CHAPTER III
REGISTRATION, ASSIGNMENT AND TRANSMISSION OF TRADE MARKS AND DOMAIN NAMES
REGISTRATION, ASSIGNMENT AND TRANSMISSION OF TRADE MARKS AND DOMAIN NAMES

A- Trade Mark

An Overview

Before the enactment of the Trade Mark Law, the trademark used to be called common law marks. However the common law mark could not be registered. Further the owner of a common law mark had to protect his mark against the acts of infringement or passing off by initiating common law proceedings. But such proceeding can be launched only when the mark had actually been used by an infringer. As a result, such proceeding used to be time taking, that led the necessity to bring a special legislation for smooth functioning.

It is not necessary that the trade mark is registered, it may be either registered or unregistered. The law provides legal remedies against infringement for both registered trademarks and unregistered trademarks. Registration of Trademarks is prima facie evidence of ownership, whereas in case non registration it has to be established by the way of prior use and passing off in action.

Registrar of Trade Mark

Registrar of trademarks is defined in the section 3 of the Trade Marks Act, 1999. The Registrar of Trade Marks is the authority who is accountable for the registration of trademarks, along with the responsibility of settling opposition proceedings and rectification of the register. The registrar indeed is vested with a remarkable range of discretionary powers. Besides these he has powers of civil courts in any specified matters and residuary powers as well. He also has the power to review his own decision.
There is also a Joint Registrar, Deputy Registrar, Assistant Registrars and Examiners of trademarks and clerical staff to assist the Registrar.

**Basic Rules for Registration of Trade Marks**

The purpose of the Trade Mark Act 1999, as stated in the preamble, is to provide for the registration and better protection of Trade Marks and to prevent the use of fraudulent marks. In consonance with this object the following fundamental principles of Trade Mark law are embodied in the various provisions of the Act.¹

(a) According to section 9 since registration confers on the proprietor a kind of monopoly right over the use of the mark, which may consist of a word or symbol legitimately required by other traders for bona fide trading or business purposes, certain restrictions are necessary for the class of words or symbols over which such monopoly right may be granted. Thus descriptive words, surnames and geographical names are not considered prime facie registrable.

(b) According to section 9 registration of a Trade Mark should not interfere with the bona fide use by any person of his own name or that of his place of business, or the use of any bona fide description of the character or quality of the goods.

(c) Section 34 of the Act provides that property rights in a Trade Mark acquired by use are superior to similar rights obtained by registration under the Act. It, therefore, follows that prior users of Trade Marks should be protected against any monopoly rights granted under the Statute.

(d) According to section 11 there are obviously two main interests to be protected when a mark is presented for registration. There is first the interest of the public. A Trade Mark ought not to be registered if its use will be apt to mislead the public as to the
origin of the goods they are purchasing. There are also the interests of other traders who are entitled to object if the use of the Trade Mark proposed for registration will be calculated to enable the applicant’s goods to be passed off on the public as such other trader’s goods. Thus a mark which is similar to a mark already registered or used for similar goods will not be allowed registration.

(e) Section 12 of the Act states that it may so happen that a trader honestly used a Trade Mark for a number of years although an identical or similar mark has been registered or used by another. It will obviously cause hardship to such a trader if he is deprived of the benefits of registration. There is therefore provision for registration of such marks subject to suitable conditions and limitations.

(f) According to section 12 the life of a Trade Mark depends on its use; and continued non-use may lead to its eventual defeat. There is, therefore, no equitable or logical basis for the continuance of the protection afforded by registration where the mark is no longer in use for a sufficiently long period. This principle is recognized in the Act by providing for the removal of a mark from the register on the ground of non-use.

(g) Sections 40-45 provides that a Trade Mark is recognised as a form of property. The term “proprietor of a Trade Mark” is used in the definition of a Trade Mark and also in various other provisions of the Act. It should, therefore, be assignable and transmissible as in the case of other forms of property. Having regard to the peculiar nature of this property, the Act has taken care to impose various restrictions and conditions for the assignment or transmission of property rights in a Trade Mark, whether registered or unregistered.

(h) According to sections 20 and 21 granting the benefits of registration under the Statute is not only a matter of interest to
the applicant seeking registration, but is a matter is which the public is also interested. It is, therefore, necessary that any member of the public who wants to object to the registration should be permitted to do so. The Act accordingly provides for advertisement of the application and opposition thereto by any person.

These principles are substantially the same in all countries administering Trade Mark law.

**Registration of Trade Mark**

The process whereby a Trade Mark is entered on the register of the Trade Marks is referred to as registration. The Trade Mark Act, 1999 does not expressly list any requisites of registration. The requirements of registration and the definition of Trade Mark have converged. Instead of detailing requisites for registration. The Trade Mark Act, 1999 envisages a list of negative elements.

The Trade Mark Act, 1999 does not define the categories of marks registerable or the requisites for the registration of a mark. It defines what marks are not registerable under two headings, namely absolute grounds for refusal section 9 and relative grounds for refusal under Section 11 of the Act and then proceed to state the circumstance in which they may be registered. The basic qualification of registrability of a mark is contained in the definition of Trade Mark itself, namely-

1. Capable of being represented graphically, and
2. Capable of distinguishing the goods or services of one person from those of others.

The advantage of this scheme is that whatever is not prohibited from registration is registerable if it satisfies the above two requirements. This has enormously included the scope of registerable marks.
Grounds for Refusal of Registrations

(1) Absolute Grounds for Refusal

The following categories of trademarks shall not be registered under section 9.

(a) Trade Mark Devoid of Distinctive Character

If a Trade Mark is devoid of distinctive character the same cannot be registered under section 9 (1) (a).

The word ‘distinctive’ in the context of Trade Marks means distinguishing a person’s goods or services from similar goods or services of another or from such goods or services without a Trade Mark.

On the basis of the degree of distinctiveness present in the marks the Trade Marks were also divided into two categories i.e. Part A and Part B with different rights. The 1999 Act has integrated both types of distinctiveness and categories into one. Now registration can be granted in the presence of a lower degree of distinctiveness, which is referred to as distinctive character or capability of distinguishing naturally there is no objection to the presence of higher degree of distinctiveness.

The distinctive character can be both inherent or acquired when the Trade Marks ipso facto possesses certain features making it capable of distinguishing if is referred to as an inherent distinctive character in the Trade Mark. A Trade Mark may come to acquire distinctive character as a result of use other circumstances, is referred to as acquired a distinctive character. A Trade Mark which possesses acquired distinctive character can never be refused registration.
(b) Trade Marks Consist Exclusively of Marks

As per section 9 (1) (b), the Trade Mark which consist exclusively of marks or indications which may serve in trade to designate they are

(i) Kind
(ii) Quality
(iii) Quantity
(iv) Intended purpose
(v) Value
(vi) Geographical origin or
(vii) Time of production or rendering of services; or
(viii) Other characteristics of goods or services shall not be registered as Trade Mark, Laudatory words such as perfection, good, excellent, fine and words of common usage may now be register able if they form act of a Trade Mark in combination with other material, and display ‘distinctive character’.

