CHAPTER-VI

LEGISLATIVE, JUDICIAL AND NONJUDICIAL RESPONSE

1 Introduction

With the ever-expanding reach of Internet, it was just a matter of time when the Indian business houses and other legal persons got the taste of trademark trafficking in cyberspace. In fact, trademark jurisprudence in India was already vibrant with judiciary lending legal protection to registered and unregistered trademarks through Trade and Merchandise Marks Act, 1958¹ and the English Common Law of passing-off, respectively. However, with newer challenges posed by technology, there has been a constant tussle among the advocates of a sui generis mechanism to deal with cases pertaining to cyberspace on the one hand; and the status quo-ists on the other, who prefer application, suitable interpretation, and extension of existing laws to deal with new challenges.

As the world is fast transforming into a globalised² and borderless community with several trades and commercial undertakings benefitting -from the global reach of Internet, the domain names have suddenly become a hot property. The tussle for domain names first reached Indian courts in 1999.³ And since then, there has been a constant flow of domain name disputes reaching various High Courts in the country, though the Supreme Court has not been approached in too many cases.

² Glocalisation is a portmanteau word of globalisation and localisation. By definition, the term "glocal" refers to the individual, group, division, unit, organisation, and community, which is willing and able to "think globally and act locally." Source: http://en.wikipedia.org/wiki/Glocalisation. Last accessed on January 18, 2016
³ Yahoo! Inc. v. Akash Arora (1999) PTC (19) 201
2. Legislative Response in deal with Trademark Issues in Cyberspace

The Trade Marks Act, 1999\textsuperscript{4} the successor of Trade and Merchandise Marks, Act, 1958, did not differentiate between traditional trademark disputes and the trademark issues raised by the Internet. To make the matters worse, even the Information Technology Act, 2000\textsuperscript{5} and then, Information Technology (Amendment) Act, 2008\textsuperscript{6} refused to address the specific Intellectual Property issues in cyberspace. Resultantly, the Indian legislature made no extra efforts to draft specific legislation(s) dealing with trademark trafficking in cyberspace.

Therefore, the courts in India were left with the following indirect legislative provisions to aid them in deciding multifarious disputes relating to trademark trafficking in cyberspace:

(i) **Trade Marks Act 1999**: Section 134(1)(c) of the Trade Marks Act, 1999 provides that a suit for passing-off arising out of the use by the defendant of any trademark, which is identical with, or deceptively similar to, the plaintiffs trademark, whether registered or unregistered, shall be filed before a court, not inferior to a District Court. Further, Section 135 of the Trade Marks Act, 1999, provides that the jurisdictional District Court may grant injunction as a relief in a suit for passing-off.

Thus, a domain name dispute involving passing-off allegations by the plaintiff can be filed either in a court of District Magistrate or the High Court. The appeal from District Magistrate's order lies with the jurisdictional High Court and the appeal from the High Court's decision lies with the Supreme Court of India.

The order of the District Magistrate in a suit for domain names passing-off can take the form of issuance or refusal to issue temporary or permanent injunction to the respondent regarding the use of impugned domain name.

(ii) **Code of Civil Procedure, 1908:** The courts in India derive jurisdictional powers by referring Section 20, Code of Civil Procedure, 1908, which provides that the suit is to be instituted in the court:

(a) within the local limits of whose jurisdiction the defendant (or one of them) at the time of the commencement of the suit actually or voluntarily resides or carries on business or personally works for gain; or

(b) within the local limits of whose jurisdiction the cause of action, either wholly or in part, arises.

Further, a corporation shall be deemed to carry on business at its sole or principal office in India or, in respect of any cause of action arising at any place where it has also a subordinate office, at such place.

An application under Order 39 Rule 1 & 2 read with Section 151 of the Code of Civil Procedure, 1908, can also be filed for grant of temporary or ad interim ex parte injunction.

It implies that a court in India would have jurisdiction to entertain a domain name dispute, even if the defendant resides outside the country, in case the plaintiff establishes that the cause of action arose within the territorial jurisdiction of the court.

Considering the fact that the presence of the Internet can be felt wherever it can be accessible from, the fact that the Internet has no territorial boundaries and the fact that the effect of a bad faith registration of a domain name can be felt in India, it would be up to the court to be proactive and assert its jurisdiction by interpreting that the cause of action partly arose within its jurisdiction, in matters of domain name disputes.7

In **SIL Import v. Exim Aides Silk Importers,**8 the Supreme Court of India recognised the need for the judiciary to interpret a Statute by making allowances for any relevant technological change that has occurred. Until there is specific legislation in regard to the jurisdiction of the Indian Courts

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8 (1999) 4 SCC 567
with respect to Internet disputes, or unless India is a signatory to an
International Treaty under which the jurisdiction of the national courts and the
circumstances under which they can be exercised are spelt out, the Indian
courts will have to give a wide interpretation to Section 20 of the Code of
Civil Procedure, 1908, for exercising Internet Disputes.

(iii) Limitation Act, 1963: Under the Limitation Act, 1963, the period
of limitation for filing of a suit in terms of Sec. 134 of the Trade Marks Act,
1999, is three years from the date of impugned act of infringement or passing-
off.  

3. Judicial Response in Addressing Trademark Issues in Cyberspace

Though domain names are not defined under any Indian law or are
covered under any special enactment, the Courts in India has applied Trade
Marks Act, 1999 to such cases.

Like in other cases under Trademarks Act, 1999 two kind of reliefs are
available:

1. Remedy of infringement
2. Remedy of passing off

Thus, the courts in India do not have any dedicated legislation to fall
back on in deciding disputes alleging trademark violations in cyberspace. In
interpreting such cases from the prisms of Trade Marks Act, 1999, and the
established Common Law principles of passing-off, the judges have always
given due weight to Indian consumers and their cultural background.

For instance, as Desai, J. of Bombay High Court observed (later
affirmed by Supreme Court of India), "English cases proceeding on the
English way of pronouncing an English word by Englishmen, which, it may
be stated, is not always the same, may not be of much assistance in our
country in deciding questions of phonetic similarity. It cannot be overlooked

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9 Schedule, Part X, Limitation Act 1963, which states that any suit for which no period of
limitation is provided elsewhere in the Schedule, the period of limitation shall be three years
starting from the date when the right to sue accrues

10 Vakul Sharma, Information Technology Law & Practice, (2004) at 426
that the word is an English word, which, to the mass of the Indian people, is a foreign word."

The first domain name dispute that ended up in courts was YAHOO! Inc. v. Akash Arora & Anr. Here, defendant, with trading name Netlink Internet Solutions, set up a website yahooindia.com, which was nearly identical to plaintiff's renowned website yahoo.com. Moreover, the defendant's website also provided similar services as those provided by the plaintiff's website. In alleging passing-off via cybersquatting, the plaintiff submitted that it was a global Internet media, rendering Web Directory and search services under its renowned domain name yahoo.com, which was registered in their favour in 1995. Trademark 'Yahoo!' and its variants were registered or pending registration in 69 countries (in India, it was pending registration).

Internet users were familiar with the practice of companies to select domain names that incorporated their company name, well-known trademark, and / or product / service name and generally, attempted to locate a particular company's website by simply typing in www.(company name).com or www.(product name).com when they were unsure of the Internet address of the company. Thus, it would not be unusual for someone looking for an authorised Yahoo! site with India specific content to type in yahooindia.com, i.e., defendant's instead of the plaintiffs. In fact, plaintiff provided extensive India specific content both on its Yahoo! Asia site and its main yahoo.com site, under the categories "Regional» Countries» India".

The defendant argued on a number of points contending:

(a) Plaintiff's trademark was not registered in India. Therefore, there could not be any action for infringement of registered trademark;

(b) There could not be an action of passing-off as the defendants were not offering goods, but services;

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11 Corn Products Refining Company v. Shangrila Food Products Ltd. AIR 1960 SC 142
12 1999 PTC (19) 201 (Del)
(c) 'Yahoo!' is a general dictionary word and was not invented. Therefore, it could not have acquired distinctiveness;

(d) Defendants had been using a disclaimer;

(e) Persons using the Internet and seeking to reach the Internet sites were all technically educated and literate persons. Therefore, there was no chance of deception and confusion.

Refusing all contentions of the defendant and awarding interim injunction to the plaintiff restraining defendants from using the domain name yahoo india. com, the court concluded:

(i) The principle underlying the passing-off action is that no man is entitled to carry on business in such a way as to lead to the belief that he is carrying on the business of another man or has any connection with the other man. Since business 'goodwill' is an asset, it is a species of property, which the law protects against encroachment. Action of passing-off is not limited to goods and includes services as well. Citing Card service International Inc. v. McGee,14 the court held that the domain name serves the same function as the trademark. In the said case, it was held that plaintiffs customers who wish to take advantage of its Internet's services but do not know its domain name are likely to assume that cardservice.com belongs to the plaintiff. However, these customers would reach the defendant's website and see a home page for "Cardservice" and thereby, assume that they have reached plaintiff's site.

"The services of plaintiff under the trademark / domain name 'Yahoo!' have been publicised and written about globally. In an Internet service, a particular Internet site could be reached by anyone anywhere in the world who proposes to visit the said Internet site ... as a matter of fact, in a matter where services are rendered through the domain name on the Internet, a very alert vigil is necessary and a strict view is to be taken for its easy access and reach by anyone from any corner of the globe……there can be no two opinions that the two marks / domain names 'Yahoo!' of the plaintiff and 'Yahooindia' of the

14 42USPQ 2d
defendant are almost similar ……and there is every possibility and likelihood of confusion and deception being caused."

(ii) 'Yahoo!', though a dictionary word could be appropriated as domain name / trademark. The said word had acquired distinctiveness and uniqueness and was associated with plaintiffs.\footnote{Citing N.R. Dongre v. Whirlpool Corp. 1996 PTC (16) for the word 'WHIRLPOOL'. Here, though the word 'Whirlpool' was not registered in India as a trademark, yet it was held to be entitled for protection as its reputation had travelled trans-border to India} \footnote{46USPQ 2d 1652}

(iii) Sophisticated user of the Internet may still be an unsophisticated consumer of information and not immune from confusion.

(iv) Use of disclaimer by defendants could not eliminate the problem as observed in Jews for Jesus v. Brodsky,\footnote{16} nor would addition of the word 'india' in defendant's domain name (i.e., 'yahooindia) distinguish it from plaintiffs domain name.

This case was unique, not just because it was the first case pertaining to domain name dispute to be decided by Indian courts, but also because it showed that the courts in India were not averse to deriving suitable interpretations from the U.S. case law in arriving at a decision.

