Brad Sherman, *Intellectual Property Law*, 712 (Oxford University Press, 3rd edn., 2008)

⁴ David Kitchin, David Llewelyn, *et.al.*, *Kerly's Law of Trademarks and Trade Names*, 8 (Sweet and Maxwell, UK, 14th edn. 2005).

⁵ William Larsen, "A Stern Look at the Property status of Top Level Domains" 82, No. 3, *UCLR* 1459 (2015).

numbers into plain text web addresses.⁶ In other words, domain names are user-friendly addresses of computers that allow users to connect to the internet.⁷ It could be said that Domain Names are linguistic counterparts of IP Addresses. Originally, the function of domain names was to facilitate connection between a computer and the internet. However, presently, domain names function as a business identifier. In the virtual world, domain names perform similar functions as those performed by trademark in the physical world, as one can promote and advertise one's products and services on the internet. For example, the trademark of International Business Machines Corporation is  accordingly, the corporation got the domain name "ibm.com." registered. It is to be noted that an average consumer, may for one time fail to remember and associate Computer goods and accessories with the name of the Company viz International Business Machines Corporation, however, the first thing that comes to mind with just a slight glance of the logo  or domain name ibm.com, is definitely computer related products and accessories. This showcases the remarkable characteristic of a trademark and the domain name which enables association of goods / services and also serves as a business identifier and a medium to advertise the products and services.

There exists an uncertainty regarding the nature of the domain names i.e. whether the domain names are intellectual property like a trademark or they are mere addresses on the internet.⁸ It is evident that domain names overlap certain conceptual borders related with the trademark, particularly, the proprietary issues.⁹ Hence, the disputes relating to passing off, dilution and infringement of trademark in cyberspace, and cyber-squatting arise with respect to domain name and trademark.

II. Justification of Protection of Trademark in Cyber-Space

Trademark as a form of intellectual property holds vital importance in today's world, both to consumers as well as to business entities. The goodwill and reputation of the business entities are

⁶ Sunando Mukherjee, "Passing off in Internet Domain Names – A Legal Analysis", 9 *JIPR* 137 (2004).

⁷ *Supra* note 1 at 23.

⁸ Blazer Charles, "The Five Indicia of Virtual Property", 5 *PLR* 139 (2006).

⁹ *Supra* note 5 at 1474.

attached with the trademark and it also offers a guarantee to the consumer that the quality of the product will be equivalent with which they are habitual.¹⁰ Representation of a 'trademark' can be in the form of an invented word, signature, brand, device, a label (or any combination thereof) or colour combination.¹¹ These marks must be capable of graphical representation and hold distinctive characteristics or should be capable of distinguishing goods and services of one manufacturer from that of another.¹² Trademark indicates the source of the goods and services in respect of which it is used.¹³ Hence, the misuse of trademark / trade names may lead to developing a bad opinion in the minds of the consumers with respect to the origin of the product.¹⁴

During the industrial revolution many merchants continued with the practice of applying marks on their produce and as the advertisement industry evolved, entities began promoting their products with such symbols. These marks were important for the manufacturers as they are the mode of communication between the manufacturer and the final consumer; thereby they started to influence their purchasing decisions. Role of marks hereby transformed from source of liability to indicator of quality.¹⁵

The twentieth Century witnessed another change in the role of these marks, wherein they were considered to be valuable assets for any entity rather than a mere indicator of source of origin.¹⁶ Forming an important linkage of trust and quality assurance amongst seller and buyer these marks emerged as utmost important assets in free market economy for its owners as a sign of goodwill and reputation in the market.¹⁷

Marks turned out to be a tool for promotion and marketing as it helps in distinguishing the products associated with the mark and other products available in the market.¹⁸ Courts even started to recognize the economic and moral value of these marks held and the necessity to protect the holder

¹⁰ Alexandra Yelnik, *From the point of view of commercial value of trademarks, do current laws sufficiently protect brands from infringement?* MARQUES ANNUAL CONFERENCE, 2-3 (2009).

¹¹ Poonam Dass, "Conflict between Trademarks and Domain Names", XXIV DLR, 150(2002).

¹² The Trademarks Act, 1999 (Act 47 of 1999) s. 2(1)(zb)

¹³ *Supra* Note 4 at 9.

¹⁴ V. A. Mohta, *Trademarks, Passing off and Franchising* 46 (All India Reported Pvt. Ltd., Nagpur, 2004)

¹⁵ *Supra* note 3 at 716.

