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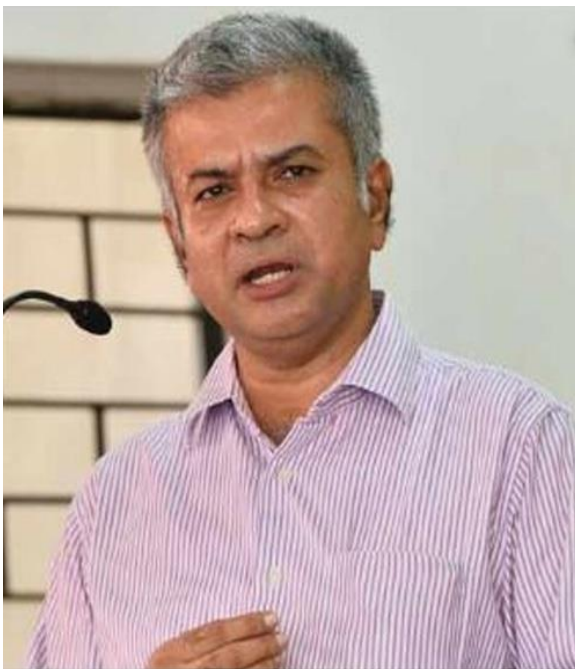
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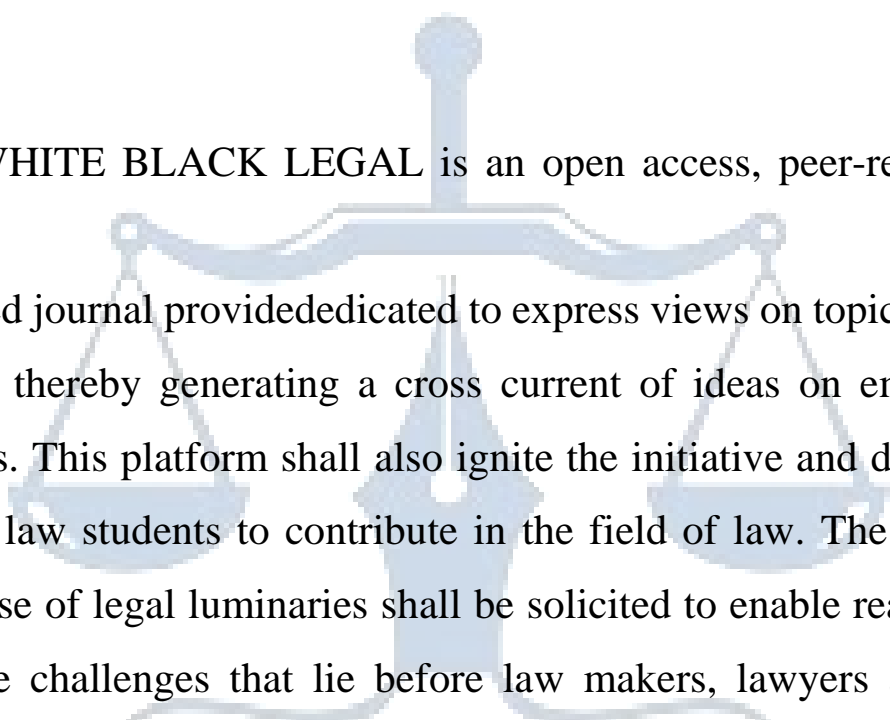


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ABOUT US



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

“CYBERSQUATTING – ANALYSING THE NEXUS OF IPR AND TECHNOLOGY”

AUTHORED BY - MOHD ARSH KHAN

ABSTRACT

Today, we are witnessing the era in which the technology has become an inseparable part of human lives, Technology is permeating into every professional field and the field of law too cannot be kept isolated from the purview of technology. In figuring out the nexus of Law and Technology, it is found that there are aspects of technology that cater to the law breakers, such as in the field of IPR and technology, the world in general and India in particular, is immensely grappling with the significant rise in the menace of the cybersquatting and domain name disputes. The author in this paper has addressed the issues pertaining to Cybersquatting which entails Domain name disputes. The paper commences with descriptive analysis of domain name and how it differs from trade mark, this has been explained in a lucid manner with illustrations. Thereafter, origin of cybersquatting and its classification has been described, in which the author has delved deeper into Typo squatting. The essence of this research lies in highlighting the fact that India till today lacks any specific legislation to adjudicate the domain name disputes and to prove this hypothesis, comparative analysis approach has been resorted to, through which, an author extensively elaborates the international scenario, particularly the laws in USA, to effectively resolve the domain name disputes. The research further shows that Indian Courts have been relying upon the traditional trademark law to adjudicate the domain name disputes and lacks any particular law to deal with the same, even the Information Technology Act, 2000 has no mention of cybersquatting and domain name disputes, and domain names in India have been recognized only through the judicial pronouncements.

Keywords: Domain Names, Cybersquatting, Trademark.