Though Yahoo! case was the first reported case pertaining to domain name dispute to be decided by an Indian court, there was another case, which was initiated in the Delhi High Court in 1998, Titan Industries Ltd. v. Prashant Koorapati\footnote{Case No. - S 179/1998. Order available at http://courtnic.nic.in/dhcorder/dhcqrydisp_o.asp?pn=153404& yr=2002. Last accessed on January 19, 2016} However, it was finally disposed off only on November 1, 2002. The defendant registered the domain name tanishq.com. The plaintiff company, which had been using the trademark 'tanishq' with respect to watches manufactured by it, sued the defendant for passing-off alleging that the use of domain name by the defendant would lead to confusion and deception and damage the goodwill and reputation of the plaintiff. 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 likely to lead to passing-off the business and goods of the defendants as the business and goods of the plaintiff.\textsuperscript{18}

However, the domain name tanishq.com was subsequently purchased by Tanishq Corporation of Dubai. The plaintiff had to initiate WIPO UDRP proceedings for the disputed domain name,\textsuperscript{19} wherein the latter denied that it acquired the domain name from Mr. Prashant Koorapati, the defendant in the earlier case. The case was arbitrated by the 3-judge Panel, which ruled in favour of the respondent on the ground that Titan Industries could not prove that the defendant lacks rights or legitimate interest in the domain name, or that the respondent registered and used the domain name in bad faith. In ruling against the complainant, however, the Panel observed that it "…… felt at a disadvantage in not having an Indian Panellist among its number. There are certain aspects of the respondent's evidence. Which give cause for concern and which an Indian national might have been able to clarify. However, this administrative procedure is not an ideal forum for resolving issues of fact and, indeed, determining whether or not a party is being truthful. Accordingly, unless the evidence against the respondent is clear; the Panel has no alternative but to resolve the doubt in favour of the respondent."

On bad faith registration, the Panel observed thus: "The evidence supporting complainant's position is limited to the fact that complainant has registered and used the TANISHQ mark for jewellery and watches since 1995, primarily in India, where respondent's administrative contact and website developer are located and where respondent intends to do business. However, it is also undisputed that complainant did not register the mark in Dubai, where respondent is located. Further, respondent has claimed a prior intent to use the mark for a different business and there is no evidence to counter that claim. Respondent has also shown that the name TANISHQ is an apt choice for a body care product business because it conveys the meaning 'love for

\textsuperscript{18} Detailed by Ashwani Kr. Bansal, Law Of Trademarks In India, (2006) at 646

one's body.' On the evidence before us, it is certainly plausible that respondent registered and intends to use the name in good faith for a body care business, without any intent to trade on complainant's good will. Whether the use of the mark and domain name TANISHQ for body care products may ultimately infringe complainant's trademark rights in TANISHQ for jewellery and watches is an issue beyond the scope of the UDRP."

Thus, it is manifestly clear that even the arguments forwarded by the WIPO Panel in this case were not plausible enough to establish the rights of the respondent on the domain name.

Having analysed this case in detail, it is safe to conclude that resolving domain name disputes is a difficult task even for the experts appointed by WIPO to act as arbitrators in the disputes.

Another case from Delhi High Court reached WIPO Panel. However, in this case, the tables were turned on the respondent. In SAP System v. Devinder Pal Singh Bhatia,20 the defendant who had registered sapwizard.com and sapmaster.com offered to sell the two domain names to SAP America for U.S. $38,000. However, the court restrained the defendants.21 This 1999 case was disposed off on September 7, 2001.

The complainants approached WIPO Panel for the transfer of impugned domain names.22 Ruling in favour of the complainant, the Panel relied on a number of cases where generic words (e.g., 'Master', 'Wizard') used as suffix or prefix to a domain name do not necessarily distinguish the domain name from the trademark of the complainant. The Panel found respondent's bad faith by the offer to sell the impugned domain names to the complainant.

Soon, the Bombay High Court had an occasion to dwell on domain name disputes in Rediff Communication Ltd. v. Cyberbooth.23 The plaintiffs

23 AIR 2000 Bom 27
had registered the domain name reddie.com on Feb 8, 1997 with Network Solutions Inc. The defendants registered a similar domain name radiff.com with the same Registrar on January 31, 1999. Initiating proceedings against the defendant under the old Trade and Merchandise Marks, 1958, plaintiff alleged that the defendants had adopted the word Radiff as part of their trading style deliberately with a view to pass-off their business services as that of the plaintiffs. The petitioner further contended that this was done deliberately by the defendant in order to induce members of the public into believing that the defendant is associated with the plaintiff. The plaintiff drove home the point by claiming that REDIFF is comprised of the first six letters of their group companies' corporate names being Rediffusion Dentsu Young and Rubicam Advertising Limited.

The defendants contested the plaintiffs' action on the ground that the 'look and feel' of the plaintiffs' website is totally different from that of the defendants' website. Further, RADIFF has been coined by taking the first three letters of the word 'Radical', first letter of the word 'Information', first letter of the word 'Future,' and first letter of the word 'Free'. It was also contended that there is no likelihood of deception or confusion between the two domain names.

In deciding the case against the respondent and granting interlocutory injunction against the defendant's domain name, the court referred to Cardservice International Inc v. McGee, Marks & Spencer v. One-in-a-Million and Yahoo!, Inc. v. Akash Arora. The court further observed that Internet is undoubtedly one of the important features of information revolution. It is increasingly used by commercial organisations to promote themselves and their products and in some cases, to buy and sell. The domain name enables them to have an email address and a website address. The court observed that a domain name is more than an Internet address, and is entitled

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24 42 USPQD 2d 1850 relating to cardservice.com
25 1998 FSR 265 relating to marksandspencer.co.uk
26 1999 PTC (19) 201 relating to Yahooindia.com
to equal protection as trademark. Further, the court observed that both the plaintiffs' and defendants' websites had a common field of activity. Both offered a chat line and a cricket opinion poll. There could be no doubt that both the marks / domain names are almost similar. The court held that there is every possibility of the Internet user getting confused and deceived in believing that both domain names belong to one common source and connection, although the two belong to two different persons. The explanation of origin of the word RADIFF given by the defendants was found to be unsatisfactory and merely an attempt to answer the plaintiffs' claim. The court held that the defendants had adopted the domain name RADIFF with the intention to trade on the plaintiffs' reputation.

As we have seen, distinctiveness is required for the registration of any sign as a trademark. Distinctiveness can be either inherent or acquired through a secondary meaning. The Delhi High Court first applied this approach of acquired distinctiveness to domain name disputes in the case of Online India Capital Co. Pvt. Ltd. v. Dimension Corporate. 27 The plaintiff company was running the website www.mutualfundsindia.com while the defendant had created a similar website www.mutualfundindia.com. Defending its domain name, the defendant contended that "mutual fund" is a generic term and no monopoly can be claimed in relation thereto by any person. The court observed that the expression "mutual funds" forming part of the plaintiffs' domain name is the description of the services being offered by the plaintiff. The material placed on record failed to show that the said expression had acquired a secondary meaning, which is a precondition for grant of protection to a descriptive name. It was, thus, held that no prima facie case was made out for the grant of an interim injunction prayed for by the plaintiff.

However, the outcome was different in Dr. Reddy's Laboratories Limited v. Manu Kosuri, 28 where the plaintiff company is the proprietor of the trademark DR. REDDY'S. The defendants had registered the domain name

27 2000 PTC 396 (Del)
28 2001 PTC 859 (Del)
drreddyslab.com. The web page merely showed the caption ‘welcome to the future Website of drreddyslab.com.’ A suit was filed by the plaintiff company praying for a permanent injunction restraining the defendants from using the trademark / domain name drreddyslab.com, since the same was identical or deceptively similar to the plaintiff's trademark DR. REDDY'S. The plaintiff company averred that it was established in 1984 for research and development activity in the field of medicine and over 15 years, grew into a fully integrated pharmaceutical organisation. It was further contended that DR. REDDY’S is always perceived as indicative of the source of the company and the trademark DR. REDDY'S is a personal name of the plaintiff company's founder and its use as a trademark in relation to pharmaceuticals is completely arbitrary. The plaintiffs also contended that the defendants are in the business of registering domain names in India and their purpose of existence appears to be to block well-known trademark and even names of well-known personalities on the Internet. Having once registered as domain names, the defendants offer them for sale for large amounts. The potential for confusion or deception being caused on account of the adoption of the impugned trademark / name by the defendants and the likelihood of damage to plaintiff's company business, goodwill, and reputation by the operation of a website under the impugned domain name by them is enormous, and is aimed at diverting the business of plaintiff company and to earn easy, illegal, and undeserved profit. The defendants had chosen not to appear and contest.

On the basis of available materials on record, the court, after looking into well-settled legal proposition of passing-off and after observing that domain name serves same function as a trademark, held that the two names, DR. REDDY'S and drreddyslab.com being almost identical or similar in nature and there is every possibility of an Internet user being confused and deceived in believing that both the domain names belong to plaintiff, although the two domain names belong to two different concerns. The court observed that the plaintiff holds the trademark in the name DR. REDDY’S and it has acquired distinctiveness through a secondary meaning and hence, any use of
the domain name drreddyslab.com by the defendant could cause confusion and deception to the Internet users. The court restrained the defendants from using any mark / domain name identical or deceptively similar to plaintiff’s trademark DR.REDDY’S.

The same argument was forwarded by the plaintiff in Info Edge (India) (P) Ltd. v. Shailesh Gupta. The plaintiff filed an application for an order of injunction under Order 39 Rules 1 & 2 of the Code of Civil Procedure. The plaintiff company adopted the domain name naukri.com on March 27, 1997. It was contended that the domain name has assumed distinctiveness as the plaintiff has chosen a Hindi word and use the same in the English script as early as in March, 1997, in the Internet world, which is dominated by the English domain names. According to the plaintiff, the word NAUKRI has attained a secondary in connection with its services. The defendant, on the other hand, was offering similar services through jobsourceindia.com. However, it also registered a variant of plaintiffs domain name naukari.com in 1999 and used it as a hyperlink to jobsourceindia.com. Therefore, anyone who types in naukari.com would be led to jobsoureindia.com. The plaintiff alleged that naukari.com was registered in bad faith and to attract Web surfers and innocent users for diverting the traffic to jobsourceindia.com. The plaintiff alleged that: (a) there was passing-off of services and goods; (b) defendant's domain name was deceptively similar to the plaintiff's; (c) there is grave and immense possibility of confusion and deception; (d) defendant's dishonesty is clear since jobsourceindia.com and naukari.com were registered two years after the plaintiff registered naukri.com. The defendant argued that naukri.com is generic and hence, incapable of achieving the trademark significance or secondary meaning. It was further contended that in case naukri.com has attained secondary meaning, same has to be proved.

