CHAPTER V
UNIFORM DOMAIN
NAME DISPUTE
RESOLUTION POLICY
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POLICY

An Overview

With the development and advancement in technology the trades and businesses have also become technology oriented. In this new phenomenal growth a revolutionary change has occurred in the field of trades and businesses through the internet. Thus most businesses require its registration under a particular domain name and website. The internet revolution has introduced new dimensions in the field of Intellectual Property Rights. Threats from Cyber Squatter of unfair use of domain name’s indiscriminate copying of information from diverse web sites and unauthorized distribution of copyrighted material through the cyber space by digital pirates are challenges to be met by creators , owners, traders and enforces of Intellectual Property.

Background of Uniform Domain Name Dispute Resolution Policy

The Uniform Domain Name Dispute Resolution Police (UDRP) was created to establish a uniform means of administering domain name conflicts. Domain name disputes have a number of characteristics that make traditional Court proceedings unsuitable for their resolution:

Firstly, the Internet being a global system, there is no settled rule as to where jurisdiction lies, so that a single case may involve several different municipal Courts asserting jurisdiction, with the result that a whole series of actions may have to be brought in relation to trademarks in different countries.

Secondly, a similar volume of court proceedings may be required if the same name has been registered in multiple ccTLDs.

Thirdly, the speed at which an Internet site can be created, and the ease at which it can be reached, may make the need to resolve a dispute urgent.
Fourthly, the cost of registering a domain name is extremely low in comparison with the economic damage that it may cause, or the cost of litigation.¹

Because of these factors, since 1995 there has been available an alternative, specially designed dispute resolution policy (DRP) for resolving domain name disputes [at least as regards generic TLDs (gTLDs)]² that is intended to be time and cost efficient in comparison with Court proceedings. But over the time, there was a call for a new entity to manage the domain name system.³ In response to such concerns, ICANN was formed,⁴ and WIPO was entrusted with developing UDRP.

With the approval of other Member States of the United Nations, WIPO undertook this process, issuing its findings to ICANN in April 1999 in its report “The Management of Internet Names and Addresses: Intellectual Property Issues: Final Report of the WIPO Internet Domain Name Process”⁵ After a series of resolutions and conferences, ICANN adopted the Final Report and approved the UDRP⁶ and the accompanying Rules for the UDRP⁷ in October 1999.⁸ The UDRP improves upon the NSI policies in three significant respects:⁹

First, the domain name is not placed ‘on hold’ or affected in any way until the end of proceedings.¹⁰

Second, there is a far greater burden on complainants, who must show both that the registrant lacks any legitimate interests in the name, and is, using the registered name in bad faith.¹¹

Third, the policy is wider in that it is applicable where the domain name is ‘confusingly similar’ to the relevant mark (and not just where it is identical), and applies to service marks as well as trademarks.¹²

**Uniform Domain Name Dispute Resolution Policy (“UDRP”)**

The Uniform Domain Name Dispute Resolution Policy (UDRP) is an online system for resolving complaints made by trademark owners about domain
names conflicting with their trademarks. It isn’t a court nor is it an arbitration, but the authority that established it in 1999 (ICANN) has the power to order the deletion or transfer of domain names. ICANN requires the domain registrars in .biz, .com, .info, .org, and .net to abide by the results of UDRP proceedings. They must cancel or transfer a domain registration as a UDRP Panel directs. Domain holders agree to this procedure in their domain registration contracts.  

The UDRP Rules outline the process for filing a complaint (if you are a trademark owner) and for responding to a complaint (if you are the domain name holder). The Policy and the Rules also explain some of the basics of the proceedings, such as how to choose a Provider, how Panels make their decisions, how the parties are notified of the outcome, language to be used in the proceeding, the availability and effect of court proceedings, and the types of remedies available.

The dispute resolution Panel is a body of rules which are developed for the purpose of dispute settlement in respect of domain names. The dispute resolution Panel does not apply laws of any particular country.

The validity of the UDRP is not easy to define, because UDRP is not an arbitration policy and it does not have any binding effect except on the register of the domain names. It is incorporated by reference in the agreement of the registrant with ICANN. It is required to include the terms of UDRP in the agreements with the registrants for the purpose of receiving ICANN accreditations. This means that the UDRP is a legally qualified specific contract term.

UDRP procedure is a faster, cheaper, and easy alternative for challenging the domain name registration in courts of law as it takes a long time and the complex procedures grant relief to the plaintiff with delay which can result in damage to the business and goodwill of the plaintiff. The UDRP does not prohibit any trademark owner or a domain name holder from going to court before or during or after the UDRP proceedings. Complainant/Respondent is required to inform the
Panel if they have taken any court action so the Panel can decide as to whether to continue with the proceedings or to post-pone it.\textsuperscript{16}

At present the Internet Corporation for Assigned Names and Numbers (ICANN) is responsible for managing and co-ordinating the DNS to ensure that it continues to function effectively by overseeing the distribution of unique numeric IP addresses and domain names. A company or organisation, called registry under contract with ICANN manages TLDs. But they do not sell domain names to the public, that task is handled by other accredited companies, called registrars, who collect a fee for each name and pay a portion of it to the registry.\textsuperscript{17}

As has been explained earlier, the administration and procedure for registration of domain names for generic TLDs is left to the private company, Network Solutions, Inc. (NSI). As the Internet grew in popularity and trademark owners began seeking to register their marks as domain names, it came to be realized that often, these names were already taken up by others. This could be due to deliberate misappropriation followed by what effectively amounted to extortion, or it could be due to a genuine conflict. In any case, these developments gave rise to a number of conflicts prompting the realization that effective dispute resolution policies would be required if these disputes are
(a) to be prevented or
(b) if inevitable, resolved amicably.

A number of proposals have been brought out, and some have been put into operation. As the party most affected by domain name disputes, NSI has been the most active in this regard. It would therefore be appropriate to first examine the NSI plan.\textsuperscript{18}

**The NSI Policy**

NSI began with an initial premise, namely, that domain names have no legal significance, but are merely addresses of various sites in cyberspace. Further, NSI denies that it, as a registry, has any duty to perform trademark searches or
arbitrate on domain name disputes.\textsuperscript{19} However, this premise was rendered inoperative due to several complaints that emerged from various trademark owners. Further, NSI itself began to be sued by these disputants. No doubt, these suits were of little financial concern to NSI, for they were usually parties to the principal dispute for merely procedural reasons.\textsuperscript{20} Yet, preferring to opt out of these cases, NSI instituted a domain name policy in 1995, which has had several subsequent revisions. The current policy was last revised in February 1998.

The highlights of the new policy can be summarised as follows:

An applicant for a domain name must certify that to his knowledge, the name does not interfere or infringe rights of third parties. After this, once the name is given, it may be challenged by the holder of a trademark (US or foreign registered), provided that trademark has been registered prior to the domain name being used. On such challenge, the domain name holder is given 30 days to show either that his use of the domain name predates the trademark registration, or that he has his own trademark registration. If he fails to do so, the domain name goes into a hold status, pending the e-resolution of the dispute between the parties.\textsuperscript{21} By the February 1998 revision, however, NSI made one important modification to this policy; it suggested that it may require “suspension, transfer or modifications to a domain name”. But in a number of cases, though NSI’s policy seemed tilted in favour of the trademark owners, when the owners of the domain name went to court against the 30 day letter issued by NSI. NSI agreed to scrap its policy, and in one case, where it did not, the judge signed an injunction preventing NSI from cutting off the domain name.\textsuperscript{22} It, therefore, emerged that if a domain name holder was not violating anybody’s trademark, it would be possible to retain the domain name, even if NSI itself sided with the challenger.

Another important change made by the revisions was that it insisted that the domain name holder’s trademark registration should, in order to serve as a valid defence, be registered prior to the emergence of the domain name dispute. This eliminated the possibility of the domain name holder obtaining a registration
in a foreign country when the dispute emerged and using that as a method to defend its trademark violation.  

Criticism

The NSI policy has been criticized on several grounds. The idea of putting a domain name on hold is said to lead to the possibility that the domain name owner may unjustifiably lose access to the domain name, as a result of which he may be put out of business. Thus, the policy may serve as a weapon in the hands of the trademark owners. The policy therefore seems to favour large corporations.

The policy also enables trademark owners to obtain remedies in cases where they may have no remedy in the courts of law.

The policy does not look at rights which a domain name holder may have, even if he does not have a trademark registration. These could include common law rights of usage.

Proposed Domain Name Systems

While several proposals have been put forward by various bodies, this paper restricts itself to a selected few, in order to provide a broad outline of different ideas on this issue.

The International Ad-Hoc Committee (IAHC) has brought out a proposal to increase the number of gTLDs. In May 1997 members signed a Memorandum of Understanding on Generic Top Level Domain Space of the Internet Domain Name System (MOU). This MOU sets up an Internet self-governance system pursuant to the plan for increasing and administering generic top level domains. Seven new generic Top Level Domains are to be created, and more firms around the world are to be allowed to act as registrars. The new top level domains will be “.firm” for businesses or firms; “.store” for businesses offering goods to purchase; “.web” for entities with web activities; “.arts” for entities in the cultural and entertainment activities; “.rec” for recreation and entertainment activities; “.info”
for information services, and “.nom” for individual or personal nomenclature. Twenty eight new registrars will be established to deal with the administration under these top level domains, and each will also be able to register second level domains.

Further, all these names will be shared among different registries, and all applications will be publicly available. Applicants for domain names have to agree to on-line mediation and arbitration. Grounds for challenge, etc are also provided.

Criticism

The IAHC model has, however, been subjected to scathing criticism on the ground that it is merely a stop gap arrangement and does not clarify the essentials of disputes over domain names. To merely provide more domain names has been to delay the inevitable flood of litigation for a few years, at best. What is required is a permanent solution that would ensure that no further disputes took place, and also that any other disputes would be resolved by well-developed and accepted principles. Further, this does not solve conflicts between holders of the same trademark in different countries or in different products.29

NSI critiques the IAHC plan on a number of grounds, including the suggestion that it is too bureaucratic, and the dispute resolution mechanisms are unworkable. The NSI plan30, on the other hand, envisages an unlimited number of gTLDs, together with limited regulation. This proposal can also be critiqued on the ground that an unlimited number of gTLDs will require constant monitoring by trademark holders to ensure that there is no violation of trademarks by any of these domain names.

Yet another approach is to do away with the value of domain names by replacing them with a set of random numbers, as in the case telephone directories. This would minimize any trademark disputes involved in the DNS, while still maintaining the Internet’s basics. However, this policy is also subject to criticism on the ground that it nullified the huge investment already made in domain
“names” by companies. To counter this criticism, David Mahler and Robert Frank have offered a hybrid plan combining “personalized” and random domain names. A similar proposal is to differentiate domain names for different products by adopting the International Trademark Classification System, and providing different numbers for two identical domain names, if they represent different products. However, this system is useless when one considers trademark conflicts between different countries. Thus, most new approaches appear to prefer avoiding the trademark issue rather than tackling it and emerging with some permanent solutions to these problems. Most of the suggestions seem to be short term, and fail to address core issues.31

Internet Corporation for Assigned Names and Numbers (ICANN)32

An international Non Profit Corporation, Internet Corporation for Assigned Names and Numbers (ICANN) formed in 1998 is the internet’s naming system and technical coordinator, responsible for developing the policy for the internet’s unique identifiers and addresses. ICANN oversees the distribution of unique technical identifiers which are used in the Internet’s operations and also delegates Top-Level Domain names (such as .com, .info, etc) resulting in universal resolvability.

In order to register a domain name, one must first contact the ICANN authorized administrator of the desired TLD through a service provider. As long as the desired name has not been assigned to any prior applicant, the requested name will be approved without any requirement towards proof of ownership, trademark registration or any other form of evidence. However once a domain name has been registered in the above manner, the same does not ensure trademark status. A domain name is not itself a trademark. In order to attain trademark status various factors such as date of use, the distinctiveness of the domain name with respect to goods or services, the manner of use etc. will contribute after ensuring that no-one prior existing identical deceptively similar
trademark is being violated. ICANN has also provided guidelines for domain name registration, working towards bona fide registrations. Since ICANN is the international core of the internet, it is but practical that it provides a dispute resolution mechanism for domain name disputes in association with The World Intellectual Property Organization (WIPO). The World Intellectual Property Organization has numerous countries as signatories and international dispute resolution is a workable solution.

In general, the policy provides that registrars receiving complaints concerning the impact of domain names they have registered on trademarks or service marks will take no action until they receive instructions from the domain name holder or an order of a court, arbitrator, or other neutral decision maker deciding the parties dispute. There is an exception in the policy, however, for disputes involving domain names that are shown to have been registered in abusive attempts to profit from another’s trademark (i.e., cybersquatting and cyber piracy and other “bad faith” registrations). In these cases of abusive registration, the complaining party can invoke a special administrative procedure to resolve the dispute. Under this procedure, neutral persons selected from panels established for that purpose would decide the dispute. The decision is made on the basis of the submissions of the documents by complainants and registrant/respondent. A panel’s decision must be published online, decided in less than 45 days, and is expected to cost around $1000 in fees. Parties to such dispute can also go to court to settle their dispute or to contest the outcome of the procedure. Every ICANN-accredited registrar has agreed to adhere to the dispute-resolution policies that ICANN adopts under its established consensus procedures.

**Government Advisory Committee (GAC)**

ICANN’s Organizational Structure includes a Governmental Advisory Committee (GAC) set up in 1999 accessible at gac.icann.org. The GAC has an open-ended membership driven policy, inviting nations the world over to partake in ICANN’s policymaking activities. It includes Government representatives,
ICANN’s activities and policies are considered by the Governmental Advisory Committee (GAC), pertaining to special government interests and implications in matters involving an interaction between ICANN’s policies and national laws or international agreements. The GAC typically holds quarterly meetings in conjunction with ICANN meetings. Over 50 national governments, distinct economies, and multinational governmental organizations such as the ITU and the World Intellectual Property Organization (WIPO) currently attend the GAC on a regular basis.

India is a member country represented by Mr. N. Ravi Shankar of the Ministry of Communications & IT. Dr. Govind and Mr. Ranjan Kumar of the Department of Information Technology, Ministry of Communications & IT of the Government of India head the GAC Secretariat aims at increasing the influence of ICANN.

Uniform Dispute Resolution Policy: Its Viability

The international domain name regulatory authority called the Internet Corporation for Assigned Names and Numbers (ICANN) adopted the Uniform Domain Name Dispute Resolution Policy (UDRP) following the domain name case of Mcdonalds.com that came to light in 1994. The policy formulated thereafter provided for incorporation of terms and conditions in the registration agreement concerning disputes between the registrant and any party other than the registrar over the registration and the use of a registered Internet domain name. Under the UDRP, a person seeking to register a domain name is under an obligation to ensure that the domain name he seeks to register does not infringe or violate someone else’s rights.

Under Clause 3, the UDRP provides that ICANN will cancel, transfer or otherwise make changes to domain name registrations under the following circumstances.
(i) on receipt by ICANN of written or appropriate electronic instructions from the domain name registrant or his duly authorised agent;

(ii) on receipt by ICANN from a Court or arbitral tribunal (of competent jurisdiction), requiring such action and/or

(iii) on receipt by ICANN of a decision by an administrative panel requiring such action in any administrative proceeding to which the domain name registrant was a party and which was conducted under the UDRP.

Clause 4 of the UDRP deals with mandatory administrative proceedings and provides that a domain name registrant has to submit to such proceedings in the event a third party files a complaint (complainant) with a Provider against the domain name registrant alleging the following:

(i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;

(ii) The domain name registrant has no rights in the domain name; and

(iii) The domain name has been registered in bad faith.

Rule 4(b) has listed by way of illustration the following four circumstances as evidence of registration and use of a domain name in bad faith:

(i) circumstances indicating that the domain name registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the domain name registrant’s documented out-of-pocket costs directly related to the domain name; or

(ii) the domain name registrant 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, provided that the domain name registrant has engaged in a pattern of such conduct; or

(iii) the domain name registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
by using the domain name, the domain name registrant has intentionally attempted to attract, for commercial gain. Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the domain name registrant’s website or location or of a product or service on the domain name registrant’s website or location.

The defences available to such a complaint have been particularized ‘without limitation’ in clause Rule 4(c) as follows:

(i) before any notice to the domain name registrant of the dispute, the use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the domain name registrant (as an individual, business, or other organisation) has been commonly known by the domain name, even if the domain name registrant has acquired no trademark or service mark rights; or

(iii) the domain name registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Rule 4 (k) of the UDRP, however, provides that an aggrieved party is not compelled to initiate proceedings only under the UDRP and that a domain name registrant or the complainant may, before or after the conclusion of any administrative proceedings, submit the dispute to a Court of competent jurisdiction.