(I) INTRODUCTION

Domain Name

Domain name is a web address, i.e. it is the address of your website that people type in the browser URL to visit your website. It could be understood as if your website is your home and domain name is its address. Example is, amazon.com. The URL is a standard way of identifying everything found on the Internet. It entails information regarding where something is and who may see it. Each device or service on the Internet has a domain name that is essentially their address. The domain name system translates names into an IP address or numerical sequence. The domain name makes the address easy to remember and can be put to use by linking it to the digits that represent the domain name itself. The domain name does not have to change, because it stays the same no matter what happens to the computer or service. In contrast, the IP address does change. Contrary to a list of statistics, the name of the location is given greater prominence. To keep names from getting confused, internet users can take advantage of memorable and easy to spot domain names. **ICANN (Internet Corporation for Assigned Names and Numbers) is in charge of all the domain names at the top level.** To determine domain names, NSI uses a hierarchical system with global generic top – level domains (TLDs) like .com and .net. To start, a company will contact the administrator of the TLD (the Top Level Domain) if a domain name is requested that is already in use, and the administrator will thereafter contemplate if the required domain name should be issued. That single service provides centralized IP addressing and domain name allocation services. There is a distinct registration process that must be followed. INTERNIC (Internet Network Information Centre) the internet body that issues IP address and domain names, serves as the central administration for the global Internet.

What is the use of domain names? ,

As each Computer is assigned an IP address. It is a series of numbers that identify a particular computer on internet. A typical IP address looks like this: 66.249.66.1, now an IP address like this is not easy to remember, in case you have to visit your favourite websites, so the Domain names were discovered to solve this problem. Now, if you wish to visit a website, then you don't need to enter a long string of numbers. In place of this, you can access it by typing domain name in your browser's address bar which will not be difficult to remember¹

¹ Beginner's Guide: What is a Domain Name and How Do Domains Work? , March 26, 2021, *available at:* <https://www.wpbeginner.com/beginners-guide/beginners-guide-what-is-a-domain-name-and-how-do-domains-work/> (last visited on June 21, 2022)

(II) DOMAIN NAME V TRADEMARK

Domain name and Trademark though seemed to resemble each other, but, there is a difference between the two. Often a business will resort to its business name, brand name or another business identifier as its domain name. However, unlike trademarks, domain names are:-

- Global
- Unique by nature
- Cannot be shared between two websites

It is pertinent to mention that - Registering a domain name does not per se give you any rights over the matching trademark.

A *Domain Name* is a peculiar group of letters which is part of an Internet address. It is common for a domain name to be same or similar to trademark or a business name. Domain names are used to spot and attract users to a particular website or place on an Internet. Registering a domain name gives you exclusive rights to use that domain for the duration of the license period. You can agree the expiration term when buying the domain and renew indefinitely subject to paying renewal fees on time.

A *Trademark* is any sign which distinguishes your goods and services from those of your rivals. A trademark is used to identify and distinguish your goods or services in the market place. You can protect a registered trademark by law. It is to be noted that UK registered trademarks last for ten years, after which you can renew your trademark registration.

You will be permitted to register a domain name, provided, it hasn't been used by someone else in advance. Avoid registering a domain name that uses or is similar to competitor's brand name or trade mark, as this can lead to disputes.

In most cases, trade marking a domain name can help protect your business' identity, reputation and profit.². Now here, following couple of questions arises:-

Can a domain be a trademark?

Domain names can be registered as trademarks. They are subject to same rules and standards

² "Domain name and trademark conflicts – Relationship between trade mark and domain name", NIBUSINESS INFO.CO.UK available at: <https://www.nibusinessinfo.co.uk/content/domain-name-and-trade-mark-conflicts> (last visited on June 21, 2022)

as all other types of trademarks.

It is pertinent to note that registering a domain name does not per se:-

- make that name a trademark
- gives you exclusive rights to use and protect that name.

Why trademark a domain name?

There are certain reasons why you should trade mark your domain name.

Trademarks are usually:-

- more valuable than domain names
- more smoothly safeguarded, both under common law and statutory law.

Trade marking your domain name will:-

- give you legal rights over the name in the country where the trademark was granted
- averts others from using a same domain
- re-establish your brand name and assure noticeability of your business online³

(III) WHAT IS CYBERSQUATTING?

The term squatting means to occupy unlawfully and the word cyber indicate something pertaining to Information and communication technology. “Cyber Squatting is defined as an unlawful practise where the registrants procure and use the domain names with dishonest intent to gain from the goodwill of the actual trademark owner”. It is an unauthorized registration of domain name that are identical or similar to trademarks, service marks, company names or personal names.

With the growing reliance on the Internet, a lot of importance has been attached to domain names since 1995 across the globe. Big Corporations and businesses prefer to register domain names in the name in which they carry out their business outside their nation. Although, there is an inclination towards domain names with a bad faith to register the names of these giant corporations and renowned businesses as domain names by persons other than the owners of such commercial undertakings. Registering domain name in the name of a well-known or a registered trademark or confusingly similar trademark, and then making an attempt to sell that

³ “Domain name and trade mark conflicts – Can a domain name be a trade mark?”, NIBUSINESS INFO.CO.UK , available at: <https://www.nibusinessinfo.co.uk/content/can-domain-name-be-trade-mark#:~:text=Domain%20names%20can%20be%20registered,that%20name%20a%20trade%20mark> (last visited on June 21, 2022)

domain name to the owner of a well-known registered trademark or to a third party with a malafide intent of selling it at a higher profitable price to the trademark owner is termed as “**Cybersquatting**”.⁴ The Delhi High Court in the case of *Manish Vij V Indra Chugh*⁵ has defined cybersquatting as “an act of obtaining fraudulent registration with an intent to sell the domain name to an actual legal owner of the name at a premium.”

