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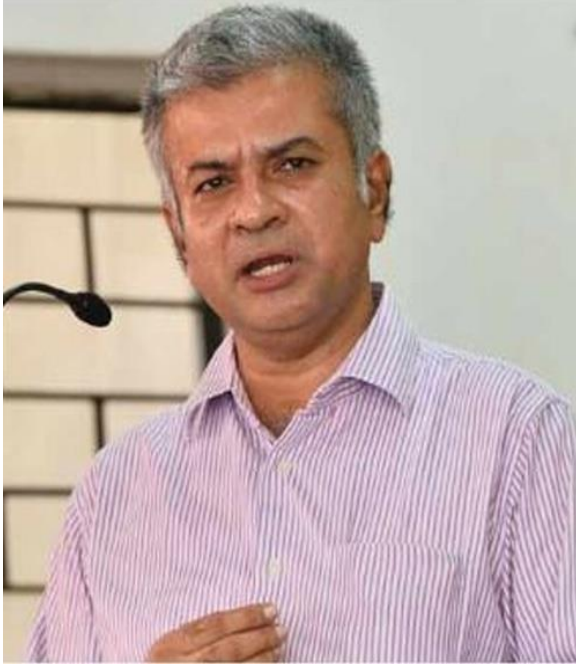
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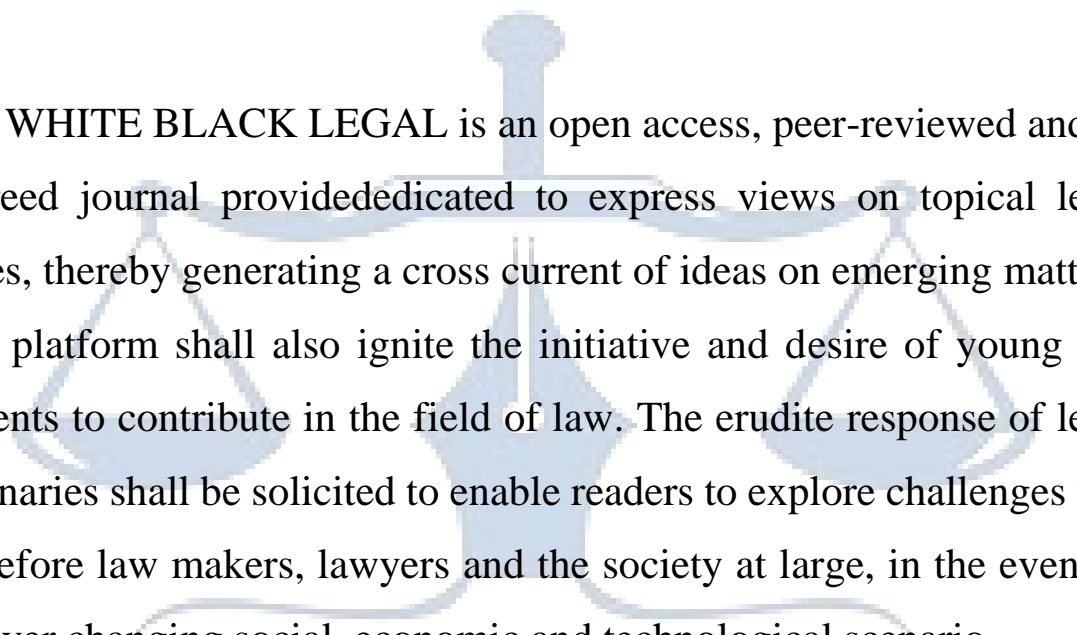
Subhrajit Chanda



BBA. LL.B. (Hons.) (Amity University, Rajasthan); LL. M. (UPES, Dehradun) (Nottingham Trent University, UK); Ph.D. Candidate (G.D. Goenka University)