¹⁶ Thomas D. Drescher, *The Transformation and Evolution of Trademarks—From Signals to Symbols to Myth*, 82 *Trademark Rep.* 301 (1992)

¹⁷ *Brands Reputation and Image in Global Market Place*, WIPO Economic and Statistics Series 3 (2013) available at: http://www.wipo.int/edocs/pubdocs/en/intproperty/944/wipo_pub_944_2013.pdf (last visited on July 19, 2021)

¹⁸ C D G Pickering, *Trademarks in Theory & Practice* 186 (Oxford: Hart Publishing, 1998).

and creator whose ‘goodwill’ and market reputation was thus, the courts started to recognize the value these symbols held and the need to safeguard the originator whose ‘goodwill’ and market standing was associated with these mark.¹⁹

The functions performed by trademark include:²⁰

- a) Indicator of source of origin
- b) Quality function
- c) Advertising function

Apart from the aforesaid functions, trademarks also perform other significant functions like imposing confidence in public, increasing sales and market standing, owners can fetch rent by licensing or franchising, curbing unfair competition etc.²¹ Trademarks further assist the consumers by indicating the source as well as the quality of the products. This enables the consumers to anticipate in advance, the quality as well as to get substantially the same product again and again over the period of time. Trademarks also ensures prevention of wrongful appropriation / adoption of the mark and resultantly protects the goodwill / reputation of the original proprietor.²²

However, there are certain issues concerning trademark law that do not go well with the cyberspace. The first and foremost is the issue of territoriality. The trademark laws primarily follow the principle of territoriality, whereas cyberspace having no limitations as to boundaries makes the trademarks vulnerable and the probability of two traders dealing in similar goods and services under a similar trademark/trade name enhances, which may further lead to confusion as well as deception to the consumers. Whereas , in the offline world, where traders are separated by physical boundaries, the chances of deception and confusion become minimal as the consumers are entirely different for both the traders.

With the advent of the internet and the cut-throat competition in today’s globalized world, digital presence of the trader is completely unavoidable in order to ensure survival in this competitive environment. For making such a digital presence, the traders prefer to adopt their trademarks/trade

¹⁹ Arul George Scaria, *Ambush Marketing Game Within A Game* 9 (Oxford University Press, 2008).

²⁰ *Supra* note 4 at 9.

²¹ Ashwani Kumar Bansal, *Law of Trademarks In India*, 79 (3rd ed. Thomson Reuter 2014).

²² Daniel Gervais (ed.), *Intellectual Property, Trade and Development Strategies to Optimize Economic Development in a TRIPS-PLUS Era* 34-35 (Oxford University Press, 2007).

names only by getting them registered as a domain name. Further, the traders in return of the investments while taking their businesses online, expect some priority in getting the domain names identical to that of their trademarks and further seek protection from wrongful registration by unscrupulous people to make wrongful gains for themselves and cause wrongful losses to the original trademark proprietors.

III. Domain Names and Their Significance

The internet is a high speed electronic postal system, which is a large network of linked computers.²³ Every computer connected to the internet has a unique numerical address for example, 1.256.123.123 which is also known as an Internet protocol (IP) address. The purpose of this address is to make it easy to locate the recipient of the electronic information so that the information gets delivered at the right place. These IP addresses are difficult to memorize hence, with a view to make these identification numbers more user friendly, they are converted by the Domain Name System into alphanumeric characters. These identifiers are Domain names. Domain names must be distinct and the same name cannot be allotted to two different registrants as it would lead to confusion.²⁴

Is Domain Name a Trademark?

There exists an uncertainty regarding the nature of the domain names *i.e.*, whether the domain names are intellectual property like a trademark or they are mere addresses on the internet.²⁵ It is evident that domain names overlap certain conceptual borders related with the trademark, particularly, the proprietary issues.²⁶ There have been two distinct nuances on the correlation amongst trademarks and domain names. One view is that the protection that is granted to trademarks under the trademark laws cannot be extended to domain names as the domain names are not an intellectual property like the trademarks and the domain name holders cannot said to have any rights provided under the trademark laws, primarily because the domain names does not pass the rigors of the registration process as provided under the Trademarks Act.²⁷ A contrary

²³ *Supra* note 4 at 720.

²⁴ *Supra* note 6 at 137.

²⁵ *Supra* note 8 at 137.

²⁶ *Supra* note 5 at 1474.

²⁷ Shuli L Green, "Launching Trademark Law Into Cyberspace: Should The Domain Name System be Federalized", 49 *ALR* 1031-1050 (1997)

view is that it treats trademarks and domain names equally and advocates for extending the protections of trademarks upon domain names as well.²⁸ Hence, disputes arise concerning passing off, infringement and dilution of trademarks in cyberspace and offence of cybersquatting relating to trademark and domain names. The answers to these issues and questions would enable one to understand the true nature and features of domain names.²⁹

The Courts in India have, time and again, protected domain names under the common law remedy of passing off and have recognized domain names not merely as IP addresses. *Yahoo Inc v. Akash Arora*,³⁰ can be regarded as the earliest case relating to domain name in the country, where the Delhi High Court granted protection to the domain name under the common law doctrine of passing off. Other leading cases where the Court was inclined to grant protection to the trademark holders against unjust registration of domain names by registrants were *Rediff Communication v. Cyberbooth*³¹ and *Aqual Minerals Ltd v. Pramod Borse*.³² The Supreme Court, for the first time, dealt with the issue in the year 2004 where the position relating to the treatment of domain names got settled. In *Satyam Infoway Ltd v. Sifynet Solutions Pvt Ltd.*,³³ settling the law, the Supreme Court observed that though the primary function of the domain name was to serve as an web address, which can simplify and help in locating a web page however, with the advancement of e-commerce, the role of domain name have had a dramatic shift from that being merely an IP Address to becoming a business identifier.

