

DOMAIN NAME DISPUTE RESOLUTION WITH RESPECT TO TRADEMARKS: LEGAL SOLUTIONS TO IT

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Abstract

In this study an endeavour will be made to examine about the concept of Domain Name Dispute Resolution. E-commerce and its link with Domain name disputes will be discussed. Domain names have been used as web addresses and their link with commercial activities on the net make them a business identifier. An attempt has been made to draw a comparison between trademark and web addresses. Various types of domain name disputes have been discussed. Indian framework with respect to domain name dispute has been thoroughly discussed along with cases.

In the last half of the paper the international legal framework of the domain name disputes has been studied. Remedies may be obtained in the two forums of Judicial Remedy and Arbitration Remedy. Judicial Remedy with respect to statutes in United States and the traditional remedy of passing off in operation in other countries and Private arbitration under the Uniform Domain Name Dispute Resolution Policy (UDRP) promulgated by the Internet Corporation for Assigned Names and Numbers (ICANN) is within the domain of this paper. Various Cases will be discussed with respect to these policies. At last we have debated about the difference between INDRP and UDRP and various loopholes in it has been analysed.

Keywords: Domain, Addresses, Trademarks, UDRP, INDRP

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INTRODUCTION

Internet has evolved from a United States government research project into a major medium of Communication. The Evolution of Domain name Systems (DNS) has facilitated international commerce and global exchange of knowledge.¹ Domain names are internet addresses that help users to locate the websites. It has assumed key role in E-Commerce. It facilitates the ability of consumers to navigate the Internet to find the websites and also Facilitates Business by serving to Identify and distinguish the business itself or its goods and services and to specify its Internet Location. E- Commerce is a very common term for the Current Generation. Commerce Conducted through electronic media facilitates an array of Activities including buying, selling, trading, advertising and transaction of all kinds which are conducted by processing and transmission of digitalized data. The Concept of Intellectual Property holds an importance in E-Commerce as otherwise they can be stolen or Pirated .Trademarks also form an integral part of The Web Business as is Branding, Customer Recognition, and goodwill. Several challenges have always appeared in the administration of E-Commerce and Trade. One of them being unauthorized copying of content causing loss of revenue of the owner of Rights. Disputes of Domain Names arise at the intersection of international trademark law and internet. Domain names having acquired increasing significance as business identifiers gave rise to policy questions due to conflict between domain names and standard intellectual property rights. The Domain name systems have a global presence where the standard IPR system has a territorial basis leading to notable disputes regarding well known trademarks being registered by entities having no relation to those trademark rights. Cybersquatting disputes are on a growing number reflecting it to be a premium business place.² To reconcile the disputes and complexities created by domain name disputes, a few remedies to has been developed by which the aggrieved parties can get their rights. The two most notable forums include - traditional litigation or private arbitration under Uniform Domain Name Dispute Resolution Policy (UDRP) promulgated by the Internet Corporation for Assigned Names and Numbers (ICANN).

¹ Lisa M. Sharrock , *The Future Of Domain Name Dispute Resolution: Crafting Practical International Legal Solutions From Within The UDRP Framework* http://www.jstor.org/stable/1373211?Search=yes&resultItemClick=true&searchText=domain&searchText=name&searchText=dispute&searchText=resolution&searchUri=%2Faction%2FdoBasicSearch%3FQuery%3Ddomain%2Bname%2Bdispute%2Bresolution%26amp%3Bacc%3Don%26amp%3Bwc%3Don%26amp%3Bfc%3Doff%26amp%3Bgroup%3Dnone&seq=1#page_scan_tab_contents (Last accessed Feb 9th, 2015)

² Shahid Alikhan and Raghunath Mashelkar, *Intellectual Property and competitive strategies in the 21st century* 193-195 (2d ed,2011)

TYPES OF DOMAIN NAME DISPUTES

Cybersquatting

Cybersquatting is registering, selling or using a domain name reflecting the trade mark or brand name of another existing company for the purpose of making profit. Cybersquatting thus means occupying or buying domain name containing another person's trademark or brand name. Here the cyber squatter buys the domain name having the names of existing brands and then sells them to the lawful owners at a premium thus making huge money out of such transaction. A person who has nothing to do with the domain name thus pirates it to earn profits. For instance if yahoo.com is registered as yahoo.org with a top level domain or wwwyahoo.com by omitting a dot symbol or yaho.com by deliberate misspelling or yahoos.com, these are different ways in which cybersquatting can be done. Many countries have legislations to prevent cybersquatting, in US there are anti-cybersquatting consumer protection act (ACPA) along with this they have Federal trademark dilution act, 1995 that use doctrine of dilution to grant remedies to trademark owners. The Federal trademark dilution act, 1995 gives protection to the existing trademarks from those uses which dilute its distinctiveness. To come under the purview of this act a mark must be famous and the cyber squatter's use must dilute its distinctiveness. ACPA enables the owner to file a civil suit if someone uses his trade mark in bad faith to gain profit.