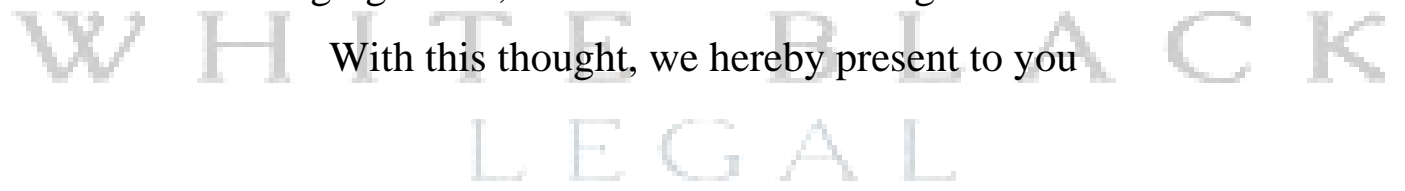
Subhrajit did his LL.M. in Sports Law, from Nottingham Trent University of United Kingdoms, with international scholarship provided by university; he has also completed another LL.M. in Energy Law from University of Petroleum and Energy Studies, India. He did his B.B.A.LL.B. (Hons.) focussing on International Trade Law.

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WHITE BLACK LEGAL is an open access, peer-reviewed and refereed journal providededicated to express views on topical legal issues, thereby generating a cross current of ideas on emerging matters. This platform shall also ignite the initiative and desire of young law students to contribute in the field of law. The erudite response of legal luminaries shall be solicited to enable readers to explore challenges that lie before law makers, lawyers and the society at large, in the event of the ever changing social, economic and technological scenario.

With this thought, we hereby present to you



VISUAL & PHONETIC SIMILARITY IN TRADEMARKS: A STUDY OF JUDICIAL TRENDS IN INDIA

AUTHORED BY - BHAWNA GAUTAM

I. INTRODUCTION

Trade Mark Act, 1999 deals with mainly the issues of infringement and passing off of trade marks in traditional context. However, with the tremendous growth in international trade and commerce and development of communication technology through internet, new issues like trade dress, domain names, non-conventional marks like sound, smell and moving objects are emerging. Transborder Reputation of Trademarks i.e. the concept of well known trade marks is also gaining recognition worldwide. Further, the instances of cyber squatting are growing at an alarming rate down the internet highway thereby raising jurisdictional issue in cyber space, for which there is no separate legislation in India. Moreover, Ambush Marketing and Contextual advertisement on internet search engine are also growing threats in the field of trademarks. These issues are not specifically covered in the existing Indian legislation. Hence, it is very interesting to know as to how the Indian Judiciary interpreted existing legislation to address these new emerging issues and to ascertain whether it offered adequate protection to these new forms of trademarks.

II. Domain Names :

“Domain names have and will continue to go up in value faster than any other product ever known to human”.¹

The domain name is usually an address given to the website so that the person intending to visit the same may visit the website of the identified person. e.g. www.google.com. So far as individual persons or eminent personalities/popular companies are concerned, their identity is established in the virtual world of internet by way of

¹ Bill Gates, The Founder of Microsoft

domain names. Thus, the popularity or the fame of any individual or the company will be no different on the internet than the reality. A domain name can be easily remembered and used. It is an instrument of commerce as it identifies and distinguishes the business itself, or its goods or services and specifies its corresponding online internet location. As such, domain names are integral parts of businesses having any online commercial activity. They can be referred to as an 'online identity' of one's business. Since the commercial activities online are increasing day by day, the usefulness and purpose of domain names cannot be ignored. These days, domain names are not just names of websites, but they are business identifiers. Hon'ble Bombay High Court in held in case of *People Interactive (India) Pvt Ltd. vs. Vivek Pahwa and Ors*² that "domain name is the online equivalent of a physical address. It takes a user to a particular part of the website where a domain name registrant stores and displays his information & offers his services."

Thus, a domain name and trademark perform the same function as "identifiers." But, the process of acquiring a domain name requires no examination as to whether the domain name is distinctive or capable of distinguishing itself from others. Descriptive words or even names of persons can be registered as domain names. Some businesses also use their registered trade marks as domain names. On the other hand, once a domain name has been chosen, the holder can also apply to obtain trademark protection in order to prevent others from using the same.

III. Domain Name Protection Law in India :

In India we have no domain name protection Law and cyber squatting cases in that regard are decided under Trade Marks Act, 1999 in addition to those which are decided by WIPO. In this regard, Hon'ble Apex Court in the case of *Satyam Infoway Ltd vs Sifynet Solutions Pvt Ltd*³ while drawing distinction between trade mark and domain name held that "the distinction lies in the manner in which trade mark and domain name operate. A trademark is protected under the law of a country where such trademark is registered. Thus, a trade mark may have several registrations in many countries throughout the world. On the other hand, since the domain name operates on the internet and it can be accessed from anywhere in the world without any geographical limitation, national laws might be inadequate to effectively protect a domain name".