Relying on, Yahoo, Inc., Rediff Communication V Acqua Minerals, and Dr. Reddy's Laboratories, the court reiterated that a domain name is more than an Internet address and is entitled to equal protection as that of

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29 2002 (24) PTC 355 (Del)
trademark. The court also observed that in a matter where services are rendered through the domain name on the Internet, a very alert vigil is necessary and a strict view is to be taken for its easy access and reach by anyone from any corner of the globe. After considering the material and evidence on record, the court held that distinctiveness can be attributed to the domain name of the plaintiff. The court further observed that the defendant has employed minor misspelling of the plaintiff's mark, although it has another such mark available to it, which is also a registered domain name. The defendant's choice of slightly misspelt version of the plaintiff's domain name was deliberate in order to suit the business activities of the defendant and for the purpose of diverting traffic of the Internet users to website unrelated to the plaintiff. (This kind to activity is known as typosquatting.)

In awarding temporary injunction against the defendant's use of the disputed domain name, the court referred to Paragraph 4(b)(iv) of the UDRP to appreciate the argument of 'bad faith'. It held that the website using the domain name, similar to that of the plaintiff, for commercial purposes, would lead to an inference that the domain name was chosen intentionally to attract Internet users of the plaintiff. This was also established in view of the minor spelling variant to the a well-known mark, without any explanation and the same definitely creates a primafacie evidence of bad faith within the meaning of Paragraph 4(b)(iv) of UDRP.

The Delhi High Court was once again called in to adjudicate upon a dispute on domain names in Acqua Minerals Ltd. v. Pramod Borse. \(^{30}\) The plaintiff sought permanent injunction restraining the defendants from using the mark BISLERI and / or BISLARI.com as part of their domain name or in any other manner whatsoever as for any products, goods or services so as to result in passing-off, an infringement of copyright, and directing them to transfer the domain name bisleri.com to the plaintiff. The plaintiff is the registered proprietor of the trademark BISLERI. The word has no dictionary meaning and is an Italian surname. Its reputation grew over the years as result

\(^{30}\) 2001 PTC 619 (Del)
of enormous consumer confidence and trust in the mineral water and the mark BISLERI came to be associated exclusively with the plaintiff. Plaintiff applied for registration of domain name bisleri.com but found that the defendants had already registered the same. When the plaintiff called upon the defendants to immediately transfer the rights of the said domain name in the name of the plaintiff, the defendants demanded large sums of money for doing the same. It was further contended that a person wanting to know more about their product will type bisleri.com but will be taken to the defendant's website, which has nothing to do with the plaintiff's goods. Thus, this action of defendant constitutes a mischief of passing-off by the defendants. The plaintiff also referred to Paragraph 4(b)(i&ii) of the UDRP to project the element of 'bad faith'. The question before the court was whether the domain name registered with the Network Solutions, Inc. i.e., the Registering Authority, has the same protection as the trade name or trademark registered under the old Trade and Merchandise Marks Act, 1958.

In its examination of the word 'domain', the court observed "the word 'domain' as per Chambers 21st Century Dictionary means a territory owned or ruled by one person or government. Webster's Dictionary defines it in various contexts as under: (a) a field of action, thought, and influence; (b) the territory governed by a single ruler or government; (c) region characterised by a specific feature; (d) law; (e) land of which, there is superior title and absolute, ownership." The court rested the discussion on the word 'domain' by concluding that "trademark is at par with a territory and the owner of any trademark is placed in the same position as owner of a territory." Further, the court observed that "with the advancement of Internet communication, the domain name has attained as much legal sanctity as a trade name. Since the services rendered on the Internet are crucial for any business, the domain name needs to be preserved so as to protect such provider of services against anyone else trying to traffic or usurp the domain name." The court also relied upon the 'bad faith' test under the UDRP and found that the defendants had blocked user of the trade name EISLERI from getting the registration as a
domain name and as such, it has affected the trade and name of the plaintiff. "It was obvious that the domain name bisleri.com was chosen by the defendants with mala fide and dishonest intention and as a blocking or squatting tactic." The court found that the only object of the defendant in adopting the disputed domain name was to earn huge money for transferring the said domain name in the name of the plaintiff knowing it well that they had no right either of registration of the domain name or of any other domain name which consisted of the plaintiff’s mark or copyright name. The suit was decreed on the ground of bad faith registration.

The case of Tata Sons Ltd. v. Manu Kosuri,\(^{31}\) involved a number of domain names incorporating the brand name of the plaintiffs, like jrdtata.com, ratantata.com, tatahoneywell.com, tatayodagawa.com, tatateleservices.com, tatass1.com, tatapowerco.com, tatahydro.com, tatawestide.com, and tatatimken.com. The plaintiff averred that the defendants had misappropriated the plaintiffs trademark TATA since a part of a series of domain names that had been registered by the defendants incorporated the well-known and famous trademark TATA. The plaintiff further contended that it was the registered proprietor of TATA since 1917 in relation to various goods, in various classes. It was further asserted that the plaintiff had trademarks registered in nine other countries in various classes. The plaintiff's case was that since its trademark and name TATA was already perceived as a household name due to the involvement of its companies in almost every form of business activity, a business under identical name would attract actual or potential customers' attention and induce them to subscribe to the services of the defendants or to deal in some manner with the defendants operating under the domain names believing them to be licensed or authorised by the plaintiff to do the said business. In default of the defendants, the court, on the basis of the materials on record, found that the plaintiff has been able to prove the averments made in the plaint and restrained the defendants from using the above domain names.

\(^{31}\) 2001 PTC 432 (Del)
After discussing the decisions in Yahoo, Inc. and Rediff Communications, the court observed that it is now well settled law that with the advent of modem technology, particularly that relating to cyberspace, domain name or Internet sites are entitled to protection as a trademark because they are more than a mere address. The rendering of Internet services is also entitled to protection in the same way as goods and services are, and trademark law applies to activities on the Internet.

In Manish Vij v. Indra Chugh, the plaintiff instituted the suit for permanent injunction restraining the defendants from operating any business, making, selling, transferring, offering for sale, advertising, and in any other manner, dealing with the goods or services using domain name kabaribazaar.com or any other combination thereof, as a website on the Internet, identical with or deceptively similar to plaintiff's trade name / domain name kabadibazaar.com, as it is likely to lead to passing-off the business of defendants as those of plaintiffs.

The court first maintained a distinction between the suit for infringement action and passing-off action. The action for passing-off lies when a trademark identified with an individual, is used by another; thereby, trading on the goodwill acquired by the proprietor of the trademark, goods / services of the dishonest trader are mistaken for that of the lawful proprietor resulting in confusion. In an action for passing-off, the court is firstly required to consider whether the plaintiff is the proprietor of the trademark and then, whether the defendants are passing-off the trademark.

The plaintiff's contention that the word KABADIBAZAAR was coined by the plaintiff was rejected by the court by observing that the word "Kabadi" is a person who takes away unwanted goods from the house, which may be of some use in other context. "Bazaar" is a place where the trading takes place. The periodical existence of markets for second hand goods is, in fact, conceded in the plaint. Thus, the word "kabadibazaar" cannot be said to be a

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32 Ibid
33 AIR 2002 Del. 243
newly coined word. The word 'kabadibazaar" also finds reference in Hindi dictionary "Rajpal Hindi Shabdkosh." The court, further, made it clear that the trademark protection is available to imaginative or suggestive words and not to descriptive words. The trademark is descriptive if it imparts information directly. If it stands for some idea which requires some imagination to connect it with the goods, it is suggestive. The information may concern some characteristic or quality or ingredient of the product. Applying these principles, it was held that the word "kabadi" means a person, who buys unwanted goods, and sometimes even unwanted goods are called "kabaad." "Bazaar" is a place where goods are sold or bought. Thus, the word "kabadibazaar" is descriptive word as it imparts information directly. It requires no imagination to connect it with second hand goods. It cannot be said to be suggestive.

The court observed that while it is true that, at times, descriptive words or other devices used as trademarks, may acquire distinctiveness over a period of time when such a mark has come to signify that particular goods are manufactured or services are rendered by a particular person, it may be said that the mark has acquired secondary meaning. It could be demonstrated by proving advertisements, promotions and sales. But there it is not so. The material placed on record is not enough to prima facie, show that the domain name has acquired secondary meaning.

The plaintiff also tried to invoke ICANN UDRP to prove bad faith registration of the disputed domain name by the defendant. The facts argued were: (a) that the defendants got registered various other combinations with different spellings of the said domain name; (b) that on receipt of the complaint, when the plaintiff met the defendants, they asked for huge amount of money and were not willing to transfer for less; and (c) that the defendants had also booked several other domain names like rajourigardenmarket.com, karolbagmarket.com, with which they have no connection and none of these websites are operational, and these sites consist of advertisements of defendants. These were booked with the intention of making illegal profits.
However, the defendant argued that booking and selling of domain names is not prohibited under the Internet Law; that the defendants have hosted sites for traders belonging to various markets in Delhi and the features and rates offered at the said sites are exceptional and rarely available on the Internet. The defendants had live website www.kabaribazaar.com since November, 1999 which attracted more traffic than that of the plaintiffs' website.

Rejecting the contentions of the plaintiff, the court observed the registration of a domain name is considered to be abusive only when the conditions laid down in Paragraph 4(a) of ICANN UDRP are met and not otherwise. The term 'bad faith' does not simply mean bad judgment, but it implies the conscious doing of a wrong with a dishonest purpose. It contemplates a dishonest state of mind.

In Celador Productions Ltd. v. Gaurav Mehrotra\textsuperscript{34} the plaintiff company is the legal and beneficial owner of the copyrights / intellectual property rights pertaining to the show "Who wants to be a Millionaire?" In India, the rights to produce the Hindi equivalent of the programme under the title KAUN BANEGA CROREPATI have been granted to News Television India Ltd., a member of the Star TV Group. Owing to popularity of the show, the plaintiff produced or licensed the production of a variety of merchandise including a board game, a junior board game, a chocolate game etc. Apart from the distinctive element of the programme, the plaintiff has been using a circular logo with the words "Who wants to be a Millionaire?" written inside the circle together with other distinctive material including a number of 'pound' sings. This distinctive logo has been modified for use in India by replacing words "Who wants to be a Millionaire?" with Hind equivalent KAUN BANEGA CROREPATI and by replacing the 'pound' with symbol of rupees. The plaintiff filed the application in India and worldwide for registration of the circular logo, which was created in August, 1998. The plaintiff also has a website and has also licensed ITV network in UK to run the website. The website has complete details about the programme i.e. the

\textsuperscript{34}2003 (26) PTC 140 (Del)
rules of programme, winners, showcase and details that could be downloaded by persons accessing the website. In May 2001, it came to the notice of the plaintiff that defendants are running a website on a commercial basis with a similar domain name of the plaintiff game show KAUN BANEGA CROREPATI. The website of the defendant invites people to play online game KAUN BANEGA CROREPATI. The defendants systematically copied the trademarks, design, rights, copyrights and intellectual property rights of the plaintiff. The defendants also opened a fan club through their website and they are charging subscription from the members. Observing that since domain name is more than an Internet address; therefore, person can certainly seek protection of its domain name, the court decreed the suit.