IV. Cybersquatting

In present times, domain names have become an intrinsic part of the reputation of an enterprise and are noticeable in various media like posters, magazines and television commercials.³⁴ Thus, like trademarks, domain names also serve as source identifier or quality assurer for an enterprise.³⁵ Despite the above discussed similarities, the process of registration of domain name is completely

²⁸ *Ibid.*

²⁹ Eddie Hurte, "The international domain name classification debate: are domain names 'virtual property', intellectual property, property or not property at all? 42 *COMP. & INTL LJ. S. AFR*, 288, 289 (2009).

³⁰ *Yahoo Inc v. Akash Arora*, 78 (1999) DLT 285.

³¹ *Rediff Communication v. Cyberbooth*, AIR 2000 Bom 27.

³² *Aqual Minerals Ltd v. Pramod Borse*, 93 (2001) DLT 203.

³³ *Satyam Infoway Ltd v. Sifynet Solutions Pvt Ltd*, AIR 2004 SC 3540.

³⁴ Intellectual Property Rights in Cyber Space, Domain names and trademarks (March 5, 2000), available at: <http://cyber.law.harvard.edu/property/domain/> (last visited on July 21, 2021).

³⁵ *Ibid.*

independent and distinct from the process of trademark registration³⁶. Trademark registration is a tedious process that may go on for months, whereas domain name registration adheres to a simple “first come, first serve” process which only checks for uniqueness of the domain name being registered.³⁷ However, this easy process of domain name registration has become a root cause of many disputes.³⁸ This lenient registration process encouraged cyber-squatters to hastily register domain names similar to trademark/names with the intent of demanding exorbitant prices in lieu of transfer/ sale of such registered domain names to the interested legitimate stakeholders.³⁹ Even the Technological Giant, ‘Microsoft’ was not immune to the acts of the Cyber Squatters. A Canadian Teenager named Mike Rowe got registered a domain name Mikerowesoft.com which was identically and deceptively similar to the trademark and tradename ‘Microsoft’. Further famous celebrities like Paris Hilton, Jennifer Lopez, Madonna, have also been victims of cybersquatting and had to knock the doors of justice to curb the cyber squatters from misusing the domain names and for seeking the relief of cancellation / delivery up of the disputed domain names.

Simply put, cybersquatting is basically a malafide use of a trademark by registering it as a domain name with the primary motive to cash upon the reputation associated with such a trademark that, in fact, belongs to some other person.⁴⁰ Cybersquatting happens whenever a trademark is registered as a domain name in bad faith to make unfair gains from the rightful owner of the mark and domain⁴¹. The modus operandi of the cyber squatters is to first search for a well-known trademark, having good value and brand associated with it and then to look if it is being used by the owner as a website or not. If not then whether there is any remotest of probability that the owner may use it as a website in future times. If the cyber squatter is able to find out such a trademark, he would get the same registered as a domain name with the hope that the owner of the registered trademark shall approach him for the said domain name and the cyber squatter may make gains out of it, by selling the domain name to the rightful owner.

³⁶ John D Mercer, “Cybersquatting: Blackmail on the information superhighway, 6 *BUJ of Sci & Tech* 11 (2000).

³⁷ Ankita Goel, “Trademarks and Domain Names”, 2 *COMPLJ* 113 (2004).

³⁸ *Supra* note 36 at 15.

³⁹ *Ibid.*

⁴⁰ J Thomas McCarthy, Trademarks, Cybersquatters and Domain Names, 10 *DJArt & Ent L* 231 (2000).

⁴¹ Hasan A Deveci, “Domain Names: Has Trade Mark Law Strayed from its Path? 11 *IJLIT* 220 (2003).

The internet, on one hand, is used by various corporations to advertise and promote their products and services, whereas on the other hand, it is being used by various unscrupulous people to make wrongful gains by banking upon the goodwill by wrongfully obtaining rights in the trademarks of others. While pronouncing the judgment in the case of *Manish Vij v. Indra Chugh*,⁴² the Delhi High Court defined the term Cybersquatting as “an act of obtaining fraudulent registration with an intent to sell the domain name to the lawful owner of the name at a premium”.⁴³

Bombay High Court in *Rediff Communications Ltd v. Cyberbooth*⁴⁴ recognized domain name as a valuable asset. The court held that the people associate the domain name with the owner as well as the business hence domain name is an intrinsic part of any business. The court hence, observed that the act of the defendant of registering the domain name “Radiff” which was deceptively as well as phonetically similar to the domain name of the plaintiff “Rediff” was merely a planned move to make undue gains by using the goodwill of the plaintiff. The Court further held this act as prohibited and violation of law.