Profit grabbing

In this type of domain name dispute one registers the domain name that is identical or confusingly similar to the trademark or trade name of other in order to procure profit by making the website in such a way that misleads the users in believing that real owner of the trade name is the domain name registrant and no other person. It differs from cybersquatting in a way that in cybersquatting profit is made by selling back domain names to its lawful owners but in profit grabbing the registrant uses the brand name of a company in his domain and makes profit by making a site in a way that the users believe that real owner of the trade name is the registrant. In United Kingdom and Indian countries, law of passing off is applied to govern cases which involve profit grabbing. For instance in *Satyam Infoway Ltd. V Sifynet Solutions Pvt Ltd*. The Supreme Court held that internet domain names are subject to the legal norms applicable to other intellectual properties such as trademarks and the principles of trademark law and in particular to those relating to passing off would apply.

Misspelling/Typo squatting

Numerous individuals register Domain names which seem, by all accounts, to be like effectively existing Domain names. The distinction between profit Grabbing and Typo squatting is that in profit grabbing the defendant registers a domain name similar to a trade-name with the intention of trading with it, but in typo-squatting the defendant registers a domain name which is similar to an existing domain name. These entities mostly sell advertisements rather than products and services. Indian Courts use the principle of Passing off to decide cases of Typo-squatting.

Concurrent Claims

Concurrent claims are involved when two legitimate parties are involved in a dispute and both of them claim that they are the legitimate owners of the acquired domain names on account of using similar marks in their respective businesses. In the real world different people can use the same trade name due to different jurisdiction and different class of goods sold by them but when it comes to domain name a problem might arise as both will want to use their traditional names as domain names but domain names can identify only one site and is unique to that site. The remedies to it are sought in law relating to trademark, passing off, and unfair competition. Courts in cases of conflict usually give remedies against the parties who have unauthorized domain names.³

INDIAN FRAMEWORK**Overview**

The use of internet in the field of education, commerce, trade has increased rapidly in the recent times which in turn increase the significance of domain names. In this scenario an efficient policy regulating the registration and addressing various issues of dispute resolution is indispensable. An .IN Internet domain name policy framework and implementation plan has been formulated and the policy was announced by the Government in October 2004. In January 2005, the Ministry of Communications and Information Technology, through the Department of Electronics and Information Technology (DeitY) and National Internet Exchange of India (NIXI) took the important step of setting up a state-of the art, hardware

³ Pankaj Jain and Pandey Sangeet Rai, Copyright and Trademark Law relating to computers, 120-135 (1d ed. 2005)

and software and recreated the .IN country code top level domain (cc TLD) Registry. For resolving the domain name disputes pertaining to the .IN domains the NIXI has evolved an Dispute Resolution mechanism namely .INDRP (.IN Domain Name Dispute Resolution Policy).⁴ .IN Dispute Resolution Policy was formulated by IN registry to resolve domain name disputes in India. It sets out terms and conditions to resolve disputes between the Registrant and the aggrieved person, arising out of the registration and use of the .in Internet Domain Name. The INDRP is in line with UDRP and other internationally accepted rules and policies. It is a policy applicable to country code top level domain (cc TLD) names⁵. In India the .IN domain names are registered with IN Registry which operates as an autonomous body under NIXI.