These rules indicate that the disputes may be broadly categorised as:

(a) disputes between trademark owners and domain name owners and
(b) between domain name owners inter se.
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. The defences available to a complaint are also substantially similar to those available to an action for passing off under trademark law.

The complainant must prove that each of these three elements mentioned in Clause 4(a) of UDRP are present to initiate the administrative proceedings.

**Mechanism**

The following are the salient features of the mechanism of domain name dispute resolution under UDRP: 41

- Administrative proceedings are very expeditious. These proceedings are usually concluded within 2 months;

- The UDRP Rules of Procedure and the Supplemental Rules are very simple to understand and apply. There is no standard form of complaint or reply/response to be filed before the approved domain name dispute resolution provider. Paragraph 3 of the ICANN Rules of Procedure prescribes the information to be included in the complaint. Under Para 3 of the ICANN Rules, the complaint may relate to more than one domain name, so long as the person or entity that is the registrant of the domain names specified in the complaint is the same. Unless, the issues are complex, lawyers may not be necessary to represent the parties;

- Proceedings are conducted online. Rule 13 of the Rules for UDRP stipulates that there shall be no in-person hearings (including hearings by teleconference, video conference, and web conference), unless the Panel determines, its sole discretion and as an exceptional matter, that such a hearing is necessary for deciding the complaint;

- The fees for dispute resolution under the UDRP are very nominal;

- The dispute resolution mechanism does not seek to bypass legal remedies, rather gives due respect to the decision of the competent courts.
Thus we can conclude that the mechanism of the UDRP is judicious, fair, independent, equitable and competent to decide domain name disputes.

**The Uniform Domain Name Dispute Resolution Policy: Processual Paradigms in Arbitration**

The Uniform Domain Name Dispute Resolution Policy (UDRP) and the UDRP Rules prescribe detailed procedures for appointing either a sole arbitrator or a three-member panel to conduct the inquiry. A panel is expected to issue its decision within 14 days of its appointment. If the panel rules in the complainant’s favour, the only remedy available is for the registrar to cancel the domain name registration or transfer it to the complainant. A registrar may automatically implement a UDRP panel decision after the 10 day period that it has “commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted” as required by the UDRP Rules. After notification, the registrar “will take no further action” until it receives “satisfactory” evidence of the resolution of the dispute, the dismissal or withdrawal of the lawsuit, or a court order that the registrant does “not have the right to continue using” the domain name.42

One of the major drawbacks of the UDRP system - as opposed to court proceedings which may go to the extent of awarding damages - is the fact that relief is limited to either getting the domain name struck off or transferred.43

(1) .IN Registry

The National Internet exchange of India (NIXI) (http://www.nixi.in/) is a Government Company registered under section 25 of the Indian Companies Act, 1956. It has been set up to facilitate the exchange of domestic Internet traffic within the country by Internet service providers in India. NIXI has also been entrusted with the responsibility of the setting up of the .IN ccTLD Registry by the Government of India. The .INRegistry (http://www.registry.in/) has been created by NIXI. It functions as an autonomous body under NIXI with the primary
responsibility of maintaining the .DM ccTLD and ensuring its operational stability, reliability, and security.

.IN Registry does not carry out registration itself. Instead, it accredits registrars (for names of the registrars see http://www.registry.in/ accredited.registrars) to register .IN domain names.  

(2) IN Dispute Resolution Policy

IN Registry has also come out with an .IN Dispute Resolution Policy (INDRP) (http://www.registry.in/policies/dispute_resolution/indrp) on the same lines as UDRP and has also framed INDRP Rules of Procedure (http://www.registry.in/ policies/dispute_resolution/indrp_rules). However, it uses the words Arbitrators in place of service providers used in UDRP.45

In India, anyone interested in registration of .IN domain name has been allowed to do so since early 2005. Registration is open to parties inside and outside of India without restriction and of late the scourge of cyber-squatting has seen on a steady rise especially after the expiry of the sunrise period in January 2005. With domain name prices falling to as low as Rs 200, squatters seem to be on a domain buying spree. ‘IN’ is India’s top-level domain on the internet. Like .COM, .IN can be used for e-mail, web sites and other applications. But unlike other domains, .IN is a unique symbol of India and its role in the world. IN Registry is the official .IN registry. It was appointed by the Government of India to operate under the authority of the National Internet Exchange of India (NIXI).46

Under section 25 of the Indian Companies Act 1956 the Department of Information Technology (DIT) in association with the Internet Service Providers Association of India (ISPAI) has promoted the National Internet Exchange of India (NIXI) as a none profit company with the objective of facilitating improved internet services in the country. The aim of NIXI is to ensure that the internet traffic which originates within India and also has destination in India remains
within the country. And also NIXI aims is to improve traffic latency, reduced cost
and better security.

.IN Domain Name Dispute Resolution Policy (‘Policy’) and the dispute
resolution mechanism are based on the internationally accepted UDRP as
prescribed by ICANN and sets out the terms and conditions to resolve a dispute
between the registrant and the complainant, arising out of the registration and use
of the .In Internet Domain Name.

Any person who considers that a registered domain name conflicts with his
legitimate rights or interests may file a complaint to the .IN Registry on the
following premises:

• the registrant’s domain name is identical or confusingly similar to a name,
trademark or service mark in which the complainant has rights;
• the registrant has no rights or legitimate interests in respect of the domain
name; and
• the registrant’s domain name has been registered or is being used in bad
faith.

The registrant is required to submit to a mandatory arbitration proceeding
in the event of a complaint before the .IN Registry’ in accordance with the policy
and rules framed there under. The remedies available to the complainant pursuant
to any proceeding before an arbitrator shall be limited to requiring the cancellation
of the registrant’s domain name or the transfer of the registrant’s domain name
registration to the complainant.47

Domain Name Dispute-Suit-Principle
Sony Ericsson Mobile Communications AB v. Chen Shenglu48

In this case complaint was made with respect to the registration of Domain
Name www.sonyericsson.co.in by the respondent in bad faith and being identical
to the complainant’s website / domain www.sonyericsson.com. The complainant
is proprietor of the trademark and domain name incorporating the word Sony
Ericsson-The complainant also owned the domain name sonyericsson.cn in China where the respondent is based. The complainant, Sony Ericsson, also registered its domain name in more than 100 countries. The allegations of likelihood of confusion and deception were made. It was held that the domain name of the respondent was identical to the trademark and domain name of the Complainant. The registration of country level domain in India by the Respondent based in China found to be in bad faith to cause confusion to the Internet users and to make such users falsely believe that the disputed website is sponsored, endorsed or authorised by the complainant Respondent failed to show any right or legitimate interest in registering the disputed domain name. It was directed that the complainant is entitled to the transfer of the disputed domain name www.sonyericsson.co.in.

NIXI decides cases, on the principles of the UDRP

The Supreme Court in the Satyam Infoway case held that the domain name has characteristic of a trademark and the suit to protect it is maintainable and injunction can be granted. The courts have been entertaining suit and have laid down the principles to grant injunction after taking into account UDRP and INDRP. They are as follows:

CIT1 Corp v. Todi Investors
UDRP and INDRP are agreements between the Registrars and the domain name owners. It is a condition for obtaining a domain name. The domain name owner is bound by it but not a third party. In case the third party raises a dispute in a court then the Arbitration and Conciliation Act may not apply to the dispute between the two.

Beiersdorf A.G. v Ajai Sukhwani
The object of UDRP is to provide cheap and speedy disposal of complaints regarding registration of Domain name. The decision of the administrative panel under the UDRP is not final; it is merely an administrative decision.
In this case the court has held that Nevertheless a court while entertaining a suit by a third party—who does not avail the remedy of the UDRP or INDRP—may refuse to grant an injunction in view of section 41 (h) of the Specific Relief Act on the ground that equally efficacious relief can be obtained by invoking them. However, it will be a different matter if damages are also claimed. The Delhi High Court

- Relief in a suit for passing off are wider than mere cancellation or transfer of a domain name;
- In such a suit damages are also claimed that cannot be granted under UDRP or INDRP; and
- The suit is the proper remedy instead of raising dispute under UDRP or INDRP.


In such a suit punitive damages may be granted. The plaintiff will also be entitled to an injunction, where the defendant has obtained a domain name identical to the coined trademark of the plaintiff.

The principles as to when a court within whose jurisdiction plaintiff is not carrying on business: will have jurisdiction against an accessible website in a suit for passing off action has been discussed and explained in the decision of the Delhi High Court in Banyan Tree Holding v. Murali Krishna Reddy⁵⁴. The court explained that:

- The plaintiff would have to prima facie show that the nature of the defendant’s activity was with an intention to conclude a commercial transaction with the website user within the court’s jurisdiction and it resulted in an injury or harm to the plaintiff within the court’s jurisdiction;
• For the purposes of section 20(c) CC, the plaintiff will have to prima facie show that the said website specifically targeted at viewers within the court’s jurisdiction for commercial transactions. The plaintiff would have to plead this and produce material to show that some commercial transaction using the website was entered into by the defendant by a user of its website within the jurisdiction of the court resulting in an injury or harm to the plaintiff;

• The commercial transaction entered into by the defendant with an internet user located within the jurisdiction of the 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 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.

(3) Charter Eligibility Dispute Resolution Policy 55

The Charter Eligibility Dispute Resolution Policy (CEDRP) is followed by the sponsored TLDs .aero, .coop, .museum, and .travel for challenges to registration of a domain name on the grounds that the registrant does not meet the eligibility requirements (set forth in the sponsored TLD charter) for registration of a domain name in the given TLD. Any person or entity may bring a challenge to a registered name under the CEDRP.

(4) .ASIA Charter Eligibility Requirements Policy 56

The .ASIA Charter Eligibility Requirements Policy (.ASIA CERP) applies to domain names registered in the .ASIA sponsored TLD. Registrations in .ASIA are restricted to members of the Pan-Asia and Asia-Pacific Internet community.
Challenges to a registration in .ASIA on the grounds that it does not meet the eligibility requirements are filed under the CERP. Further information can be found on the .ASIA website.

(5) **.cat Eligibility Requirements Dispute Resolution Policy** 57

The .cat Eligibility Requirements Dispute Resolution Policy (.cat ERDRP) applies to domain names registered in the sponsored TLD .cat. Registrations in .cat are restricted to members of the Catalan linguistic and cultural community. Challenges to a registration in .cat on the grounds that it does not meet the eligibility requirements are filed under the ERDRP. Further information can be found on the .cat website.

(6) **Intellectual Property Defensive Registration Challenge Policy** 58

The Intellectual Property Defensive Registration Challenge Policy (IPDRCP) applies to intellectual property defensive registrations in the .pro TLD, which is restricted to use by certified practicing members of certain professions (currently the medical, legal, and accounting professions). An intellectual property defensive registration may be registered only by the owner of an eligible trademark or service mark registration. The IPDRCP provides an avenue for challenges to Intellectual Property Defensive Registrations concerning whether such registrant meets the Registration Qualifications. Any person or entity may initiate an IPDRCP proceeding by submitting a challenge in accordance with the rules.

(7) **Start-Up Trade Mark Opposition Policy (STOP)** 59

If there are two or more applications are filed for the same name, the registrar would on a particular day (suppose 26th to 30th September 2001) pool in all the applications and randomly choose the registrant. Thereafter, the aggrieved party may resort to the process called “STOP”.
Under this procedure, the domain name would be frozen for a month. The domain name dispute shall then be settled and decided. However, the burden of proving bad faith registration is not as heavy as under the UDRP.\(^6\)

STOP is no longer available as a dispute resolution policy for .biz domain names. Disputes can be brought under the UDRP, RDRP or available courts of law. For more information, see the registry operator’s site.

(8) **Sunrise Challenge Policy**\(^6\)

The Sunrise Challenge Policy (SCP) was applied only during the sunrise period for the .info TLD. Challenges under the Sunrise Challenge Policy were administered by the registry operator (Afilias). As the one hundred twenty (120) day sunrise period has closed, parties disputing the validity of a sunrise registration may utilize the UDRP or available courts of law.

(9) **Inter-Registrar Transfer Policy**\(^6\)

The Inter-Registrar Transfer Policy has been adopted by all ICANN-accredited registrars. All requests to transfer a domain name to a new registrar must be handled according to the procedures detailed in this policy, incorporating the Standardized Forms. Dispute proceedings arising from a registrar’s alleged failure to abide by this policy may be initiated by any ICANN-accredited registrar under the Transfer Dispute Resolution Policy.

(10) **.info Dispute Resolution Policy**\(^6\)

The .info domain implemented a Sunrise Registration Period (from July 25 to August 31, 2001), during which only trademark owners could register a domain name that was identical to the textual elements of their trademark, provided the trademark

Registration had national effect and was issued prior to October 2 2000 That period was followed by a Sunrise Challenge Period (from August 28 to December 26, 2001), during which such sunrise registrations could be challenged
under a Sunrise Challenge Policy (SCP), exclusively administered by the WIPO Centre. The Policy enabled any third party to apply for the cancellation or transfer of a domain name that had been registered in violation of the conditions of .info sunrise registration. The SCP intellectual property protection measure had one serious shortcoming, however, in the absence of any verification of intellectual property “rights upon application for domain name registration. This allowed Speculators to register info names, by providing false trademark registration information. As a result, the operator of the .info registry, Afilias decided to file SCP challenges to any sunrise registrations not independently challenged, in order to clear its database of potentially improper sunrise registrations.

(11) .biz Dispute Resolution Policy 64

The .biz domain implemented a period (from May 21 to August 6, 2001), during which trademark owners could file one or more “intellectual property claims” relating to an alphanumeric string, or name, identical to their marks, thereby enabling the registry to advise them if the same string was registered as a domain name during the start-up period. Upon notification by the .biz registry, trademark owners who had filed such a claim were given the opportunity to commence opposition proceedings under the Start-Up Trademark Opposition Policy (STOP) with any accredited dispute resolution service provider, requesting the transfer of the contested domain name. The .biz domain has been open to the general public for registrations since June 25, 2001 and, as above, the UDRP applies to all such registrations.

(12) .name Dispute Resolution Policy 65

The .name domain devised yet another mechanism to handle abusive registration practices in the initial stages of its operation. This mechanism enabled trademark owners to apply for a defensive registration in the preliminary phase (from August 15 to December 14, 2001), by reserving a given alphanumeric string or name in order to prevent the registration of domain names that included the string at the second or third, or both, levels. The registry also offers trademark
owners a Name Watch service that advises them of any .name registration that matches their trademarked name.

(13) .pro Dispute Resolution Policy

The .pro registry is not yet operational, but proposes to implement a “sunrise period” during which owners of trademarks registered prior to December 31, 2001, can register a name that corresponds to their mark, provided they meet the registration eligibility restrictions for .pro. During the “sunrise challenge period” any person will be able to submit a challenge against a sunrise domain name for non-compliance with these registration conditions. As above, when registrations open to the general public, the UDRP will apply to all .pro domain name registrations.

Protection of Domain Name: Global Efforts

(1) British Law

Recent IP disputes have led to the reconsideration of the applicable rules of jurisdiction and justifiably. These actions are needed to apply the Brussels Lugumon convention. The scope of application of this convention may be wider in the UK Courts than of those in Europe.

In UK one is a subject to the Civil Jurisdiction and Judgments Act, 1982, and the Private International Amendment Act, 1995, the common law on conflicts of law and the Supreme Court rules of practice. The statutes cited incorporated into UK law the Brussels Luguano convention of 1986, which affects the whole of Europe (non convention countries). Non-convention countries are also affected.

In relation to Civil Jurisdictions and Judgments Act, 1982, particular attention should be taken of the 1995 amendments, specifically section 10 and 11. Section 10 abolished the double action ability, rule, which allowed claims only where the tort would be actionable as a tort in the foreign jurisdiction. Section 11 was enacted to clarify the required test for jurisdiction for contract, and other tort and claims. The rules are as follows: for actions in tort, the jurisdiction in place of
the tort; for action in contract, the jurisdiction in place where there is the contact; for all other actions, the jurisdiction is the country with the most significant relationship with the occurrence.\textsuperscript{67}

The court have held that cybersquatting is violative of the rights protected under the trademarks law.

In \textit{Marks & Spencer PLC Vs One in a Million}\textsuperscript{68} in the High Court of Justice, chancery Division, enjoined the activities of the two cyber dealers and their related companies, who had obtained and were offering for sale and ‘hire’, numerous domain names containing well known marks. In this group of cases, the Court enjoined “the threat of passing of” (a threat which would become and reality if in of tending domain names was sold and to use by a stranger to the trademark owner), issuing a warning to cyber squatters.

Any person who deliberately registers a domain name on account of its similarity to the name, brand name or trademark of an unconnected commercial organization must expect to the find himself on the receiving and of an injunction to restrain the threat of passing off and the injunction will be in terms which will make the domain name commercially useless to the dealer.”