Similarly, the Delhi High Court while dealing with the concern relating to the registration of domain name “Bisleri.com” in the suit titled as *Acqua Minerals Ltd v. Pramod Borse*⁴⁵, observed that the act of the defendant of registering the well-known trademark “Bisleri” as his domain name “Bisleri.com” was nothing but cogent representation of his malafides. The Court held that the defendant was in no manner associated with the term “Bisleri”, whereas the plaintiffs are using the trademark Bisleri prior to 1969. The court further held that the defendant is involved in the activities of blocking and hindering the business of well-known brands and the court also noticed the fact that the defendant was owner of other domain names like cyberworld.com etc as well.

Another case relating to cybersquatting, decided by the Delhi High Court is *Buffalo Network Pvt Ltd v. Manish Jain*,⁴⁶ wherein the disputed domain name was ‘tachelka.com’ which was similar to the domain name of the plaintiff ‘tehelka.com’. After the trial, while passing the judgment, the court held that adaptation of such a similar domain name by the defendant is nothing but an overt act of bad faith registration merely to divert the traffic. It was further observed that the defendant

⁴² *Manish Vij v. Indra Chugh*, AIR 2002 Del 243.

⁴³ *Ibid.*

⁴⁴ *Supra* note 31 at 27.

⁴⁵ *Supra* note 32 at 203.

⁴⁶ *Buffalo Network Pvt Ltd v. Manish Jain*, 2005 (30) PTC 242 Del.

had plagiarized the website content of the plaintiff as well and adopted the same as it is, which further strengthens the case of the plaintiff. The court, accordingly ordered for cancellation of the domain name and further imposed a cost of Rs. 1,00,000/- upon the defendant.

*Arun Jaitley v. Network Solutions Pvt Ltd.*⁴⁷ is another case of cybersquatting decided by the Delhi High Court, however it is one of its kind. In this case, the defendant got a domain name 'www.arunjatley.com' registered. The plaintiff sought permanent injunction and decree for transferring the said domain name in favour of the plaintiff on the ground that the said domain name was in fact the name of the plaintiff only and plaintiff being a well-known personality, Member of the Rajya Sabha as well as former Law Minister, a legal stalwart, designated senior advocate of Delhi High Court and the Supreme Court of India. In the suit the plaintiff stated that he tried to register his domain name 'Arun Jaitley' however, he was unable to do so since it was already registered by the defendants. It was further stated that when the plaintiff approached the defendant for transferring the domain name, the defendant instead of bonafidely transferring the domain name, demanded an exorbitant amount from the plaintiff. The plaintiff contended that the act of refusal of transferring the domain name and demand of price of transfer was nothing but malafide and dishonest intention. The court while directing the defendant to transfer the domain name to the plaintiff, made the following pertinent observations:

Right to use one's personal name holds more water when compared to the exclusive right to use a trademark. Since trademark is a commercial right whereas the former is a personal right. However, the court as an abundant caution, signified that every name does not qualify for such a protection as a matter of right. Unless the name has attained sufficient distinctive character and association with the personality, it would not be entitled for protection. Every common name / surname cannot be granted protection of exclusivity.

*HT Media Limited v. Brainlink International, Inc.*⁴⁸ is another case wherein the Delhi High Court while restraining the defendant and its affiliates from directly or indirectly using the domain name www.hindustan.com categorically observed that the act of the defendant of demanding an exorbitant amount to the tune of \$ 3 Million from the plaintiffs for transferring the domain name, is nothing but filled with malafide and bad faith. The Court further relied upon the earlier judgment

⁴⁷*Arun Jaitley v. Network Solutions Pvt. Ltd.*, 2011 (181) DLT 716

⁴⁸ *HT Media Limited v. Brainlink International, Inc* (2020) 82 PTC 396 (Del.)

passed in *Arun Jaitley v. Network Solutions Private Limited*⁴⁹ and held that the only motive of the defendants to register and passively hold the impugned domain name is to make wrongful gains and is thus a classic case of cybersquatting and is squarely covered under Clause 4 of the UDRP.

In *Bajaj Finance Limited v. Registrant of www.bajaj-finserve.org*⁵⁰ an application under Order XXXIX Rules 1 and 2, CPC was filed by the plaintiff against the defendants from unauthorizedly using fake domain names which are identical and deceptively similar to the domain names www.bajajfinance.com and www.bajajfinserve.in of the Plaintiff. It was averred in the suit and the application that plaintiff is the registered proprietor of the trademark 'Bajaj Finance' and 'Bajaj Finserve' and domain names www.bajajfinance.com and www.bajajfinserve.in. It was further averred that the defendants no. 1-5 are registrants of domain names www.bajaj-finserve.org, www.bajajfinoservices.in, www.bajazfin.online, www.bajajfincorp.in and www.bjafince.in respectively. The Delhi High Court observed that the use by defendants no. 1-5 of the above noted domain names which are identical / deceptively similar to the plaintiffs trademarks, brandnames and domain names tantamount to infringement of the rights of the plaintiff. The Court accordingly restrained the defendants no. 1-5 from using the trademarks / domain names. The Court further directed the domain registrars to suspend the aforesaid domain names till the websites are registered with the said domain names.