The refusal of registration entails only, whereas Trade Mark is exclusively formed by any of these eight characteristics matters. If there is another matter in Trademark, which makes the Trade Mark a composite whole of non-distinctive and distinctive matter and the Trade Mark finally possesses a distinctive character, than the above disabilities do not operate as a prohibition for registration.

(c) Customary Paradigms in Contemporary Semantics of Trade and Established Practices

Section 9 (1) (c) prohibits marks, indications, very common words, words common to trade or customary in the current language or in the established practices of trade from being registered as a Trade Mark. Two cases are covered: marks or indications which have become customary (a) in the current language, or (b) in the bona fide and established practice of trade. Trade Marks consisting exclusively of marks or indications which have been customary in the current
language or are used in the bona fide and established practice of trade, shall not be registered as Trade Marks.

Very common words and indication which are required by other traders and such other marks which appear to be in the public domain shall not be registered.

(d) **Grounds Based on Public Policy and the Public Interest**

Section 9 (2) fulfils the proposition that all Trade Marks serve a double purpose of identification of the source and protection against confusion function for the benefit of consumers, Section 9 (2) reads as under-

**A mark shall not be registered as a Trade Mark if**

(a) It is of such a nature as to deceive the public or cause confusion;
(b) It contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizen of India;
(c) It comprises or contains scandalous or obscene matter;
(d) Its use is prohibited under the Emblems and Names (Prevention of Improper use) Act, 1950.

Section 9 (2) (a) is double edged provisions and would come handy in favour of owners of the reputed Trade Mark (s) to successfully oppose the registration application in relation to similar Trade Marks sought to be registered on similar or even for different goods or services. The protection afforded to repute Trade Marks by refusing the registration application of others under section 11 of the 1958 Act had contributed to creating a legal environment in which there have been less chances of Traders attempting to imitate Trade Marks of others.

(e) **Grounds for Refusal Based on Shapes and Contours of Goods**

The growth of design variations of shapes of goods has helped the marketing success of the products, which built a desire to protect
such shapes as a Trade Mark. In the Trade Marks Act, 1999, there is specific mention of possibility of the shape of goods as a mark.

Shape Trade Marks are possible only for goods and they are not available for services. Shape Trade Marks are allowed registration for the first time in India from the commencement of the Trade Marks Act, 1999.

A Trade Mark consisting of shapes other than the three prohibited shapes shall be registered as a Trade Mark. In effect the permission to register the shape is somewhat like allowing registration of an industrial design as a Trade Mark.

Section 9 (3) prohibits registration of marks as Trade Marks if the marks consist exclusively of the shape of goods, which read as follows-

Section 9 (3) a mark shall not be registered as a Trade Mark if it consists exclusively of:

(a) The shape of goods which result from the nature of the goods themselves; or
(b) The shape of goods which is necessary to obtain a technical result; or
(c) The shape which gives substantial value to the goods.

(2) Relative Grounds for Refusal

Section 11 (1) to (3) state the law of refusing registration of Trade Marks on the basis of likelihood of confusion or association with earlier Trade Marks including well-known Trade Marks.

(a) Similarity with Earlier Trade Marks – Similar Goods/ Services

Section 11 (1) of the Trade Marks Act, 1999 enacts the basic principle of Trade Mark law that no Trade Mark shall be registered if it
is identical or similar to an earlier registered Trade Mark for similar goods or services. The requirements under section 11 (1) is a collar to the exclusive right extended to the registered Trade Marks and to protect the rights of the Traders in relation to the goods or services marketed by them under those Trade Marks.

Section 11 (1) (a) and (b) operative only if one of the two results are achieved

(i)  Likelihood confusion on the part of the public; or
(ii)  Likelihood of association with earlier Trademark.

Likelihood of confusion with the earlier Trademark may arise, if there is a likelihood on the part of the public to associate the Trade Mark sought to be registered with ‘Earlier Trade Mark’.

The likelihood of confusion resulting in refusal of registration in section 11 has to be based upon:

(a)  Identity of the Trade Mark with an earlier Trade Mark and similarity of goods or services covered by earlier Trade Mark;
(b)  Similarity of Trade Mark with earlier Trade Mark and their identity of similarity of goods or services covered by earlier Trade Mark. Section 11 (1) prohibits the registration, when the Trade Mark applied for being identical or is similar to an earlier Trade Mark and the goods or services on which later mark is sought to be used are similar to goods or services covered by the earlier Trade Mark. It follows that there can not be on the register simultaneously two or more registrations the same or nearly resembling marks, in the name of different proprietors in respect of similar goods or services.

Section 11 (1) states that a Trade Mark will not be registered if there exists a likelihood of confusion on the part of public. In British India Corp V. Kharaiti Ram² where the petitioners were established manufacturers of shawls, blankets and they have been selling their
goods from 1920 under the Trade name ‘DHARIWAL’ with the device of lamb written in a characteristic style. The petitioners got registration of the mark granted in its favour in 1955. The respondents' registration application describes their Trade Mark as DWM - DHARIWAL, for the same goods in the same class, which could be registered. They have been in fact been using a part of the same class, which could be registered. They have in fact been using a part of the proposed Trade Mark namely DHARIWAL, which is same as registered for the petitioner. By dropping the prefix ‘DWM’ from the Trade Mark in doing actual business an effect is being made by the respondents to device the general public. This cannot be said to be an honest intention. The possibility of confusion between the goods of the two manufacturers by virtue of their using the Trade Mark containing the same device and the same Trade Mark containing the same device and the same trademark is very real. The court held that the registration is justifiably refused.

(b) Similarity with Earlier Trade Marks

Section 11 (2) prohibits registration of subsequent marks even for different goods or services if the earlier Trade Mark is a well-known Trade Mark in India. The protection to well-known marks for different goods is not absolute, it would be operative only if the later mark, without due cause-

- It taking unfair advantage of earlier Trade Mark?
- Is detrimental to the distinctive character of an earlier Trade Mark? Or-
- Is detrimental to the repute of earlier Trade Mark for applicability of section 11 (2)?, the following is also required-

(i) Earlier Trademark satisfies the definition of earlier Trade Mark given in the explanation to section 11 (4),
(ii) Earlier Trade Mark is registered in the name of different proprietors, irrespective of the goods or services for which it is registered,

(iii) Earlier Trade Mark is well-known in India. This last requisite would mean that the Trade Mark has to be well known as per the standards listed in section 2 (1) (zg) read with section 11 (6) to section 11 (9).

(c) **Later Mark Likely to be Prevented from Use**

Section 11 (3) is a new path breaking provision and reads as follows-

A Trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented.

(a) By virtue of any law in particular and law of passing off protecting an unregistered Trade Mark used in the course of Trade, or

(b) By virtue of law of copyright.