Thus, Indian Courts recognized the lacuna in the Trade mark Act for want of express provision to

² (2016) 6 AIR Bom R 275

³ AIR 2004 SC 3540

protect domain names. However, in the absence of explicit legislation, Courts in India applied the provisions of the Trade Marks Act to such disputes. The Court in above case further observed - "There is no statute in India which directly and specifically deals with resolution of domain name conflicts. Though the operation of the Trade Marks Act, 1999 is not extra territorial and may not allow for effective protection of domain names, yet it does not mean that domain names are not to be protected to the extent possible under the laws relating to passing off". Thus, trade mark Act is applied to domain names by Indian Judiciary.

It is to be noted that the Trade mark law does not permit any one to carry on his business in such a way as would make the customers to believe that the goods or services belonging to someone else are his or are associated therewith. Hence, it is necessary to protect the domain names so that the identified names of companies and individuals which are distinct at the market place may not go at the hands of individuals who are nowhere concerned with those names thereby preventing the menace of cyber squatting and passing off.

Concept of Cyber squatting : Cybersquatting can be defined as registering, trafficking in, or using a domain name with bad-faith that is mala fide intention to make profit from the goodwill of a trademark belonging to others. The cyber squatter then makes an offer to sell the domain to the person/ who owns a trademark contained within the name at a high price. There are several Indian cases where the cybersquatters have been restrained on the basis of Passing off. In the *Bisleri case*⁴, the Delhi High Court on a complaint by the proprietors of the TM Bisleri and the domain name Bislerimineralwater.com restrained an IT company from using the domain name Bisleri.com. In another judgment passed by the Delhi High court in yahoo! Inc case⁵, the Court restrained the defendant from using the domain name Yahooindia.com on the ground that it violated the rights of the plaintiff who was the proprietor of the domain name yahoo.com which was registered earlier in several countries except India.

Domain Name protection : A trademark is protected by the laws of a country where such trademark may be registered. It may have multiple registrations in many countries throughout the world. On the other hand, a domain name on the internet is accessible from anywhere irrespective of territorial

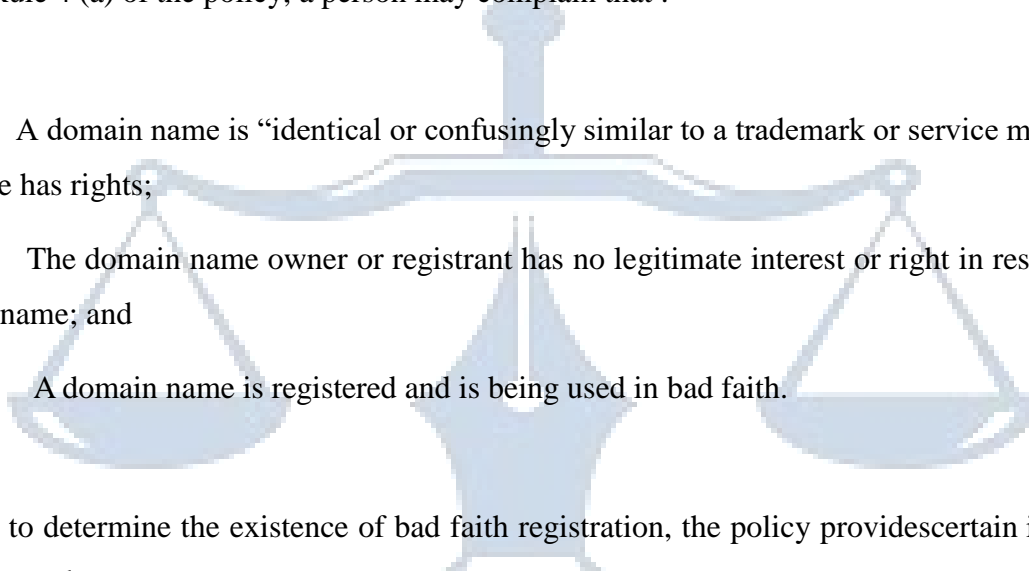
⁴ Acqua Minerals Limited vs. Pramod Bose and Ors, 2001 PTC 619