(2) United States Law

To deal with the menace of cybersquatting U.S. has passed the Anti Cybersquatting Consumer Protection Act 1999. Prior to the Act of 1999 the judiciary relied on the Lanham Act and FTDA to decide the disputes between domain name registration and trademark owners.

(a) The Lanham Act (1946)

It provides a trademark owner three, potential causes of action:

- If his trademark has been registered on the Principal Federal Registry, he can claim that the registration, of a similar domain name would create a “likelihood of consumer confusion” in violation of section 32(1) - 15 USC S.I) 14(1).
• If his trademark has not been registered, he can claim that registration of a similar domain name would constitute unfair competition in violation of section 43(a) - 15 USCS. 1125(a).
• Even if the defendant’s domain name does not create “consumer confusion,” the owner of a “famous” trademark can claim that the defendant’s behavior would “dilute” the power of his mark — i.e., lessen its “capacity ... to identify and distinguish goods and service' in violation of section 43(c) - 15 USC S. 1125(c).^9

(b) Federal Trademark Dilution Act (FTDA) (1995)

NS1 started distributing domain names as early as in 1994. It resulted in mayhem as the trademarks were being infringed with impunity. Initially, the domain name disputes were resolved under the NSI’s dispute resolution policy. Under the policy the owner of the federal trademark registration in the U.S or a registration in a foreign country may challenge the use of an identical second level domain by submitting the registration certificate to NSI, along with proof that the trademark owner has sent the domain holder written notice of the trademark owner’s claim that use and registration of the domain name violates the trademark owner’s legal rights.

This dispute resolution policy gave way to the application of ‘likelihood of confusion or deception’ analysis by the courts to adjudicate domain name disputes. An essential element of a trademark infringement action is that the plaintiff must prove that a defendant’s use of a particular name creates a likelihood of confusion, deception or mistake among an appreciable number of ordinary buyers as to the source or association between the two names.

Generally, courts all over the world have applied Trademark Laws in order to resolve domain name disputes. Normally the following factors are taken into account by the courts in case of an infringement and/or passing off action with respect to domain name dispute:

Whether the domain name in dispute is^70
i. Identical or deceptively similar with the already registered trademark;  
ii. Identical or deceptively similar to a mark that has acquired reputation in the market;  
iii. Deceptively similar to already existing domain name;  
iv. Adopted in a bad faith;  
v. Causing confusion or likely to cause confusion in the mind of the general public with respect to the real owner  
vi. Causing damage or likely to cause damage in terms of business and goodwill.

**Card Service International Inc. v Me Gee**

It was the one of the earliest case on cybersquatting, where the US court held that the domain name serve the same function as a trademark and is not a mere address or like finding number on the Internet and therefore, it is entitled to equal protection as trademarks. The court further held that a domain name is more than a mere Internet address as it also identifies the Internet site to those who reach it, much like a person’s name identifies a particular person or more relevant to trademark disputes, company’s name identifies a specific company. In light of this observation the court granted the injunction as under Section 32 of the Lehman Act. The court further held that the Card service International’s customers who wish to take advantage of its Internet services offered by the company are likely to assume that “Cardservice.com”, belongs to Card service International although it’s not being true. These customers would instead reach Me Gee page when looking for “card services” and thereby many would assume that they have reached “Card service International” so there is a likelihood of confusion.

**Comp Examiner Agency, Inc., v. Juris, Inc**

It was the first case in which a U.S court applied a traditional likelihood of confusion. In this case, juris, Inc., owner of a federal trademark registration of JURIS for its legal time and billing software products, had been forced to choose the domain jurisinc.com after learning its first choice, juris.com, had already been
assigned to The Comp Examiner Agency (“Comp Examiner”). When Juris, Inc subsequently accused Comp Examiner of trademark infringement, Comp Examiner, which used the domain for the legal information website, filed an action seeking cancellation of Juris, Inc’s JURIS trademark registration on the ground of genericness; Juris, Inc. then counterclaimed for trademark infringement and dilution.

The court granted Juris, Inc. a preliminary injunction which not only precludes Comp Examiner from using the domain juris.com, but also from using “juris” juriscom.com or any confusingly similar variation for “the advertising, operation or maintenance of any Internet site or bulletin board service”.

Later, even NSI faced lawsuits alleging trademark infringements. In *Lockheed Martin Corp. v. Network Solutions, Inc*73 In this case the issue was whether NSI violated federal trademark law by accepting registration of the Internet domain names that are identical or similar to Lockheed Martin Corporation’s (Lockheed) SKUNKWORKS service mark. The plaintiff (Lockheed) asserts that NSI directly infringed and diluted its mark by accepting the registrations. It also asserted that NSI is liable as a contributory infringer because NSI did not comply with Lockheed’s demands to cancel the registrations.

The court held that NSI’s had a limited role as a registrar of domain names. Also, it had no reason to know of potentially infringing uses by others. That is, contributory infringement doctrine does not impose upon NSI an affirmative duty to seek out potentially infringing uses of domain names by registrants.

**Panavision International, L.P v Toeppen**74

It was the most egregious case in the early days on cybersquatting and cyber piracy. The Appellate Court (Ninth Circuit) was asked to apply existing rules of personal jurisdiction to the actions that occurred, in part, in cyberspace. Further, it was to interpret the FTDA as it applies to the Internet.
In the instant case, Panavision accused Dennis Toeppen of being a Cyber pirate who had stolen valuable trademarks and established them as his domain names on the Internet.

Panavision holds registered trademarks to the names Panavision and Panaflex in connection with motion picture camera equipment. Panavision promotes its trademarks through motion picture and television credits and other media advertising.

In December, 1995, Panavision attempted to register a website on the Internet with the domain name Panavision.com. It could not do that, however, because Toppen had already established a website using Panavision’s trademark as his domain names. Toeppen’s web page for this site displayed photographs of the City of Pana, Illinois.

Toeppen argued that his use of Panavision’s trademarks simply as his domain names could not constitute a commercial use under the Act. Further, he contended that a domain name is simply an address to locate a web page. If a user were to type Panavision.com as a domain name, the computer screen would display Toeppen’s webpage with aerial views of Pana, Illinois. The screen would not provide any information about Panavision, other than a location window which displays the domain name. Toeppen argues that a user who types in Panavision.com but who sees no reference to the plaintiff Panavision on Toeppen’s web page is not likely to conclude the web page is related in any way to the plaintiff, Panavision.

The 9th circuit court held that “cybersquatting generally referred to an individual who register domain names identical to well-known marks in an attempt to resell it to the mark owner at a significant profit, whereas the term cyberpirates are those who register the same or confusingly similar domain name
in an attempt to lure traffic intended for the mark owner away to pirate’s web site. In the absence of legislative definition, these terms are interchangeable.

Further, the 9th Circuit Court found that Toeppen’s conduct diminished “the capacity of the Panavision marks to identify and distinguish Panavision’s goods and services on the Internet”. The Court justified its dilution arguments on grounds similar to an earlier case. **Intermatic v. Toeppen**, where it was held that the defendant diluted plaintiff’s trademark by lessening Intermatic’s ability to “identify its goods and services by means of the Internet” and by using the Intermatic name on an unauthorized web page.

**The Ant cybersquatting Consumer Protection Act (1999)**

The first legislation which was enacted to curb the menace of cybersquatting came from the U.S Congress, in November 1999, with the name Anti-Cybersquatting Consumer Protection Act (ACPA). It amends the Trademark Act of 1946 to make domain name holders legally liable in a civil actions brought by trademark holders (including a personal name protected as a mark) any person who, with a bad faith intent to profit from the mark, registers, traffics in, orgies a domain name which, at the time of its registration, is

1. identical or confusingly similar to a distinctive mark;
2. dilutive of a famous trademark; or
3. is a protected trademark, word, or name

The Act also creates an *in rem* action against offending domain names—an important new option for trademark owners when federal courts do not have *in personam* jurisdiction over the domain name registrant. The Act further provides that:

(Section 3002) Specifies factors a court may consider in determining bad faith intent, but prohibits such a determination if the defendant believed, with reasonable grounds, that the use of the domain name was fair or otherwise lawful.
“A court may order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark,” if the domain name was “registered before, on or after the date of the enactment of this Act”.

(Section 3003) Applies to cybersquatting actions such trademark remedies in addition to injunctive relief as recovery of defendant’s profits, actual damages, and attorney’s fees and court costs. Provided for statutory damages in an amount of at least $1,000 and up to $100,000 per domain name, as the court considers just.

(Section 3005) Shields a registrar, registry, or other registration authority from liability for damages for the registration or maintenance of a domain name for another, unless there is a showing of bad faith intent to profit from such registration or maintenance of the domain name.77

The judgments in Intermatic and Panavision have played an important role in the drafting of the Anti cybersquatting Consumer Prevention Act (ACPA). The Act was enacted to specifically target trademark infringement in cyberspace.78

• The ACPA lists nine non-exclusive factors that courts may consider when determining whether the plaintiff has acted with bad faith intent:79

(I) The trademark or other intellectual property rights of the person, if any, in the domain name;

(II) The extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) The person’s prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV) The person’s bona fide non-commercial or fair use of the mark in a site accessible under the domain name;

(V) The person’s intent to divert consumers from the mark owner’s online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of
confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) The person’s offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person’s prior conduct indicating a pattern of such conduct;

(VII) The person’s provision of material and misleading false contact information when applying for the registration of the domain name, the person’s intentional failure to maintain accurate contact information, or the person’s prior conduct indicating a pattern of such conduct;

(VIII) The person’s registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) The extent to which the mark incorporated in the person’s domain name registration is or is not distinctive and famous.

**Sporty’s Farm L.L.C v. Sportsman’s Market, Inc.**

This new enactment was first applied in the case. The case involved a dispute over the domain name “sportys.com” between two competing aviation supply corporations. Omega a mail order catalog company used to sell mainly scientific process measurement and control instruments. It registered the domain name “sportys.com” with NSI in 1995. Early the following year, Omega sold the domain name for $16,200 to another, newly formed subsidiary specializing in the sale of Christmas tree, and soon began advertising its Christmas trees on a sportys.com web page.

The defendant, Sportsman’s Market, a mail order catalog, company has been providing aviation equipment to pilots through its mail order catalogue since
the 1960s under the name “Sporty’s”. It subsequently sought to recover the “sportys.com” domain name from Sporty’s Farm.

The District Court granted an equitable injunction under the FTDA. On appeal the Second Circuit determined that Sporty’s Farm acted with “bad faith intent to profit” from the domain name “sportys.com” as articulated in the ACPA.

It observed that “Omega’s owners, (the Hcallauders), were fully aware that sporty’s was a very strong mark for consumer of those products. It cannot be doubted, as the court found below, that Omega registered sportys.com for the primary purpose of keeping Sportsman’s from using that domain name. Several months later, and after this lawsuit was filed. Omega created another company in an unrelated business that received the name Sporty’s Farm so that it could (1) use the sportys.com domain name in some commercial fashion, (2) keep the name away from Sportsman’s and (3) protect itself in the event that Sportsman’s brought an infringement claim alleging that a “likelihood of confusion” had been created by Omega’s version of cybersquatting.

The case emphasizes that stopping egregious commercial misbehavior, like blocking a rival corporation from using its own mark, fall squarely within the purview of the ACPA.

ACPA and in rem Action
In Alitalia-Lince Aeree Italiane, S.P.A v. Casinoalitalia.com

Wherein the plaintiff, an Italian airline, has sued both the foreign registrant of an allegedly infringing domain name in personam and the domain name itself in rem .

Alitalia an Italy’s national airline,his founders coined the word Alitalia, which has been used by the airline since 1957. by combining the word Ali which in Italian means wings and d’Italia which means Italian; the term Alitalia therefore literally means Italian wings.
In addition Alitalia maintains a website for its airline business at www.alitalia.it and has registered the Internet domain names www.alitalia.com and www.alitalia.net. A search of the Internet for the word Alitalia however returns not only Alitalia’s website, but also an Internet site using the domain name “casinoalitalia.com”, which has no affiliation or connection whatsoever to Alitalia.

Defendant Technologia JPR. Inc. (JPR) had registered the domain name “casinoalitalia.com” with registrar NSI. JPR is an entity established under the laws of the Dominican Republic, and JPR’s NSI registration information lists JPR’s place of business (including administrative, technical and billing contacts) as located in Santo Domingo, Dominican Republic.

The plaintiff contended that it was evident from a visit to “casinoalitalia.com” that the website exists for the purpose of conducting the business of online gambling and on its home page the term Alitalia appeared. It claimed that the domain name “casinoalitalia.com” and JPR’s unauthorized use of the term Alitalia created a false impression that Alitalia has been promoting the business of online gambling and/or any other enterprise pursued by defendants. The plaintiff further claimed that since the word “casino” means brothel, so that a literal translation of “casinoalitalia” would mean Alitalia’s brothel. It argued that the consumers who were familiar with the Italian language would assume “casinoalitalia.com” as a brothel associated or affiliated with Alitalia. It contended that the website “casinoalitalia.com” irreparably harms, tarnishes, and dilutes the goodwill, reputation and image of Alitalia mark.

The court concluded that JPR is subject to in personam jurisdiction in Virginia, and therefore, Alitalia cannot maintain its ACPA in rem cause of action against casinoalitalia.com.
A recent decision by the United States District Court for the District of Virginia held it had ‘In Rem Jurisdiction’ over domain name registrants that were located in a foreign country and had been accused of Cybersquatting in Virginia. Even though this was not a contested case and the plaintiff granted summary judgment, this decision is a great precedent for the interpretation of the US Anti-cybersquatting Act and US Courts’ jurisdiction on foreign cybersquatters.

In the past few years ACPA has been put to varied uses: to block parody website PETA v. Doughney\textsuperscript{82} protect free speech Northland Insurance Co. v. Blaylock\textsuperscript{83} and bad faith registration Mattel Inc. v. Internet Dimensions, Inc\textsuperscript{84}

It is therefore very much clear that ACPA requires “bad faith intent to profit”, whereas the FTDA requires a “commercial use in commerce” of the mark.

The Act has been severely criticized, on a number of grounds. For example, it is alleged that trademark holders are given more rights than they currently have under trademark law. Domain name holders could be liable for “tarnishing” or “disparaging” a trademark. The concepts of tarnishment and disparagement are unique to the small number of trademarks that qualify as “famous marks”. Yet, the Act expands these concepts to all trademarks. Another example: a domain name holder who has not actually set up a site using a registered domain name may be liable to a trademark holder if he offers to sell the domain name to the trademark holder, even if the offer is made in order to avoid costly litigation.\textsuperscript{85}

Thus, it’s claimed, could have disastrous effects on free speech and privacy. Domain name registrants who want to remain anonymous, or even those who forget to update their registrations, may be held liable for “intentionally failing to maintain accurate contact information”. Domain name holders engaging in protected criticism or satire would not only risk having their names taken away, but, ironically, they could be held responsible for compensating trademark holders who are the brunt of their criticism. And trademark holders in the US would now,
after simple hearing, be able to take away domain name holders in other countries (holding them financially liable, as well), without actual notice being given to the domain name holders. Courts may award damages of as much as $100,000 per domain name registration, even in the absence of any lost profits or actual harm. Domain name holders have to file their own lawsuits to protect their interests, and in any event must affirmatively demonstrate good faith; use of the domain name for legal business interests, and otherwise proves they are not trademark pirates. Even then, these are only factors for the court to consider, not actual defences. These problems, it is suggested, are tantamount to “guilty until proven innocent”. Among the few mitigating factors domain name holders can defend themselves with, only non-infringing commercial interests or use are given at any weight.86

Another criticism is that the Act also sets up a system whereby US-based companies would be able to take away domain names without notice from foreign companies and individuals who can’t afford to travel to the US to defend themselves (assuming they even know about the action against them at all)

Finally, the Act simply fails to cater to the most difficult kind of dispute those between twins (i.e. disputes between parties equally entitled to a trademark). Until some resolution of these disputes is ensured, it is unlikely that legislation will serve any purpose.

To overcome the hardship which are in ACPA, the United States, enacted the Truth in Domain Names Act in 2003, in combination with the PROTECT Act of 2003, forbids the use of a misleading domain name with the intention of attracting Internet users into visiting Internet pornography sites.