Section 11 (3) may be invoked by proprietor of earlier Trade Mark when the use of later Trade Mark would be prevented in India by virtue of (i) any law in particular the law of passing off protecting an unregistered Trade Mark or (ii) by Indian law of copyright. This type of phraseology or language appears to subsume or give sanction to the concept of trans boarder reputation which was evolved by Indian courts to protect reputed foreign marks whether registered or unregistered in India. The law of passing off protecting unregistered Trade Mark is also available to proprietors of registered marks. Protection by passing off may be claimed by registered marks when the similar later mark is liable to be prevented by virtue of the law of copyright, section 11 (3) has an application.
(3) **Honest and Concurrent Use**

Under Section 12 the Registrar may permit the registration to more than one proprietor of the trademarks which are identical or similar, irrespective of an earlier registration in respect of one of them, on the ground of honest and concurrent use or other special circumstances.

In *Gupta Enterprises V. Gupta Enterprises* the court allowed registration of the trade mark “MBS” on the ground that there was no complaint from public in relation to the goods under the rival marks even after the user of mark for 25 years and there was nothing to suggest that the user of the trade mark was not innocent, honest and bona fide.

(4) **Names of Chemical Elements or International Non-Proprietary Names not Remittable**

No word, which is commonly used and accepted name of any single chemical element or any single chemical compound (as distinguished from a mixture) in respect of a substance or preparation, or which is declared by the World Health Organisation and notified in the prescribed manner by the Registrar from time to time, as an international non-proprietary name or which is deceptively similar to such name, shall be registered as a trademark.

(5) **Names and Representations of Living Persons or Persons who Recently Died**

Where an application is made for the registration of a trademark which falsely suggests a connection with any living person, or a person whose death took place within twenty years prior to the date of application for registration of the trade mark, the Registrar may, before he proceeds with the application, require the applicant to furnish him with the consent in writing of such living person or, as the case may be.
be, of the legal representative of the deceased person to the connection appearing on the trade mark, and may refuse to proceed with the application unless the applicant furnished the registrar with such consent.  

**Judicial Response**

There are various judicial decisions which are indeed helpful for clear and proper understanding to refuse registration on the absolute & relative grounds of a trade mark and reasons when the trade marks can be allowed for registration.

**Apple Laboratories V. Boots Company**

In this case already registered trade mark was BRUFEN and trademark sought to be registered in the name of BRUFSRTE. Registration refused on the ground of likelihood of causing confusion or deceptive similarity.

**British Steel Corporation London V. The Registrar of Trade Marks**

As mention earlier, distinctiveness is the primary Condition of a trade mark. The burden is on the applicant to prove distinctiveness or capability of being distinguished of the mark so as to claim monopoly of using the mark.

**Eastman Photographic Material V. The Controller General Trade Marks.**

Solio word for photographic paper allowed for registration on the ground of invented world.

**Illustrations :**

<table>
<thead>
<tr>
<th>Words Found</th>
<th>Invented</th>
<th>Registration Allowed</th>
</tr>
</thead>
<tbody>
<tr>
<td>Flexgrip</td>
<td></td>
<td>used in relation to pens &amp; the other writing instrument.</td>
</tr>
</tbody>
</table>
Matkewala used for items like roasted gram and roasted groundnuts.  

Colgate Palmolive Co. V. Balsara Hygiene
The registration of word Promise allowed on the ground that the word found non-descriptive.

Illustrations-

<table>
<thead>
<tr>
<th>Words Found Non-Descriptive</th>
<th>Registration Allowed.</th>
</tr>
</thead>
<tbody>
<tr>
<td>Solar</td>
<td>used for photographic apparatus, studio light etc.</td>
</tr>
<tr>
<td>Stayfree</td>
<td>used for sanitary napkins etc.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Words Found Descriptive</th>
<th>Registration Refused</th>
</tr>
</thead>
<tbody>
<tr>
<td>Fair and Lovely</td>
<td>for cosmetics</td>
</tr>
<tr>
<td>Tripti</td>
<td>For aerated water, juice and beverages</td>
</tr>
</tbody>
</table>

Surnames
Registration allowed on the ground of distinctiveness and the user.
Cadbury – For confectionery.
Toefani- For cigarettes on the proof of extensive user.

Surnames – Registration Refused
Spicer – No evidence of distinctiveness.
Zimmer – No evidence of distinctiveness.

Geographical Names- Registration Allowed
Italia – For motor cars.
North Pole – On the ground of distinctiveness.

Geographical Names – Registration Refused.
India – For electric fans.
Himalaya – No importance in respect of goods.
Procedure for Registration

The foremost conditions during the registration process is the desire of the person to register the Trade Mark. Before seeking registration the person should either be the proprietor of the Trade Mark or the same must be proposed to be used by him in respect of goods or services. The surest means of acquiring effective Trade Mark right is to obtain registration and also use the mark on goods or in relation to services in India.

The Procedure for registration of a Trade Mark is enumerated in sections- 18 to 23 of the Trade Marks Act, 1999.
Appropriate Office of Registry

The application for registration of Trade Mark should be filed in the office of the appropriate Trade Marks registry. The head office and office of the appropriate Trade Marks registry. The head office and various branches of the Trade Marks registry exercise their functions within territorial limits which are defined by the Central Government through notification in the official gazette. The application for registration has to be filed in that office of the registry within whose territorial limits the principal place of business of the applicant is located. In the case of a joint application, the location of the applicant whose name is mentioned first in the application is to be taken into account for the purpose of jurisdiction.

An application for registration of a Trade Mark may be made for one or more particular goods included in one or more classes of goods or services. The class to which the goods or services belong is determined by the Registrar.

The goods or services on which the Trade Mark is used or is proposed to be used may belong to different classes as are classified by the Registrar in terms of section 7 (1). The Trade Mark Act, 1999 allows a single application to be made for registration of Trade Mark for goods or services falling in more than one class of goods or services. However the application fee shall be payable in respect of each such class of goods or services to which the goods or services belong.

An applicant makes an application for registration of Trade Mark still not used by him, this shall operate as a claim on the Trade Mark till the time applicant does not abandon his claim. If another person makes an application for similar Trade Mark than the claim of earlier applicant is superior and will be preferred.
A joint application may be filed, where the relations between one or more persons interested in a Trade Mark is such that none of them is entitled between oneself and the other or others of them to use the Trade Mark except (a) on behalf of both or all of them; or (b) In relation to an article or service with which both or all of them connected in the course of trade. Such persons may be registered as joint proprietors of the trade mark.

Section 18 (3) of the TM Act, 1999 states that the applicant for registration of a Trade Mark may or may not carry on business in India but an address for service in India must be declared.

If an applicant or an opponent in registration proceeding is not a resident of India or does not carry on business in India, the Registrar may require such a non-resident person to give security for the costs of proceedings. In case such non-resident party does not furnish the security, the application or opposition that had been established by the party would be treated as abandoned.

Section 133 provides for the applicant to obtain information by making an application in the prescribed form of the proposed Trade Mark is prima facie distinctive, before making an application for registration.

If a person wants to know whether the mark selected by him for registration resembles any Trade Mark already on record, he may make a request for search and obtain a search report from the registrar. If a favourable report is given and he makes an application for registration of the mark, the Registrar can still take objections. His search is not conclusive. If the Trade Mark resembles any mark which was not disclosed in the search report furnished to the applicant but was on record on the date of search the applicant is entitled to repayment of
the fee paid thereon giving notice of withdrawal of the application. Other conditions are practically same as applicable in advice on distinctiveness.