(IV) ORIGIN OF CYBERSQUATTING⁶ –

The origin of Cybersquatting lies in the late 1990’s when most of the companies did not rely on the Internet for marketing purposes and did not understand the value of registering their own trademark domain names. Others saw the good amount of profit and registered these valuable domain names for the purpose of selling them back to the companies with a significant mark – up. **The first Cybersquatting case occurred in 1994 in the United States** and since the cases have risen almost across the globe. It all began at a time when most companies had no clue of the commercial potential that existed on the Internet. Some entrepreneurial people registered domain names in the names of well-known companies to make a profit when the corporations woke up and realised that they had no claim to the names. Domain names squatters are now trying to crack the toughest nut as now the businesses are all cognizant and vigilant of the need to secure domain names.

(V) KINDS OF CYBERSQUATTING⁷ –

a.) Typo squatting⁸ –

Typo squatting is one of the most common types of Cybersquatting, that entails nearly a quarter of total cases. In this case, the cyber squatter purchases domain names that are misspelled versions of well – known brands on purpose. Creating an illicit website to cause users to land on it when they make a typing error (for example, by misspelling a domain name, hitting one or more erroneous keys, etc.) is the purpose. For an instance:

- [Twitter.com](https://twitter.com)

⁴ Shivani Singh, “*Cyber Squatting in India*”, pleaders’ Intelligent Legal Solutions, December 3, 2021 , available at: <https://blog.ipleaders.in/cybersquatting-in-india/> (last visited on June 21, 2022)

⁵ AIR 2002 Delhi 243, 97 (2002) DLT1

⁶ Ritesh Nangia , “*CYBER SQUATTING FROM A LEGAL PERSPECTIVE*”, Legal Desire International Journal on Law Vol.8 Edition 27, Page No.17,

⁷ *Id* at 19

⁸ Madhavendra Singh, “*Typo squatting – An Evil in Cyberspace*” , Live Law , June 7, 2022, available at: <https://www.livelaw.in/columns/typosquatting-cyberspace-cybercrimes-cybersquatter-201029#:~:text=In%20India%2C%20there%20is%20no,activity%20is%20universal%20i> (last visited on June 21, 2022)

- Twittr.com
- Twittor.com
- Twitter.cm, and
- Wwwwtwitter.com (without the period between “www” and “Twitter”) are all examples of Twitter domain names.

Now, for an instance, say a young Indian child while scrolling Internet wishes to visit a website *www.indiachild.com* so that he can read short inspiring stories, missing letter “a” types *www.indinchild.com* recklessly, would visit a website that has adult content. Again the situation will turn into worse when that child would attempt to shut the window but he is not able to do so and with his every try a new window appears on his computer screen. In the former case, he became the innocent victim of typo squatting, and in latter one, he falls prey to **mousetrapping**, a typical Typo squatting method. This abovementioned scenario could be faced by all Internet users regardless of their age group because typo squatters have been targeting various categories of websites.

The business of typo squatting is not only targeting websites devoted to children but this evil has spread all over the cyberspace. A research report has been released that displays that five most highly squatted website categories are game sites (14.0 %). Airlines (11.4 %), main stream media company sites (10.8 %), adult sites (10.2 %) and technology and Web 2.0 related sites (9.6 %). Undoubtedly, Children sites are highly targeted by typo squatters but consumer orientated and renowned websites are too targeted by more typo squatters.

Internet is one of the biggest technological advancement in the history of science and technology. The Internet has become an important and useful source for a bulk of information. Many businesses, resorting heavily on customer website usage, distinguish products through their trademarks, which insinuates the quality and help develop brand names. Therefore, **using trademarks as domain names help businesses to create a strong presence on the Internet.** Yet, domain name registration once a convenient identification method for consumers has become a profitable venture for cunning entrepreneurs such as Cyber squatters including Typo squatters.

A typo squatter is a sort of Cyber squatter, who intentionally, with malafide intent, registers misspelled domain name variation of the legitimate domain name of a company. Generally,

Cybercriminals uses typo squatting tactics in order to make pecuniary benefit from the mistakes of the Internet – users.

Typo squatting incidents are widely occurring today and it is evident by the fact that even the website of the World Intellectual Property Organisation, the organisation which is vested with the authority by ICANN to adjudicate the cases of cybersquatting and typo squatting at an International level, has also been targeted by typo squatters. In 1997, typo squatter created an adult and political entertainment website *www.whitehouse.com* similar to the official website of Whitehouse “*www.whitehouse.gov*” and he made millions from this website alone.

Moreover, the role of Google was challenged in case filed against Google over typo squatting. Harvard University professor alleges that Google profits from typo squatting websites that run ads using Google’s Ad sense – which ironically are often bought by the owners of legitimate sites, web surfers were trying to visit. Professor along with lawyers have filed a class action lawsuit who claim the “**Google Ad sense for Domains**” (AFD) program is assisting in violating trademarks.

United States is the first country that criminalises Typo squatting by enacting a law ‘The Truth in Domain names Act’ in 2003. The ‘Truth in Domain Names Act, 2003’ is to prevent the use of fraudulent domain names for the purpose of alluring surfers to adult websites, But numerous nations lack any particular legislation to tackle ‘Typo squatting’ and the courts in such countries apply traditional trademark law on typo squatting cases. The traditional trademark law is only an alternative but not a solution to typo squatting and because of lack of any particular law against typo squatting. Typo squatter easily get an opportunity to spread this menace.