In Casio India Co. Ltd. v. Ashita Tele Systems Pvt. Ltd., the questions were raised by the defendant on the plaintiff's locus standi to file the suit. The defendant was using the mark casioindia.com. The plaintiff had an agreement with Casio Japan conferring on him the right to use the brand Casio. The court held that no specific assignment was needed for the plaintiff to file the suit as the right was a natural consequence to the existence of the plaintiff as juristic person under the Companies Act, 1956. Therefore, the court pointed out that the plaintiff has a locus standi to institute the suit and the objection of the defendant is without merit.

In one of the rare occurrences, Supreme Court of India was presented with an occasion to ponder over domain name disputes between Satyam Infoway Ltd. v. Sifynet Solutions (P) Ltd. The main question for the consideration of Supreme Court was whether Internet domain names are subject to the legal norms applicable to other Intellectual Properties, such as trademarks. The appellant, incorporated in 1995, registered several domain names, like sifynet.com, sifymal1.com, sifyrealestate.com, etc. in June, 1999, with ICANN. The word 'Sify' is a coined word, which the appellant claimed to have invented by using elements of its corporate name, Satyam Infoway. The

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35 2003 PTC 265 (Del)
36 (2004) 6 SCC 145
respondent, on the other hand, started carrying on business of Internet marketing under the domain names siffynet.net and siffynet.com from June, 2001. After the respondent refused to transfer these domain names to the petitioner, a suit was filed on the ground that the respondent was passing-off its business and services by using the appellant's business name and domain name. An application for temporary injunction was also filed, which was allowed by the trial court but on appeal, reversed by the High Court. The plaintiff / appellant preferred a special leave to appeal before the Supreme Court, which was granted.

The respondent contended that a domain name could not be confused with 'property names,' such as trademarks. According to him, a domain name is merely an address on the Internet. It was also submitted that registration of a domain name with ICANN does not confer any Intellectual Property right; that it was a contract with a registration authority allowing communication to reach the owner's computer via Internet links and channelled through the registration authority's server and that it was akin to registration of a company name which is a unique identifier of a company but of itself confers no Intellectual Property rights.

After reiterating the principles of passing-off, the Supreme Court held that the domain names are entitled to legal protection equal to that of a trademark. The Apex Court observed as under:

"The use of the same or similar domain name may lead to a diversion of users, which would result from such users mistakenly accessing one domain name instead of another. This may occur in e-commerce with its rapid progress and instant (and theoretically, limitless) accessibility to users and potential customers and particularly so, in areas of specific overlap. Ordinary consumers/users seeking to locate the functions available under one domain name may be confused if they accidentally arrived at a different but similar website, which offers no such services. Such users could well conclude that the first domain name owner has misrepresented its goods or services through its promotional activities, and the first domain owner would thereby lose its
customers. It is apparent, therefore, that a domain name may have all the characteristics of a trademark and could found an action for passing off."

The Court further observed that there is no legislation in India which explicitly refers to dispute resolution in connection with domain names. The operation of the Trade Marks Act, 1999, is also not extra-territorial and may not allow for adequate protection of domain names. This does not mean that domain names are not to be legally protected to the extent possible under the laws relating to passing-off.

Emphasising the importance of a domain name, the Supreme Court observed that "a domain name is accessible by all Internet users and the need to maintain an exclusive symbol for such access is crucial, therefore, a deceptively similar domain name may not only lead to a confusion of the source but the receipt of unsought for services. The Court further observed that "it may be difficult for the appellant to prove actual loss having regard to the nature of the service and the means of access' but the possibility of loss in the form of diverted customers is more than reasonably probable."

As regards passing-off, the Court observed that 'it is an action not only to preserve the reputation of the plaintiff but also to safeguard the public." Upholding the contention of the plaintiff, the Court held that "the appellant is the prior user and has the right to debar the respondent from eating into the goodwill that it may have built up in connection with the name."

The Court also discussed at some length the provisions of ICANN UDRP relating to resolution of domain name disputes. The Court acknowledged that a prior registrant can protect its domain name against subsequent registrants. Confusing similarity in domain names may be a ground for complaint and similarity is to be decided on the possibility of deception amongst potential customers.

Apart from the close visual similarity between 'Sify' and 'Siffy', the Court held that there was phonetic similarity between the two names as well. The addition of 'net' to 'Siffy' did not detract from this similarity. The Court rejected the argument of the defendant that the word 'Siffy' has been derived
from a combination of the first letter of the five promoters of the respondent, namely, Saleem, Ibrahim, Fazal, Fareed, and Yusuf. It was found that the domain name of the respondent already stood registered as in the name of one Mr. C.V. Kumar. Further, 'Sify' as an original acronym was based on the initial letters of the respondent company's promoters seemed unsupported by any evidence.

Importantly, a trademark defence of 'operating in different fields' was taken by the respondent. However, the same was rejected on the ground that a deceptively similar domain name may not only lead to a confusion of the source but the receipt of unsought-for services. Also, on facts, it was found that the respondent was, on its website, offering software solution, integrating and management solutions and software development, which were similar to services provided by the appellant.

Finally, the Supreme Court concluded that in view of finding of prima facie dishonest adoption of the appellant's trade name by the respondent, the investments made by the appellant in connection with the trade name, and the public association of the trade name 'Sify' with the appellant, the appellant was entitled to the relief it claimed.

The Delhi High Court was again called in action to decide a domain name dispute in Buffalo Networks Ltd. v. Manish Jain. The court decreed the suit against the defendant who had registered a deceptively similar name tahelka.com vis-a-vis the plaintiff's domain name tehelka.com. The court, in deciding against the defendant, also imposed a cost of Rs. 1 lakh on him, which shows that the courts want to sternly deal with the domain name offenders while protecting the legitimate interests of the plaintiffs.

Again, in Time Incorporated vs. Lokesh Srivastava, the Delhi High Court awarded the plaintiff Rs. 5 lakh as punitive damages as well as Rs. 5 lakh as compensatory damages for loss of reputation and goodwill.

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37 2005 PTC 242 (Del)
38 (2005) 30 PTC 3 (Del)
Further, in Tata Sons Ltd. v. Fashion ID Ltd.\textsuperscript{39} the Delhi High Court again imposed costs of Rs. 1 lakh on the defendant as well as restrained the defendant from using the domain name tatainfotecheducation.com, which was deemed identical or deceptively similar to the plaintiffs trademark TATA, TATA INFOTECH and TATAINFOTECH EDUCATION.

Addressing the issue of jurisdiction in domain name disputes for the first time in Tata Sons Ltd. v. Ghassan Yacoub,\textsuperscript{40} the Delhi High Court accepted the contention put forth by the plaintiffs that in matters concerning Internet communications, which have transnational ramifications, the effect of the impugned transactions in India is an important factor for determining jurisdiction. In arriving at its decision, the court also considered the principles of Private International Law including the courts' ability to enforce the injunction against the defendant. In the instant case, ASAP Solutions of California, U.S.A., registered the domain name tatagroup.com with NSI and on receipt of a cease and desist notice from the plaintiffs, the owner of the trademark TATA, transferred the same to the Tatagroup located in New York. The plaintiff filed a suit for injunction restraining passing-off and dilution of its well-known trademark TATA, against both ASAP Solutions and Tatagroup. The court granted an ex-parte interim injunction against the defendants restraining them from using and transferring the infringing domain name.

The issue of jurisdiction in domain name cases was recently taken up by the Delhi High Court in Banyan Tree Holding (P) Ltd. v. A. Murali Krishna Reddy.\textsuperscript{41} In this case, neither the defendant nor the plaintiff is located within the territorial jurisdiction of the Delhi High Court. The plaintiff, part of a group of companies involved in the hospitality business, claimed that since 1994, it adopted and used the word mark "Banyan Tree" and also the Banyan Tree device.

\textsuperscript{39} (2005) 30 PTC 182 (Del)
\textsuperscript{40} 2004 (29) PTC 522 (Del)
\textsuperscript{41} Suit No.: CS(OS) No.894/2008. Date of Decision: November 23,2009
The application for registration of trademark is pending. It is further claimed that on account of the extensive and continuous use by the plaintiff of the said mark and device in relation to its business, they have acquired secondary meaning, have become highly distinctive, and have come to be associated with the plaintiff and its sister concerns. The plaintiff maintains the websites banyantree.com and banayantreespa.com since 1996 and the said websites are accessible in India. Since 2002, the plaintiff, in collaboration with the Oberoi Group, has been operating 15 spas across India. However, in October, 2007, the plaintiff learnt that the defendants had initiated work on a project under the name "Banyan Tree Retreat." The plaintiffs contentions include: (a) the word mark and the device adopted by the defendants in relation to their retreat is deceptively similar to that of the plaintiff; (b) the defendants have advertised their project on their website makprojects.com/banyantree, which the plaintiff alleged that the use of the said mark and device by the defendants was dishonest, and an attempt to encash on the reputation and goodwill of the plaintiff, and was calculated to cause confusion and deception among the public by passing-off the services of the defendants as that of the plaintiff.

Dealing with the issue of jurisdiction first, the court observed that the present suit is an action for passing-off in which neither the plaintiff nor any of the defendants voluntarily resides or carries on business within the local limits of Delhi. Consequently, neither Section 20(a) nor Section 20(b), CPC applies. The plaintiff, however, contended that the court had jurisdiction under Section 20(c), CPC, as the cause of action, wholly or in part, arises within the jurisdiction of this court because; (i) the website of the defendants is accessible in Delhi; and it is not a passive website but used for soliciting business in Delhi; and (ii) there was at least one instance of the defendants' brochure being sent to a Delhi resident for the purposes of sale of property.

In determining jurisdiction, the court extensively relied on the decisions by the courts in U.S.A., namely International Shoe Co. v.
Washington,\(^{42}\) Burger King Corp v. Rudzewicz,\(^{43}\) Asahi Metal Industries v. Superior Court,\(^{44}\) Inset Systems Inc. v. Instruction Set Inc.,\(^{45}\) Bensusan Restaurant Corp. v. King,\(^{46}\) Ballard v. Savage,\(^{47}\) CompuServe, Inc. v. Patterson\(^{48}\) Maritz; Inc. v. CyberGold, Inc.,\(^{49}\) Neogen Corp. v. Neo Gen Screening, Inc.,\(^{50}\) Zippo Mfg. Co. v. Zippo Dot Com, Inc.,\(^{51}\) Cybersell, Inc. v. Cybersell Inc.\(^{52}\) and a host of other decisions from other countries.