Section 47 (1) (a) of the Trade Marks Act, 1999 enables any aggrieved person to apply to the registrar or to the Appellate Board to take off a registered Trade Mark from the register the Trade Mark was registered without any bona fide intention on the part of the applicant to use the Trade Mark on goods or services stated in the application.

**Procedure by the Registrar**

Upon receipt of an application for registration; the Registrar’s office undertakes what is described as an ex-officio examination.

(1) **Ex-Officio Examination of Application**

It causes a search to be made amongst the registered Trade Marks and pending applications to ascertain whether there are on record, in respect of the same or similar goods or services or description of goods or services, any mark identical with or confusingly similar or which may show an association with the mark sought to be registered.

Section 18 (4) confers a discretion on the Registrar in relation to the registration application. In conformity with the previous provisions he may accept the application either absolutely or subject to such amendments, conditions or limitations as he may think fit. He is entitled to refuse the application, but only after recording in writing the grounds for refusal or for conditional acceptance and stating the material used by him.

After acceptance the application is advertised in the form in which it has been accepted in the Trade Mark journal [Section 20 (1)].
There are incidental powers vested in Registrar in Section 19 and 20 to withdraw the acceptance or very the acceptance or to advertise the application before acceptance if proviso to section 20 (1) applied. The advertisement before the acceptance of the application may be in the cases falling in Section 9 (1) or section 11 (1) and (2) or in other cases of exceptional circumstances.

(2) **Opposition, Hearing and Evidence**

Within three months of the advertisement or re-advertisement of acceptance of an application for registration which is extendable by one month by the Registrar, any person may [Section - 21 (1)] give notice in writing, of opposition to registration. The registrar requires to serve a copy of opposition notice to the applicant for registration. The applicant, in turn, must submit his counter statement of the ground on which the applicant relies within two months there from, otherwise it will be deemed that the registration application has been abandoned [Section 21 (2)]. The copy of counter statement is required to be served on the opponents [Section 21 (3) of the TM Act, 1999]. All the evidences are required to be submitted [Section 21 (4)]. In the prescribed manner before the Registrar. The Registrar shall decide after hearing the parties and pass a speaking order stating all the reasons for imposing any conditions or limitations whether registration is to be permitted or not.²³ The registration is to be permitted to take into account any ground of objection even if that has not been relied on by the opponents.²⁴
(3) **Abandoning Tie Registration Application**

If in the opinion of the Registrar, an application is in default in perusing an application filed under the law, the Registrar must give notice to the applicant to remedy the default within a specified time. The Registrar may treat the application as abandoned, unless the default is remedied within the time specified in the notice.

(4) **Grant of Registration and Power of Central Government to Prohibit**

The Registration of Trade Mark is completed under section 23, before the grant of registration, either the registration application should not have been opposed or if it was opposed the opposition should have been decided in favour of the applicant. Moreover the Central Government should not have prohibited the legislation.\(^25\) If the above conditions are fulfilled, than the Trade Mark is entered in the register and the Registrar issues a certificate to that effect. The registration takes effect from the date of application and is valid for a duration of ten years.\(^26\) Which may be renewed simply by payment of renewal fee. However for the purpose of removal from the register on the ground of non-use under section 47 (1) (b), the period of 5 years of non-use shall be reckoned from the date of its actual entry in the register.

On registration of the Trade Marks, the Registrar is required to issue to the applicant a certificate of registration sealed with the seal of Trade Mark Registry.\(^27\)

**Direction of Central Government**

The Central Government may direct the Registrar not to register any particular Trade Mark (s). Trade Marks which are directed by the provisions as not to be registered are not accepted for registration. The power of Central Government can be exercised at any stage of registration application. The Central Government had also issued
notifications and direction of general applicability under this power prohibiting certain marks from registration.

Renewal Process and Fee

A Trade Mark is registered from the date of registration application for a period of ten years and can be renewed from time to time. On the expiration of a period of ten years, the registered proprietor or an assignee can obtain a renewal on payment of prescribed fees by making an application in the prescribed manner and period. The Registrar has no discretion in the matter of renewal. The Trade Mark can be further renewed indefinitely by following the same procedure on each expiration of registration. For the benefit of Trade Mark owners, the Registrar is required to give notice for payment of fee stating date of expiration of Trade Mark so as to avoid inadvertent lapse or delay in making the application or payment of the renewal fee. If the payment is not made in stipulated time, the Registrar may remove the Trade Marks from the register. If the application is made within six months from the time of expiration with a fee and surcharge, the Registrar is mandated to renew the registration and is not to remove the mark from the registrar.

When the Trade Mark is removed for non-payment of fee, in spite of its removal it is deemed to be on the register for the limited purposes of registration of other marks. It means that an expired Trade Mark would continue to be earlier Trade Mark for the purpose of section 11 for a period of one year.

Non-Renewal and Restoration

An application for restoration of Trade Mark may be filed before the Registrar. The registrar after six months and within one year from the expiration of registration, on receipt of an application and when
satisfied that it is just to do so, may restore the Trade Mark to the register and renew the registration of the Trade Mark for a period of ten years from the expiry of the registration. The Registrar has discretion not only in relation to the restoration of the trade mark but also as to imposing conditions or limitations while restoring the mark on the Register.

**Non-Renewal and Registration of Similar Marks**

If the Trade Mark is removed from the register for non-payment of the prescribed renewal fee, The Trade Mark is deemed to be on the register for a period of one year from the date of last expiration of the Trade Mark for the purpose of deciding other application. This disables similar Trade Marks from obtaining registration for that duration. During this waiting period of one year, the registration may be granted to the other applicant.

(i) If the tribunal is satisfied that prior to its removal, the expired Trade Mark was not being used for a period of two years; and

(ii) If a new similar Trade Mark is registered there is no likelihood of deception or confusion because of the previous use of such removed Trade Mark.29

**Right Conferred on Trade Marks on Applying for Registration**

Certain rights vest by the mere fact of applying for registration of a Trade Mark.30

(1) It serves as evidence of the adoption and solution of Trade Mark of state goods or services.

(2) It enjoys priority against identical or similar marks pending registration for same or similar goods or services, if similar mark is applied or used after the date of application. This
priority of six months is applicable in members of the Paris convention and the WTO countries.

(3) Preservation of the filing date within six months of priority period in all countries of the Paris convention and WTO which means that by making an application in one country, if the applicant chooses to make an application in the other countries, other application will be deemed to have been filed at the earliest date.

Rights Conferred on Trade Marks by Registration

The registration of Trade Mark confers the following rights of the registered proprietor.

(1) It confers on the registered proprietor the exclusive right to use of the Trade Mark in relation to the goods or services in respect of which the Trade Mark is registered.

(2) If the Trade Mark consists of several matters, there is an exclusive right to the use of the Trade Mark taken as a whole. If the Trade Mark contains matter common to Trade or is not of a distinctive character there shall be no exclusive right in such part.

(3) It entitles the registered proprietor to obtain relief in respect of infringement of Trade Mark in the manner provided by the Trade Mark Act 1999, when a similar mark is used on (a) same goods or services (b) similar goods or services (c) dissimilar goods or services.