The word ‘Typo squatting’ has been allegedly coined by famous typo squatter John Zuccarini to describe his conduct of registering common misspellings of well – known domain names. John Zuccarini is one of the worst known Typo squatter in virtual world. He typo squatted more than 5000 domain names to divert Internet surfers and earned over million dollars.

Typo squatting, also called URL hijacking, is based on the probability of a considerable number of Internet users would make typographical error while netsurfing. The two typo squatting methods adopted by typo squatters for their evil intent of Typo squatting are “Mouse trapping” and “Redirecting.”. Either a Typo squatter adopts method of “Mouse trapping” or “he relies

upon “Redirecting” technique. Apart from these two methods, an important process followed by a Typo squatter is “Domain Name Tasking”.

Typo squatters make money by putting pay-per-click ads on their typo squatted web pages. The ads are generated by keywords relate to the misspelled product, for example, for Nokia typos , one might see ads for cell phone accessories , ring tones or calling plans. Typo squatting becomes profitable through continuously clicking on various ads which open one by one constantly. It is quite clear beyond doubt that no single misspelled domain name will generate enough profit to provide a living to the typo squatter, but a large portfolio of even slightly profitable domains can generate significant income.

Professional Typo squatters often hold domain portfolios in thousands or more because individual domains may return only a few dollars but when multiplied by thousands, those few dollars can become significant.

Remedies against Typo squatting -

A domain name owner who becomes victim of Typo squatting usually sends a **cease and desist** letter to the offender at first stage in order to stop the infringing activity. Moreover, he may also try to purchase the domain name from the typo squatter, which could have been the typo squatter’s aim. And if the typo squatter does not cease the activity then lawsuits will be filed against the offending site or typo squatter.

There are two types of remedies available against a typo squatter:

- **Administrative remedy-** a person can file a petition in World Intellectual Property Organisation’s (WIPO) Arbitration and mediation centre under UDRP (uniform domain name dispute resolution policy) established by ‘Internet Corporation of Assigned Names and Numbers’ (ICANN) . In India, .IN Domain Name Dispute Resolution Policy (INDRP) was formulated by .IN Registry which is applicable for .in domain names.- **Civil Remedy** –a person can file a civil suit in a court of law against Typo squatter under traditional trademark law of the country or under any other concerned statute, if exists.

In addition to it , there are technologies in the market to tackle Typo squatting, for example, Microsoft has released a software “*Strider Typo-patrol* “ to help in combating Typo squatting. This is a tool that scans and shows third-party domains that are allegedly typo squatted. It also

lets parents restrict access to typo squatted domains that show sexually oriented ads on children's websites.

In US, the first case under the *Truth in Domain Names Act, 2003 (TDNA)* was brought case against John Zuccarini, and he was incarcerated in September 2003 in Florida. The TDNA, 2003 was proved effective as under the act, the most notorious Typo squatter John Zuccarini sentenced to imprisonment.

Other types of Cybersquatting are as follows:-

b.) Combo squatting –

Combo squatting relies upon the term “combo” in place of misspellings and popularly known trademarks. The results of the test found that using an online form is better than targeting misspellings and that it is catching on fast. *'disneyworldamusement.info'* is an example of a combo squatting URL.

c.) Name Jacking –

Name Jacking occurs when an individual registers domain names, often resorting to someone of prominence. Name jackets (name tags) benefit from domain traffic generated through the name of a specific well – known individual. In the field of domain name theft, the best example is madonna.com, the mirror domain the name of an American Pop Singer Madonna.

(VI) LEGAL SCENARIO IN INDIA TO COMBAT CYBERSQUATTING

In India, there is no legislation at place to tackle this menace of Cybersquatting, even there are no particular provisions under the Information Technology Act, 2000 to deal with cybersquatting. Our law makers hardly respond against this problem of Typo squatting despite the fact that this illegitimate activity is universal in nature. The only remedy is to bring an action under the Trademarks Act, 1999, the sole enactment to safeguard domain name in India. Generally, the Courts across the world applied their respective Trademark Laws in order to resolve domain name disputes.

In India, the legal development in this respect has been made by various judicial pronouncements. However , the term “Typo squatting was not categorically mentioned in the

very first case in India pertaining to Typo squatting, decided by Delhi High Court⁹, which was *Yahoo Inc. V Aakash Arora & Anr*¹⁰. In this famous case, the defendant launched a website almost identical to the plaintiff's popular website and also provided similar services. Here the Court delivered a decision in favour of trademark rights of U.S. based Yahoo.Inc (the Plaintiff) and against the defendant (a typo squatter), that had registered itself as YahooIndia.com.

The Delhi High Court dismissed the argument that the provisions of the Indian Trademark Mark Act would not be applicable to the matter of the domain trade name or domain name on the Internet. The Court noted, "It was an effort to do business on the status and popularity of yahoo's trademark. A domain name registrant does not possess any legal right to use that specific domain name merely because he has registered the domain name, he could be still be liable for trademark violation., **This was the very first case in India in which a trademark law applied in a domain name dispute.**

It is to be noted that the lack of particular law does not prevent the Courts from taking action against typo squatters. In *Satyam Infoway Ltd. V Sifynet Solutions Pvt. Ltd*¹¹, the Supreme Court held that "**India lacks any such legislation which explicitly entails the method of dispute resolution pertaining to domain names.**" But although the applicability of Trademarks Act, 1999 per se is not extraterritorial and may not permit for sufficient safeguard of domain names, this does not mean that domain names are not to be legally protected to the extent possible under the laws relation to passing off.