The court also referred to an earlier decision by the Delhi Court in (India TV) Independent News Service Pvt. Limited v. India Broadcast Live, LLC,\(^{53}\) where the plaintiff company ran a Hindi news channel INDIA TV, which was launched in March 2004. The plaintiff claimed to have adopted the mark INDIA TV since December 1, 2001, and had applied for its registration, and the said applications were published in the trademarks journal. The plaintiff was also the owner of the domain name INDIA TY, which was registered on November 18, 2003. The channel was made available for live viewing on the said website. Defendants hosted a website indiatvlive.com that contained the words INDIA TV, which were displayed prominently inside the sketch of "a television. A passing-off action was initiated to injunct the defendants from using the domain name indiatvlive.com. While the suit was pending, the defendant was proceeding with the action instituted by it in the Arizona District Court in U.S.A., where the defendants were located, against the plaintiff in respect of "reverse domain name hijacking" seeking a declaration of non-infringement of the plaintiff's mark by the defendant. The plaintiff then applied to Delhi High court stating that the defendant had

\(^{42}\) 326 U.S. 340 (1945) \\
^{43}\) 471 U.S. 462 (1985) \\
^{44}\) 480 U. S. 102 (1987) \\
^{45}\) 937 F. Supp. 161 (D. Conn. 1996) \\
^{46}\) 937 F. Supp. 295 (S.D.N.Y. 1996) \\
^{47}\) 65 F.3d 1495 (1995) \\
^{48}\) 89 F.3d 1257(6th Cir. 1996) \\
^{50}\) 282 F.3d 883,890 (6th Cir. 2002) \\
^{51}\) 952 F. Supp. 1119 (W.D.Pa.1997) \\
^{52}\) 130 F.3d414 (1997) \\
^{53}\) 2007 (35) PTC 177 (Del)
suppressed the fact of having filed the aforesaid action in Arizona and prayed for an injunction against defendant from proceeding with the said action in the Arizona courts particularly since the suit of Delhi High court was prior action. In resisting the application, the defendant argued that Delhi High court was not a court of competent jurisdiction not being the appropriate forum / forum conveniens. Inasmuch as defendants did not reside or work for gain in India, it was only the District Court, Arizona that was the appropriate forum / forum conveniens to decide the dispute. After referring to the articles posted on defendant's website, the court concluded that the defendant intended to target expatriate Indians as well as Indians within the country. Further, the stand taken by defendant in its written statement was that it had a global presence, including in India. It claimed to be the first IPTV delivery system of Indian content from India. The website of defendant was launched in India as well as in Los Angeles. It was accordingly held that defendant has sufficient connection with India. It was further held that "the defendant is carrying on activities within the jurisdiction of this court; has sufficient contacts with the jurisdiction of the court and the claim of the plaintiff has arisen as a consequence of the activities of defendant within the jurisdiction of this court."

Upholding the plaintiff's contention, the court summarised the law pertaining to jurisdictional aspect in Internet cases in India by observing that:

(i) Mere accessibility of the defendants' website in Delhi would not enable Delhi High Court to exercise jurisdiction;

(ii) A passive website, with no intention to specifically target audiences outside the State where the host of the website is located, cannot vest the Forum Court with jurisdiction;

(iii) For the purposes of a passing-off action or an action for infringement where the plaintiff is not carrying on business within the jurisdiction of the Forum Court, and where there is no longarm Statute, the plaintiff would have to show that the defendant purposefully availed itself of the jurisdiction of the forum court;
(iv) It is not enough merely to show that the website hosted by the defendant is an interactive one. It would have to be shown that the nature of the activity indulged in by the defendant by the use of the website was with an intention to conclude a commercial transaction with the website user;

(v) The issue of incorporating filters to block access to the website by viewers located outside the Forum State will have to be considered while deciding if the defendant had "purposefully avoided" the Forum State. However, that question will arise only if the plaintiff has been able to show that the website of the defendant is interactive and permits commercial transactions to be concluded by the defendant with a user of the website;

(vi) Jurisdiction of the Forum Court does not get attracted merely on the basis of inter activity of the website, which is accessible in the Forum State. The degree of the interactivity apart, the nature of the activity permissible and whether it results in a commercial transaction has to be examined;

(vii) For the "Effects" test to apply, the plaintiff must necessarily plead and show prima facie that the specific targeting of the forum state by the defendant resulted in an injury or harm to the plaintiff within the Forum State;

(viii) For the purposes of a passing-off or an infringement action (where the plaintiff is not located within the jurisdiction of the court), the injurious effect on the plaintiff's business, goodwill or reputation within the Forum State as a result of the defendant's website being accessed in the Forum State would have to be shown. This would require the presence of the plaintiff in the Forum State and not merely the possibility of such presence in the future;

(ix) To show that an injurious effect has been felt by the plaintiff, it would have to be shown that viewers in the Forum State were specifically targeted. Therefore, the "Effects" test would have to be applied in conjunction with the "Sliding Scale" test to determine if the Forum Court has jurisdiction to try a suit concerning Internet based disputes; _
(x) The commercial transaction entered into by the defendant with an
Internet user located within the jurisdiction of the Forum Court cannot
possibly be a solitary trap transaction since that would not be an instance of
"purposeful availment" by the defendant. It would have to be a real
commercial transaction that the defendant has with someone not set up by the
plaintiff itself. If the only evidence is in the form of a series of trap
transactions, they have to be shown as having been obtained using fair means.
The plaintiff seeking to establish jurisdiction on the basis of such trap
transactions would have to aver unambiguously in the plaint, and also place
along with it supporting material, to prima facie show that the trap
transactions relied upon satisfy the above test.

Thus, it is well settled that till the time there is a new legislation in
place, the domain names on the Internet shall be given protection under the
Trade Marks Act, 1999, and the Indian courts shall have jurisdiction over such
disputes subject to the well established principles reiterated by the court in
Banyan Tree Holding (P) Ltd. v. A. Murali Krishna Reddy.54

4. National Non-Judicial Response in Addressing Trademark Issues in
Cyberspace

As discussed earlier, .in ccTLD registration is managed by INRegistry,
which was created by NIXI, a Government of India undertaking. As part of
registration, the registrants are required to submit to a mandatory arbitration
proceeding under the .IN Domain Name Dispute Resolution Policy (INDRP).

This Policy was enacted in pursuance of Policy Framework &
Implementation by the Government of India,55 which, inter alia, requires the
adoption of a comprehensive Dispute Resolution Policy (DRP) in line with
internationally accepted guidelines prescribed by the World Intellectual

54 Ibid
55 Government of India, Ministry of Communications & Information Technology,
Department of Information Technology, (www.mit.gov.in and nixi.org). .IN Internet
Property Organization (WIPO) and Universal Dispute Resolution Policy (UDRP) adopted by the ICANN. Further, this Policy will be in line with the relevant provisions of the Indian IT Act 2000.\textsuperscript{56} It was further required that any dispute involving the .IN Registry will be considered by a duly appointed Dispute Resolution Committee.\textsuperscript{57} The .IN Registry would also appoint Arbitrators, through a process of open selection, who can be approached by any aggrieved party(ies) for redressal of grievance with the Registrars. The decision of the Arbitrator(s) shall be binding on both the parties. For this purpose, a Service Fee will be prescribed which will be required to be paid to the Arbitrator by the aggrieved party for such arbitration.\textsuperscript{58}

In pursuance thereof, INDRP was drafted and posted on the INRegistry website on June 28, 2005.\textsuperscript{59} This Policy explains what types of disputes can be brought for arbitration, and the criteria that will be considered by the arbitrators. The INDRP is supplemented by INDRP Rules of Procedure,\textsuperscript{60} which describe how to file a complaint, how to respond to a complaint, the fees, communications, and the other procedures that will be used in processing a complaint.

Under INDRP, a complaint can be submitted on three grounds, which are identical to those set out in the ICANN UDRP, i.e.,

(1) The registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights;

(2) The registrant has no rights or legitimate interests in respect of the domain name;

(3) The registrant's domain name has been registered or is being used in bad faith.

The INDRP sets out the factors to be taken into account when determining the issues. These factors are similar to the provisions of the

\textsuperscript{56} Id., at Para 3.4.10
\textsuperscript{57} Id., at Para 3.4.11
\textsuperscript{58} Id., at Para 3.4.12
\textsuperscript{60} Available at http://www.registry.in/Policies/Dispute%20Resolution. Last accessed on January 20, 2015.
ICANN UDRP, with the exception that the INDRP does not impose the burden of proof on the complainant. However, in Monster.com (India) Pvt. Ltd v Domain Leasing Company, the Arbitral Tribunal held that this omission does not mean that the onus to disprove the complainant's assertions is on the respondent. Relying on the Evidence Act 1872, the Arbitral Tribunal held that the complainant would still have to prove these matters in accordance with the Act. In the same vein, in Jagdish Purohit v Stephen Koeing, the Arbitral Tribunal observed that The Evidence Act requires a party to prove the facts on which it wishes to rely to obtain a judgment. In the same case, the Arbitral Tribunal made it clear that there is no restriction on obtaining ex parte orders in cases where the domain name registrant resides outside India and fails to respond to notices sent to the address maintained by the registry.

Proceedings initiated under the INDRP are quasi-judicial in nature and are statutorily recognised arbitrations under the Arbitration and Conciliation Act, 1996. Therefore, a judgment is enforceable in the same manner as a civil court decree. However, the contractual provisions that allow cancellation of the domain in the event of an arbitral decision enable the INRegistry to enforce an arbitral award effectively, even in the absence of enforcement of the award in accordance with civil procedure. It should be noted that the INDRP is neither a Statute nor an Act, and an arbitrator's status under the INDRP is that of neither a judge nor a judicial officer; he or she has only a limited mandate to adjudicate on the three questions referred to in the INDRP.

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64 Id
The first case that came up before the INDRP arbitral tribunal for adjudication was Rediff.com India Ltd. v. Abhishek Verma and iAdvance Media. The complainant, an online media company, objected to the use of domain name rediff.in by the respondents. The complainant contended:

a) The domain name rediff.in is identical or confusingly similar to the complainant’s trademark.

b) The respondent has no rights or legitimate interests in respect of disputed domain name.

c) The domain name has been registered in bad faith.

d) Rediff is a part of corporate name of the complainant.

e) The complainant has also applied for registration of the trademark ‘Rediff’ and other marks with prefix ‘Rediff’ such as Rediff.com, Rediffmail, Rediff Bol in India and several other countries of the world.

f) The word REDIFF is coined by the complainant and has no dictionary meaning or equivalent.

g) The complainant also owns and controls domain names with the prefix ‘Rediff’ such as rediff.com, rediff.co.in, rediffindia.com, etc.

h) It has built up good and valuable reputation and goodwill in the name REDIFF including Internet over several years.

i) The respondent has registered domain name, which is deceptively similar to the corporate name of the complainant; thereby, wrongfully, illegally, and dishonestly trading upon the reputation of the complainant.

j) Upon communication among the parties, the respondent showed willingness to transfer the domain name to the complainant only on payment of a sum of money mutually agreeable.