(4) Registration of a Trade Mark forbids every other person (except the registered or unregistered permitted user) to use or to obtain the registration of the same Trade mark or a confusingly similar mark in relation to the same goods or services or the same description of goods or services in relation to which the Trade Mark is registered.
After registration of the Trade Mark for goods or services, there shall not be registered the same or confusingly similar Trade Mark not only for the same goods or services but also in respect of similar goods or services by virtue of section 11 (2) of Trade Mark, 1999.

Moreover, after registration of the Trade Mark for goods or services, there shall not be registered the same or confusingly similar Trade Mark even in respect of dissimilar goods or services by virtue of Section 11 (2) in case of well-known Trade Mark.

Registered Trade Mark shall not be used by any one use in business papers in advertising. Use incorporate advertising should not take under the advantage of the Trade Mark. Such advertising should not be contrary to honest practices in industrial or commercial matters. The advertising should not be detrimental to the distinctive character or reputation of the trade mark.

There is a right to restrict the import of goods or services marked with a Trade Mark similar to once’ Trade Mark.

There is a right to restrain use of the Trade Mark as Trade name or part of the Trade name of business concern dealing in the same goods or services.

The registered Trade Mark continues to enjoy all the rights which vest in an unregistered Trade Mark. By registering the proprietor of an unregistered Trade Mark is converted into proprietor of the registered mark. An application for registration may be based on a mark in use from prior to such application and such a Trade Mark is already vested with right at common law from the time the use of the mark was commenced.

So getting a trademark registered is more beneficial. Here in TM Act, 1999 the object is to provide for registration and better protection
of trade marks for the prevention of the use of fraudulent marks and
erthandise.

**Assignment and Transmission of Trademark**

Section 37 to 45 deals with the assignment and transmission of a
trade mark. Section 37 empowers the registered proprietor to assign the	trademark and to give effectual receipts for any consideration for such
assignment. For assignment and transmission to a registered or
unregistered trade mark's goodwill of a business is not the matter of
corner. A trademark can be assigned & transmitted with or without
the good will of the business.\(^\text{31}\)

There is the restriction on assignment or transmission of a trade
mark under section 40 of the Trade Marks Act, 1999, where multiple
exclusive rights would be created with more than one person to deceive
or cause confusion. Provided that an assignment or transmission shall
not be deemed to be invalid if the exclusive rights subsisting as a
thereof in the person concerned respectively are having regard to
limitations imposed thereon, such as not to be exercisable by two or
more of those persons in relation to goods to be sold, or otherwise
trade in, within India otherwise than export there from, or in relation to
goods to be exported to the same market outside India or in relation to
services for use at any place in India or any place outside India in
relation to services available for acceptance in India.\(^\text{32}\)

A trade mark shall not be assignable or transmissible in a case in
which as a result of the assignment or transmission there would in the
circumstances subsist, whether under this Act or any other law –

(a) An exclusive right in one of the persons concerned, to the use of
the trademark limited to use in relation to goods to be sold or
otherwise traded in, in any place in India, or in relation to
services for use, or services available for acceptance in any place in India; and

(b) An exclusive right at another of these persons concerned, to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to –

(i) The same goods or services; or

(ii) The same description of goods or services; or

(iii) Services which are associated with those goods or goods of that description or goods which are associated with those services or services of that description,

**Limited to use in relation to goods to be sold or otherwise traded in, or services for use, or available for acceptance, in any other place in India**

Provided that in any such case, on application in the prescribed manner by the proprietor of a trade mark who proposes to assign it, or by a person who claims that a registered trade mark has been transmitted to him or to a predecessor in title of his since the commencement of this Act, the Registrar, if he is satisfied that in all the circumstances the use of the trademark in exercise of the said rights would not be contrary to the public interest may approve the assignment or transmission, and an assignment or transmission so approved shall nor, unless it is shown that the approval was obtained by fraud or misrepresentation, be deemed to be invalid under this section or section 40 if application for the registration under section 45 of the title of the person becoming entitled is made within six months from the date on which the approval is or, in the case of a transmission, was made before that date.33

Where an assignment of a trade mark, whether registered or unregistered is made otherwise than in connection with the goodwill of the business in which the mark has been or is used, the assignment
shall not take effect unless the assignee, not later than the expiration of six months from the date on which the assignment is made or within such extended period, if any. Not exceeding three months in the aggregate, as the Registrar may allow, applies to the Registrar for directions with respect to the advertisement of the assignment, and advertises it in such form and manner and within such period as the Registrar may direct.

Explanation

For the purposes of this section, an assignment of a trademark of the following description shall not be deemed to be an assignment made otherwise than in connection with the goodwill of the business in which the mark is used, namely :

(a) An assignment of a trademark in respect only of some of the goods or services for which the trade mark is registered accompanied by the transfer of the goodwill of the business concerned those goods or services only: or

(b) An assignment of a trade mark which is used in relation to goods exported from India or in relation to services for use outside India if the assignment is accompanied by the transfer of the goodwill of the export business only.34

Assignment of Certification trademarks can only be done with the consent of the registrar under section 43 of the Trade Marks Act 1999. The associated trademarks shall be assignable and transmissible only as whole and not separately but will be treated as a separate trademark for all other purposes under section 44 of the act.

(1) Where a person becomes entitled by assignment or transmission to a registered trademark, he shall apply in the prescribed manner to the Registrar to register his title, and the Registrar shall, on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods or services in respect of which the assignment or transmission has an effect, and shall cause
particulars of the assignment or transmission to be entered on the register:

Provided that where the validity of an assignment or transmission is in dispute between the parties, the Registrar may refuse to register the assignment or transmission until the rights of the parties have been determined by a competent court.

(2) Except for the purpose of an application before the Registrar under sub section (1) or an appeal from an order thereon, or an application under section 75 or an appeal from an order thereon, a document or instrument in respect of which no entry has been made in the register in accordance with sub-section (1), shall not be admitted in evidence by the Registrar or the Appellate Board or any court in proof of title to the trade mark by assignment or transmission unless the Registrar or the appellate Board or the court, as the case may be, otherwise directs.

Special Provisions Relating to Protection of Trade Marks for International Registration under the Madrid Protocol

The provisions of this Chapter shall apply to international applications and international registrations under the Madrid Protocol.

Trade Marks Registry to deal with international applications. Notwithstanding anything contained in sub-section (3) of section 5, an international application shall be dealt with by the head office of the Trade Marks Registry or such branch office of the Registry, as the Central Government may, by notification in the Official Gazette, specify.

(1) International Application Originating from India

(1) Where an application for the registration of a trade mark has been made under section 18 or a trade mark has been registered
under section 23, the applicant or the registered proprietor may make an international application on the form prescribed by the Common Regulations for international registration of that trade mark.

(2) A person holding an international registration may make an international application on the form prescribed by the Common Regulations for extension of the protection resulting from such registration to any other Contracting Party.

(3) An international application under sub-section (1) or sub-section (2) shall designate the Contracting Parties where the protection resulting from the international registration is required.