The Truth in Domain Names Act follows the more general Ant cybersquatting Consumer Protection Act, aimed at preventing typo squatting and deceptive use of names and trademarks in domain names.
Before the enactment of the Truth of Domain Name Act (TDNA) trademark owners had only civil remedies that they can only resort to in the event of typo squatting. According to Sec 3002 of the ACPA, which is now part of the Lanham Act, the trademark owner must establish two elements to win a case against a typo squatter. First, he must establish that the registrant has a domain name that is identical to or confusingly similar to his distinctive or famous trademark, or that dilutes the famous trademark. Second, he must establish bad faith intent to profit from the mark”. The court can order the cancellation of the domain name, as well as require the payment of damages to the plaintiff trademark owner from $1000 to $100,000 per domain name.87

The trademark owner can also resort to the UDRP adopted by ICANN, which became effective on December 1, 1999. The UDRP applies to .biz, .com, .info, .name, .net, and .org generic Top Level Domains (gTLDs). The UDRP provides relief for trademark holders, if they can provide mainly according to article 4 (a) of the Uniform Domain Name Policy, the following”88

(i) Domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
(ii) The domain name registrant have no rights or legitimate interests in respect of the domain name; and
(iii) The domain name has been registered and is being used in bad faith. The only relief that the UDRP offers to the trademark owner is to transfer or cancellation of disputed domain name and there are no monetary damages.

The TDNA was passed in 2003 and provides that “anyone who knowingly uses a misleading domain name in the internet, intending to lure a person into viewing obscene material can be fined/ and/or imprisoned. The purpose of the Act is to “prevent the use of a misleading domain name with the internet to deceive a person into viewing .obscenity on the internet”. Sec. 2252 B provides as follows.89

a) Whoever knowingly uses a misleading domain name with the intent to deceive a person into viewing obscenity on the internet shall be fined
under this title or imprisoned more than 2 years, or both” b) Whoever knowingly uses a misleading domain name with the intent to deceive a minor into viewing material that is harmful to minors on the internet shall be fined under this title or imprisoned not more than 4 years, or both.

Under the TDNA, it is a criminal offense to use a misleading Internet domain name to deceive a person into viewing pornography. Those who violate the Act are subject to a fine and/or up to two years in prison, while those who do so with the intent to deceive a minor are subject to a fine and/or up to four years in prison.

The TDNA was criticized on the ground that is not clear on certain issues and that may create problems. For example the TDNA does not define what is considered to be a “misleading domain name” Who can decide what is considered obscene and harmful to minors? The TDNA is silent on all of these issues.90

(3) Indian Law

Indian Government has taken its first step in regulating the cybercrimes by legislating the IT Act 2000, the legal regime on Information Technology in India is still in its nascent stage. There exist numerous grey areas and loopholes in the Act which need to be looked into and also the accelerated pace of technological development has raised many unprecedented issues that do not find express solution in the existing Act. The issues relating to intellectual property rights on internet, cybersquatting, credit card frauds, data protection and privacy on the net need to be addressed. Following the footsteps of United States and EU which have adopted specific legislations for data protection and privacy, India Government is also in the process of formulating laws to tighten its legal regime over the issues relating to data protection and privacy to bolster its offshore credibility. The government has taken into account the modern ways of cybercrimes, violation of data protection norms and prepared the Draft Information Technology Amendment Act 2006 addressing issues relating to innovative cybercrimes, in order to bring a comprehensive legislation to protect the rights of the citizens. This
will go a long way in making Internet and cyber space safer, people friendly and commercially more viable.

Protection under Trade Mar Act 1999

Trademark is defined under section 2 (1) (zb) of the Trade marks Act 1999. It means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include the shape of goods, their packaging & combination of colours. The purpose of the Trademark law is not to confer a monopoly on a right to use a specific word or symbol, instead it allows the first user to have some exclusive rights, which in effect exclude some other entities from adopting a similar work.⁹¹

A domain name is part of the address of the location of a site on the internet. For instance harrods.com is the domain name of the London department store, Harrods. While Trademark has been around for a long time, domain names are comparatively a recent phenomenon attracting public attention only since the rise in popularity of the internet. The legal interface between the domain name and the TM has been the subject of much analysis. When the potential for conflict between the two first arose, there was there was the potential for a wave of cross border litigation as TM owners and the Domain name holders battled for the control of the domain names.⁹²

Disputes over ownership of the domain names have arisen for a number of reasons. The domain name has been considered as akin to a trademark. Therefore those who own the mark for the no-internet business wish to use the same name on the internet; it is seen as a valuable addition to the branding of goods or services or the business as a whole. Trademark law is territorial whereas the internet is global. Therefore, different business trading under the same mark in various parts of the world may have what they consider to be the same legitimate claim to a particular domain name, as no domain name can be identical therefore only one business house can have a particular name.⁹³
In India, Trademark Act, 1999 provides protection to trademarks and service marks respectively. A closer perusal of the provisions of the Act and the judgments given by the courts in India reveals that the protection available under the act is stronger than internationally required and provided. Rule 2 of the Uniform Dispute Resolution Policy requires that applicant to determine that the domain name for which registration is sought, does not infringe or violates someone else’s rights. Thus, if the domain name, proposed to be registered, is in violation of another person’s “trademark rights”, it will violate Rule 2 of the Policy. In such a situation, the registrar is within his right to refuse to register the domain name. This shows that the domain name, though properly registered as per requirements of ICANN, it is still subject to the Trade Marks Act, 1999 if a person successfully proves that he has “right” flowing out of the Act. This point is further strengthened by reading Rule 2 along with Rule 4(k) of the Policy, which provides the parties have a right to agitate before a court of competent jurisdiction, irrespective of the declaration or decision to the contrary by the ICANN. Thus, a contrary decision of an Indian Court of competent jurisdiction will prevail over the decision of ICANN.

Rights and Liabilities

The rights and liability to be adjudicated under the Trade Marks Act, 1999 can be sub-divided under the following groups.94

(a) Liability for infringement, and
(b) Liability for passing off

(a) Liability for infringement

A trademark on registration is provided with a strong protection under the Act. The Act allows the owner of a registered trademark to avail of the remedies for infringement and passing off. It must be noted that though the passing off remedy can be availed of irrespective of registration, the remedy of infringement can be availed of only if the trade mark is registered properly as per the provisions of the Act. Thus, a person holding a domain name violating a registered trademark can be held liable for infringement under the provisions of this Act.95
(b) Liability for passing off

The passing off action depends upon the principle that nobody has a right to represent his goods as the goods of somebody. In other words a man is not to sell his goods or services under the pretence that they are those of another person. Requirements for a passing off action to be successful:

1. a misrepresentation,
2. made by a trader in the course of trade,
3. to prospective customers of his or ultimate consumers of goods or services supplied by him,
4. which is calculated to injure the business or good will of another trader (in the sense that this is a reasonably foreseeable consequence) and
5. which causes actual damage to a business or good will of the trader by whom the action is brought or (in a quia timet action) will probably do so.

The Trademark’ is essentially adopted to advertise ones product and to make it known to the purchaser. It attempts to portray the nature and, if possible, the quality of the product and over a period of time the mark may become popular. It is usually at that stage that other people are tempted to pass off their products as that of the original owner of the mark. That is why it is said that in a passing off action, the plaintiff’s right is against the conduct of the defendant, which leads to or is intended or calculated to lead to deception. It must be noted that the Trade and Merchandise Marks Act, 1958 (the “TM Act”) and the Information Technology Act, 2000 of India do not deal with domain name disputes. Indian Courts, therefore, apply the rules of “passing off with respect to such disputes.96

Passing off is a species of unfair trade competition by which one person seeks to profit from the reputation of another in a particular business or trade. A passing off action is a direct subject matter of the law of tort or common law of right i.e. case law. The T.M Act does not define passing off, but only provides the rules of procedure and the remedies available.97
Wounder Ltd. V. Antox India Pvt. Ltd.\textsuperscript{98}

Passing off is said to be a species of unfair trade competition or of actionable unfair trading by which one person, through deception, attempts to obtain an economic benefit of the reputation, which other has established it himself in a particular trade or business. The action is regarded as an action for deceit.

Scope of Protection under Trade Mark Act, 1999

The Act covers the remedies peculiar to the Indian legal system as well as the well-known common law principles of passing off. At the same time it is in conformity with the recognized international principles and norms. Thus, the protection provided under the Act is more reliable and secure. The following provisions are relevant in this regard:\textsuperscript{99}

(a) A trademark registered under the act has the backing of the infringement arid passing off remedies. An unregistered trade mark is not protected by the Act, except to the extent of availing of passing off remedy.\textsuperscript{100} The definition of the terms “marks” and “trademarks” is so widely given that it is conveniently covers domain name.\textsuperscript{101} It must be noted that a “mark” is used, rightly or wrongly, if it is used in printed or other visual Representation.\textsuperscript{102} It cannot be doubted that a domain name corresponding a mark is definitely used both in the printed form (electronic form) and by visual representation. Thus, the provisions of the Act can safely be invoked to fix the liability in those cases.

(b) A passing off action is maintained in law even against the registered owner of the trade mark, particularly if the trademark has a trans-border reputation.\textsuperscript{103} This principle recognizes the mandate of protecting the well-known trademarks, as required by the TRIPS Agreement and the Trade Marks Act, 1999. Thus even if a domain name is registered in good faith and innocently, the passing off action is maintainable against the registrant.

(c) The registration of domain name with the Registrars recognized and approved by the ICANN may not have the same consequences as
registration under the Trade Mark Act. 1999. For instance, a registration under the Act carries with it a presumption of validity.

(d) The Act considers even an innocent infringement or passing off as a wrong against the right holder, unlike domain name where mala fides has to be proved. Thus, it does not matter whether the person offending the right does so fraudulently or otherwise.

(e) The Act will have overriding effect over any other law, which is in conflict with it. Further, since it is in conformity with the TRIPS Agreement, it is equally in conformity with the well accepted international standards. It must be noted that Rule 4(k) provides that the proceedings under the UDRP Policy would not prevent either the domain name owner/registrant or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution, either before proceeding under ICANN’s Policy or after such proceedings is concluded. This shows that there is a simultaneous and double protection available under the Act.

(f) The provisions of the Act are in conformity with the TRIPS Agreement and WTO provisions. These provisions are mandatory in nature unlike the provisions of WIPO, which are persuasive and discretionary in nature. The UDRP Policy is formulated under the provisions of WIPO; hence it is not binding on parties whose rights are flowing from the Act. The distinction is crucial since in case of conflict between the Policy and the Act, the later will prevail and will govern the rights of the parties falling within the ambit.

(g) The Act allows the making of an “International application” resulting in automatic protection in designated countries mentioned in it. This gives a wider and stronger protection to the trade mark and makes its misappropriation harsh and punitive.

(h) The procedure for registration under the Act is more safe and reliable, as it is not granted on first come first basis. The safeguards provided under the Act are properly followed and only thereafter a trademark is granted.
Thus, the right recognized under the Act is more reliable, strong and authentic.

**Consim Info Pvt. Ltd. V/s. Google India Pvt. Ltd. and Ors**

This is the one of the recent case which shows that domain names are protected under Trade Mark Act, 1999. In this case the High court of Madras has held that the generic names not registrable under Section 9\(^9\) of the Trade Marks Act, but registered under Section 31 (2)\(^10\) cannot be held invalid as a protected trademark at the same instance they cannot enjoy exclusivity.

**Information Technology Act, 2000**

Indian passed the Information Technology Act, 2000 to deal with the emerging cyber issues. It aims to provide for the legal framework so that legal sanctity is accorded to all electronic records and transactions carried out by the means of electronic data interchange and other means of electronic communication (e-commerce). However, it does not deal with major issues like Cher squatting, Spamming, Cyber Stalking, Phishing etc. Though it was expected to deal with so.

For the effective regulation of a phenomenon, the legal regime for it must be abreast with the latest developments taking place in that field, which becomes difficult in the case of Information Technology as it has an accelerated pace of development and hence the statute requires constant updating.

The Indian Information Technology Act reaffirms India’s commitment towards building a knowledge based society and keeping in pace with the rest of the world by providing a legal framework within which such society can flourish. While the Indian Government has taken its first step in regulating the cybercrimes by legislating the IT Act 2000. The legal regime on information Technology in India is still in its nascent stage. There exist numerous grey areas and loopholes in the Act which need to be looked into and also the accelerated pace of technological development has raised many unprecedented issues that do not find
express solution in the existing Act. The issues relating to intellectual property rights on internet, spamming, cybersquatting, cyber stalking, credit card frauds, data protection and privacy on the net need to be addressed. Following the footsteps of United States and EU which have adopted specific legislations for data protection and privacy, India Government is also in the process of formulating laws to tighten its legal regime over the issues relating to data protection and privacy to bolster its offshore credibility. The government has taken into account the modern ways of cybercrimes, violation of data protection norms and prepared the Draft Information Technology Amendment Act 2006 addressing issues relating to electronic contracts, breach of confidentiality and privacy, child pornography, e-commerce frauds like Phishing, identity theft, sending offensive mails, in order to bring a comprehensive legislation to protect the rights of the citizens. This will go a long way in making Internet and cyber space safer, people friendly and commercially more viable.

**Yahoo! Inc. v. Aakash Arora & Anr.**

This suit was filed by the plaintiff before the High Court of Delhi seeking a decree of permanent injunction restraining the defendant from operating any business or selling, offering for sale, advertising and in any manner dealing in any services or goods on the Internet under the domain name ‘YAHOOINDIA.COM’.

It was submitted that the plaintiff was the owner of the trademark ‘Yahoo!’ and domain name ‘YAHOO.COM’ which are well-known and have acquired a distinctive reputation and goodwill. It was submitted that a domain name adopted by the plaintiff is entitled to equal protection against passing off as in the case of a trademark. The plaintiff contended that it would not be unusual for someone looking for an authorized ‘Yahoo!’ site with India-specific content to type in ‘YAHOOINDIA.COM’ (which is defendant’s domain name) and thereby instead of reaching the Internet site of the plaintiff, such person would reach the Internet site of the defendants. Allegation of cybersquatting was also made.
The defendants, on the other hand, averred that the Indian Trade Marks Act related only to good and not services and there could not be any action of passing off as the services rendered both by the plaintiff and the defendants cannot be said to be goods within the Act. It was also contended that ‘Yahoo!’ is a general dictionary word. Further, defendants have been using a disclaimer and thus, there were no chances of any deception. The contention that the principle of unwary customer which is applicable in a case of infringement and passing off of the trademark would not be applicable since the Internet users are technically education and literate persons.

It came on record that ‘YAHOO.COM’ was registered in plaintiffs favour with Network Solution Inc since 18 Jan 1995. It also came on to record that the trademark ‘Yahoo!’ and its variance is registered or pending registration in 69 countries across the globe, India is one of them.

After appreciation of evidence on record and the law on the subject, the Court held as under:

(a) The present is not for an action for infringement of a registered trademark but an action for passing off. The principle underlying the act is that no man is entitled to carry on his business in such a way as to lead to believe that he is carrying on or has any connection with the business carried on by another man. After referring to decisions in Cardservice International Inc v. McGee and Marks & Spencer v. One-in-a-Million, the Court held that although the word ‘services’ may not find a place in the expression -used in Sections 27 and 29 of the Trade and Merchandise Marks Act, yet, services rendered have come to be recognized for an action of passing off.

(b) There can be no two opinions that the two domain names ‘YAHOO.COM’ and ‘YAHOOINDIA.COM’ are almost similar except for use of the suffix ‘India’ in the latter. When both the domain names are considered, it is crystal clear that the two names being almost identical or similar in nature, there is every possibility of an Internet user being confused and deceived
in believing that both the domain names belong to one common source and connection, although the two belong to two different concerns.

(c) On the ‘literate Internet consumer’ argument, it was held that the consumer might be an unsophisticated consumer of information and might find his way to the defendant’s website providing for similar information, thereby creating confusion.

(d) The “disclaimer” contention was rejected on the ground that the defendant’s appropriation of plaintiffs mark as a domain name and home page address cannot adequately be remedied by a disclaimer.

(e) Though ‘Yahoo’ is a dictionary word, yet, it has acquired uniqueness and distinctiveness and are associated with the business of the concerned company and such words have come to receive the maximum degree of protection by the courts.

Ad-interim injunction retraining the defendant from using the domain name ‘YAHOOINDIA.COM’ till the disposal of the suit was granted.

Ruston and Hornby Ltd. v. Zamindara Engineering Co

The decision in Yahoo case has been quite similar to the one given by the Supreme Court in the above mention case, where it was found that there was a striking similarity in between the two words “Ruston” and “Rustamlndia” and the fact that the word “India” was added to the respondent’s trade mark was inconsequential and would not make any difference and the appellant was entitled to succeed for the infringement of his trademark.

The Rediff case is considered as a landmark in the development of Indian Jurisprudence on domain names.

Rediff Communication Ltd. v. Cyberbooth

In this case the plaintiffs filed a suit for a permanent injunction restraining the defendants from using the mark/ domain name “RADIFF” or any other similar
name so as to pass off or enable others to pass off their business or goods or services as for the business or goods or services of the plaintiffs. Further it was contended by the defendants that the manner of watching for information on the Internet is such that there is no likelihood of deception or confusion between www.rediff.com and www.radiff.com; that the users of the Internet can never connect to a website by mistake. Besides, the users of the website are person skilled in the use of computers and are educated people and thus there is no possibility of any confusion being made by an Internet user in the two names.