In the latest case of *Singh & Singh LLP v. Singh + Singh Lawyers LLP*,⁵¹ the Delhi High Court restrained the defendants from using the trademark "Singh + Singh", "Singh + Singh LLP", "Singh + Singh Lawyers LLP" and also the domain name "singhllp.com", twitter handle "@singhsinghllp", LinkedIn profile, facebook profile, etc., which is identical to or deceptively similar to the Plaintiffs' mark(s) / domain names 'Singh & Singh', 'Singh & Singh Law Firm LLP', 'Singh & Singh.com', 'Singh & Singh Advocates'. The Court further directed to suspend the domain name of www.singhllp.com.

⁴⁹ *Supra* note 47 at 718.

⁵⁰ *Bajaj Finance Limited v. Registrant of www.bajaj-finserve.org* CS (COMM) 228/2021 decided on May 18, 2021 (Delhi High Court).

⁵¹ *Singh & Singh LLP v. Singh + Singh Lawyers LLP* CS (COMM) 263/2021 decided on June 2, 2021 (Delhi High Court).

V. Uniform Domain Name Dispute Resolution Policy

As discussed above, traditional litigation was the only remedy available for settling the domain name disputes. However, litigation was a very time consuming, tedious as well as costly affair. Not everyone had the purse or strength to fight legal battles. This was majorly due to multiple reasons, some of which can be summarized as follows:⁵²

- The internet cannot be confined within territorial boundaries, which leads to jurisdictional issues. In absence of any common resolution process across the globe, different courts of the world may assume jurisdictions adjudicate the disputes in the absence of both the parties.
- Jurisdictional issues further lead to one sided proceedings which further result in non-enforcement of the orders across the borders and multiple proceedings, contradictory decisions in the same subject matter, concurrent adjudication by different courts are also some practical problems surrounding the issue.
- Registration of the same domain name in different countries having country code top level domain names may further enhance the problem and worsen the situation.
- The pace at which transactions occur over the internet and time taken by the courts in disposing of the dispute are poles apart, which further questions the efficacy of traditional litigations for settling domain name disputes.
- Even otherwise, the litigation costs, lawyer fees and incidental expenses are comparatively much higher than the amount that is required for registering a domain name.

The above stated factors cogently prove that litigation cannot be said to be a comprehensive and exhaustive remedy for adjudicating the domain name disputes.⁵³

The World Intellectual Property Organisation, in order to fulfil its obligation and in an effort to fill the gaps in the Domain Name System , took a step forward and submitted its detailed report with the Internet Corporation for Assigned Names and Numbers (ICANN). Accordingly, the ICANN, after a series of conferences and discussions, adopted and approved the Uniform Domain Name

⁵² Sourabh Ghosh, "Domain Name And Evolution of ICANN's Uniform Domain Name Dispute Resolution Policy", 9 *JIPR* 424-439 (2004).

⁵³ *Supra* note 36 at 113.

Dispute Resolution Policy (UDRP)⁵⁴. UDRP provides the guiding principles to resolve domain name disputes through online arbitration. UDRP provides the remedy of transfer and cancellation of domain names registered in bad faith. It also focuses upon providing an expeditious resolution of cyber-squatting complaints through administrative proceedings.⁵⁵

In order to maintain a complaint under the UDRP, the complainant must establish the following three elements:

- a) Impugned domain name is “identical or confusingly similar” to the domain name of the complainant; and
- b) Registrant has “no legitimate right or interest” in such name; and
- c) The domain name was “registered and is being used in bad faith” by the registrant.

The onus is upon the complainant to establish the above stated three grounds. In cases where the domain name is registered primarily for the purpose of sale, or to disrupt the business of the complainant or to deceive the consumers, then it shall be a conclusive proof of registration of domain name in bad faith. On the other hand, the respondent can show his legitimate right in the disputed mark if he proves that prior to receiving the notice of the dispute, the respondent was bonafidely using such domain name while dealing in goods and services, and the respondent is known by such name, irrespective of the fact that he has not acquired any trademark and that the respondent used the domain name for non-commercial purposes. In December, 1999, the Center received its first case titled as *World Wrestling Federation Entertainment, Inc. v. Michael Bosman*⁵⁶, where the impugned domain name was ‘worldwrestlingfederation.com’.

While deciding the case, the panel observed that within 3 days post registration of the impugned domain name, the respondent (registrant) offered the complainant to purchase the domain name for \$1000, which revealed the true intentions of the respondent. The Panel further opined that in order to establish the case of cybersquatting, the complainant must be able to prove all the three ingredients provided under Clause 4 of the UDRP. The case was decided in favour of the

⁵⁴ United Nations Conference On Trade And Development, *available at*: <http://unctad.org/en/docs/edmmisc232add35en.pdf> (last visited on May 5, 2022).