The respondent argued to the following effect:

(i) The complainant, in accordance with the Sunrise policy published by the Department of Information Technology, should have registered the domain name within Sunrise Period. Since the complainant did not do so within the stipulated period, it lacked interest in the registration of domain name in its own name.

(ii) According to dictionary.com and American Heritage Dictionary by Houghton Mifflin Company, the word REDIFF is a combination of two words RED and IFF, which means "smart identification of friend or foe" and that he has coined the word by making this combination. Thus, it is his original term and unique business idea.

(iii) He chose .in TLD because he wanted users to know that people behind the website are from India.

(iv) Several parties, other than the complainant, have registered domain names using the word REDIFF not only in India but worldwide.

(v) The respondent wanted to launch a discussion board website where users can register and post real stories which they had experienced with a person. The other registered users on discussion board (website) would present their views and comment on posted story that would help author to decide whether the person in story behaved like a friend or a foe. In other words, he contended that it is his innovation in respect of the word REDIFF as also the business venture and therefore, he is entitled to the domain name.

In response to respondent's averments, the complainant submitted that:

(a) There is no bar in the policy of Department of Information Technology or law, to apply for registration of the domain names by the holders of trademarks or service marks, (which were reserved for 90 days under Sunrise policy for holders of trademarks or service marks) even after they were opened for registration by the general public. The complainant had, in fact, initiated process to register the said domain name well within the Sunrise Period with Net4India Ltd.'
(b) A delay in registration of domain name docs not mean waiver of rights, interests or claims in it, nor does it mean that the complainant is precluded from safeguarding Intellectual Property rights.

(c) The respondent's intention to make monetary gain by selling the domain name to the complainant and not to start any business is evident from his emails.

(d) Since February 16, 2005, till date the respondent has not put the domain name to any use.

(e) The respondent's claim about proposed launching a discussion board on the domain name is false and moreover, a copy of the facility which the complainant has been offering through its website.

(f) The respondent has intentionally attempted to create a framework whereby he can attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the complainant's mark and its group.

(g) The name REDIFF forms integral part of the complainant's various products and offerings. For instance, Rediffmail, Rediffmail Pro. Rediffmail Mobile, Rediff Bol, Rediff Matchmaker, Rediff Connexions, RediffIndia Abroad, and so on.

(h) Mere fact that the other parties are using combinations of the word 'rediff does not per se give any right to the respondent to use it. A delay in taking appropriate legal action against these parties does not mean that the complainant supports, agrees, or endorses such usage. An infringement of the complainant's Intellectual Property rights by third parties cannot confer a vested right in the respondent to infringe the same.

In response to complainant's reply, the respondent contended:

(i) It is a false statement of the complainant that they had initiated process of registration of domain within the prescribed period under Sunrise policy. Assuming that they had initiated the domain name registration
 process, the fact that they were not allotted the domain name, means they were not eligible for the domain name.

(ii) The complainant has not done anything to get domain name transferred in their name from the respondent during this entire period except discussion for the same.

(iii) There is no Message Board facility on the website of the complainant.

(iv) For want of support from venture capitalists, who put the matter on hold due to dispute raised by the complainant, the respondent could not commence use of domain name during the year.

(v) Despite friendly offer by the respondent to transfer the domain name, no positive steps were taken by the complainant to that effect.

(vi) Any legal action of the complainant is subject to Limitation Act.

(vii) In general, the complaint is bad, discriminatory, arbitrary, and unjustified.

After assessing the Sunrise Policy, the Arbitral Tribunal concluded that "since the complainant made no valid application during the prescribed period, the domain name automatically became open to general public from February 16, 2005." After perusal of the letter from the respondent to the complainant, the Arbitral Tribunal concluded that the registrant registered disputed domain name primarily for the purpose of selling or otherwise transferring it to the complainant. Further, the Tribunal held that there is no nexus between respondent's firm's name and the word 'rediff'. In the absence of any such evidence, it can be inferred that the respondent intentionally attempted to attract Internet users to the proposed website by creating confusion in respect of the complainant's names. By observing that "the registrant has registered the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration, to the complainant who owns trademark, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name," the Arbitral Tribunal ordered the transfer of disputed domain name to the complainant.
In Shevaldas C. Raghani v. Stephan Koenig, the complaint, who is in the business of sarees, alleged that the respondent has registered domain name computer.in, which is confusingly similar to his trademark and respondent is well-known speculator and has registered the domain name computer.in with the intention to sell it to others for profits. The complainant further alleged that the respondent has put up the domain name on parking, and is making money by luring customers to the website. Respondent, however, argued that the complainant failed to establish any contention and has not adduced any document to prove use of the mark. Further, the word 'computer' is highly descriptive and generic, and the complainant failed to prove that the word has acquired a secondary meaning. The respondent further contends that the complaint has been filed to harass him or to browbeat him into surrendering a legitimately registered domain name and is a blatant abuse of proceedings. Ruling against the complainant's contentions, the Arbitral Tribunal observed that "the only evidence is the bald claim that the mark has been under use since last 8 years. It is extremely weak and inadequate evidence to 'prove any enforceable right in the domain name against the respondents ... the complainant failed to prove that the domain name computer.in is related to the business of complainant. It is merely confined to a fact that the complainant is registered owner of the mark computer, in relation to sarees.

The Tribunal turned the tables on the complainant by observing that the complainant was guilty of reverse domain name hijacking and observed that '<the complaint is a blatant attempt by the complainant to hijack the domain name of respondent and in bad faith to harass the respondent and to abuse the process of law." The Arbitral Tribunal further directed the complainant to deposit - 10,000 in the registry of NIXI as a cost of this proceedings and burdening the administration to fulfil his ulterior motives. Not stopping at this, the Arbitral Tribunal directed the registry of NIXI to (a) take adequate precaution in entertaining such complaints; and (b) send a copy of this

decision to the Hon'ble High Court of Delhi at New Delhi to take further actions against the complainants, as this Tribunal cannot go beyond its jurisdiction, but at the same time, at pains that the scrupulous persons abusing process of law to harass others.”

In Google Inc. v. R. Jain,\(^67\) the complainant, Google Inc. is the owner of the mark ORKUT, which is also an immensely popular social networking website known for its video sharing features. The complainant has also applied for trademark registration for ORKUT in India. Complainant also owns several domain names consisting of the trademark ORKUT, like orkut.com, orkut.co.uk, orkut.ca; orkut.de, orkut.pt, orkut.co.il, orkut.com.au, and orkut.nz. The complainant objects to the use of domain name orkut.in by the respondent. In the absence of any response from the respondent, the Tribunal found the contentions forwarded by the complainant plausible and ordered the transfer of disputed domain name to the complainant.

Google was involved in another tussle to secure its domain name rights in the Indian context. In Google Inc. v. Edmunds Gaidis,\(^68\) the complainant objected to the use of domain name igoogle.co.in by the respondent. Upholding the contention of the complainant and transferring the disputed domain name to the complainant, the arbitrator observed that "the complainant's trademark GOOGLE is the keyword not only in website but in complainant's other business also. The disputed domain name had been registered intentionally only for the sole purpose to take advantages of the goodwill and the reputation enjoyed by the complainant under the trademark of GOOGLE. Respondent has other intention to register the disputed domain name for making money either from the complainant or from the third party by selling it."

Google seem to be a favourite among the domain name speculators. The company again challenged a .in domain name, google-money-system.in


in Google, Inc., U.S.A. v. Vaibhav Jain. Here, the complainant alleged identical or confusingly similar trademark being used by the respondent in his domain name google-money-system.in. The complainant contended that mere addition of letters "money or system" to GOOGLE does not differentiate the two domain names. Holding the respondent's domain name confusingly similar to the complainant's trademark GOOGLE and ordering transfer of the same to the complainant, the Arbitral Tribunal observed that the complainant's mark and domain name GOOGLE is a coined word and highly distinctive in nature. As such, consumers looking for GOOGLE may instead reach the registrant's website.

In another arbitration proceeding involving world famous fashion house, Armani, the Arbitration Tribunal sought to protect the goodwill and celebrity rights of well-known brands. In G.A. Modefine S.A. v. Naveen Tiwari trading as MKHOJ, the complainant had 263 trademark registrations for the mark ARMANI throughout the world, including India, and about 650 domain names registered in its name throughout the world, all having ARMANI as a significant part thereof, including several .in registrations. The complainant registered the domain name armani.co.in on July 8, 2004, under the Sunshine policy from C-DAC (which was subsequently transferred to Net4India). The domain name was renewed on July 8, 2006 for a period of one year. However, on application for further renewal on July 8, 2007, the Registrar refused to renew the same and issued it to the respondent. On request for transfer of the disputed domain name, the Registrar refused stating that the domain name was not timely renewed by the complainant. It is pertinent to note here that whenever a user types in armani.co.in, he / she was redirected to the complainant's international website armani.com.

The arbitrator held that the respondent had no right or legitimate interest in respect of the disputed domain name because: (a) respondent has

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not filed any reply and has not come up with any reason for adopting the disputed domain name; (b) respondent directed the website under the disputed domain name, to the official website of the complainant till the filing of the complaint; and (c) respondent has stopped using the disputed domain name after filing of the complaint. The Arbitral Tribunal found bad faith in respondent's conduct by observing that "mere non-renewal of disputed domain name in 2007 by the complainant does not entitle the respondent to adopt the same. Even in the absence of prior adoption of disputed domain name, the complainant is entitled to take action against the respondent. It is because the disputed domain name wholly incorporates the prior registered well-known trademark ARMANI of the complainant. Further, the arbitrator concluded that the respondent has registered the disputed domain name for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant, who is the proprietor of the trademark and trade name ARMANI, or to a competitor of the complainant, for a valuable consideration. Ordering the transfer of the disputed domain name to the complainant, the arbitrator observed that by using the disputed domain name, the respondent has intentionally attempted to attract Internet users to the respondent's website or other online location, by creating a likelihood of confusion with the complainants' trade name or trademark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The complainant again had to approach the arbitral tribunal to secure another domain name armaniexchange.in. In G.A. Modefine S.A. v. Domain Bazaar,71 the Arbitral Tribunal transferred the disputed domain name armaniexchange.in to the complainant by finding that the respondent's bad faith is exemplified by them asking for compensation to transfer the domain name.