A. P. Shah, J. of Bombay High Court observed, “the Internet domain names are of importance and can be valuable corporate asset. A domain name is more than an Internet address and is entitled to the equal protection as a trade mark. With the advancement and progress in the technology, the services rendered in the Internet site have also come to be recognized and accepted and are being given protection so as to protect such provider of service from passing off the services rendered by the other as his services”.

He concluded that “I am prima facie satisfied that the only object in adopting the domain name “RADIFF” was to trade upon the reputation of the plaintiff’s domain name.... Once the intention to deceive is established, the court will not make further enquiry about likelihood of confusion. If it is found that man’s object in doing that which he did was to deceive that he had an intention to deceive the court will be very much more ready to infer that his object has been achieved, if the facts tend to show that is the case and to say that his intention to deceive ripening into deceit gives ground for an injunction”.

On the basis of above observation the court gave the decision in favour of the plaintiff.

As the traditional approach suggests that distinctiveness is needed for registration of any sign as a trade mark. Distinctiveness may be either inherently
distinctive, or may acquire distinctiveness through a secondary meaning (in the market place).

**Dr. Reddy’s Laboratories Ltd. v. Manu Kosuri**

The plaintiff-company is the proprietor of the trademark ‘DR. REDDY’S’. The defendants had registered the domain name ‘DRREDDYSLAB.COM’. The webpage merely showed the caption ‘welcome to the future Website ofdrreddyslab.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 plaintiffs trademark DR. REDDY’S.

The plaintiff-company was established in 1984 for research and development activity in the field of medicine and over 15 years, grew into a full integrated pharmaceutical organization. It was 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 plaintiffs' company business, goodwill and reputation by the operation of a website under the impugned domain name with 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 the available materials on record, the Delhi High Court in March 2001 granted a permanent injunction against a cyber-squatter Manu Kosuri thereby restraining him from using the domain name drreddyslab.com or any other deceptively similar trade mark/domain name for Internet related services which may lead to a dilution of the distinctiveness of the plaintiff's trade mark “Dr. Reddy’s”. The cyber squatter has also been directed to transfer the domain name “dereddyslab.com” to the plaintiff Dr. Reddy’s Laboritories Ltd. The court held that a domain name is of vital importance in e-commerce. Though the registration of the trade mark “Dr Reddy’s” was still pending registration, the High Court used the common law relief of “passing off, where a person has a right over a mark/name through adoption, continuous and exclusive use.

**Tata Sons Ltd. v. Manu Kosuri& Others**

This case involved the following domain names: jrdtata.com, ratantata.com, tatahoneywell.com, tatayodagawa.com, tatatele services.com, tatassl.com, tatapowerco.com, tatahydro.com, tatawestide.com and tatatimken.com. The plaintiff averred that the defendants had misappropriated the plaintiff's trademark TATA since a part of a series of domain names that had been registered by the defendants incorporating the well-known and famous trademark TATA.

The plaintiff contended that it has been the registered proprietor of TATA since 1917 in relation to various goods, in various classes. It further 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 authorized by the plaintiff to do the said business.
The defendants did not put in their appearance despite service.

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.

After discussing the decisions in Yahoo, Inc. \textit{(supra)} and Red if Communications \textit{(supra)}, it was observed that it is now well settled law that with the advent of modern 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 also entitled to protection in the same way as goods and services are, and trademark law applies to activities on the Internet.

The suit was decreed was the defendants were restrained from using the above domain names.

\textbf{Acqua Minerals Ltd. v. Pramod Borse}\textsuperscript{116}  

This was a suit seeking a decree for permanent injunction restraining the defendants from using the mark BISLERI 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 a result 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. It was 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 plaintiffs' goods. Thus, constitutes a mischief of passing off by the defendants. The plaintiff referred to Paragraph 4(b)(i&ii) of the UDRP to project the element of ‘bad faith’.
The question which arose for consideration 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 Trade and Merchandise Marks Act, 1958.

With the advancement of Internet communication, the domain name has attained as much legal sanctity as a trade name. After discussing the meaning of ‘domain, it was held that the same principles and criteria are applicable for providing protection to the domain name either for action for infringement if such a name is registered under the Trade and Merchandise Marks Act or for a passing off action as are applicable in respect of trade mark or name.

The court also relied upon the ‘bad faith’ test under the UDRP. It found that the defendants had blocked user of the trade name BISLERI 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’ was chosen by the defendants with *mala fide* and dishonest intention and as a blocking or squatting tactic.

It was also found that the defendants already had their own domain name, namely, info@cyberworld.com. It appeared that the only object of the ‘defendant in adopting BISLERI.COM 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 the registration of the domain name or of any other domain name which consisted of the plaintiff's mark or copyright name.

The suit was thus decreed on the ground of bad faith registration.

*Mawana Sugars Limited v. Panalink Infotech Limited.*

The complainant company has been in the sugar producing and marketing business under the trademarks MAWANA and MAWANA SUGARS for the past 55 years. The complainant registered its domain names through the
respondent, who illegally transferred the same to some third party during the pendency of the proceedings. It was held that it was a typical case of “Cyberflying”, which means a phenomenon where a registrant of a domain name, when named as a respondent in a domain name dispute case, systematically transfers the domain name to a different registrant to disrupt the Policy. Held that respondent failed to show any legitimate right in the domain names and transfer of the domain name without the consent of the complainant was an action in bad faith. It was held that the respondent was involved in “CYBERFLYING”.

**Times Internet Ltd. v. Belize Domain Whois Service Ltd. & Others.**

In this case the domain name in dispute was “indiatimestravel.com”. The plaintiff alleged that the trademark and logo “Indiatimes” was coined by *M/s Bennett Coleman & Co*. Which runs numerous publications such as the Times of India, The Economic Times, Navbharat Times, Delhi Times and Bombay Times and with the passage of time the website “indiatimes.com” acquired an extensive reputation amongst the people and large number of persons started using its services and purchasing goods through it. It has also been alleged that the mark/name “indiatimes” has come to be associated exclusively with the plaintiff company and the mere mention of the word “indiatimes” signifies the services and products marketed by the plaintiff through its e-commerce website. The products marketed by this name/mark are known for the quality, authenticity and best prices/bargains. The trademark “travel.indiatimes.com” was also registered in the name of the plaintiff company w.e.f 7th June 2000. It is also offering extensive travel services and on clicking “http://travel.indiatimes.com” on the internet, the user is taken to the page “http://travel.indiatimes.com/ovt/ faces/ travellndex.jsp”, which is the travel services desk of the plaintiff on the internet. The same page can also be assessed by clicking on various links on the home page of “indiatimes.com” and this service is immensely popular, attracting large business. The plaintiff has also got the name “indiatimes.com” registered as a domain name with Network Solutions Inc. The plaintiff recently came to know that a domain name “India times travel .com” has got been registered by defendant. The defendant is trying to take advantage of the branding and promotional initiatives
of the plaintiff’s company in relation to the site “indiatimestravel.com”. The plaintiff also claimed that the domain name “indiatimestravel.com” is identical with the registered trademark of the defendant’s “travel. India times. com” and the web address “http://travel.indiatimes.com” belongs to the plaintiff company and is deceptively similar to the domain name of the plaintiff's company “indiatimes.com”. The domain name in issue, registered by the defendant is virtually a copy of the domain name “indiatimes.com”. Any user on the net who come across the domain name “indiatimestravel.com” is likely to get confused and believe that the said domain name belongs to the plaintiff company and this has been done by the defendant to earn huge money by using the plaintiff's domain name.

The plaintiff prayed for the injunction restraining the defendants from using or squatting from the trademark or domain name “indiatimestravel.com” or operating any business or selling, offering for sale, advertising and /or deal in any manner in services or goods using the trademark/domain name “indiatimestravel.com” or any other identical or deceptively similar name. An injunction has also been sought seeking directions for the transfer of the domain name “indiatimestravels.com” to the plaintiff.

The court held that, a domain name may have all the characteristics of T.M. and could find an action for passing off. Any attempt on the part of a person to enrich upon the good will generated by any other person needs to be curbed by the court whenever approached by the aggrieved party in this regard. Further the court was of the opinion that in the instant case, the domain name adopted registered by the defendant being identical to the coined Trademark of the plaintiff, it is a clear case of passing off and the defendant is not entitled to continue using the domain name.

Satyam Infoway Ltd. v. Sifynet Soloutions Pvt. Ltd.119

The aforesaid principle of law has now been cited with approval by the Hon’ble Apex Court in this case. The question before the court was whether the
use of the same or similar domain names might lead to a diversion of users, which could result from such users mistakenly accessing one domain name instead of another.

As per the facts of the case, the appellant which was incorporated in 1995 registered several domain names like vwww.sify.net, www.sifymall.com, www.sifyrealestate.com, etc in June 1999. The word “Sify” is a coined word, which the appellant claims to have invented by using elements of its corporate name, Satyam Infoway. The appellant claimed a wide reputation and good will in the name “Sify”. The respondent started carrying on business of internet marketing under the domain names, www.sifynet.net and www.siffynet.com from May 2001.

Coming to know about the use of the word “Sifry” as part of the respondent’s corporate and domain name, the appellant served notice on the respondent to cease and desist from either carrying on business in the name of Sifynet Solutions (P) Ltd or Sifynet Corporation and to transfer the domain names to the appellant. On the refusal of the respondent on the basis that the respondent was passing off its business and services by using the appellant’s business name and domain name.

The City Civil Court Judge allowed the application for a temporary injunction on the grounds that the appellant was the prior user of the trade name “Sify”, that it had earned good reputation in connection with the internet and computer services under the name “Sify”, that the respondent’s domain names were similar to the domain name of the appellant and that confusion would be caused in the mind of the general public by such deceptive similarity. It was also found that the balance of convenience was in favour of granting an injunction in favour of the appellant.

The respondent preferred an appeal before the High Court. It was held that the finding that the appellant had earned a reputation and goodwill in respect of
the domain name “Sify” was not based on a consideration of the necessary factors. It was observed by the High Court that there was no question of customers being misled or misguided or getting confused.

On the basis of above observations the Supreme Court concluded that “the respondent was seeking to cash in on the appellant’s reputation as a provider of service on the internet. In view of our findings albeit prima facie on the dishonest adoption of the appellant’s trade name by the respondent, the investment name of the appellant in connection with the trade name, and the public association of the trade name Sify with the appellant, the appellant is entitled to the relief it claims”

Thus, it is very much clear that with the advancement of technology and communication, domain names have attained as much legal sanctity, as trade names. The domain name is a valuable corporate asset and is entitled to equal protection as a trademark. The decisions in the aforesaid cases suggest that the basic principles of the trademark law apply to the Internet domain names.

From the above discussion it is quite clear that the courts in India granted, injunction as a relief for infringement and passing off action in domain name disputes. The courts were not concerned with liquidated damages because of the notion that it is difficult to quantify the loss which a person has suffered by the cybersquatting. But in recent years there has been a transition in the judicial trend in cases relating to cybersquatting.

The courts have extended remedial measures beyond the statutory provisions for compensating the loss caused to the person at the hands of cyber squatter.

**Non Judicial Dispute Resolution Policy under UDRP**

Internet Corporation for Assigned Name and Numbers (ICANN) as successor of NS1 came out with its own version of dispute resolution policy, called ‘Uniform Domain Name Dispute Resolution Policy” on October 24, 1999.
It preceded the ACPA by a month. It is a comprehensive policy that covers domain name dispute areas, like trademark or service mark infringement. It has been able to create a basis for global uniformity in the resolution of domain name disputes.

All registrars in the .aero, .biz, .com, .coop, .info, .museum, .name, .net, .org and .mobi top level domains follow the UDRP. Under the policy, most types of trademark based domain name disputes must be resolved by agreement, court action or arbitration before a registrar will cancel, suspend, or transfer a domain name. Disputes alleged to arise from abusive registrations of domain name (cybersquatting). Disputes alleged to address by expedited administrative proceedings that the holder of trademark rights initiates by filing a complaint with an approved dispute-resolution service provider.

To invoke the policy, a trademark owner should either (a) files a complaint in a court of proper jurisdiction against the domain name holder (or where appropriate an in rem action concerning the domain name) or (b) in cases of abusive registration submit a complaint to an approved dispute-resolution service provider.\textsuperscript{120}

As discussed earlier in the Policies section of this paper, it is quite clear that in UDRP much emphasis has been given to the bad faith registration.

**UDRP: Registration in Bad faith**

The following circumstances, in particular but without limitation, provide evidence that a domain name has been registered and used in bad faith [Para 4(b)]:

- Circumstances indicating that the respondent-registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent’s documented out-of-pocket costs directly related to the domain name; or
• The respondent-registrant 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, provided that the respondent-registrant has engaged in a pattern of such conduct; or

• The respondent-registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor, or

• By using the domain name, the respondent-registrant has intentionally attempted to attract, for commercial gain, Internet users to his website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the respondent’s web-site or location or of a product or service on his (respondent’s) web-site or location.

**Bennett Coleman & Co. Ltd v. Steven S. Lahvani** and **Bennett Coleman & Co. Ltd v. Long Distance Telephone Co.**

Bennett Coleman & Co. Ltd. a complaint filed with WIPO in January 2000, regarding the names <the economictimes.com> and <thetimesofindia.com> respectively. The complainant published in newspapers of Indian content named “The Economic Times,” which had an average daily circulation of 350,100, and “The Times of India,” which had a daily circulation of 2,522,488. The complainant had held the domain names, <economic times.com> and <timesofindia.corn> since 1996, using them for the electronic publication of its respective newspapers. The respondent’s web sites used the domain names and redirected Internet users to the site<indiaheadlines.com> which also provided India-related news and articles. While passing their decision in the matter, WIPO took cognizance of the following factors:

1. The newspapers of the complainant had a wide circulation both within and outside India. The newspaper websites would have added to their overall reputation, since Internet users around the world could access the sites.

2. The disputed domain names, having the same title as the hard-copy of the complainant’s newspapers, differed from the complainant’s domain name only by the incorporation of the definite article “the” at the beginning.
3. The respondent’s sites diverted the Internet users to another web-site and appeared to act as “postal addresses.” The necessary implication was that the domain names in contention were used to take advantage of the reputation of the complainant by misleading Internet users that the disputed sites were owned by the complainant.

4. Since the Internet is accessible world-wide, it could not be contended that the trade mark of the complainant was not registered in a particular country.

5. Even though the marks may not have been registered, the act of the respondent would amount to the tort of passing off, since it was the reputation of the complainant and not registration of the trademarks that was paramount to the complaint.

Therefore, the WIPO panelists confirmed the presence of all three requirements as stated in Para 4(a), and transferred the domain names, <theeconomictimes.com> and <thetimesofindia.com> to Bennett Coleman & Co.Ltd.

**Tata Sons Ltd. v. The Advance Information Technology Association.**¹²³

In this case, Tata Sons filed a complaint against AITA with WIPO for the illegal registration of the domain name <tata.org> The WIPO panellists held that “Tata” was a well-known name, linked to high quality products. The name “Tata” was a family name and had no dictionary meaning. Further, both AITA and Tata were based in the same city and AITA was bound to know of Tata’s reputation. Further, AITA had not activated the disputed domain name which indicated that AITA was merely hoarding the domain name. In this case the WIPO panellists held that even if the web-site were activated, the facts would lead them to believe that the registration was in bad faith. The domain name <tata.org> was, therefore, transferred by ICANN to Tata Sons based on the award granted by WIPO in favour of Tata Sons.
**Hero Honda Motors v. Rao Telia**

On the basis of above case it can be said that non-activation of the disputed mark is also an indication of the mala fides of the respondent. Another dispute was the passive holding of a domain name’ indicated that its registration was in bad faith occurred. The complaint was filed with the WIPO by Hero Honda Motors and Honda’s joint venture company in India against Rao Telia, in relation to the domain name <herohonda.com>. A person based in the United States of America, who had registered the domain name for a website dedicated to fans of Honda. However, Mr. Telia had not activated the website. The WIPO panellists held that the domain name was identical to the trademark of the complainant, and the domain name<herohonda.com> was transferred to Hero Honda Motors.

**NIIT Ltd. v. Parthasarathy Venkatram**

The domain name at issue before World Intellectual Property Organization Arbitration and Mediation Centre (the “WIPO Center”) was “myniit.com”. The Complainant’s business run under the mark “NIIT” has achieved a phenomenal growth ever since its inception and the Complainant also extensively advertised its business and goods under the mark “NIIT”. The panel held that the registration of the domain name “myniit.com” be transferred to the Complainant.