⁵⁵ John G White “ICANN’s Uniform Domain Name Dispute Resolution Policy in Action”, *Uni of Cal., School of Law & Tech* 229-249, 232 (2001), *available at*: <http://www.jstor.org/stable/24119922> (last visited on January 17, 2021).

⁵⁶ *World Wrestling Federation Entertainment, Inc. v. Michael Bosman*, Case No. D1999-0001, *available at*: <http://www.wipo.int/amc/en/domains/decisions/html/1999/d1999-0001.html> (last visited on July 22, 2021).

complainant and the respondent was directed to transfer the impugned domain name in favour of the complainant.

UDRP has also protected the celebrity rights to register their names as domain names and have also restrained the cybersquatters from misusing the domain names identical / deceptively similar to the names of famous celebrities registered and used by them in bad faith for making commercial gains by piggybacking of the reputation of the celebrities.⁵⁷

Irrespective of the fact that UDRP has been an efficient global online domain name dispute resolution procedure, the rules of procedure of the UDRP have always been harshly criticized. Particularly, UDRP has always been criticized on the grounds of being biased in favour of the complainants. In a further analysis of the disputes decided by the UDRP panel showcases that each panellist exercises discretion in a different manner, which leads to conflicting interpretations of the rules of procedure and destabilizes coherence in decisions. Further the process of UDRP has also been found to be abused. The low cost proceedings have encouraged filing of frivolous complaints.⁵⁸ It has been almost two decades since the inception of the UDRP and it is certainly the need of the hour to make requisite changes and reform the UDRP to meet the present requirements.

VI. .IN Domain Name Dispute Resolution Policy

.IN Domain Name Dispute Resolution Policy is the brainchild of the National Internet Exchange of India (NIXI), duly adopted and incorporated by reference to the Registration Accreditation Agreement (RAA) which sets forth the manner, terms, conditions and provisions for governing all disputes pertaining to .in ccTLD or .bharat domain name.

The policy has been formulated in consonance with the internationally accepted guidelines and standards and relevant provisions of the Information Technology Act, 2000.

The complainant can file the complaint on following premises:

⁵⁷ *Madhuri Dixit Nene v. VG Online* D2012-1505, para 4, available at: <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0014.html> (last visited on July 22, 2021); *Julia Fiona Roberts v. Russell Boyd*, Case No. D2000-0210, available at: <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html> (last visited on July 22, 2021).

⁵⁸ *Proto Software, Inc. v. Vertical Axis Inc/PROTO.COM* D2006-0905, available at: <https://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0905.html> (last visited on July 22, 2021).

- i. The domain name of registrant is identical and / or confusingly similar to the name, trademark or service mark in which Complainant has rights; and
- ii. There no right or legitimate interest of the registrant in the domain name; and
- iii. That the domain name has been registered or is being used in bad faith by the registrant.

The arbitrator in *Jagdish Prasad v. Stephen Koeing*⁵⁹ stated that prior to INDRP coming into force, it was UDRP that was being followed and primarily both these policies are similar in substance. On the point of burden of proof, the arbitrator held that Para 4 of the .INDR policy begins with the words that “*Any person who considers that a registered domain name conflicts with his legitimate interest may file a complaint to the IN registry.*” Further while pointing out at the initial lines of paragraph 4(i), paragraph 4(iii) and paragraph 6 the arbitrator stated that these paragraphs contain positive statements which clearly place the burden of proof to prove the conditions upon the complainant. The arbitrator further held that Paragraph 4(ii) when read with Paragraph 7 of the policy places the burden of proof with respect to proving the legitimate interest qua the impugned domain name upon the respondent and not upon the complainant.

In a nutshell , the burden of proof regarding the legitimate interest in the impugned domain name is shifting BOP. Once the complainant is able to prove that the respondent does not have any legitimate interest in the domain name, the BOP shifts upon the shoulders of the respondent, who becomes obligated to discharge his burden by proving his legitimate interest by credible evidence.

Complainant is entitled to the remedies available under this policy only after the ground mentioned in para 4 of the policy and other provisions of the policy are complied with. Remedies available to the complainant are limited to cancellation of registration of disputed domain name, transfer of the said domain name in the name of complainant and cost may also be accorded at the discretion of the arbitrator.⁶⁰

Empirical Analysis of The Decisions Under INDRP

The following chart depicts the year wise statistics of Dispute Settlement under INDRP. From the inception of the Dispute settlement body to October 26, 2020, 1245 disputes have been decided under INDRP.

⁵⁹ *Jagdish Prasad v. Stephen Koeing*, INDRP/006, decided on July 5, 2006, page 12, available at: https://www.registry.in/system/files/internet_0.pdf (last visited on July 22, 2021).