Endorsing the .INDRP Arbitral Tribunal's finding in the ARMANI case, another arbitrator, in Kenneth Cole Productions, Inc. v. Naveen Tiwari,\textsuperscript{72} ordered the transfer of disputed domain name kennethcole.co.in from the respondent to the complainant. In this case too, the complainant was a world famous fashion house and the respondent failed to file any reply in response to the allegations of bad faith registration and lacking any right or legitimate interest in the disputed domain name.

Kenneth Cole fashion house again had to fight for the domain name kennethcole.in. In Kenneth Cole Productions, Inc. v. Viswas Infomedia,\textsuperscript{73} the complainant objected to the use of domain name kennethcole.in by the respondent, who did not file any reply despite repeated notices from the Arbitral Tribunal requesting the same. Transferring the disputed domain name to the complainant, the arbitrator observed that "registration of a famous trademark without legitimate commercial interests in the same is prima facie evidence that the respondent was well aware of the reputation and goodwill attached to the complainant's trademark / name. Thus, the respondent has registered the website in bad faith."

Another big corporation that had to repeatedly knock the doors of INDRP Arbitral Tribunal is Microsoft Corporation. The first case involving Microsoft Corporation was Microsoft Corporation v. Lhazang Ladenla,\textsuperscript{74} where the dispute was regarding the domain name microsoft.org.in. The complainant contended that the complainant's trademark MICROSOFT (which is also registered in India) was adopted in the year 1975 and has been used continuously and extensively not only as a trademark but also as a promotion key and a leading brand in the computer world. Further, the trademark MICROSOFT is most famous and well-known to the computer software users regarding its goods and services and by that, the total current

market of complainant is $254.52 billion worldwide as on March 2, 2010. After satisfying itself of all the requirements under the INDRP, the Arbitral Tribunal ordered transfer of the disputed domain name to the complainant.

In Microsoft Corporation v. Chun Man Kam,75 the complainant own, among other trademarks, the trademark MSN, and has also obtained trademark registrations in numerous countries for the MSN -mark in several classes of goods and services, including India. The complainant also offers localised versions of its MSN services, including MSN Hotmail and MSN Messenger, in eighteen languages to more than thirty countries worldwide and as a result, MSN has become one of the world's most popular Internet destinations. The respondent, however, argued that he registered the disputed domain msn.in solely for an upcoming online project named "Ms.N" and "Ms." is an English honorific used with the last name or full name of a woman, while "N" stands for people. The disputed domain name includes the word "msn," but in fact, the word "msn" is referring to "Ms.N". Since the respondent was unable to register the domain ms.n.in due to the inherent limitation of a domain structure, the respondent, therefore, omitted the 'dot' between "Ms" and "N," and hence, registered msn.in. According to the respondent, most of the cases relied on by the complainant in the Annexure may have bias, because the respondents in such cases likely did not file any response to the (WIPO) Panel. According to the respondent, the domain msn.in never resolves to the complainant's website, and the complainant statement is false and groundless. The respondent further stated that the complainant submitted the false statement for some improper purposes, so as to harass the respondent. The respondent further stated that he had deferred the online project "Ms.N" due to the financial crisis, and the respondent has registered the domain in a bonafide manner, although the domain still is not resolved yet.

The complainant sent a rejoinder to these contentions and averred that the impugned domain name is phonetically, visually, and structurally identical to complainant's registered trademark msn.in; thereby, not only infringing the proprietary rights of the complainant over the said mark but by doing so, also causing a confusion among the general public and the complainant's mark MSN is registered in numerous countries in several classes of goods and services and the MSN's Internet portal msn.com is the 6th most visited domain name on the Internet. Further, the complainant contended that the cases are decisions given by the WIPO Arbitration and Mediation Centre and the fact that the decisions were made ex parte does not in any manner affect the validity and binding nature of the decisions.

In ruling against the respondent and ordering transfer of disputed domain name to the complainant, the arbitrator reasoned thus: (a) the respondent has not produced any material to support his contention that 'N' stands for people and that the respondent has not shown any connection or resemblance between his upcoming online project and the "Ms.N"; (b) the respondent attempts to educate a reason that due to the inherent limitation of a domain structure, he omitted the 'dot' between 'Ms' and 'N', and registered msn.in, which is neither plausible nor permissible in law; (c) merely because of non-availability of a particular structure in domain name, no one can be permitted to encroach upon another one's lawful domain; and (d) even the respondent's admission that he has deferred the online project "Ms.N" raises strong suspicious over the respondent's bonafide.

Again, in Microsoft Corporation v. Yan Wei, the Arbitral Tribunal inclined in favour of the complainant for the disputed domain name microsoftstore.in. In the instant case, the arbitrator transferred the disputed domain name to the complainant due to the immense popularity and trademark associated with the complainant, and in the absence of any reply from the respondent to rebut the claims of identical or confusingly similar

domain name registration with bad faith having no right or legitimate interest in the disputed domain name.

In an associated case related to the owner of the Microsoft Corporation, Bill Gates, the Arbitral Tribunal again weighed in favour of the renown accompanying the complainants. In Bill & Melinda Gates Foundation v. Syed Shahzad, the complainant, a charitable organisation that works to help all people lead healthy and productive lives; and in developing countries, it focuses on improving people's health and to lift themselves out of hunger and extreme poverty, objects to the use of domain name gatesfoundation.org.in by the respondent. The complainant has applied for registration of the mark "Bill & Melinda Gates Foundation" in India, which is pending. However the complainant is already registered owner of the service mark in U.S.A. Further, the complainant owns several websites incorporating the words 'gates' and 'foundation', like gatesfoundation.org, gatesfoundation.in, and gatesfoundation.co.in. The complainant contended that the logo on the respondent's website is exactly the same, and the font and colours are also the same. There is also a button provided for 'Apply Now' on the respondent's site by which the users are directed to a page where they are directed to fill in a sheet of information about themselves, though it is not clear as to how this gathered information is actually being used by the respondent. The respondent, however, apologised in this case and offered unconditional transfer of the disputed domain name to the complainant. In conclusion, the arbitrator noted that "I must mention and bring on record that an act of the respondent of registering such domain name appears clearly to be with ill-intentions and in bad faith."

The Arbitral Tribunal was also approached for the transfer of domain name einstein.in. In Yeshiva University v. Liu (Xiong), the complainant is a research institution located in the U.S.A. and has its activities in some other

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countries also; and also holds the service mark ALBERT EINSTEIN, ALBERT EINSTEIN COLLEGE OF MEDICINE in U.S.A. The applications of the complainant for the registration of the trademark EINSTEIN is pending in India and European Union. In disputing the respondent's claim over the domain name einstein.com, the complainant submitted: (a) the complainant's institutions include the Albert Einstein College of Medicine, Yeshiva College, Stem College for Women, Sy Syms School of Business, Benjamin N Cardozo School of Law, Wurzweiler School of Social Work, Ferkauf Graduate School of Psychology, Azrieli Graduate School of Jewish Education and Administration, Bernard Revel Graduate School of Jewish Studies, and Rabbi Isaac Elchanan Theological Seminary, etc. (b) the respondent (as an individual, business, or other organization) has not been commonly known by the mark "Einstein"; (c) the respondent is not making a legitimate or fair use of the said domain name for offering goods and services; and (d) the respondent registered the domain name for the sole purpose of creating confusion and misleading the general public; (e) the main object of registering the disputed domain name by the respondent is to earn profit by selling it and to mislead the general public and the customers of the complainant; (f) the use of a domain name that appropriates a well-known trademark or service mark to promote competing or infringing products cannot be considered a "bona fide offering of goods and services."

Upholding the complainant's contentions and ordering transfer of the disputed domain name to the complainant, the Arbitral Tribunal had to examine the bad faith since complainant didn't furnish adequate information of respondent's attempt to sell the disputed domain name for profit. The complainant stated that during March 2010, one Mr. K. Gogoi had registered the disputed domain name. On March 23, 2010 the complainant sent a Cease and Desist notice to Mr. Gogoi. On March 31, 2010, Mr. Gogoi replied via email that he had registered the said domain on January 19, 2009, and that the said registration has expired on January 19, 2010, and he had not renewed it during renewal grace period as well. Therefore, within a short period (in usual
domain cycle of 7 5 days) the said domain will be freed by registry for registration. However, the complainant did not take any action for the registration of the disputed domain. On April 7, 2010, the respondent acquired the same. A visit to the disputed domain name says that "the domain einstein.in may be for sale by its owner. More details sedo." A click at the said statement opens a domain name www.sedo.co.uk, which contains a description that "domain Einstein.in is for sale. Seller's Listing Price: US $3,000." It is, thus, clear that the registrant is using the domain only for sale. The complainant, however, didn't give these details to the Arbitral Tribunal.

In transferring the disputed domain name to the complainants, the arbitrator made note of a peculiar aspect concerning the registration of the disputed domain name. The arbitrator observed "that the registrant has given his address only as '503 Room, New Delhi and mobile telephone number as 91.12345678.' How a domain could be registered by the Directi Internet Solutions Pvt. Ltd., the Registrars, with these particulars? This requires investigation and appropriate action by the competent authorities."

Finally, in the latest ruling by an INDRP arbitrator in Rhodia v. Shi Jing,79 the arbitrator relied on several WIPO and INDRP decisions to transfer the disputed domain name to the complainant. The complainant, a French corporation, is the owner of numerous trademark registrations with the term RHODIA in several jurisdictions, including India. The complainant is the world leader in the development and production of specialty chemicals. Further, the complainant provides added-value products and high-performance solutions to diversified markets, including automotive, electronics, flavours and fragrances, health, personal and home care, consumer and industrials goods, through its six global enterprises, including two companies in India, Albright & Wilson Chemicals India Ltd. (A WeI), acquired in 2000, and Hindustan Gum & Chemicals (HICHEM) - a joint venture with one of India's largest conglomerates, the MP Birla Group, since 1962. The respondent, a

Chinese resident, failed to file any reply pertaining to the disputed domain name rhodia.in. Placing reliance on a number of decisions from WIPO Arbitration and Mediation Centre as well as those decided under INDRP, the arbitrator found the registration of disputed domain name as a case of bad faith registration. The arbitrator observed that "while the overall burden of proof rests with the complainant, Panels have recognised that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. Therefore, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. Thus, it is clear that the respondent is using the disputed domain name in bad faith and has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name."

In conclusion, it can be safely submitted that INDRP zealously protects the well-known names, trademarks, and trade names.

The INDRP and the INDRP Rules of Procedure are modelled on ICANN UDRP and Rules for UDRP respectively, which provide quick, inexpensive and efficient domain name dispute resolution mechanism. While both the policies and associated rules are similar, yet there are subtle differences between the two, which are highlighted below:

(1) While INDRP deals only with domain names registered as .in ccTLD, UDRP deals with disputes arising out of the registration of any domain name, including those ccTLDs, the Registries of which have entered into an understanding with ICANN to submit the registrants to ICANN UDRP procedures in case of disputes pertaining to such ccTLDs.