(4) The Registrar shall certify in the prescribed manner that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certification, in the application under section 18 or the registration under section 23, and shall indicate the date and number of that application or the date and number of that registration as well as the date and number of the application from which that registration resulted, as the case may be, and shall within the prescribed period, forward the international application to the International Bureau for registration, also indicating the date of the international application.

(5) Where at any time before the expiry of a period of five years of an international registration, whether such registration has been transferred to another person or not, the application under section 18 or the registration under section 23, as the case may be, has been withdrawn or cancelled or has expired or has been finally refused in respect of all or some of the goods or services listed in the international registration, the protection resulting from such international registration shall cease to have effect:
Provided that where an appeal is made against the decision of registration and an action requesting for withdrawal of an application or an opposition to the application has been initiated before the expiry of the period of five years of an international registration, any final decision resulting into withdrawal, cancellation, expiration or refusal shall be deemed to have taken place before the expiry of five years of the international registration.

(6) The Registrar shall, during the period of five years beginning with the date of the international registration, transmit to the International Bureau every information referred to in sub-section (5).

(7) The Registrar shall notify the International Bureau the cancellation to be effected to an international registration keeping in view the current status of the basic application or the basic registration, as the case may be.

(2) International Registrations where India has been Designated

(1) The Registrar shall, after receipt of an advice from the International Bureau about any international registration where India has been designated, keeps a record of the particulars of that international registration in the prescribed manner.

(2) Where, after recording the particulars of any international registration referred to in sub-section (1), the Registrar is satisfied that in the circumstances of the case the protection of trade mark in India should not be granted or such protection should be granted subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the international registration has been accepted, he may, after hearing the applicant if he so desires, refuse grant of protection and inform the International Bureau in the prescribed manner within eighteen months from
the date on which the advice referred to in sub-section (1) was received.

(3) Where the Registrar finds nothing in the particulars of an international registration to refuse the grant of protection under sub-section (2), he shall within the prescribed period cause such international registration to be advertised in the prescribed manner.

(4) The provisions of sections 9 to 21 (both inclusive), 63 and 74 shall apply mutatis mutandis in relation to an international registration as if such international registration was an application for registration of a trade mark under section 18.

(5) When the protection of an international registration has not been opposed and the time for notice of opposition has expired, the Registrar shall within a period of eighteen months of the receipt of advice under sub-section (1) notify the International Bureau in its acceptance of extension of protection of the trade mark under such international registration and, in case the Registrar fails to notify the International Bureau, it shall be deemed that the protection has been extended to the trade mark.

(6) Where a registered proprietor of a trade mark makes an international registration of that trade mark and designates India, the international registration from the date of the registration shall be deemed to replace the registration held in India without prejudice to any right acquired under such previously held registration and the Registrar shall, upon request by the applicant, make necessary entries in the register referred to in sub-section (1) of section 6.

(7) A holder of international registration of a trade mark who designates India and who has not been extended protection in India shall have the same remedy which is available to any person making an application for the registration of a trade mark
under section 18 and which has not resulted in registration under section 23.

(8) Where at any time before the expiry of a period of five years of an international registration, whether such registration has been transferred to another person or not, the related basic application or, as the case may be, the basic registration in a Contracting Party other than India has been withdrawn or cancelled or has expired or has been finally refused in respect of all or some of the goods or services listed in the international registration, the protection resulting From such international registration in India shall cease to have effect.

(3) **Effects of International Registration**

(1) From the date of the international registration of a trade mark where India has been designated or the date of the recording in the register of the International Bureau about the extension of the protection resulting from an international registration of a trade mark of India, the protection of the trade mark in India shall be the same as if the trade mark had been registered in India.

(2) The indication of classes of goods and services given by the applicant shall not bind the Registrar with regard to the determination of the scope of the protection of the trade mark.

(4) **Duration and Renewal of International Registration**

(1) The international registration of a trade mark at the International Bureau shall be for a period of ten years and may be renewed for a period of ten years from the expiry of the preceding period.
Subject to payment of a surcharge prescribed by the rules, a grace period of six months shall be allowed for a renewal of the international registration.”

B- Domain Name

An Overview

A computer system firm in Cambridge Massachusetts had registered his first commercial Internet domain name (.com) under the name symbolics.com on 15 March 1985. By 1992 fewer than 15000 (.com) domains were registered. In December 2009 there were 192 million domain names, including 11.9 million online businesses and e-commerce sites, 4.3 million entertainment sites, 3.1 million finance related sites and 1.8 million sports sites.36

Thus from the above statistic it is clear that the demand for domain names has been increasing speciously with the advent of e-business, organizations had to cater to new marks and new philosophic, in the fulfilment of which the Internet is to play a profound role. As a result, the securing of an appropriate domain name and the protection of the company’s right to use it are aspects that every organization has to confront.37

As domain names now carry goodwill, reputation and high recall value. Further, by the representation of both name and address in the online context, a domain name can serve the classic trademark function of symbolizing a company’s recognition and goodwill in the marketplace. Domain names are therefore, relevant in e-business.38

The increasing demand for domain names led to the emergence of industry which provides services related to the transfer, assignment and registration of domain names and related services. The pressure for
new TLDs led to the conversion of some country codes to quasi-generi
camic TLDs. Moreover in 2001, ICANN introduced seven new domain
name extension.

Thus it can be said that unlike country code top-level domain
names, which are issued by the authorities in each country, generic top
level domains are issued by the registrars, which are accredited by
Internet Corporation for Assigned Names and Number (ICANN). 39

From the above discussion, we can broadly summaries that the
discovery of the importance of a domain name has ensured that
organizations are willing to devote to the acquisition of these names, a
considerable amount of money and time. This quest has led to the only
to be expected conflicts over the registration of domain names.
Numerous disputes have arisen where companies with similar names,
or manufacturing the same types of products, have wanted to adopt
similar or identical domain names. 40

In the U.S., the Network Solutions Inc. (NSI) 41 has registered
domain names since 1992 under an agreement with the National
Science Foundation and the U.S. Department of Commerce. In
assigning a domain. NSI uses a multi-level system, including a Top
Level Domain (“TLD”) such as <.com>, <.net> and <.org>, which are
considered world wide “generic” TLDs, coupled with a Second Level
Domain (“SLD”) requested by the party seeking the domain
assignment.

Elsewhere, a number of registration entities (called NICs
{Network Information Centre} or registries), assign individual country
TLDs using two character ISO country codes, such as <.in> for India,
<.ca> for Canada or <.fr> for France, etc. 42 Every nation uses its two
letter identifier as the TLD. In many countries such as India, there are
also second level domains that roughly parallel those in use in the U.S.
Thus, <.co> in India corresponds to <.com> in the U.S. Typically, companies in the U.S. ignore the <.us> TLD and use <.com>, <.edu>, etc as their TLDs.43 Though overseas business has by passed country TLDs and have registered <.com> domain with NSI.