⁵ Yahoo vs. Akash Arora 1999 PTC 201

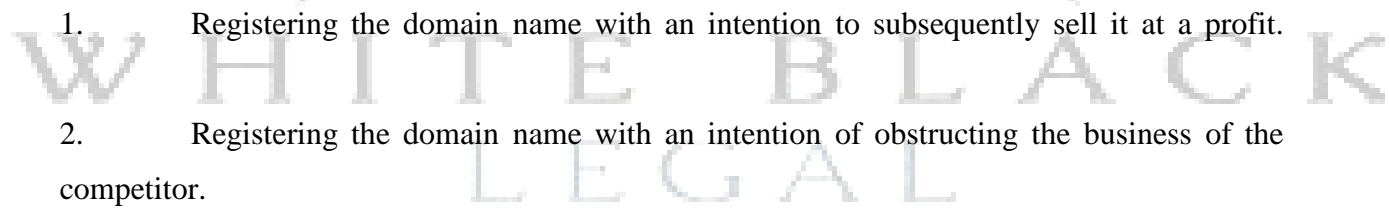
limits. In such circumstances, domestic legislation is inadequate to protect them outside the respective country. Hence, in the year 1999, Internet Corporation for Assigned Names and Numbers (ICANN) framed an international regulation of the domain name system (DNS) i.e. Uniform Domain Name Disputes Resolution Policy (UDNDR Policy) in order to deal with the trademark disputes over the domain names.

IV. Dispute Resolution Under The Uniform Domain Name Disputes Resolution Policy(UDNDR Policy) By ICANN :

As per Rule 4 (a) of the policy, a person may complain that :

- 
- i) A domain name is “identical or confusingly similar to a trademark or service mark” in which he has rights;
 - ii) The domain name owner or registrant has no legitimate interest or right in respect of the domain name; and
 - iii) A domain name is registered and is being used in bad faith.

In order to determine the existence of bad faith registration, the policy provides certain inclusive factors as under :

- 
1. Registering the domain name with an intention to subsequently sell it at a profit.
 2. Registering the domain name with an intention of obstructing the business of the competitor.
 3. Registering the domain name in order to restrain the owner from reflecting the mark in a corresponding domain name.
 4. Using the domain name to attract netizens to one’s website by creating a likelihood of confusion with the complainant’s trademark.

If the complaint prevails, the domain name will be cancelled or transferred to the complainant, but financial remedies are not available under the UDNDRP.

In this regard, India has also established its own INRegistry under the authority of National

Internet Exchange of India (NIXI), where the domain name disputes are resolved under the .IN Dispute Resolution Policy (INDRP). The Policy has been formulated after considering internationally accepted guidelines and the relevant provisions of the Indian Information Technology Act, 2000.

V. Cases Decided By The Indian Courts Regarding Protection Of Domain Names :

1. *Yahoo vs. Akash Arora*⁶ : In this case, for the first time Indian Court extended the principles of common law to cover services offered through the Internet. The plaintiffs submitted that they registered the domain name yahoo.com with the Network Solutions Inc. and had registrations of the same in over 69 countries. The defendant raised the issue that its website had a disclaimer that it was not connected to the plaintiffs website and this avoided confusion of any kind. It was also contended that yahoo was a dictionary word and could not be protected. Hon'ble Delhi High Court held that the marks were similar and the disclaimer would not avoid confusion. Court also observed that the word yahoo was given protection as it was a well known trade mark used by the plaintiff and was having distinctiveness.

2. *Rediff Communications Ltd. vs. Cyberbooth* : In this case, plaintiff, the owner of the well-known portal and domain name rediff.com filed suit for injunction against the defendant, registrant of the domain name "rediff.com". The Court was satisfied that there was a 'clear intention to deceive' and granted interim relief to the plaintiff by observing that -"A domain name is more than an Internet address and it is entitled to equal protection as trademark".

3. *Online India Capital Co. Pvt. Ltd. Vs. Dimensions Corporate*⁷ : In this case, the plaintiff was unable to get an interim Injunction because the court held that the words www.mutualfundsindia.com were descriptive and had not acquired a secondary meaning.