(VII) INDIAN JURISPRUDENCE ON DOMAIN NAME

A significant case that led to the evolution of Indian jurisprudence on a domain name is a Rediff case. In *Rediff Communication Ltd. V Cyber booth and Another*¹², Bombay High Court, observed that – "A domain name is not restricted to merely an Internet address, but it is more than that and has a right to get equivalent protection like trademark." In this matter, the plaintiff moved an application for an injunction against the defendant who had registered the domain name in the likeness of the domain name of the plaintiff, claiming that such domain name was deceptively similar to theirs. There was a common field of activity. The judge was satisfied

⁹ *Ibid*

¹⁰ 1999 IIAD Delhi 229, 78 (1999) DLT 285.

¹¹ 2004 (3) AWC 2366 SC

¹² 1999 (4) BomCR 278

that there was an apparent intention to deceive and that the only purpose of registration by the defendants was to trade on the goodwill and reputation of the plaintiffs.

*Satyam Infoway Ltd. V Sifynet Solutions (P) Ltd.*¹³ – This very case is believed to have changed the course of Indian domain name scenario way back in 2004. The Supreme Court in this matter, laid down the observation that – “India lacks any such legislation which explicitly entails the method of dispute resolution pertaining to domain names.” But although the applicability of Trademarks Act, 1999 per se is not extraterritorial and may not permit for sufficient safeguard of domain names, this does not mean that domain names are not to be legally protected to the extent possible under the laws relation to passing off. The judgement in this matter favoured plaintiff, where the defendant had registered domain names and which were akin to plaintiff’s domain name. The Court remarked that **domain names possessed all the features of trademark and an action of passing off can be resorted to, in the matters involving domain names.**

(VIII) MODES OF RESOLVING DOMAIN NAME DISPUTES¹⁴

At International Forum

a.) *ICANN Dispute Resolution Policy* – A trademark is protected by the laws of a country where such trademark has been registered. Moreover, a trademark might have umpteen registrations in numerous countries across the globe. Since the Internet permits us for the reach without any geographical boundaries, a domain name is reachable regardless of the geographical location of the consumers. This will be beneficial for the universal connectivity which will grant domain name worldwide exclusivity and also many times the national laws might be inadequate to effectively protect a domain name. The International regulation was into action through WIPO and ICANN. India is one of the 171 states of the world which is a member of WIPO. Services unleashed by WIPO to its member nations entail the provision regarding a forum for the drafting and execution of intellectual property policies internationally through treaties and other policy instruments.

The base of the ICANN (Internet Corporation for Assigned Names and Numbers) in 1998 as a worldwide internet administration and the introduction of UDRP (Uniform Domain

¹³ 2004 (3) AWC 2366 SC

¹⁴ Pratibha Ahirwar, “India: Domain Name Disputes and Cyber Squatting in India – Part II” mondaq connecting knowledge and people , February 26, 2019, available at: <https://www.mondaq.com/india/trademark/784296/domain-name-disputes-and-cybersquatting-in-india-part-ii> (last visited on June 21, 2022)

Name Dispute Resolution Policy) in 1999 for actual and cost efficient International domain name disputes. This has been one of the most remarkable events in the past, particularly for solving international legal problems originating through the nature of borderless internet on the one hand and IP rights of some users on the other side of the spectrum.

b.) Uniform Domain Name Dispute Resolution Policy¹⁵ – ICANN has adopted the Uniform Domain Name Dispute Resolution Policy (UDNDRP or UDRP), the policy for resolution of domain name disputes. This policy caters to the arbitration of disputes in place of litigation regarding domain name disputes. According to this policy, any person (complainant) is entitled to initiate an action on the basis that:-

- A domain name is identical or confusingly akin to a trademark or service mark regarding which the complainant possesses rights.
- The domain name owner is bereft of rights or legitimate interests in the domain name.
- The domain name is registered and is used bonafide

But the complainant is bound to substantiate all these ingredients if he wishes his action to succeed. If the unlawful registration is substantiated, the domain name registration is revoked, but hardly any financial remedies are provided to him.

The **Uniform Domain Name Dispute Resolution Policy (the UDRP Policy)** lays down the legal framework for the adjudication of disputes between a domain name registrant and third party over the unlawful registration and use of an Internet Domain in a generic top level domains or gTLDs (eg., .biz, .com, .info, .mobi, .name, .net, .org), and those country code top level domains or ccTLDs that have embraced the UDRP policy voluntarily. At its meetings on August 25 and 26, 1999 in Santiago, Chile, the ICANN Board of Directors adopted the UDRP Policy, based largely on the recommendations entailed in the **Report of the WIPO Internet Domain Name Process**, including comments which have been submitted by Registrars and other interested parties. All **ICANN – accredited registrars** that are authorised to register names in the gTLDs and ccTLDs that have adopted the policy have agreed to abide by and implement it for those domains. Any person or entity looking forward to registering domain names in the gTLDs and ccTLDs in question is supposed to be in consonance with the terms and conditions of UDRP Policy.