TYPES OF DISPUTES AND PROCEDURE FOR RESOLUTION

If any registered domain name is violating the rights of any person on the grounds that –

- The registrant's domain name is confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- The Registrant has no rights or legitimate interests in respect of the domain name; and
- The Registrant's domain name has been registered or is being used in bad faith.⁶

Arbitration proceeding is mandatory in the event of filing a complaint to the .IN Registry. The .IN Registry website publishes a list of arbitrators and appoints an arbitrator out of the list maintained by it. Such arbitrators carryout the arbitration proceedings according to the Arbitration & Conciliation Act 1996. The arbitrator is appointed by the registry only after a prescribed fee is paid to the registry and when a copy of the complaint is sent to the respondent. Once the arbitrator has negotiated a reasonable award he must forward a copy to the complainant, respondent and registry. The award is passed within 60 days of the commencement of the proceeding. The registry before appointing an arbitrator also gives five

⁴ Advertisement For Arbitrators, NIXI, <http://www.nixi.in/files/Arbitrator%20advertisement.pdf>(last accessed Feb 9th, 2015)

⁵ INDRP In India (.IN DISPUTE RESOLUTION POLICY) , S.S Rana & Co. , http://www.ssrana.in/Intellectual%20Property/Domain%20Names/DomainName_INDRP.aspx last acceded on 8.2.2015 (last accessed Feb. 9th , 2015)

⁶ IN Domain Name Dispute Resolution Policy (INDRP) , [https://registry.in/index.php?q=.IN%20Domain%20Name%20Dispute%20Resolution%20Policy%20\(INDRP\)](https://registry.in/index.php?q=.IN%20Domain%20Name%20Dispute%20Resolution%20Policy%20(INDRP)) (last accessed Feb 8, 2015)

days' time period to the complainant to rectify and error if the complaint is not according to rules and policy of the registry. The communication with the arbitrator must not be unilateral and must be according to the rules of the registry. The arbitrator allows hearing, the general rule being that hearings are not mandatory. Except in some circumstances the arbitrator gives his decision in writing stating the reasons to the registry within 60 days from the commencement of proceedings. The registry must communicate the decision to each party within 5 days.

The registry and the registrar are not involved in the proceedings they only provide information to the arbitrator about the registration and use of domain names. Thus the proceeding is free from any kind of biasness. The authorities are not even liable for the activities of the arbitrator, in other words arbitrator is the sole authority to settle the disputes, the work of the registry ends just after appointing the arbitrator. After that they just have to exchange information between the parties and nothing else. The remedies include cancellation of the domain names of the registrant or transfer of registration of the domain name in the name of the complainant. Arbitrator may also provide damages if necessary.⁷

ADVANTAGES OF INDRP

INDRP leads to compulsory contrivance of the resulting decisions apart from this the process is legit, neutral and effective to all as there is no biasness. The registry publishes all the disputed domain names, case status and decision on its site thus making the process lucid and clear. INDRP grants relief whenever a person's interest or rights are violated or where there is similarity between domain names of the registrant and trademark of the complainant whereas in UDRP identifies only three situations upon violation of which relief is granted. Therefore we can say that INDRP covers a broader range of issues.⁸

CASE STUDY

⁷ Dispute Resolution Procedure, S.S Rana & Co. , http://www.ssrana.in/Intellectual%20Property/Domain%20Names/DomainName_DisputeresolutionProcedure.aspx, (last accessed Feb 8th, 2015)

⁸ Differences Between UDRP and INDRP in India , S.S Rana & Co. , http://www.ssrana.in/Intellectual%20Property/Domain%20Names/DomainName_UDRPAndINDRP.aspx, (last accessed Feb 8th, 2015)

Morgan Stanley v Bharat Jain⁹

The domain name morganstanleybank.co.in was registered by Mr. Bharat Jain and the plaintiff contended that the respondent had no interest in the registered domain name and a mere extension of the cc TLD did not make the domain name distinctive and disparate and unrelated. He contended that the respondent had registered the domain name in bad faith just to make profit out of the domain name of the plaintiff. The arbitrator ruled in favor of the complainant and said that Mr. Bharat Jain was in no way related with the domain name and he was not allowed to use the brand name of the respondent.

Panavision International LP V Toeppen and Network Solutions Inc.(Case No. 97-55467)

The Toeppen argument was that the domain name was merely an address. The defendant further referred before the court a number of cases which were authority to the fact that neither registration of Domain name nor acceptance for registration constituted commercial use within the meaning of federal Trademark Dilution Act. The court however was of the view that Toeppen's use was not as benign as he suggests. The court observed that Toeppen traded on the value of Panavision's mark. So long as he held the Internet registrations he curtailed Panavision's Exploitation of the value of its trademark on the Internet.