4. *Tata Sons Limited vs. Monu Kosuri & others*⁸ : The defendant was a well known cybersquatter who had registered a number of domain names containing the name Tata which is a well known brand name of the plaintiff. It was held that Internet domain names are more than internet addresses and are entitled to protection equal to trademarks and the plaintiff was granted the ad

⁶ 1999 PTC 201

⁷ 2000 PTC 396

⁸ 2001 PTC432

interim injunction.

5. *Titan Industries Ltd. Vs. Prashanth Koorapati & Ors*⁹ : The Delhi High Court granted an ex-parte ad-interim injunction restraining the defendants from using the name "TANISHQ" on the Internet or otherwise and from committing any other act as is likely to lead to passing off of the business and goods of the defendants as the business and goods of the plaintiff.

6. *Times Internet vs. M/s Belize Domian Whois Service Ltd. and Others*¹⁰ : In this case, the word "indiatimes" which was the essential component of the domain name of plaintiff, was used by the defendant without any explanation. Hence, Hon'ble Delhi High Court held that this could confuse an ordinary netizen and could result in associating defendant's portal with that of the plaintiff company and hence, it was a clear case of passing off.

7. *Dr. Reddy's Laboratories Ltd. v. Manu Kosuri and Anr*¹¹, the defendants were restrained from using the domain name in question, "drreddyslab.com" which was identical to the plaintiff's trade name. The Court was of opinion that domain names hold an important position in e-commerce and the defendants were liable under passing-off.

VI. Global Cybersquatting cases :

1. Panavision International, L.P. v. Toepfen¹²

In this case, defendant applied for and received registration of the domain name panavision.com which was similar to name of plaintiff company. Plaintiff i.e. Panavision International is a well-established manufacturer of filming equipment and camera. It tried to register panavision.com, but was informed about defendant's registration of the domain name. Hence, plaintiff notified defendant of its desire to use the domain name panavision.com. But, defendant demanded \$13,000 to relinquish the domain name. Plaintiff refused to pay and sued the defendant on a federal trademark dilution claim. The Court restrained Toepfen from further use of the web site, and ordered him to relinquish

⁹ Delhi High Court Suit No. 179 of 1998, Decision dated 28 Jan 1998

¹⁰ 2011 (45) PTC 96 (Del.)

¹¹ 2001 PTC 859 (Del)

¹² 141 F 3d 1316 (1998)

the registration of the domain name to plaintiff.

VII. Federal District Court's findings were as under :

1. Panavision was a famous mark.
2. Toeppen's business of registering domain names to be sold later qualified as commercial use.
3. Toeppen's use diluted Panavision's mark by preventing it from identifying and distinguishing its products over the Internet.

2. Marks & Spencer PLC vs. One in a Million In this case, the High Court of Justice, Chancery Division, restrained the activities of cyber dealers and their related companies, as they had obtained and were offering for sale various domain names containing well known marks. In this case, the Court restrained "the threat of passing off" i.e. a threat which may become a reality if an offending domain name was sold to and used by a stranger to the trademark owner, by issuing a warning to cyber squattersto the effect that: "If any person registers a domain name intentionally on account of its similarity to the name, brand name or trademark of an unconnected commercial entity, then he must expect to find himself on the receiving end of an injunction to prevent the threat of passing off, and the injunction will be in such terms which will make the domain name commercially useless to the dealer".

VIII. Cases decided by the World Intellectual Property Organisation

(WIPO):

1. Sbicards.com vs Domain Active Property Ltd.:

In this case, domain name Sbicards.com was ordered by the World Intellectual Property Organisation to be transferred to the Indian Company from an Australian entity, which hijacked the domain name with a motive to later sell it for a huge sum to the State Bank of India subsidiary. The WIPO panel accepted the argument of SBI Card counsel to the effect that "the Australian company was in the business of buying and selling domain name through its website."

2. *Mahindra & Mahindra Limited (M&M) case* : In M&M's case, a young student residing in Andhra Pradesh, registered the domain names mahindra.com, mahindra.net and mahindra.org, in his name. M&M appealed before WIPO stating that the name Mahindra was its registered trademark in India and the United States. The panelists ordered that the domain names, be immediately transferred in favour of the Indian company.