¹⁵ WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP), *available at:* <https://www.wipo.int/amc/en/domains/guide/> (last visited on June 21, 2022)

On October 24, 1999, the ICANN Board embraced a bundle of rules for Uniform Domain Name Dispute Resolution Policy (UDRP Rules) lays out the procedures and other requirements for each level of the dispute resolution administrative procedure. The procedure is governed by dispute resolution service providers accredited by ICANN. The **WIPO Arbitration and Mediation Centre (WIPO Centre)** is one such dispute adjudication service provider.

The WIPO centre has been instrumental as technical advisors to the ICANN drafting committee charged with giving the final push to the UDRP Policy and Rules.

Who can use the UDRP Administrative Procedure?

Any person or company across world could initiate filing a domain name complaint regarding a gTLD , complying with the UDRP Administrative Procedure.

In case of a dispute involving a domain name registered in a ccTLD, the UDRP Administrative Procedure can also be used, provided that the concerned ccTLD registration adopted the UDRP Policy on a voluntary basis. This information is laid down in the overview of all ccTLDs for which WIPO unleashes dispute resolution services.

What kind of disputes are addressed by the UDRP Administrative Procedure?

According to the paragraph 4 (a) of the UDRP Policy , the UDRP Administrative Procedure is only available for disputes concerning an alleged abusive registration of domain name , that is , which meet the following criteria :-

- The domain name registered by domain name registrant is identical or confusingly akin to the trademark or service mark in which the complainant possesses rights
- The domain name registrant is bereft of rights or legitimate interests concerning the domain name in question
- The domain name has been registered and is being used with malafide intent.

What circumstances are evidence that domain name has been registered and is being used in bad faith?

Paragraph 4 (b) of the UDRP Policy sets out the following *examples* of circumstances that will be considered by an Administrative Panel to evidence of the bad faith registration and

use of a domain name:-

- i. Circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the domain name registrant's out of pocket costs directly to the domain name; or
- ii. The domain name was registered in order to prevent the owner of trademark or service mark from reflecting the mark in a corresponding domain name, provided that the domain name registrant got indulged in a loop of such conduct.
- iii. The domain name was registered primarily with an aim to subvert the business of the competitor; or,
- iv. By making use of the domain name, the domain name registrant intentionally made an effort to get financial gain, internet users to the registrant's website or other online location, by leading to a possibility of confusion with the complainant's mark as to the origin, sponsorship, affiliation or endorsement of the registrant's website or location or of a product or service on the registrant's website or location.

The above-mentioned examples are not isolated and other circumstances might prevail that shows the registration and use of a domain name with malafide intent.

Advantages of the UDRP Administrative Procedure –

The main benefit of the UDRP Administrative Procedure is that it categorically provides a swift and cost efficient means to adjudicate the dispute concerning the registration and use of an Internet Domain Name than going to the Court. Apart from this, the procedures are comparatively casual than litigation and the decision makers are experts in such areas as International trademark law, domain name issues and electronic commerce, the internet and dispute resolution. It has also got an International scope: it provides a singular method for adjudicating domain name disputes irrespective of where the registrar or the domain name holder or the complainant are located.

Can recourse to the Courts be taken, besides relying upon the UDRP Administrative Procedure?

Yes, **Paragraph 4 (k)** of the UDRP Policy provides that the compulsory administrative proceeding requirement shall not avert either the domain name registrant (Respondent) or the

third party (Complainant) from submitting a dispute to the Court of competent jurisdiction for independent resolution. There exists a possibility for a party to initiate a lawsuit in a court **before** an administrative proceeding has begun. A party can also file a legal case **after** the administrative proceeding is summed up, in case the party is not content with the result.

Paragraph 18 of the **UDRP Rules** sets out what action an Administrative panel may resort to, if Court proceedings have begun prior to or during an administrative proceeding.

It is pertinent to take a note of this fact - that UDRP Administrative Procedure cannot be used to bring a case against a Registrar with whom you have registered a domain name, because, he UDRP Administrative procedure is only available to resolve disputes between a third party alleging an abusive registration of a domain name and the domain name registrant.

Various Stages in the UDRP Administrative Procedure are –

The five basic stages in the Administrative Procedure are:-

- The filing of a Complaint with an ICANN – accredited dispute resolution service provider chosen by the complainant, such as the WIPO Centre.
- The filing of a Response by the person or entity against whom the Complaint was made.
- The appointment by the chosen dispute resolution service provider of an Administrative Panel of one or three persons who will decide the dispute
- The issuance of the Administrative Panel's decision and the notification of all the relevant parties
- The implementation of an Administrative Panel's decision by the registrar(s) concerned.

The Administrative Procedure normally should be completed within 60 days of the date of the WIPO Centre receives the Complaint.

Is the UDRP Administrative Procedure Confidential?

Following the formal commencement of an Administrative Proceeding, the WIPO Centre publishes on its website the domain name(s) in issue, the date of formal commencement of administrative proceeding and the status of the case. The WIPO centre also makes available on its website the decisions rendered under the UDRP policy in accordance with Para 16 of the

UDRP Rules, by the case number or by topic through searchable index.

The WIPO centre will normally not disclose any other information about the proceedings.

c.) WIPO Arbitration and Mediation Centre Decisions on Domain Names –

World Intellectual Property Organisation is the principal domain name dispute resolution service provider under the UDRP and is accredited by ICANN. WIPO provided experts panellist, thorough and swift administrative procedures, and overall objectivity and believability. A domain name case filed with WIPO is normally concluded within two months, using online procedures, and a minimal fee is charged. Only extraordinary cases are heard in person.