Growth of e-commerce has ensured that the most domain name disputes surround <.com> TLD.44 Another result of this global growth is that it is quite possible for a U.S. company to have the domain name <business.com>, while there is also a separate and unrelated Indian user with <business.co.in> and yet another user in France with <business.co.fr> and so on in every country all around the world.45

The most recent development has been the establishment of the Internet Corporation for Assigned Names and Numbers (ICANN) the non-profit corporation that was formed to assume responsibility for the IP address space allocation, protocol parameter assignment, domain name system management, and root server system management, and root server system management functions now performed under U.S. Government contract by the Internet Assigned Names Authority (IANA) and other entities.46

A domain name register is an organization or commercial entity, accredited by both ICANN and generic top-level domain registry (gTLD) and/or by a country code top-level domain (ccTLD) registry to sell CCTLDs; to manage the reservation of Internet domain names in accordance with the guidelines of the designated domain name registries and to offer such services to the public.

Registration

The first step in acquiring the right to use a domain name is to contact (usually through a service provider) the administrator (authorized by the ICANN) of the desired TLD. If the identical
requested domain name is not already assigned, the name will be approved by the administrator. No proof of ownership or trademark registration is required to register.

When domain names are sought to be registered, they need not mirror the name of the applicant. Mere registration of a domain name does not ensure any trademark status. The requestor must ensure that it is not violating anyone else’s trademark.47

The maximum period of registration for a domain name is 10 years. Some registrars offer longer periods of up to 100 years, but such offers involve the registrar renewing the registration for their customer; the 100-year registration would not be in the official registration database.

**Domain Name Structure and Naming in the .IN Domain**

As explained, the allocation of IP addresses and domain names worldwide is done centrally. There is a specific registration process involved. The Internet Assigned Numbers Authority (IANA) is the central Internet authority that allocates IP addresses and domain names through the Inter NIC. The allocations are done either directly by the Inter NIC or by regional registries to whom the registration and allocation functions have been delegated. The RIPE NCC takes care of the allocations and registry in Europe and in the Asia Pacific region this is done by the APNIC.48 The Inter NIC takes care of all else. Country code domains are important for big companies as well who either want to register defensively (as did Amazon at www.amazon.co.in) or to try and establish a presence and an indigenous identify as well.

India has a top level domain <.in> as listed in the ISO-3166. The second level sub domains registered under the <.in> domain are
<.ernet> for the academic and research network, <.nic> for the government’s network, <.ac> for the academic community, <.co> for commercial organizations, <.net> for Internet Services Providers, <.res> for the research community, <.gov> for government offices and machinery, <.mil> for military organizations and <.org> for organizations which do not get covered under any of the above sub-domains. 49

The <.in> domain administration is done by the National Centre for Software Technology (NCST), Mumbai which runs the Indian Domain Registration Service. This <.in> domain will be solely managed by the Domain Registrar until either the registration activity is delegated to sub domains or there are separate Domain Registrars for each (or a set) of domains. 50

Domain Naming

The third level sub domain provides the space for registering organization names or organization acronyms. Some typical patterns that can result are detailed below:

<org_names>,<org_category>.in-eg.<vsnl.net.in>or<micro.res.in>or <nls.ernet.in>.

Each organization will register a domain as above. The organization can then plan its own sub domain hierarchy under the registered domain. For e.g., a commercial organization BUSINESSNAME registers a domain <businessname.co.in>. The organization then subdivided the domain space under this registered domain based on division names resulting in domain names like:

<publicity.businessname.co.in>-Publicity Division
<finance.businessname.co.in>-Finance Division.
<support.businessname.co.in>-Support Division.

The hostnames will then be prefixed to these domain names to yield names like www.publicity.businessname.co.in.
For every registration made, an entry will be made in the DNS by NCST. A DNS server will be required to be run by every organization.\(^5^1\)

**Domain Registration**

Domain name registration requests are entertained by NCST only if the organization has a valid IP address or has applied for one. The domain may be registered electronically.\(^5^2\) The application form, on receipt, is circulated within a review group and the applicant will be contacted for clarifications/name clashes, if any. If there is none, then the applicant will be allocated the desired domain name and intimated. Domain names are generally registered on a first come first serve basis.

Upon registration, the registrant is required to run a DNS server.\(^5^3\) the DNS entries are then made into the primary name-server (for \(<.in>\)domain) by NCST. A negligible fee is charged to cover the registration costs and the cost of providing the secondary name server service and the registration information services.

Regarding the trademark issue, when contacted via e-mail, the domain registrar at NCST stated that if the name of the brand is registered in India, then one could register a domain like, brand name.co.in>. As regards the concept names, one cannot go under the \(<.co.in>\) domain. They could go under the \(<.org.in>\) domain. However, when one is going for some such domain, one will need to give a declaration that if some company comes up with the same name as their brand name or company name, one will give back the domain name. This is only if the other company objects to the domain name holder holding the domain name.\(^5^4\)

Thus, a domain name requires a strong, constant and instant protection under all the legal systems of the world, including India. This can be achieved either by adopting harmonisation of laws all over
the world or by jealously protecting the same in the municipal spheres by all the countries of the world.

**Problems in the Registration of Domain Name**

The advent of domain name registration has initiated a new set of problems for the registered trade mark users/owners. Time is an important factor in the registration of a domain name and a policy of first come first serve basis is used for registering a name as a domain name. Keeping this in mind, many people registered well known domain names which resembled well-known trade mark/ names. Accordingly, they were granted/allotted a particular domain name.

Due to this policy a trend for Cyber Squatting evolved in which an unlicensed user registered a trademark as a domain name in order to pressure the bona fide trade mark owner/user and extort money or other benefits from such lawful trade mark owner/user. Since there was no connection between trade mark registration and domain name registration, such domain names did not come under objection at the time of registration. This loophole in the procedure further encouraged cyber squatters to demand exorbitant prices for selling these domain names to the registered trade mark owners/users who were desperate to protect their goodwill. Initially, the Courts too were not well equipped with knowledge in dealing with matters of cybersquatting in the absence of any law or regulation to that effect.

It is a general practice where companies desire to obtain such domain name which can be easily identified with their established trademarks. This helps the public to identify the company as there is no physical contact between the two of them. Domain names and trademarks are connected with each other. If a company or an individual register a domain name which is similar to or identical to
someone else’s trademark or domain name and then tries to sell the same for a profit. This is known as “Cybersquatting”.

**Domain Name Registration in India**

In India, the registration under the ccTLDs is managed by National Centre for Software Technology (NCST). It has been doing this task since 1995. However, internet Management Group, a committee formed by the Government of India, oversees the Internet Domain Name registration activities in .in ccTLD. The committee consists of members representing, Bharat Sanchar Nigam Limited, Ministry of Information Technology, Videsh Sanchar Nigam Limited and NCST. The primary duty of the ccTLD manager is to manage and operate the .in ccTLD Registry in the interest of the global internet community. Before an applicant applies for the domain name with NCST, he must have a valid IP address or must have applied for one. The filled up applications forms are circulated within a review group to check for clashes. In case there are none, the domain name is allotted to the applicant. Upon registration of the domain name, the owner of the domain name is required to run a DNS server.

**Summation**

Registration of a trademark is the best way to protect a mark. Trademark registration in India is regulated by the Trade Mark Act 1999. A trademark is registered for a period of 10 years, which can be renewed for another period of 10 years. If the mark has been expired one can apply for its re-registration. Therefore, a trademark is protected by the laws of a country where rich trademark may be registered. Consequently, a trademark may have multiple registrations in many countries throughout the world.