THE INTERNATIONAL FRAMEWORK**Judicial Remedies in Domain Name Dispute***The Traditional Remedy of Passing off*

The United States ACPA has been one of the most specific anti cybersquatting law. Other countries may have their own local laws but the absence of any specific legislation in other places leads the courts to use traditional infringement remedies. Cases instituted get injunction based on the threat of passing off and determination that the activities are likely to be confusing or are generally deceptive.

The issue of Jurisdiction mostly arise where it is determined by the fact whether it is accessible in the specific district or not. Other countries like Korea, Japan are trying to frame laws taking reference from United States ACPA to form a part of their own common law.

⁹ Morgan Stanley, U.S.A. v. Bharat Jain, U.S.A. , NATIONAL INTERNET EXCHANGE OF INDIA, [file:///C:/Users/SCHOOL/Downloads/morganstanleybankcoin%20\(1\).pdf](file:///C:/Users/SCHOOL/Downloads/morganstanleybankcoin%20(1).pdf) (last accessed Feb 9th, 2015)

These remedies have their own limitations as they vary from nation to nation and as known to all the procedure of these litigations are very expensive and costly leading to the victims to succumb to the threat of cyber squatters. It thus discourages the litigants to file claims. WIPO (World Intellectual Property Organisation) thus noted a need for a cost effective method which has to be internationally consistent and accepted to apply efficiently and impartially to the disputes that arise.¹⁰

Arbitration Remedy

The remedies mentioned above are basically judicial remedies that are most popular and referred by all but these remedies are territorial in nature and thus cannot provide a comprehensive solution to a conflict of a global dimension. In response to these concerns about judicial remedies and the conflict between territorial trademark systems and the global dimension of the disputes, WIPO (World Intellectual Property Organisation) in June 1998 accepted a United States Proposal for a consistent international approach.¹¹ ICANN (Internet Corporation for Assigned Names & Numbers) an internet technical coordination body was assigned a task of creating an uniform administrative procedure for the resolution of disputes concerning generic top level domain registrations. ICANN was thus responsible for the management of the Internet Domain name system and the stable operation of the Internet root server system.¹²

UDRP (Uniform Domain Name Dispute Resolution Policy) promulgated by ICANN (Internet Corporation for Assigned Names and Numbers)

ICANN implemented most of WIPO's recommendations in its Uniform Domain Name Dispute Resolution Policy (UDRP). The UDRP represents a substantial departure from traditional international trademark law. Worldwide trademark issues generally have been tended to through perplexing and prolonged arrangements that result in multinational

¹⁰ Lisa M. Sharrock ,

THE FUTURE OF DOMAIN NAME DISPUTE RESOLUTION: CRAFTING PRACTICAL INTERNATIONAL LEGAL SOLUTIONS FROM WITHIN THE UDRP FRAMEWORK
http://www.jstor.org/stable/1373211?Search=yes&resultItemClick=true&searchText=domain&searchText=name&searchText=dispute&searchText=resolution&searchUri=%2Faction%2FdoBasicSearch%3FQuery%3Ddomain%2Bname%2Bdispute%2Bresolution%26amp%3Bacc%3Don%26amp%3Bwc%3Don%26amp%3Bfc%3Doff%26amp%3Bgroup%3Dnone&seq=1#page_scan_tab_contents (Last accessed Feb 9th, 2015)

¹¹ <file:///C:/Users/SCHOOL/Downloads/Dispute%20Resolution%20Procedures.pdf> (last Updated Feb 9th , 2015)

¹² Pankaj Jain and Pandey Sangeet Rai, Copyright and Trademark Law relating to computers, 137 (1d ed. 2005)

settlements. Be that as it may, these conventional systems are ill suited to the quick moving, dynamic universe of the Internet. The lawful group's reaction to this novel circumstance has been blended. Some propose that a drastically new arrangement of control must develop as an Internet common law, while others keep up the oppositely inverse view that customary legitimate standards can and ought to be the selective method for securing and observing the Internet.¹³ The UDRP sets out the legal framework for the resolution of framework for the resolution of disputes between a domain name registrant and a third party over the abusive registration and use of an Internet domain name. It applies to all domain name registrars who are accredited with ICANN. The UDRP is a set of contractual provisions signed between the Domain name registrants and ICANN approved registrars. Before a registrar can cancel, suspend or transfer a domain name that is subject to dispute it must have a agreement signed by the parties, a court order or an arbitration award. The UDRP basically formed a cyber-arbitration procedure which is conclusive on the registrants. The policy further provides for mandatory administrative proceedings. The parties to an UDRP case are Complainant, respondent, dispute resolution service provider (DRSP) , panel and a registrar. The procedure goes like filing of a complaint by the Complainant then Complaint Compliance Review by DRSP, Commencement of administrative proceeding by DRSP, Filing of response by Respondent, Appointment of panel by DRSP then comes panel decision. The decision is notified by the DRSP and then implemented by the registrar. It is obligatory for the registrants to submit a mandatory administrative proceeding in case a third party asserts that the domain name is identical to a trademark or service mark in which complainant has rights, registrant has no rights or legitimate interest in respect of the domain name and the registrants domain name has been registered and is being used in bad faith. If the circumstances indicate that the registrant has been making commercial gains for the purpose of hampering the business of the competitor or by using it has the intention to attract for commercial gain internet users to registrant's website or other online location, by creating a source of confusion with the complainant's mark as to the source, sponsorship or endorsement of a product on registrants website it shall be evidence of the registration and use of the domain name in bad faith.