**Mahindra & Mahindra Ltd v. Neoplanet Solutions**

The impugned domain name is “mahindra, com” the complainant pleaded that they were the registered owners of the trademark mahindra and the name had been exclusively associated with motor vehicles. The respondent did not contest the case and the domain name was held to be registered and used in bad faith and it was transferred to the complainant. Similarly the complainants found success in other cases, like *Microsoft Corp v. Amit Mehrotra*, the domain name involved- “Microsoft.org”; *1TC Ltd. v. Buy This Name*, the domain name involved “itcthreadneedle.com”; *Castro; Ltd v. Shriniwas Ganediwa*. 

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The domain name involved “castrolindia.com”. In all such cases the Panel concluded that the respondent(s) had no legitimate interest in the confusingly similar domain names and that they have registered in bad faith.

**Asian Paints (India) Ltd. v. Domain Admin.** 130

In this case, it was held by the sole panelist, Alan L.Limbury that registration of domain name “asianpaints.com” is identical and confusingly similar to complainants mark (and the domain name registered by it: “asianpaints.com”). It observed that “the respondent can have no plausible explanation for registering the disputed domain name and has no right or legitimate interests in it........ the omission of the letter “s” is a deliberate attempt to exploit user’s typographical errors when seeking the complainant’s website www.asianpaints.com. The absence of any legitimate interest in the disputed domain name and the lack of association with paint on the respondent's website demonstrate registration and use in bad faith. It directed that the domain name <asianpaint.com> be transferred to the complainant.

**Telstra Corp. Ltd. v. Indian Yellow Pages** 131

The respondent registered the disputed domain name <australiayellowpages.com>and<australianyellowpages.com>in June 1997. The complainant though Australia’s leading provider of telecommunications and information services, was also producing the Australian Yellow Pages business directories.

The complainant contended that it had Australian trademark registrations for YELLOW PAGES and by virtue of its Australia-wide trade in and around its yellow pages publications over the last decade; it acquired common law rights in the name of YELLOW PAGES in Australia. It further contended that to Australians the term YELLOW PAGES means the product of tje complainant. Moreover there were features on the respondent’s website (e.g. Australian insignia and a picture of a Yellow Pages Directory), which would likely to lead people to believe that the site was a site of the complainant. It further argued that the
respondent had no rights or legitimate interests in respect of the domain name in question.

The respondent, on the other hand, contended that it has legitimate interests in respect of the domain names in question. It further contended that the complainant’s act amounts “to snatch the domains” and therefore constitutes Reverse Domain Name Hijacking (RDNH).  

The Panel [Sole Panelist - Tony Willoughby] observed that it has “no hesitation in finding that the Domain Names are confusingly similar to a trademark or service mark in which complainant has right.....at the time of registration of the Domain Name the respondent will have known, along with all other Internet service companies, that on-line versions of Yellow Page directories were an inevitable and natural progression from their printed equivalents”. It held that “the Domain Names were registered in bad faith and are being used in bad faith within the meaning of paragraph 4(a) (iii) and 4(b) (iv) of the policy”. It dismissed the allegation of RDNH and directed <austaliayellowpages.com>and<australianyellowpages.com>, be transferred to the complainant.

It is significant to note that in all aforesaid cases, the panellist came to the conclusion that the respondents have no rights or legitimate interests in respect of the Domain Names. The panels have taken cognizance to the complainant’s registered rights, giving credence to national trademark laws and practices.

It is significant to note that UDRP is a proactive dispute resolution mechanism, as it provides:

A domain name registrant may continue to use his or her domain name while the complaining party in the domain name is being determined before an ICANN-approved arbitration panel or a court of competent jurisdiction [UDRP Para7: Maintaining the Status Quo].
It permits the trademark owners to challenge the use of domain names that are confusingly similar to their trademarks. It goes beyond the Anti-cybersquatting Consumer Protection Act, which restricts the trademark owner to challenge the use of a domain name because it is dilutive of his or her famous mark. [Compare UDRP Para 4(a)(i) with 1515 U.S.C ss 125(d)(1)(A) (ii)(II)].

It applies not only to nationally registered trademarks but also to state and common law trademarks.

Proceedings under the UDRP are limited to domain name disputes in which the disputed domain name “has been registered and is being used in bad faith”. [UDRP Para 4(a) (iii)]. The UDRP is primarily targeted at cybersquatting. It does not apply if the domain name registrant has registered the disputed domain name in good faith.

The global expansion and acceptance of the UDRP is a testimony of its simplified procedure, easier accessibility and arbitral transparency. This online dispute settlement mechanism has also proved to be good ‘revenue model’ for the dispute resolution service providers.

**Wal-Mart Stores Inc. v. Walsucks**

However the arbitrators are now exceeding the scope of the policy especially in cases of gripe sites. The clearest example of the erosion of the first element of the policy i.e. domain name is identical and confusingly similar to a trademark or service mark can be seen in this case. The panel ordered the respondent to transfer the name “walmartcanadasucks .com” to the complainant Wal-Mart Inc. In the decision, the panel stated that although the site was unlikely to be confused as belonging to the corporation, it would however derive its business off of customers looking for the large retail manufacturer. However, it would be bad practice for an attorney to base a decision to file for arbitration based on this case since it has been highly criticized. Principal to the criticism is
the fact that the panel actually stated in their decision that it was unlikely there would be any confusion between the two sites.

Outside of the sucks cases, the first element of the Policy was woefully applied in Tata Sons v. D&V Enterprises,\textsuperscript{134} where the domain name “bodacious-tatas.com” was found to be confusingly similar to the trademark ‘TATA’. Although the panel was of the view that the inclusion of the word “bodacious” in the domain name registered by the Respondent, taken together with the addition of the letter ‘s’ to TATA, could create a sufficient distinction, for trademark purposes, between the Complainant’s TM TATA, on the one hand, and the Respondent’s Domain Name on the other. Such a contention, however, is untenable in the view of the Panel, by virtue of the very high level of goodwill that both TATA and TATAS have acquired. Further, TATA, without any vestige of doubt, constitutes a famous (or, in international parlance, well known) mark - a subject to which the Panel will return.

For all the foregoing reasons, and after careful consideration of the submissions and evidence, the Panel decided that the Domain Name registered by the Respondent is identical or confusingly similar to the trademark and service mark in which the Complainant has exclusive rights, and that the Respondent has no rights or legitimate interests in respect of the Domain Name, and that the Respondent’s Domain Name has been registered and is being used in bad faith. Pursuant to Paragraph 4(i) of the uniform policy therefore, the panel directed that the registration of the domain name be cancelled.

Cyber Squatting: Role of World Intellectual Property Organisation (WIPO)

(1) Cyber Squatting

Registration of domain name is purely passed on a first come – first served basis and made no checks to see if the applicant as any others were entitled to any rights in the name.
Cybersquatting is a crime against the laws and regulations of cyber law. It can be defined as registering, trafficking in, or using a domain name with bad-faith i.e. mala fide intent to make profit from the goodwill of a trademark belonging to someone else. The cyber squatter is an Internet user who has registered multiple domain names with the hope of selling them to the companies who own trademarks identical to those names.\textsuperscript{135}

The term is derived from “squatting”, which is the act of occupying an abandoned or unoccupied space or building that the squatter does not own, rent or otherwise have permission to use. Cybersquatting however, is a bit different, in that the domain names that are being “squatted” are (sometimes but not always) being paid for through the registration process by the Cyber squatters. Cyber squatters usually ask for prices far greater than that at which they purchased it. Some cyber squatters put up derogatory or defamatory remarks about the person or company the domain is meant to represent in an effort to encourage the subject to buy the domain from them.\textsuperscript{136}

Some enterprising persons registered the names or the trademarks of the well-known companies as domain names, with the sole intention of selling the names back to the companies when they finally woke up. Panasonic, tata, bennet & coleman and avon were among the “victims” of cybersquatting. This practice has reaped rich dividends for some who rushed madly to register TMs or names close to TMs and then demand high price to sell these domain names back to the interested companies. Since there is no connection between the trade mark registration and domain name registration. This lack of connection has been exploited maximum by the cyber squatters. The first come, first-served, nature of domain name is registered by someone with the sole purpose of selling it at a premium to a trade mark owner.\textsuperscript{137}

Often, cyber squatters take such names and offer them for sale to the person or company who should rightfully have the domain under trademark laws.
They usually ask for a high price, much greater than the actual cost of the domain when it was available. Some cyber squatters put derogatory remarks on the registered domain about the person or company it is meant to represent in an effort to encourage the subject in question to buy the domain.\(^{138}\)

As the commercial function of the Internet has grown, more legal disputes have arisen because many private citizens and companies have rushed to get a spot in the “cyber world” in order to exploit the potential of on-line commerce.\(^{139}\)

The existence of domains without specific requirements for the registration brought a policy of “first come, first served”. This has created many disputes with trade mark owners because, since the 1990s, many speculators have started to register domain names in order to resell them for a much higher price to trade mark owners and new businesses. Problems arose with trade mark owners because of their entitlements to IP rights make them feel ripped off by this new practice called “cybersquatting”.\(^{140}\)

An example of cybersquatting of a famous name in India was of Arun Jaitly, General Secretary of the BJP and leader of opposition in Rajya Sabha. The Delhi High Court in CS (OS) 1745 of 2009 Arun Jaitly v. Network Solutions Pvt. Ltd. Passed an order on 4.7.2011 :

- Directing to return of the domain name arunjaitly.com to him (Arun Jaitly);
- Restraining the defendants from using any derivative of his name;
- Awarding 5 lakhs punitive damages.

(2) **Typo – Squatting**

Typo – Squatting is a form of cybersquatting which is also called URL hijacking.
Typo-squatting,’ is using a minor variation of its name to divert customers who mistype it. These practices are illegal. It is a kind of Domain name dispute.

Air France has a website www.airfrance.com. Alvaro Collazo, a ruguayan owner has another website www.arifrance.com, Air France raised a dispute that he was guilty of ‘Typo-squatting’. In July 2003, WIPO, a service provider under UDRP, held that the use by Collazo of a ‘typographical misspelling’ of the Air France trademark showed that he had registered his site in bad faith, to create confusion and make money by offering links to other commercial domains. Other ‘typosquat’ sites held illegal by a service provider include www.nasdaq.com, a corruption of the New York Stock Exchange’s nasdaq.com, and www.wallsreetjournal.com, dropping only a Y from the name of the global business newspaper.141

(3) Protest Website

Protest websites, as the name suggests, are those websites that point out some shortcoming about a service or product. They are typically formed by adding the words ‘sucks’ with the name of the service or product. This means that they use the name of that service and product as well. It is not their trademark.142

Wal-MartCanadaSucks.com and four similar domains were examples of such websites. A WIPO judge while deciding a dispute under UDRP in July, 2000 held them to be illegal and handed them over to Wal-Mart saying that they infringed Wal-Mart’s trademark and were an abusive registration. This case was soon followed by another that handed over a range of “sucks” website for UK companies, including FreeserveSucks.com, DixonsSucks.com, NatWestSucks.com and DirectLineSucks.com. These cases have since been used as the foundation for many subsequent domain disputes. However this may change in view of the decision of the US Court of Appeals in Bosley Medical Institute v. Kremer (The Bosley Cae) It was held that:143
Like the District Court, we agree with Kremer. We hold today that the non-commercial use of a trademark as the domain name of a website the subject of which is consumer commentary about the products and services represented by the mark does not constitute infringement under the Lanham Act.’

The decision of the Bosley case on this point, is in line with Justice Holmes’ observation in Prestonetts. Inl v. Lory, 264 US 359 368; 44 S, ct 350 (351), 68 L.Ed. 731 (924)

Trademark does not confer a right to prohibit the use of the word or words. It is not a copyright. ... A trademark only gives the right to prohibit the use of it so far as to protect the owner’s good will against the sale of another’s product as his ‘.., When a’mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth’

In Indian context, this question has to be answered in the light of sections 28, 29 and 30 of the Trade Marks Act. These sections confer rights on registration of trade mark, explain when are they infringed, and prescribe limits on their rights. According to these sections, registered trade mark:

1. only provide exclusive right to use it in relation to goods or services;
2. is infringed only if it is used by any other person in course of trade in relation to goods or services;
3. is not infringed by its use to indicate, apart from others, the quality of goods or services.

A similar view, as taken in the Bosley case, may be taken in our country too.144

(4) Linking

Linking is a process whereby a user connects from one side of the internet to another site by clicking on a designated space on the initial site (hyperlink) which then connects the user to the other site. It is one of the most useful aspects for the internet users, because it permits users easily to navigate the internet
without needing repeatedly to type website addresses or search terms. There are three types of links to material on other sites:\textsuperscript{145}

- Simple or “outline” links- when the link is clicked, the homepage of another site is shown on the accessor’s screen, enabling access to items included in that site;
- Deep or “in-line” links- when the link is clicked, specific material on the other site is brought to accessor’s screen, bypassing the homepage of that site;
- Embedded links- the link is embedded in the accessed site, so that material in another site is automatically incorporated into display on the user’s compute

\textbf{Shetland Times, Ltd. v. Jonathan Wills and Another}\textsuperscript{146}

The first “linking” case, the issue presented in this case was whether the Shetland News’s (“News”) “deeplink” to embedded pages of the Shetland Times’s (“Times”) web site, through the use of Times’ web site’s news headlines, was an act of copyright infringement under British law. The matter settled on the day of trial, shortly after the court had issued a preliminary injunction precluding the deeplink. Although much discussed, this opinion has proved to be of little legal significance, in part because of the extremely low evidentiary standard applied by the court.

A Danish court in July, 2002 has also granted an injunction in favour of the Danish Newspapers Publishers’ Association banning news feed service News booster from deep linking to newspaper stories. An appeal against the decision is pending.

A Brussells Court also held in 2007 that Google violated copyright, by publishing links to articles from Belgian Newspapers without permission.
(5) Framing

Another issue that has emerged is framing, which allows a web page developer to build a frame or a border of text, or graphics on its own site and pull a webpage from another site into the frame or border, thus allowing it to offer the other site’s context within the frame on the developer’s own site. Framing creates significant legal issues because it enables operators to create a new page that may eliminate content advertising and even the site identifier from the framed page.  


In this case, the Washington Post and other news services sought to preclude the defendant online news service from “framing” their web sites and web site’s content. The plaintiffs claimed that the act of “framing” infringed, diluted and misappropriated their copyrighted materials. The matter settled out of court with the defendant agreeing to remove its frame and the plaintiffs allowing access to their web sites by simple hypertext link.

(6) Spamdexing

This word comes from a combination of spam and indexing. Here, either the company’s trademark is placed in the text of the web page instead of in the metatag, or placed in white print text so that it is technically part of the web page, but not visible to readers. Either way the option of the spamdexing is to cause search engines to find the web sites based on the popularity of the trade mark and thus give a website a higher “hit-rate” than it would normally have. This places it on the top of the list in a response to an internet search, and based on its position of likely option drives additional traffic to the sides.

(7) Spoofing

A web user which has an email-id sometimes may discover an unwanted message from some undesirable site for example some pornographic site, such mails are called spam and now a days most of the websites provide for the filters
which automatically junk these mails. But sometimes these blocked sites with the help of this method where they use the name of some well-established web sites so that these mails can easily pass through the filters. The method is known as spoofing. Here one web site acquires the identity of another web site.  

(8) **Metatag**

Information is retrieved on the Internet with the help of search engines they locate websites that match the user’s particular area of interest. It is done by typing a keyword query into the search engine, and the programme searches its database and returns a list of results. The results returned by search engine programmes are a list of hyperlinks related to Web pages. In finding out relevant Web pages, search engines make use of metatags. But before we discuss the legal complication in this regard, let’s understand what a meta-tag is.  

Meta means beyond the ordinary or usual and is sometimes used for anything which is about itself: metatags provide information about the contents on the Web page, rather than how the contents of that page should appear. They are information about the information on the Web page. They are located within a specially designated portion of the HTML code, which generates the page and are hidden from normal view but are read by search engines.  

Metatag is the keyword embedded in a website’s HTML code as a means for internet search engines categories the contents of the website. Metatags are not visible on the website itself (although they can be made visible together with the source code of this page). The more often a word appears in the hidden code, the higher a search engine will rank the site in its search result. In various jurisdictions, trademarks owners challenged the unauthorized use of their TMs as a metatag.  