The purpose behind the registration is to provide better protection of trademark and to prevent the use of fraudulent marks.
Registration confers on the proprietor a kind of monopoly right over the use of the mark, which may consist of a word or symbol legitimately required by other traders for bon fide trading or business purposes, certain restriction are necessary on the class of words or symbols over which such monopoly right may be granted. Thus descriptive worlds surnames and geographical names are not considered prima facie registrable.

A domain name registrar is an organization or commercial entity, accredited by both ICANN and generic top-level domain registry (gTLD) to sell gTLDs and/or by a country code top-level domain (ccTLD) registry to sell ccTLDs; to manage the reservation of Internet domain names in accordance with the guidelines of the designated domain name registries and to offer such services to the public.

Domain registration information is maintained by the domain name registries, which contract with domain registrars to provide registration services to the public. An end user or the customer selects a registrar to provide the registration service, and that registrar becomes the designated registrar for the domain chosen by the user.

When the customer buys a domain, it connotes two things. Firstly, the name, i.e., www.***********.com and a certain space (2GB to unlimited) for his websites.

The maximum period of registration for a domain name is 10 years. Some registrars offer longer periods of up to 100 years, but such offers involve the registrar renewing the registration for their customer, the 100-year registration would not be in the official registration database. Whereas a large number of trademarks containing the same name can comfortably co-exist because they are associated with different products, belong to business in different
jurisdictions etc, the distinctive nature of the domain name providing global exclusivity is much sought after.
Notes & References

2. 2000 PTC 171.
3. 1998 PTC (18) (Del) 300.
4. Sec. 13 Trade Mark Act 1999
5. Sec. 15 Trade Mark Act 1999
6. 2004 (29) PTC 265 IPAB
7. 1991 PTC 148 (SOSFT) UK
8. (1898) AC 571
10. Sant Kumar Mehra V. Ram Lakhan (1999) PTC (19) 307
11. 1992 PTC 261 (Bom.)
12. Central Camera V. Registrar (1980) IPLR 1
15. Campa Bewrages Ltd. V. Tripti Enterprises, 1984 PTC 129.
16. 1913/30 RPC 76.
18. Zimmer Orthopedics Ltd. London V. Kith De Fair, 1985 PTC 133 (Del.)
20. Pals Distilleries v. Dahisar Distilleries, 1992 PTC 41 (Bom.)
26. Section 25 Trade Mark Act 1999
Domain names serve a variety of purposes, and will rapidly grow to form the fulcrum of a company’s visibility & marketing operations. A company will soon be remembered only through its internet address, rather than its geographical or telephonic addresses & numbers. Moreover, the protection of existing domain names puts forth new challenges to the policy maker in particular and the law more generally. See, Mitchell Zimmerman & Sally M. Abel, “Securing and protecting a Domain Name for your website : Trade Marks, Trade Names And Domain Names in cyberspace”, atc http:: www.fenwick.com/pub/domain.htm>.

To understand the true dimensions of the domain name conflict, one would have to compare the attribute of a domain name with a traditional trademark. In case of the former, only one owner can possess a particular domain name. In contrast, identical trademarks may be owned by numerous persons, so long as there is differentiation on the basis of geographical application or
through product differentiation. Two companies may use the same trade maker e.g. ABC, because they are completely in different line of business and there is little, if any, likelihood of confusion. Under the current Internet naming system, however, one of these companies will not be able to include its marks in its domain name, since their can be only one <abc.com>. See, Richard Baum and Robert Cumbow, “First Use : Key Test in Internet Domain Disputes”, Nat’l L.J., Feb. 12, 1996, at p. C17 (Also see Majumdar Ankit and Kamath Nandan, “Name-Calling in Cyberspace-Domain Names and The Law, 2nd Ed. P. 214).

41. Sally M. Albel, “Trademark Issues in Cyberspace : The Brave New frontier” at <http://www.fenwick.com/pub/ cyber.html>. The organization responsible for overall coordination and management of the domain name assignment system in the Internet Assigned Numbers Authority (“IANA”). This Address Number authority was created to assign unique address to each participating network. To provide technical oversight of architectural and taxonomic development on the Internet, the National Secience Foundation created the Network Information Center (“InterNIC”) in January 1993 contracting with three companies to run it : General Atomics. AT&T, and Network Solutions Inc, a wholly owned subsidiary of Science Applications International Corp. Network Solutions, following policies set by the IANA, provides registration of all network groups,AT&T provides directory services, and General Atomics overseas the information services. The InterNIC became functional in April 1993.

Thus, the Assigned Numbers Authority (IANA) is the overall authority for the IP Address, the Domain Names, and many other parameters, used in the Internet. The day-to-day responsibility for the assignment of IP Addresses, Autonoumous System
Numbers, and most top and second level Domain Names however, are handled by the Internet Registry (IR) and regional registries. (Also see Majumdar Ankit and Kamath Nandan, “Name-Calling In Cyberspace-Domain Names and The Law, 2nd Ed, p. 214).

42. In most industrial countries outside the United States, there are voluntary and cooperative groups, supported mainly by the Internet service providers (ISPs) who collect fees for providing interconnection services to the networks operating in their respective countries. These cooperative groups assign domain names in their countries and coordinated their activities so that each domain name remains globally unique.


44. There are number of reasons for this : firstly, it is one of the oldest in terms of original top level domain names : secondly, it is a naming system which might utilize only two names, such as <business.com>, thus making the address easily and instantly recognizable. By contrast under one of the two country domains the same would be <business.co.in>, thirdly. Its association with commercial organizations is also important I that it is attractive to a commercial entitiy seeking to set up a website; and finally, the name has international connotations. See, Charlotte Waelde, “Domain names and Trademarks : What’s in a name?” Lilian Edwards & Charlotte Waelde (Eds.) Law and the Internet : Regulating Cyberspace, Hart Publishing, Oxford, 1997, pp. 7-46 (Also See Majumdar Ankit and Kamath Nandan, “Name-Calling in Cyberspace-Domain Names and The Law, 2dn Ed, p. 215).

45. Often, companies register domain names in multiple countries, esp. in countries where they operate. This ensures both visibility
and the prevention of domain name misappropriation and consequent trade mark implications.

46. Supranote41 p.216

47. Ibid.

48. Note the definition of Europe and the Asia Pacific in this context are not as per the existing political boundaries.

49. Supranote.41 p.218

50. Ibid.

51. Supra note 49, at pp. 218-219.

52. To register a domain, one may obtain the form electronically from URLs http://soochak.ncst.ernet.in or <fp://soochak.nest.ernet.in>. This form is to be filled up and mailed to domainreg@sangam.nest.ernet.in.

53. At least a 64kbps leased data circuit.

54. Supra note 51 at p. 219.

55. NCST is an autonomous society, involving in Research & Development, under the administrative purview of Department of Information Technology, Ministry of Communication & Information Technology, Government of India.

56. It’s Indian ccTLD, i.e. unique identity symbol of Indian Website.