However a domain name proprietor can successfully guard his registration by establishing that he also has certain definite rights as regards the domain name. The remedies available to a complainant in a UDRP proceeding are limited to the transfer of the disputed domain name

¹³ *supra* note 6

to the complainant, or the option of the cancellation of the domain name. Neither monetary nor injunctive relief is available. Decisions are taken by the panel on the basis of the submitted complaint and response, without oral hearing. If the panel decides the transfer or the cancellation of the disputed domain name, the concerned registrar will normally implement the decision within ten businesses. If the complaint is denied, the registrar will unlock the domain name for the benefit of the respondent. ICANN has come up with the dispute resolution policy which has been adopted by many organisations who have formed their own panels (WIPO, CPR, NSI) approved by ICANN. Panels have focussed mainly on bad faith registrations and the extent of legitimate interest. If a party loses a UDRP proceeding, in many jurisdictions it may still bring a lawsuit against the domain name registrant under local law. For example, the administrative panel's UDRP decision can be challenged and overturned in a U.S. court of law by means of e.g. the Anti cyber squatting Consumer Protection Act. If a domain name registrant loses a UDRP proceeding, it must file a lawsuit against the trademark holder within ten business days to prevent ICANN from transferring the domain name.

LEADING CASE BY WIPO

Vodafone Group Plc v. Steve Ruston (Case No. D2001-0403)

The complainant Vodafone alleged that Defendant had registered the disputed domain name 'vodafone.org'. The complainant had established its reputation in the famous mark of Vodafone. The panel thus held that the domain name be transferred to the complainant. The panel after going through the facts and evidence came to the conclusion that respondent had registered the domain name in bad faith and had attempted to sell the domain name to the complainant. The panel thus ordered the respondent to transfer the disputed domain name to the complainant.¹⁴

CONCLUSION

INDRP has many loopholes in its rules and regulations. The drawback of INDRP is that all the expenses with regard to the dispute are to borne by the complainant. In this case the complainant is burdened with the cost of the dispute which could have been distributed between the registry and the complainant with some expansion in the administrative panel.

¹⁴ Pankaj Jain and Pandey Sangeet Rai, Copyright and Trademark Law relating to computers, 142 (1d ed. 2005)

INDRP has made no provisions which can enable the complainant to file any complaint with any other court whereas in UDRP the procedure of appeal is present which gives the aggrieved a right to go to any other court to get justice. The UDRP has a lot of benefits including Rapid resolution, Cost effectiveness, International jurisdiction, Simple procedure, Consistency in decisions and availability of appellate process but still limitations do exist including the UDRP does not apply to approximately 150 cc TLDs, under the UDRP the standards are the domain holder's bad faith and absence rights or legitimate interests, panellists may come from different backgrounds and may not be familiar backgrounds and may not be familiar with trademark law. There is no possibility of monetary damages in a UDRP proceeding. That is probably the major reason some people prefer to take their chances with a lawsuit. Finally, it's possible that the arbitration won't be the end of the dispute. These are certain drawbacks whose existence makes it really disappointing. The passing off common law action has far-reaching effects but no courts have the power to grant a remedy in passing off action of transferring the domain name back to the plaintiff as according section 135 of the Trademark Act, 1999. The trademark act only allows them to restrain the defendants from using such domain names having similar or identical nature which has been acquired with no legitimate right. ICANN has been empowered to transfer the same from the defendant to the plaintiff but noticing the rising number of cases, courts must also be empowered to do so.