**Roll of the World Intellectual Property Organisation (WIPO)**

WIPO arbitration and Mediation centre was established in 1994. It has provided on alternative dispute resolution (ADR) options for the resolution of
international commercial disputes between private parties. Developed by leading experts in cross border dispute settlement, the arbitration, mediation and expert determination procedures provided by the WIPO centre are recognized as particularly appropriate for technology, entertainment and other disputes involving intellectual property.\textsuperscript{155}

The Uniform Domain Name Dispute Resolution Policy (UDRP), which was proposed by WIPO in 1999 and has become accepted as an international standard for resolving domain name disputes outside the courts, is designed specifically to discourage and resolve the abusive registration of trademarks as domain names, commonly known as cybersquatting. Under the UDRP, a complainant must demonstrate that the disputed domain name is identical or confusingly similar to its trademark, that the respondent does not have a right or legitimate interest in the domain name and that the respondent registered and uses the domain name in bad faith. Disputes are decided by independent panellists drawn from the WIPO Centre’s global list of trademark specialists. The domain name registration in question is frozen (suspended) during the proceedings. After reviewing a case, panellists submit their decision within a period of 14 days. If a panellist’s decision to transfer a domain name is not challenged in a competent court within a period of ten business days, the registrar is legally bound to implement the panellist’s decision. The entire case normally takes no more than about two months.\textsuperscript{156}

The WIPO Centre is the leading global provider of domain name dispute resolution services and provides a range of resources for users and the general public. An illustration of these resources is the freely available WIPO jurisprudential Overview, which provides a distillation of panel findings in the thousands of domain name cases filed with WIPO. Parties, counsel and others around the world use this unique WIPO tool to find their bearings in the growing cybersquatting jurisprudence.\textsuperscript{157}
Recognizing the problems raised by clashes between domain name system and trademarks, the World Intellectual Property Organization (WIPO) Arbitration and Mediation Centre has developed an online Internet based system for administering domain name disputes involving intellectual property. This Dispute Resolution Mechanism is unique in that it is designed to be used online both for document exchange and for filling of evidence. However, the original documentary evidence will still be needed to be filled in a physical form. The dispute resolution is simply signed and thus, providing an inexpensive and efficient service and does not in any way seek to take the place of national jurisdiction. A successful complainant’s remedy is limited to requiring the cancellation of the registrant’s domain name or the transfer of domain name registration to the complainant.\(^{158}\) The procedure will be handled in the large part online and is designed to take less than 45 days with a provision for the parties to go to court to resolve their disputes or contest the outcome of the procedure.

Cybersquatting is the most crucial type of domain dispute prevalent around the world. The world today acknowledges the accomplishment of WIPO online dispute resolution system. It has extended to thousands of Internet users easily accessible and reliable means of dispute resolution and delivered substantial justice in a very short span of time. WIPO has resolved number of domain name disputes online.

**The WIPO Cybersquatting Statistics**

In 2013 trademark holders filed a record 1025 cybersquatting cases covering 2759 internet domain names with the WIPO centre under procedures based on the Uniform Domain Name Dispute Resolution Policy (UDRP). According to the latest World Intellectual Property Organisation (WIPO) Domain Name Dispute Resolution Statistics there has been a much percentage of decrease over the record established in 2012.
### Number of Cases per Year

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![Number of Cases per year graph](image-url)

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### Number of Domain Names by Year

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![Graph showing the number of domain names by year](image-url)
### Area of Complaint Activity

**Industry and Commerce (Decided Cases by percentage)**

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<td>Fashion</td>
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<td>Other</td>
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### Sample of WIPO Domain Name Cases

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<th>Area</th>
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<td>Automobiles</td>
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<td>Volkswagen, Volvo</td>
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<td>Lynch, Raiffeisen, Royal Bank of Scotland, Banco Santander, Standard &amp; Poor's,</td>
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<td>Tesco Finance, VISA</td>
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<td>Biotechnology and</td>
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<td>Pharmaceuticals</td>
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<td>Fe University of Art and Design, Tufts University, University of Georgia,</td>
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<td>Marion Brando, MTV, Ubisoft, Viacom, Virgin Entertainment</td>
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<td>Millen, Lacoste, Lush, Missoni, Monsoon, Paul Frank, Pepe Jeans, Peuterey,</td>
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<td>Retail</td>
<td>ALDI, Auchan, Bandai, Barra Shopping, Calzedonia, Conforama, Costco, Fnac, Galeries Lafayette, IKEA, Leclerc, LEGO, Mattel, Palacio de Hierro, Shaw Industries, Wal-Mart</td>
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Judiciary happens to be one of the most important organs in any modern
democratic countries. It is not only the interpreter of law but also the guardian of
rights of the people. It is an established fact that judiciary is the third organ of the
government in any democratic country. It is the final protector and interpreter
fundamental rights of the people. Judiciary has been playing the vital role for the
important reflection in the field of intellectual property, particularly the
trademarks and domain names etc. The law relating to trademark is not very
common in India. So the litigation relating to internet is not very common in
India.

The disputes between trademarks and domain names present unusual
features that are currently stretching the capacity of Indian Judiciary to its limits.
In certain cases, the global dimensions of domain name disputes have made it
difficult for Indian courts to come up with comprehensive solutions to combat the
cybersquatting menace. India passed the Information Technology Act, 2000 to
deal with the emerging cyber issues. It aims to provide for the legal framework so
that legal sanctity is accorded to all electronic records and transactions carried out by the means of electronic data interchange and other means of electronic communication (e-commerce). However, it does not deal with major issues like Cybersquatting, Spamming, and Cyber Stalking, Phishing etc., though it was expected to deal with so.

A trend of increased disputes over web address is gaining ground in India over the past few years as companies recognize the commercial potential on the Internet. As companies try to state their claims in cyberspace they often find their prime panels already in the hands of somebody else. The WIPO arbitration and mediation center may order the respondent only to refrain from the use damages for the loss caused to the complainant law are being continuously amended to take care of the technological changes.

As per its reports, WIPO elected to limit its mandatory general administrates procedure for the resolution of domain name registration (cybersquatting) WIPO also recommended that the registration agreement contains a provision, for domain on an optional basis, in respect of any dispute in relation to the domain name and such arbitration takes place on live. When one is legitimately entitled to register a domain name, why should be penalized if he seeks to trade in it can be contended that a cybersquatting does not deal in any gods and hence, his activities are not likely to cause confusion in the minds of the public. Intellectual Property Law is being continuously amended to take care of the technological changes. But it still requires major amendments to deal with challenged posed by the internet and digital revolutions. This allows transactions signed electronically to be enforceable in a court of law. The Act provides legal framework for ecommerce, e-security and e-governance in India.

The Uniform Domain Name Dispute Resolution Policy (UDRP), which was proposed by WIPO in 1999 and has become accepted as an international standard for resolving domain name disputes outside the courts, is designed specifically to discourage and resolve the abusive registration of trademarks as
domain names, commonly known as cybersquatting. Under the UDRP, a complainant must demonstrate that the disputed domain name is identical or confusingly similar to its trademark, that the respondent does not have a right or legitimate interest in the domain name and that the respondent registered and uses the domain name in bad faith.

**World Wrestling Federation Entertainment, Inc. v. Michael Bosnian**

The first cybersquatting case under the WIPO was decided on January 14, 2000. The US based World Wrestling Federation (WWF) brought a suit against a California resident who registered the domain name worldwrestlingfederation.com and offered to sell it to WWF at a huge dividend a few days later. The WWF alleged that the domain name in question was registered in bad faith by the registrant in violation of WWF’s trademark.

It was held that the domain name registered by the respondent was ‘identical or confusingly similar’ to the trademark of WWF and the respondent had no legitimate rights or interests in the domain name. Therefore the respondent was ordered to transfer the registration of the domain name to the complainant, WWF.

Some of the cases decided by the WIPO Arbitration and Mediation Centre are discussed below-

**Tata Sons Ltd v. Ramadasoft.**

In this case the domain names in issues were:-


The complainant alleged that the complainant is the exclusive owner of the trademark/name and the domain names in issue, registered by the respondent are
the corporate names of companies promoted by TATA, thereby misappropriating illegally and without authority the trade mark TATA which is the exclusive property of the complainant. The respondent has also registered the domain names “jrdtata.com” and “ratantata.com”, which are the persona! name of the complainant. The unlawful adoption of the impugned domain names by the respondent would result in the dilution of the complainants trade mark TATA.

The WIPO Panel concluded that the Respondent owns the domain names:


These domain names are confusingly similar to the Complainant’s trademark TATA, and the Respondent has no rights or legitimate interests in respect of the domain names, and he has registered and used the domain names in bad faith. The Panel directed the respondent to transfer the domain names in issue to the complainant.

Sbicards.com v. Domain Active Property Ltd.\textsuperscript{167}

Sbicards.com was ordered by the World Intellectual Property Organization to be transferred to the Indian Company from an Australian entity, which hijacked the domain name hoping to later sell it for a hefty sum to the State Bank of India subsidiary. The panel accepted SBI Card counsel’s argument that “the Australian company was in the business of buying and selling domain name through its website.

Talk City, Inc. v. Michael Robertson.\textsuperscript{168}

The complainant had registered the trademark ‘Talkcity’ in the US since April, 1996. It was engaged in providing services such as online facilities for real time interaction with other computer users concerning topics of general interest and was also providing an online bulletin board in the area of consumer education
and business. The complainant also owned the domain names ‘talkcity.net’, ‘talkcity.org’, ‘imagestalkcity.com’ ‘images-talkcity.net’ and ‘images-talkcity.org’. In October 1997, one Michael Robertson, CEO of MP3 registered the domain name ‘talk-city.com’. During this period he also registered various other domain names such as ‘metacrawler.net’, ‘winzip.com’ and ‘fourll.com’. Talk City filed a complaint against the respondent Michael Robertson for illegally registering the domain name ‘talk-city.com’. The respondent failed to reply within the prescribed period of 20 days. However, on receipt of a notification of default and appointment of an arbitration panellist, the respondent replied immediately. It was contended on behalf of the respondent that an attempt had been made to resolve the dispute amicably by offering to transfer the domain name to the complainant, who had refused the offer unless it was reimbursed towards the fees and costs incurred. It was submitted that Talk City had initiated the proceedings in bad faith. This was followed by another e-mail communication with the WIPO Centre in which it was submitted on behalf of the respondent that the proceedings may be terminated since they had taken steps to transfer the domain name and it was also submitted that the failure to respond to the notice within the stipulated period of 20 days was due to some inadvertent confusion. The arbitration panel set aside the first delayed response by the respondent since he had not certified it to be complete and accurate. Although the arbitration panel had the discretion to accommodate a late-filed response, the WIPO’s arbitration award stated that as the respondent had failed to submit a substantive answer in a timely manner, the panel accepted the allegations as correct. The Panel finds that Mr, Robertson owns a domain name (talk-city.com) identical or confusingly similar to Talk City’s trademark (TALK CITY), has no rights or legitimate interests in respect of the domain name, and registered and used the domain name in bad faith. These three factors entitle Talk City to an order transferring the domain name from Mr. Robertson to Talk City. Accordingly, pursuant to Paragraph 4(i) of the Policy, the Panel orders that the registration of the domain name talk-city.com be transferred to complainant.
Experience Hendrix, L.L.C. v. Denny Hammerton and The Jimi Hendrix Fan Club

The estate of Jimi Hendrix brought an action under UDRP against the domain name registrant of ‘jimihendrix.com’. The said domain had been registered in the name of the Jimi Hendrix Fan Club. It was found by the arbitration panel that the domain name registrant had also taken a number of other celebrity and “vanity” domains such as ‘elvispresley.com’, ‘jethrotull.com’ and the like. The said domain name owner had offered to sell the ‘jimihendrix.com’ domain for US$1 million. The arbitration panel considered whether the domain registrant had any legitimate right to use the name, such as because it was his name or because he had a legitimate business purpose, or was it that the only purpose was to sell the domain to the estate or deprive the estate from using the domain. The panel found that “The Jimi Hendrix Fan Club” was not registered in the state of Florida (where the respondent resided) and that the web site was not a true fan club site but was used merely for the purpose of selling domains. If the site was being operated by a legitimate fan club, the question of fair use and bad faith would have been much cloudier and in such circumstances, having a fan club might have been deemed a legitimate use. The estate of Jimi Hendrix was the owner of the registered trade mark “Jimi Hendrix” as well as certain design marks, although none of these registrations were for categories that included web-site usage. Another issue which was considered by the panel, was whether ‘jimihendrix.com’ was confusingly similar to ‘jimihendrix’, the latter being the estate’s trade mark. The panel noted that the second-level domain, i.e. the ‘jimihendrix’ portion, was identical and similar to the registered and common law trademarks belonging to the complainant. The domain name in issue was registered and was being used in bad faith and was ordered to be transferred to the complainant.

Satyam Computer Service Limited v. Vasudeva Varma Gokharaju

The complainant is an information technology giant. Its trademark application for the word SATYAM and the corporate logo was pending in India.
The complainant submitted that the respondent had registered the disputed domain name “satyam.org” in 1999 and “satyam.net” in the year 1998 and till date the respondent had not activated its website. He contended malafide intention on behalf of the respondent. But the respondent contended that he was a devotee of Lord Satyanarayana and the mane “satyam” was its short form and wished to disseminate messages of truth and teachings of the gurus. The panellist came to the conclusion that the said domain names were registered and used in bad faith and hence they were transferred to the complainant.

**Google Inc. v. Merit Shah**

In 2009, Internet software company Google inc. won a cybersquatting case against an Indian teenager who had registered a domain name googblog.com. The domain name, Google contended, was confusingly similar to its trademark. Experts felt that complaints regarding cybersquatting were on the rise and organizations such as the World Intellectual Property Organization (WIPO) were being approached by trademark holders to resolve such disputes. On May 15, 2009, the World Intellectual Property Organization (WIPO) ordered an Indian teenager, Herit Shah, who had been using the domain name ‘googblog.com’, to transfer the rights of the domain to Google Inc (Google).

**Microsoft Corp. v. Microsof.com.**

In this case the panel found that “microsof.com” was confusingly similar to the trademark “Microsoft” and ordered the respondent to transfer the name.

**Rediff.com India Ltd v. Daniyal Waseem.**

In this case the domain name in issue was “rediffpk.com”. The complainant Rediff.com alleged that Daniyal Waseem of Quetta in Pakistan was using the domain name ‘rediffpk.com’ and the disputed Internet site was identical in part and confusingly similar as a whole to the ‘Rediff trademark, for which it has rights.
To restrain Daniyal for using the trademark, the Rediff.com approached a Geneva-based World Intellectual Property Organization (WIPO) in March 2010.

The complainant submitted before the WIPO Arbitration and Mediation panel that the name REDIFF.COM is an invented word and was adopted in 1996 by the complainant. The complainant has registered the trademark REDIFF.COM and other REDIFF prefix mark such as REDIFF MAIL and REDIFF BOL on a worldwide basis, including in the United States of America and India. Most of the Complainant’s services apply REDIFF as part of their product or service trade names such as Rediff Mail, Rediff Bol, Rediff News, Rediff Matchmaker, Rediff Shopping, RediffShare, Rediff Connexions, Rediff P4c Classifieds, Rediff Q&A and Rediff Astrology.

‘The Complainant has, in the past, succeeded in restraining other parties from using the REDIFF trade mark and other confusingly similar marks in relation to different or similar services, by obtaining injunctive relief in India. The Complainant has also succeeded in several proceedings under the Policy in relation to other domain names which were confusingly similar to the REDIFF trade mark.

The WIPO panel found that the Rediff.com.pk was confusingly similar to Rediff.com India Ltd’s trademark, noting;

“In this Complaint, the disputed domain name wholly incorporates the REDIFF trade mark. The additional letters “pk” do not appear to distract a reasonable person’s overall perception or impression of the distinctive feature of the disputed domain name, being REDIFF.”

After finding that Rediff.com.pk was confusingly similar, the panel went on to note that the domain name was registered in bad faith;

“This Panel is convinced that the REDIFF trade mark was calculatively selected by the Respondent to form the disputed domain name in order to disrupt
the Complainant’s on-going business, to extract some form of direct or indirect commercial gain or to otherwise ride on the established goodwill of the Complainant.”

The WIPO Arbitration and Mediation Centre in the light of above findings ordered that the domain name “rediffpk.com” to be transferred to the complainant, well-known Internet portal Rediff.com India from its cyber squatter owner Daniyal Waseem of Quetta in Pakistan.