⁶⁰ *Ibid.*

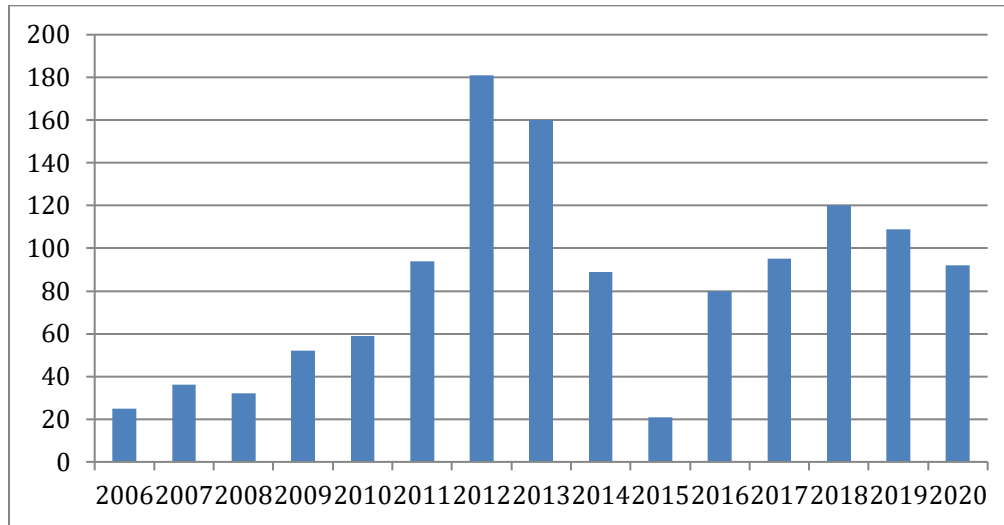


Figure 1: Year Wise Statistics of Dispute Settlement under INDRP.

The Indian traditional dispute settlement system is known for the delays and high pendency of cases. However, the INDRP dispute settlement mechanism has not been affected with such delays and pendencies. As one may notice from Figure 1, it can be observed that the rate of settlement of disputes has generally improved year on year. Till date, 1252 complaints have been filed before the registry, out of which 1245 have been decided and only 7 complaints are pending adjudication.

- The researcher, after empirically analysing around 1245 disputes settled under INDRP, observes the following:

The disputes can be divided into 5 categories. First category represents disputes where proceedings were ex parte, but all the grounds were considered; second category represents disputes where the respondent contested the complaint upon merits and all the grounds were considered. The third category is the one where respondent was proceeded ex-parte and the Domain Name was transferred considering the proprietary right of the complainant. The fourth category includes the disputes that were decided on account of amicable settlement between the parties. The last category covers the miscellaneous cases which includes the complaints that were withdrawn, or where the researcher was unable to find complete awards.

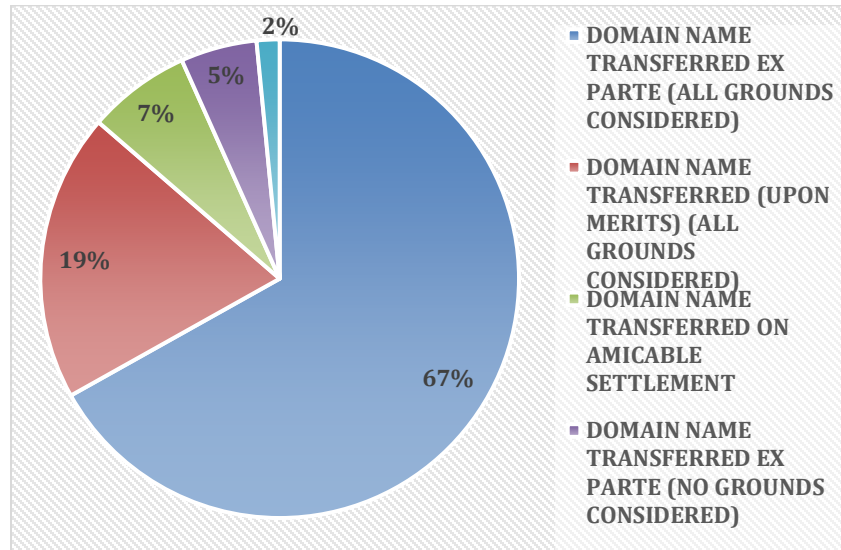


Figure 2: Overview of INDRP Dispute Settlements (Total 1245 Cases)

VII. Differences Between INDRP and UDRP

The two policies are similar in structure, but have some interesting differences also.⁶¹

1. Under the INDRP, the arbitrator is *suo motu* appointed by the NIXI to conduct the proceedings whereas under the UDRP, when a complaint is filed, the complainant has to choose a service provider from the list provided by the ICANN;
2. Under INDRP, the complainant may ask for personal hearing whereas under the UDRP, personal hearing is not possible;
3. Costs may be awarded under the INDRP whereas no such remedy as to costs is present in the UDRP.

Apart from the above stated differences, some differences can be traced between the drafting of Para 4 of the INDRP and Para 4(a) of the UDRP.