3. *Bennett Coleman & Co Ltd Vs. Steven S Lalwani*: Since 1996, the complainant held the domain names www.economicstimes.com, using them for the electronic publication of their respective newspapers. The complainant also registered the same in India for literary purposes. However, the defendant registered the same domain name in 1998. The WIPO panel observed that the complainant have a lot of reputation in their newspaper titles due to their daily use in hard copy and electronic publication. It was also held that the registration of domain names by respondents was in bad faith.

4. In *World Wrestling Federation Entertainment, Inc. v. Michael Bosman*, a cybersquatter tried to sell worldwrestlingfederation.com to WWF. It was held by WIPO that the domain name was identical or confusingly similar to petitioners trade mark and the respondent had no legitimate interest in the mark.

Thus, above discussion shows that the Indian Judiciary has clearly recognized the role of domain names as an important element of trade and commerce on the internet and protected it by stretching the passing off principle embodied in the Trade mark Act. However, it is to be noted that since domain names transcend geographical boundaries and as they are accessible on the internet through different countries, the question of territorial jurisdiction of Courts arises and it is very difficult to be answered as there is no such provision in the Trade mark Act and still the Courts have to apply the common principles of Jurisdiction as prescribed in the Code of Civil Procedure, 1908. Hence, it is very necessary to study as to how the Indian Courts addressed the issue of jurisdiction in relation to trade marks and domain names in virtual world.

IX. Jurisdictional Issue In Case Of Domain Names :

In India, a trademark is associated with a particular product that is traded. An applicant seeking to register a trademark in respect of a particular product has to register the same. In this regard, every country has its own trade mark law, which operates only in respect of its territorial sphere. Ordinarily

where a particular trade mark has not been registered within a jurisdiction, any person within that jurisdiction should be able to use that name and register trade mark in respect of that name. But, once it has been posted on the Internet which cuts through geographical barriers, he is open to the risk of potential litigation. These disputes give rise to the cross border effects of the Internet which springs problems like personal jurisdiction, conflict of laws and the question of which substantive law would be applicable. Further, question arises as to whether mere accessibility of a website from a particular State, would make the hosts amenable to the jurisdiction of the Courts of the respective State.

A US Court in *Bensusan vs King* has attempted to offer a solution to the above altercation. The facts are that of the use of a company logo on the home page of a website. Richard King, who was an operator of a jazz bar and was called 'Blue Note' in Columbia, Missouri had set up a web page on the Internet including the term 'Blue Note'

on the home page. Bensusan Restaurant Corp, the operator of jazz bars in New York and other cities in the same name, relying on its registered trademark for the name 'Blue Note', filed an action for the infringement of trade mark and unfair competition law against Richard King before the New York District Court. The Court held that the conditions for its jurisdiction according to the New York 'long arm statute' were not met. According to the tort of trade infringement, it was sufficient that only a single product infringing the plaintiff's trade mark was offered on the New York market. However, the Court held that this condition was not satisfied by the mere accessibility of a web page stating a telephone number.

X. Conclusion

“Knowledge is power”- the adage is more relevant today than any other time in the past; and it will be still more relevant in the years to come as we move more and more towards knowledge-based economy. The rationale for the creation of knowledge based rights gets defeated if they cannot be enforced. Hence, owners of intellectual property have to be their own watchdogs and take recourse to the Courts for their infringement of their rights. This is reflected from the regime of Intellectual property rights existing in the world today. As such, in the fast moving ecosystem of the IP sector and equally rapid need for laws to regulate the same, protection of trademark being one of the intellectual property rights is a serious concern today and Courts are duty bound to protect it by introducing guidelines and setting standards/ tests for tackling infringement while interpreting appropriate legislation.

In this regard, on the basis of discussion made in this thesis and on a preliminary observation of the Court Judgments and settled law on trademark infringement in Indian scenario, it can be concluded that Judiciary in India has played an important & influential role in protecting the trademark from infringement & passing off and it interpreted domestic legislation and international conventions harmoniously so as to accommodate new and emerging trademark issues in national legislation and it is active in protection of trademarks by evolving principles of high legal importance which later become precedents for lower judiciary.

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