(IX) MODES OF DEALING CYBERSQUATTING AT NATIONAL LEVEL¹⁶

In India, there is hardly any law that expressly makes a mention of cybersquatting or other domain name disputes. The Information Technology Act, 2000 (IT Act), which deals with numerous cybercrimes, has not paid heed to the problems of domain name disputes and cybersquatting. Although, domain names might be construed as trademarks on the basis of its use and brand reputation. In the absence of appropriate law that deals with cybersquatting, victims can initiate an action for passing off and infringement of trademarks under the Trademark Act, 1999. Other modes are as follows:-

The ".IN" Dispute settlement Policy (.INDRP) was developed by the.IN Registry for the domain name dispute settlement in India in response to these problems. According to the.INDRP, it complies with the regulations of the Information Technology Act of 2000 and generally acknowledged best practises. The.IN Registry operates as an independent agency within the National Internet Exchange of India (NIXI), with primary responsibility for managing the.IN ccTLD and guaranteeing its operational stability, dependability, and security. Anyone who thinks, that the registered domain name interferes with his or her legal rights or interests may initiate proceedings at the.INDRP on the grounds that

- The registrant's domain name is identical or confusingly akin to a name , trademark or service mark in which he possesses rights , or
- The registrant has no rights or legitimate interests in respect of that domain name, and

¹⁶ *Supra* note 14

- The domain name has been registered or is being used with malafide intent. The registrant is bound to submit to a mandatory arbitration proceeding, in case if a complaint is lodged. The .IN Registry appoints an arbitrator to proceedings in accordance with Arbitration and Conciliation Act, 1996. The arbitrator usually considers the domain name registered and is used in bad faith in circumstances when :
- The registrant has acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the registration to the owner of trademark or service mark , or to rival of the complainant,
- The registrant has registered the domain name in order to prevent the owner of 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
- The registrant has intentionally attempted to attract Internet users to his website or other online location, by creating a likelihood of confusion with a complainant's name or mark as to the origin, sponsorship, affiliation, or endorsement of the registrant's website.

In the case of *Starbucks Corporation V Mohan raj*,¹⁷ the respondent's domain name www.starbucks.co.in was confusingly similar to the complainant's domain name www.starbucks.in, it was contended that the domain name of the respondent is identical and confusingly similar to the complainant's domain name, additionally, it was argued that the respondent had no rightful claim to the domain name. Furthermore, it was argued that the respondent utilised the mark dishonestly. The learned arbitrator determined that the complainant had rights to the trademark and that the contested domain name was confusing, similar, and identical to them. The respondent had registered the domain name in bad faith and so the domain name should be transferred to the complainant.

In the case of *Morgan Stanley V Bharat Jain*,¹⁸. The respondent registered the impugned domain name www.morganstanleybank.co.in on June 20, 2010. The complaint claimed that the ccTDL ".co.in." extension was inadequate to distinguish the contested domain name from the complainant's mark MORGAN STANLEY. The contested domain name was therefore confusingly similar to the mentioned mark.

¹⁷ Case Number INDRP/118, decided on November 26, 2009

¹⁸ Decided on October 28, 2010

In the case of *GOOGLE Inc. V Gulshan Khatri*,¹⁹ The complainant filed the instant complaint challenging the registration of domain name in favour of the respondent, the grievance of the complainant was regarding the latter's act of adopting identical domain name and that too in respect of similar services of the respondent.

The learned arbitrator held that the disputed domain name was identical and confusingly similar to the other prior registered domain name and registered trademark of the complainant and ordered the registry to cancel the said domain name forthwith and transfer the said domain name in favour of the complainant.

In 2018, October 10 the .INDRP had restricted the respondent from making use of the domain name and transferred the domain name to the complainant.

Judicial Precedence – There has been numerous instances of cybersquatting in the past few years in India. The courts always deal with matters related to domain names disputes and cybersquatting. In India one of the earliest judgements on cybersquatting was from Bombay High Court in the case of *Rediff Communication V Cyber booth*²⁰ – In this case the Court was of the opinion that value and importance of domain name is like a corporate asset of the company. The domain name radiff.com, which was identical to rediff.com in this instance, was registered by the defendant. The Court held that Internet domain names are significant and may be a valuable company asset. These domain names are more than just an Internet address, and they should be given the same level of protection as trademarks. The plaintiff was awarded a victory by the court.

(X.) LEGISLATION IN U.S.A.: “Anti cybersquatting Consumer Protection Act (ACPA).”²¹

The United States has been proactive in curbing cybersquatting and it is indicated by the fact that for addressing this issue, it even came forward with a legislation at place, named *Anti*

¹⁹ Decided on May 6, 2011

²⁰ 1999 (4) BomCR 278

²¹ *Tenesa S.Scaturro* “THE ANTICYBERSQUATTING CONSUMER PROTECTION ACT AND THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY, THE FIRST DECADE: LOOKING BACK AND ADAPTING FORWARD”, available at: <file:///C:/Users/Dell/Documents/The%20Anticybersquatting%20Consumer%20Protection%20Act%20and%20the%20Uniform%20Do.pdf> (last visited on June 21, 2022)

cybersquatting Consumer Protection Act (ACPA)

On November 29, 1999 President Clinton signed the ACPA into law, which provides liability for cybersquatting when a person with malafide intent to earn profit registers, or uses a famous or distinctive trademark as a domain name.