(2) Under the UDRP, the complainant in each case selects the Provider from a list of Providers who will administer the proceedings; while under the INDRP, the .IN Registry is the sole Provider for dispute resolution services.
(3) The Rules for UDRP and the Supplemental Rules framed by the respective Providers govern the process of initiating and conduction the proceedings and for appointing Panel under the UDRP, while under the INDRP, the Arbitrator has to conduct the proceedings in accordance with INDRP Rules of Procedure and the Arbitration and Conciliation Act, 1996.

(4) The INDRP does not deal with consolidation. Under the UDRP, however, where there are a multiple disputes among the parties, either party may petition to consolidate the disputes before a single Administrative Panel. This petition has to be made to the first Administrative Panel appointed to hear the pending disputes between the parties.

(5) The UDRP makes an exception to the general rule that all the fees charged in connection to a dispute are payable by the complainant. It provides that if the Administrative Panel is expanded from 1 to 3 Panellists, then, all the costs arising out of the dispute would be split evenly among the parties.

(6) The UDRP specifically provides under Paragraph 4(k) that the proceeding under the Policy does not make the parties ineligible from submitting the dispute before a court of competent jurisdiction before the proceeding under the Policy is commenced or after such proceeding is concluded. The INDRP is silent in this regard.

(7) INDRP does not lay down the circumstances when a domain name will be cancelled, transferred, or changed, while UDRP recognises three circumstances when the domain name will be cancelled, transferred, or changed, as follows:

(a) subject to the provisions of Paragraph 8 of UDRP, on receipt of written or appropriate electronic instructions from the registrant or his authorised agent to take such action;

(b) on receipt of an order from a court or Arbitral Tribunal, in each case of competent jurisdiction, requiring such action; and/or

(c) upon receipt of a decision of an Administrative Panel requiring such action in any administrative proceeding to which the registrant was a party and which was conducted under UDRP.
5. Domain Names Registration in India

India has been assigned .in ccTLD by the ICANN, which is managed by The National Internet Exchange of India (NIXI). The Government of India set up NIXI, a not-for-profit organisation established under Section 25 of the Companies Act, 1956, promoted by the Department of Information Technology (DIT) in association with the Internet Service Providers Association of India (ISPAI), on July 19, 2003. The primary objective of creation of NIXI was to offer a set-up for peering of Internet Service Providers (ISPs) among themselves for the purpose of routing the domestic traffic within the country, instead of taking it all the way to other countries, like USA. This will help in achieving better quality of service in the form of reduced latency and reduced bandwidth charges for Internet Service Providers (ISPs) by saving on International Bandwidth.

Since 2005, NIXI is also managing the .in ccTLD Registry on behalf of Government of India. For this purpose, NIXI created INRegistry, which functions as an autonomous body with the primary responsibility for maintaining the .in ccTLD and ensuring its operational stability, reliability, and security. The INRegistry is responsible for implementing various elements of the new policy set out by the Government of India and its Ministry of Communications and Information Technology, Department of Information Technology.

The new era for .in began with a Sunrise Period. Owners of registered Indian trademarks or service marks, who wished to protect their marks, were given the opportunity to apply for .in domain names before the general public. Sunrise applications were taken from January 1 to January 21, 2005. During this period, Indian citizens and entities were given preference over the foreign

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83 Id
ones.\textsuperscript{84} The date for the opening of real-time, open registration for the general public on first-come-first-served basis was February 16, 2005.\textsuperscript{85}

.in domain names are available to anyone - companies, individuals, and organisations in India and abroad. .in Registry does not carry out registrations itself. Instead, it accredits Registrars to register .in domain names. The accredited Registrars authorised to register .in domain names include: \textsuperscript{86}

1. #1 IndianDomains d.b.a. Mitsu.in
2. 101Domain, Inc.
3. 1API GmhH
4. A to Z Domains Solutions Pvt. Ltd.
5. Aapkadomain.com (BE Software Solutions)
6. Alankit Technologies Ltd
7. Ascio Technologies
8. BB Online UK Ltd.
9. Bharat Domains d.b.a. Bharat.in
10. Big Rock Solutions Limited
11. BiznetIndia Dot Com Private Limited
12. Business Solutions
13. CORE Internet Council of Registrars
14. CPS-Datensysteme GmbH
15. CSC Corporate Domains, Inc.
16. Cyhersites India Technologies Pvt. Ltd.
17. Data Infosys Limited
18. Dinahosting SL
20. Directi Web Services Pvt. Ltd.
21. Domain People, Inc.

\textsuperscript{86} Source: http://www.registry.in/Accredited_Registrars. Last accessed on January 19, 2015
22. Dotcom Services (India) Pvt. Ltd. d.b.a. WorldIndia.com
23. Dynadot LLC
24. eNom
25. EPAG Domainservices GmbH
26. Enames.IN d.b.a. Pearl Infocom Media (P) Ltd.
27. Gandi SAS
28. GoDaddy.com, Inc.
29. GoodLuckDomains
30. Hostin Services Private Limited
31. IKON Marketing
32. IN Registrar d.b.a. inregistrar.com
33. IP Mirror
34. InCyber Advertising
35. IndiaLinks Web Hosting Pvt. Ltd
36. Infocom Network Ltd.
37. Instra Corporation Pty Ltd.
38. InterNetX
39. InterNetworX Ltd. & Co. KG
40. Internet.bs Corp
41. Key-Systems GmbH
42. Lime Labs LLC
43. Magnum International Ltd.
44. Mailclub SAS
45. Mark Monitor
46. Melbourne IT Ltd.
47. Mesh Digital Ltd. d/b/a Domainmonster.com
48. Mobile Name Services, Inc.
49. Mr. Site Takeaway Website Pvt. Ltd.
50. Name.com LLC
51. Net Chinese Co. Ltd.
52. Net4India Limited, d.b.a. Net4Domains
53. Netandhost.com (S.G.S. Technologie Private Limited)
54. Netlynx Technologies Pvt. Ltd.
55. Nihar Info Global Limited 56.0VH
56. OnlineNIC
57. Pioneer Elabs Limited
58. Quantum Pages Technologies Pvt. Ltd. d.b.a. OwnRegistrar.com
59. Realtime Register B.V.
60. Rediff.com
61. Safenames Ltd.
62. Secura Gmbh
63. Sify Ltd.
65. Silicon House
66. Sipence, Inc.
67. Software Technology Parks of India (STPI)
68. Space2Let.com Services Pvt. Ltd
69. Spectra ISP Networks Pvt. Limited
70. Sree Jain Infotech d.b.a. Book and Host Online Services
71. TierraNet Inc d.b.a. DomainDiscover
72. Times Internet Limited
73. Transecute Solutions Pvt. Ltd.
74. Tucows Inc.
75. Variomedia AG d.b.a. puredomain.com
76. Visesh Infotecns Ltd., dba Signdomains.com
77. Web Commerce Communications Limited
78. Web Werks India Pvt. Ltd. d.b.a. DforDomains.com
79. Webair Internet Development Inc.
80. Webiq Domains Solutions Pvt. Ltd.
81. Wild West Domains Inc.
82. documentdata Anstalt
83. eNom
84. planA Corp. d.b.a. INdomains.net
The Government Registrars include:  

1. **gov.in, mil.in**: National Informatics Centre (NIC) is the exclusive registrar for gov.in and mil.in domain names.

2. **ac.in, edu.in, res.in**: ERNET is the exclusive registrar for ac.in, edu.in, and res.in domain names.

Registration of the following .in ccTLD is available freely to all parties worldwide without any nexus or other qualifications:  

(a) .in  
(b) co.in  
(c) net.in  
(d) org.in  
(e) firm.in  
(f) gen.in (General)  
(g) ind.in (Individuals)

However, the following zones are reserved for use by only qualified organisations in India:  

(a) ac.in (Academic)  
(b) res.in (Indian Research Institutes)  
(c) edu.in (Indian Colleges and Universities)  
(d) gov.in (Indian Government)  
(e) mil.in (Indian Military)

All .in ccTLD registrations are subject to the following general rules:  

(i) **Term**: The Domain Names may be registered for a minimum of one (1) year, and a maximum often (10) years.  

(ii) **Auto-renewal**: Domains automatically renew at the end of their term (the expiration date) upon payment of requisite fee.

(iii) **Domain Length**: .in domain names may be between 3 and 63 characters in length.

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87 Id  
89 Id  
90 Id
(iv) Allowable Characters: Only letters, digits, and hyphens are accepted in a domain name. Names cannot begin or end with hyphens.

(v) Contact Information: Registrants must provide true and accurate contact information. The following contact types are required: Registrant, Administrative, Technical, and Billing. The contact data will be displayed in the .in WHOIS,\textsuperscript{91} except for the Billing contact data, which is not displayed.

(vi) Transfers: For names in the unrestricted zones mentioned above, registrants are allowed to transfer their domains to the Registrar of their choice. Registrants should contact their Registrar of choice to learn about transfer procedures, Registrar-to-Registrar transfers are not allowed in the sixty (60) days following the creation of a domain name. A Registrar-to-Registrar transfer adds one year to the term of the domain name, charged to the Gaining Registrar. Registrars may, therefore, charge the Registrant for the domain year.

(vii) Grace Periods: Certain grace periods available with the Registrars exist to allow for the cancellation of transactions by Registrars within certain time periods.

(viii) Name-servers: To register a .in domain, the registrant does not need to provide name servers. In order to appear in the zone file and resolve on the Internet, at least one (1) valid IPv4 or IPv6 name-server must be associated with the domain name. However, using at least two valid name servers is recommended.

(ix) Right of Refusal: The Registry has the authority to deny or suspend a registration if it conflicts with the sovereign national interest or public order.

(x) Right to Adjust Allocated Bandwidth: The Registry Operator has the right to adjust the allocated bandwidth and connections allotted to the Registrars.

\textsuperscript{91} Available at http://www.registry.in/WHOIS%20Search.
Besides, the .in ccTLD registrants are also subject to additional Terms & Conditions.\textsuperscript{92}

In order to prevent the abuse of .in ccTLD registration process, the Government of India has reserved a list of names for government and registry use. These include the names related to ICANN, IANA, Internet bodies, TLDs, States and Union Territories, Indian constitutional authorities, names of countries, and certain additional names.\textsuperscript{93}  

\textsuperscript{92} Available at http://www.registry.in/system/files/Terms_and_ConditionsjocRegistrants_l.pdf. Last accessed on January 19, 2015

\textsuperscript{93} For a complete list of reserved names, see, http://www.registry.in/systemfiles/Reserved\_Names_l.pdf. Last accessed on January 19, 2015