In *Stephen Koeing v. Nixi, Arbitrator*,⁶² the hon'ble Delhi High Court highlighted the following differences in UDRP and INDRP. The Court observed that:

⁶¹ Pravin Anand, "Evicting cyber-squatters", *IBLJ* 24 (2012), available at: <http://indilaw.com/pdfs/Can%20IP%20be%20owned%20in%20India.pdf> (last visited on July 22, 2021).

⁶² *Stephen Koeing v. Nixi, Arbitrator*, O.M.P. 132 of 2007, Decided on Nov. 14, 2011 (Delhi High Court).

there are at least four differences between the above para 4 of the INDRP and the corresponding Para 4 (a) of the UDRP. The first is the opening part of Para 4 of the INDRP indicating the 'premises' on which a complaint could be filed is absent in para 4 (a) UDRP. This is significant when read with the last line at the end of Para 4 (a) UDRP which states: In the administrative proceeding, the complainant must prove that each of these three elements are present. The said line is absent in Para 4 INDRP. This is the second difference. The third difference is that at the end of sub-para (i) of Para 4 UDRP, the word 'and' figures. The fourth is that in sub-para (iii) of Para 4 of the UDRP it is to be shown by the complainant that the Registrant's domain name has been registered and is being used in bad faith. It is not for the court to speculate whether these differences in Para 4 INDRP were intentional or accidental.

But as one may notice from the empirical findings from this study, even though many scholars and the Courts have tried to point out the subtle differences between UDRP and INDRP in their judgments, those differences may not be making any impact on practice of domain name dispute settlements. Most importantly, as one can see from the data collected as part of this study, the arbitrators under the INDRP have been using all the three criteria mentioned under the INDRP for settling disputes under INDRP.

VIII. Conclusion

On one hand the evolution of cyberspace has provided great benefits to society. But on the other hand this evolution has created many unexpected pitfalls.⁶³ The growth of e-commerce has resulted in many complex intellectual property issues like cyber-squatting, domain name disputes, passing off and dilution of trademarks in cyberspace.⁶⁴ Part IV of this paper explains in detail one such problem i.e. cybersquatting, wherein a trademark of someone else is registered with the sole motive of earning profits by cashing upon the goodwill and reputation attached with such mark. Under this part, the authors also provided a detailed discussion of all the leading case laws and gave insights on how the Indian judiciary proactively tackled the domain name disputes by application of the common law remedy of passing off, as and when it was deemed necessary. In the article the rationale behind protecting the domain names has been highlighted. Domain name not only serves as address for communication but also acts as a business identifier. Therefore, granting protection

⁶³ Mayuri Patel & Subhasis Saha, "Trademark Issues in Digital Era", 13 *JIPR* 118-128 (2008).

⁶⁴ *Supra* note 11 at 152.

to a domain name becomes imperative. Traditional litigation might be helpful in providing protection. But since it's a tedious process, marked by various issues like delays and pendency of millions of cases before the judiciary, it is not an appropriate option for settling domain name disputes.⁶⁵

Part V discussed the alternative dispute settlement mechanism formulated by the ICANN *i.e.* Uniform Domain Name Dispute Settlement Policy (UDRP). This policy protects the rights of trademark owners expeditiously and effectively, without resorting to the judicial proceedings before a court of law.

India opted to create its own policy that deals with '.in' cctld, known as .IN Domain Name Dispute Resolution Policy (INDRP) in 2004. Although the policy is at par with the UDRP, some differences among the two that have been highlighted in Part VII of this paper. In the UDRP, each ground is connected with the word 'and' which signifies that to establish a complaint, the grounds must co-exist. Whereas, under INDRP only the 2nd and the 3rd ground are connected with the word 'and' which signifies that the remedy can be granted to the complainant where he is able to prove the first ground. One of the potential interpretations in this regard is that if the complainant fails to prove the first ground, then he must prove the 2nd and the 3rd grounds together. In other words, a literal interpretation of INDRP reveals that the coexistence of all the three grounds may not be mandatory. However, as the data collected as part of this study indicates, in practice that may not be the case. The empirical research clearly depicts that pleading all the three grounds as mentioned in the INDRP are necessary. Even in the cases which were decided *ex-parte*, the arbitrator ensures the presence of all the three grounds.

The analysis of the empirical data collected by the researcher, *prima facie* eliminates the fear of some scholars, researchers and legal practitioners who considered INDRP as inconsistent with UDRP and that it is not an effective mechanism to deal with domain name disputes. The data and analysis done as part of this research leads one to the conclusion that the Indian system of protection of domain names is strong enough to tackle the domain name disputes, as in every dispute where the complainant was able to fulfil the conditions mentioned under INDRP, the rights of the trademark owners have been protected over the rights of the domain name holders.

⁶⁵ Shamnad Basheer, "Trademark Issues on the Internet: Domain Name Dispute Resolution, Legal Dimensions of Cyberspace", *ILI* 153 (2004).