Four components must be fulfilled to prove cybersquatting under the ACPA:

- 1.) The registrant has a bad faith intent to profit,
- 2.) The registrant registers or uses a domain name,
- 3.) The domain name is popular or distinctive,
- 4.) The domain name is identical or confusingly similar, or in the case of famous mark, dilutive.

Decoding the components

Under the **first component of ACPA**, the domain name registrant must have a bad faith intent to profit to be liable for cybersquatting. To help the Courts to figure out what constitutes bad faith under the ACPA , Congress provided a non – exhaustive list of factors : (a.) the registrant has no apparent trademark rights in the domain name , (b.) the domain name does not contain any of the registrant’s legal names, (c.) the registrant has not made any bonafide, non-commercial or fair use of the domain name (d.) the registrant has used the domain name in commercial manner, (e.) the trademark was distinctive or famous name at the time the registrant registered the domain name , (f.) the registrant has registered other domain names containing the trademarks of others , and, (g.) the registrant has offered the domain name for sale.

However, the rights of trademark owners were an important concern in enacting the ACPA, Congress proposed that there needs to be strike a balance between the property interest of trademark owners and the rights of web users to lawfully use trademarks for “comparative advertising, comment, criticism, parody, news reporting, and fair use, among other things. Courts have found that “otherwise lawful” uses of domain names include so grip sites and parody. Although because many domain name registrants could attach legal reasons for their use of domain names, the registrant’s reasonable belief requires more than plausibility. As one Court observed, “All but the most blatant cyber squatters would be able to bring forward at least some bonafide and lawful motives for their behaviour. To hold that all such individuals may qualify for the safe harbour would defeat Congress’ purpose by mechanically restricting the statute’s reach.

Under the **second ACPA component**, a registrant must register traffic. In, or use a domain name. However, not defined by the ACPA, the registering of a domain name apparently seems to be self – explanatory. Similarly, use is not defined in ACPA. Although, *traffics in* has challenged courts construing this provision of ACPA. The ACPA has provided an illustrative definition of what it entails: “Traffics in “refers to transaction that include, but are not restricted to sale , purchases , loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration. One Court has construed this language to mean” a direct transfer or receipt of ownership interest in a domain name.”

Under the **third ACPA component**, the trademark contained within the domain name must be famous or distinctive. The factors that could be taken into consideration by Courts to examine whether a trademark is famous – (a.) the duration, extent and geographical reach of advertising; (b.) amount, volume, and geographical extent of sales, (c.) extent of actual recognition of the trademark. A trademark is distinctive if it is either inherently distinctive or has acquired secondary meaning, that is to say that the consuming publics links the mark with a particular source.

Under the **fourth and the last component of ACPA**, the domain name must contain a mark that is identical or confusingly similar to the trademark owner’s mark. This is a narrower test than the likelihood of confusion test for trademark violation under the Trademark Act, 1946. To find out whether a domain name is confusingly similar to a trademark all that is required is a simple comparison to trademark at issue. Courts will determine whether a domain name is confusingly similar to trademark if consumers might think that the domain name is used, approved or permitted by the mark holder. Examples of domain names that have been found to be confusingly similar to trademarks include <4fordparts.com> (confusingly similar to FORD).

(XI) COMPARATIVE ANALYSIS OF LEGAL APPROACH IN USA V INDIA

The legislative approach of United States against Typo squatting is more advanced than that of India and it is evident from the fact that the US Congress passed a law on typo squatting in 2003 and even before that it already had ACPA enacted in 1999 which is applicable to both Cybersquatting as well as Typo squatting, whereas in India still no law has been enacted by legislature against typo squatting. Although it is only Indian Judiciary that has been trying its

level best to adjudicate domain name disputes like Typo squatting by applying traditional trademark law to such disputes. It is imperative for the Indian Parliament to soon come up with the legislation that can effectively curb this menace. Laws against typo squatting are unlikely to have major effects on typo squatting practise unless all the countries enact similar laws on the issue. Thus, a uniform law on Typo squatting across the globe would definitely give a blow to Typo squatting.

(XII) CONCLUSION & SUGGESTIONS

In the course of entire research, we got acquainted with the significance of Domain Names in the Virtual world , the nexus between the trademark and domain names as well as the ill practices associated with the domain names that leads to the domain names conflicts , We have even come across the evolution of the concerned law at the national as well as International forum , where we discovered , that at an International level there are several modes to rely upon while seeking remedy against Cybersquatting , whereas , in our own Nation (India) we are still bereft of any law that explicitly provides the mechanism to handle domain name disputes, Indian Courts have continued to resort to the traditional trademark law of the country while handling such cases, having said that , despite a lack of legislation in India, Courts have been proactive in protecting the rights in regard to domain name disputes , as it evident from the judicial precedent set over the years through the various judicial pronouncements. But, on the comparative analysis with the U.S.A., we have seen that there been specific laws to adjudicate these matters, such as Anti Cybersquatting Consumer Protection Act, 1999 and The Truth in Domain Name Act, 2003, both these legislations have proved to be effective in its operation. Like U.S.A., other countries, including India too, should bring forward the special law particularly to deal with Cybersquatting, provided all the countries should enact similar law to combat this evil, as the uniform law, across the nations, could provide a worthy outcome.