**Israel bar association v. Itai Pam.** 174

In this case the complainant was an independent Israeli statutory entity established under the Bar association and proprietor of the domain names <israelbar.org.il> and <israelbar.co.il>. It was alleged by the complainant that Domain Name <israelbar.mobi> registered in favor of the respondent amounts to infringement and demanded inter alia transfer of the Domain Name. Complainant contended that it has common law trade mark rights in the name “The Israel bar” arising from long and extensive use of that name since the foundation of the complainant and respondent’s Domain Name was calculated to deceive and to tarnish the name of the complainant. Accordingly, the issue to be decided by the Panel was whether the respondent has legitimate interests in respect of the Domain Name registered by him. The panel opined that the Domain Name is identical and similar to a trade mark in which the complainant has common law rights and has made out a persuasive case. The complainant’s name has been in continuous use in Israel for nearly 50 years. The respondent is an educated Israeli citizen and might be expected to have known of the Complainant. “Israel bar” is, on its face, an unusual combination of words to select for a domain name unless it was to be used to refer to the Complainant or, perhaps a particular Israeli drinking establishment. It is well-established that to demonstrate rights or legitimate interests for the purposes of paragraph 4 (a) (ii) of the UDRP policy complainant has to show that they have been commonly known by the domain name, once the complainant has made out a prima facie case, it is for the respondent to answer that case. The rationale behind this policy is that whether or
not the respondent has rights or legitimate interests in a question, which the respondent is best-placed to answer. Therefore, as per the provisions of the Paragraph 4(i) of the UDRP Policy and 15\textsuperscript{175} of the Rules, the Panel orders that the domain name <israelbar.mobi>, be transferred to the Complainant.

\textbf{Jay Leno v. Guadalupe Zambrano.}\textsuperscript{176}

In this case the disputed domain name <thejaylenoshow.com> is registered with GoDaddy.com, Inc. Complaint was filed with the WIPO Arbitration and Mediation Center. The Complainant alleged that, he is a successful and well-known comedian, entertainer, and television personality, is claiming common law trademark rights in his personal name, Jay Leno. The Complainant perhaps is best known for his comedic career of more than thirty (30) years, and as the host of the popular late night television talk show The Tonight Show with Jay Leno for more than seventeen (17) years, from 1992 until May 2009. The Complainant began appearing in various television shows in the mid-1970s, and prior to becoming the host of The Tonight Show in 1992 he also served as the permanent guest host of the show starting in 1987, and made frequent appearances as a guest on the show. It has been announced by the complainant that he will host a prime time talk show on NBC beginning in the fall of 2009, reportedly to be called The Jay Leno Show.

The Respondent registered the disputed domain name <thejaylenoshow.com> on September 28, 2004. The Respondent uses the disputed domain name to redirect Internet visitors to a commercial website from which Respondent promotes his real estate services.

The WIPO Panel was of the view that Jay Leno, the American stand-up comedian and television host. Obviously, he has rights over this domain name, as long as he had a 30-year career in entertainment, being the host of the highly popular show, “The Tonight Show”.

On the other shore is the respondent, represented by Guadalupe Zambrano who said Jay Leno “has no right to the disputed domain name or to any other
domain name incorporating “Jay Leno”, because the Complainant has transferred any trademark rights in the JAY LENO name and mark to his employer, the National Broadcasting Corporation, which is owned by General Electric Company (“GE”). As proof of this the Respondent maintains that a WHOIS search shows that the domain names jayleno.com and jaylenosgarage.com are owned by GE.” Moreover, the respondent stated that he registered the domain name before NBC decided to call Jay Leno’s show, “The Jay Leno Show”.

Even though the respondent had some good arguments. Jay Leno proved all the three elements of Para 4(a) of the UDRP policy to obtain the domain name. Therefore, the Panel ordered the domain name thejaylenoshow.com to be transferred to Jay Leno.

**Arcelor Mittal v. Privacy Protect.org/ Mr.singh (tajgroup@ avipl.com), Taj Pharmaceuticals Ltd., Taj Group of Companies.**¹⁷⁷

In this case the domain names in dispute were <arcelor cement.com>, <arcelorchemicals.com>, <arcelor chemicals.net>, <arcelorlaboratories.com> and <arcelorlabs.com> all registered with Directi Internet Solutions Pvt. Ltd. d/b/a PublicDomain Registry.com.

The complaint was filed with the WIPO Arbitration and Mediation Centre. The complainant an owner of a registered mark for ARCELOR and operates a website at www.arcelormittal.com. The complainant alleged the disputed domain names are identical or confusingly similar to its registered mark. The complainant says that the term “arcelor” is known only in relation to the complainant. It has no meaning in English or in any other language. A google search of the word “Arcelor” displays several results, all related to the complainant. The complainant alleged that the respondent has registered and used the disputed domain names in bad faith and respondent’s websites use logos similar to the complainant’s. The complainant contended that the respondent has intentionally attempted to create a likelihood of confusion with the complainant. On the other hand the respondent states that it has not violated the UDRP and refers to its registration as a company
under the Indian Companies Act, 1956. The respondent suggests that it is operating “with the permission with here government officially”. The address stated at the end of the response, while the same as that listed in the respondent’s website is different to that listed for the respondent in the WHOIS details of the disputed domain names. The respondent also states that “as far as name ‘Arcelor’ is concerned it means the god”.

The Panel finds that the disputed domain names are confusingly similar to that mark. The panellist found that the defendant Taj Group of Companies (a Mumbai based firm) was in violation of the federal ACPA and infringing on Arcelor Mittal’s trade mark for its conduct in registering and use of the following domain names Error! Hyperlink reference not valid., www.arcelorshemicals.net, www.arcelorlaboratories.com, www.arcelorlabs.com.

Furthermore, Panelist Barker found that the domains were registered in bad faith and that each of the five disputed domains was either in part identical or confusingly similar to ‘ARCELOR’ trademarks. Consequently WIPO on the basis of its above findings, the five disputed domains should be turned over to Arcelor Mittal.

**Indian Express Online Media Private Ltd., The Indian Express Limited, v. Mr. Sanjeev Saluja.**\(^{178}\)

In this case the disputed domain name <indianexpress,mobi> was registered with GoDaddy.com,Inc. The complainant alleged that he has registered rights in the trade mark INDIAN EXPRESS in respect of newspapers, journals, magazines, books and other literary works. The INDIAN EXPRESS was registered as a trademark and both the complainants are owners of many domain names incorporating the world “Indian Express”, including <indianexpress.co.in>, <indianexpress.in>, <indianexpress. co.in>, <the indianexpress .com> and <indianexpress, com>. As the Indian Express Online Media Private Ltd (Complainant No.1) and The Indian Express Limited (Complainant No.2) belong to one of India’s premier media and publishing
groups, the “Indian Express Group” and are publishers of several newspapers and magazines in English and other regional languages, both the complainants therefore claim a common interest in the disputed domain name <indianexpress.mobi>.

The complainants in Feb 2009 discovered that the respondent had without their consent, registered and has been using the disputed domain name. The complainant alleged that the respondent not willing to transfer disputed domain name unless the complainants were prepared to pay for it.

The Panel finds that the respondent has registered and used the disputed domain name in bad faith under Para 4 (b) (iv) of the Policy as respondent registered the domain name and used it to attract Internet users to the respondent’s website for commercial gain, by creating a likelihood of confusion with the complainant's trade mark. The respondent was clearly aware of the complainant’s trademark and reputation in the area of news publication service.

The WIPO Panel on the basis of its above finding and in accordance with Para (i) of the policy and 15 of the Rules, the Panel orders that the domain name <indianexpress.mobi> be transferred to the complainants.

Cox & Kings India Ltd. v. Rakesh Sud

In this case Cox and Kings(C&K), a travel agency, discovered that some of their advertising lines had been registered as domain names. C&K filed a complaint before the WIPO’s Domain Name Dispute Resolution Centre for contesting the registration of domain names ‘duniyadekho.com’ and ‘addmoretoyourworld.com’. It was submitted by C&K. that the respondent had registered several other popular baselines as domain names, which include Videocon’s ‘Bring home the leader’, Pepsi’s ‘Yeh dil maange more’, BPL’s ‘Believe in the Best’ and Thumbs Up’s ‘Taste the thunder’.
WIPO’s Panellist held that in so far as ‘Duniya dekho’ was concerned, it was not a mere advertisement but services under the said expression was also available to consumers. It was noticed that there was evidence that ‘Duniya dekho’ packages elicit tremendous response from the public. ‘Duniya dekho’ satisfies the conditions stipulated in ICANN’s UDRP. The complainant was found to be having trademark rights in “Duniya dekho”. However, the expression ‘Add more to your world’ was held to be a mere advertising expression as the travel agency provide sufficient evidence to establish a service mark right in such an expression. The domain name ‘addtoyourworld.com’ was thus not transferred to C&K.

**Julia Fiona Roberts v. Russell Boyd.**

The complainant Julia Roberts, i.e. the famous actress, the respondent had registered the domain ‘juliaroberts.com’. The respondent was also the owner of many other domains using the names of celebrities and he had put the said domain up for auction.

The complainant did not have a registered U.S trade mark. An issue arose as to whether she had common law trademark rights because her name had acquired a “secondary meaning”. Secondary meaning is a legal term which implies that although a name (whether a personal name or a product or service name) or a design is not a registered mark, the public has come to associate that name or design with a particular person or company or goods or services. This term is usually applied in circumstances where the mark or the claimed rights have been in use for a period of time and have been widely disseminated and used in such a way so as to create this reference in the minds of the public. If the claimant establishes this ‘secondary meaning’, the issue then is whether the use by another in a particular context would be likely to cause confusion in the minds of the public that the particular use is related to the owner of the secondary meaning. In this case, the issue was whether- when someone hears the name ‘Julia Roberts’ or logs onto a website called ‘juliaroberts.com’, such a logger identifies that name
or site with the actress, and whether the use by the respondent of a domain with that name would be likely to confuse the public into believing that the actress was somehow related to this domain in issue. The WIPO Adm. The panel held that Julia Roberts possessed the requisite secondary meaning in her name. It was found by the panel that there was identification in the minds of the public between the domain name and the actress. It was therefore concluded that she possessed trademark rights in her name although she had no register mark.

The next issue was whether the domain registrant had any legitimate rights to the name for the purposes of the site or whether the site was put up and fell within the scope of “fair use”. The panel noted that there was nothing on the site that initially related to the actress (i.e., it was not a fan site or anything of that nature), nor did the site otherwise fall within the category of “fair use”. There have been other cases where the same theory as Ms. Roberts, but did not prevail because the site owner had the same name as that of the celebrity and / or was using the site for legitimate purposes related to the domain name owner’s business or the like. In this case, however, the panel found that the domain name was established solely for the purpose of selling it to the actress or others and that the ‘respondent had established a ‘pattern of conduct’ by registering many other such domains and as such, the conduct of the respondent constitutes the requisite bad faith. The panel ordered for the transfer of the domain name in issue to the complainant.

From the above two cases it can be said that the cybersquatting is no longer restricted to companies names or trademarks. Cyber squatters have extended their tentacles to even advertisement jingles and celebrities names. Cyber squatters after filching company names or brands have now started squatting on popular advertising baselines and popular Hollywood & Bollywood celebrities and politicians (like Amitabh Bachhan, Sonia Gandhi, Sushmita Sen and Gul Panag etc).
Bright Imperial Ltd. v. Domain Administrator, Fundacion Private Whois / INTEvraccdhb2fe   Case No. D2013-0292

The Complainant is the owner of the REDTUBE trademark and has submitted evidence of its rights in a large portfolio of registered trademarks including the following: in Australia trademark REDTUBE, registration number 1228767, registered on March 10, 2008, for services in classes 38, 41 and 42; Community Trade Mark REDTUBE, registration number 007408297, filed on November 19, 2008 and registered on February 4, 2013, in classes 28, 35, 42; in the United States trademark REDTUBE, registration number 3843119 registered on August 31, 2010, for goods and services in international classes 10, 28, 41 and 45; and also in the United States trademark REDTUBE, registration number 3884412, registered on November 30, 2010, for goods and services in international classes 9, 35, 38, 41 and 42.

A number of the trademarks registrations relied upon by the Complainant appear to be registered in the name of a third party, Jaeger & Polacek, GMBH that the Complainant state is its predecessor in interest. These include the Hong Kong registered trademark REDTUBE, registration number 301305017 registered on March 17, 2009, for goods and services in classes 9, 35, 38, 41 and 42; International Trademark registration number 1003812 registered on April 22, 2009, for goods and services in classes 9, 35, 38, 41 and 42; in Mexico, trademark registration number 1177204 registered on August 31, 2010; in New Zealand trademark registration number 803428, registered on October 2009; in Norway trademark registration number 253860 registered on December 9, 2009; in Singapore trademark registration number T0902260E registered on August 27, 2009; and in Switzerland trademark registration number 589771, registered on August 3, 2009.

The Complainant is also the owner of the domain name <redtube.com> that resolves to a commercial website operated by the Complainant to provide adult video content.
As no Response or other communication has been received from the Respondent, there is no information available about the Respondent except for that provided in the Complaint and the publicly-available WhoIs. The disputed domain name was registered on April 12, 2011, and also resolves to a website with adult content.

The Complainant relies on its rights in its portfolio of registered trademarks including those listed above, and submits that the earliest of the above listed trademarks was registered three years prior to the registration of the disputed domain name. The Complainant also relies on its rights at common law through extensive use of the REDTUBE trademark on the Internet.

The Complainant submits that it and its predecessor in interest in the REDTUBE mark have been providing high quality adult entertainment videos in interstate and international commerce since at least July 2006, and has submitted evidence of use of the REDTUBE mark on the Internet since August 2007.

The Complainant claims to have thereby acquired common law trademark rights in the REDTUBE trademark in a number of countries, including but not limited to, the United States, the United Kingdom of Great Britain and Northern Ireland, Canada and Australia by virtue of: (i) the Complainant’s use of the REDTUBE mark to identify to products and services in interstate and worldwide commerce; (ii) the Complainant’s investment in publicising and advertising its products under the REDTUBE mark and creating an exclusive association between the REDTUBE mark and the Complainant’s products; and (iii) the association on the part of the public of the REDTUBE mark with products and services developed and marketed by the Complainant.

The Complainant submits that the extent of the reputation relied upon can be illustrated by the fact that there were 644,712,255 visits to its website in the seven month period from August 8, 2007, to March 21, 2008. This amounted to approximately 2,720,305 visits per day. Since the month of March 2008, the
website to which the <redtube.com> domain name resolves has continued to gain in popularity, and there were over 9 billion visits to the website between April 1, 2008, and June 22, 2011, amounting to approximately 8,059,536 visits per day. In about July 2009, the Complainant’s website at the <redtube.com> domain name was ranked as the 63rd most popular website overall on the Internet, and the third most popular adult website. The Complainant submits that in the month of March 2011, which it notes was just one month prior to the date on which the disputed domain name was registered, the Complainant’s “www.redtube.com” website was receiving average traffic of more than 8 million visits per day. In support of these assertions the Complainant has provided a copy of the Google analytics pages and Alexa pages for the website to which the <redtube.com> domain name resolves. The Complainant has also presented copies of articles from newspapers and magazines referring to its services under the REDTUBE mark which range in dates from February 7, 2008, to September 7, 2011, as evidence of the notoriety that it has achieved in the use of its mark on a global scale.

The Complainant submits that its REDTUBE trademark is inherently distinctive particularly in the context of the goods and services with which the mark is used.

The Complainant argues that the disputed domain name is confusingly similar to its REDTUBE trademark as it incorporates the Complainant’s REDTUBE trademark in its entirety, adding only the generic term for the Complainant services “porn” to the end of the mark. The Complainant submits that the addition of the generic word “porn” to the trademark is immaterial, particularly as the additional word relates to the Complainant’s goods and services.

In support of this argument the Complainant refers to previous decisions under the Policy and argues that a number of panels have decided that a domain name is identical or confusingly similar to a trademark for the purposes of the Policy, “when the domain name includes the trademark, or a confusingly similar
approximation, regardless of the other terms in the domain name”. *Wal-Mart Stores Inc. v. Richard McLeod d/b/a For Sale*, WIPO Case No. D2000-0662. UDRP panels have also determined that, “the incorporation of a trademark in its entirety may be sufficient to establish that a domain name is identical or confusingly similar to the Complainant’s registered trademark.” *Hoffmann-La Roche Inc. v. Hightech Industries, Andrew Browne*, WIPO Case No. D2010-0240. Furthermore the Complainant argues that the addition of generic terms to a domain name has little effect on a determination of confusing similarity between the domain name and the trademark relied upon. *Quixtar Investments, Inc. v. Dennis Hoffman*, WIPO Case No. D2000-0253.

The Complainant further argues that the mere addition of a generic or descriptive term generally does not exclude the likelihood of confusion. *PRL USA Holdings, Inc. v Spiral Matrix*, WIPO Case No. D2006-0189.

Specifically addressing its REDTUBE mark, the Complainant further submits that UDRP panels, have already found a number of Internet domain names registered by third parties, specifically incorporating the REDTUBE trademark in combination with additional generic or descriptive lettering or numbers, as in the present case, to be confusingly similar to the Complainant’s trademark. The Complainant cites the decisions of the panels in *Bright Imperial Ltd. v. Domain Admin, PrivacyProtect.org/Private Registration*, WIPO Case No. D2010-1078 (finding the domain name <redtubeblog.com> to be confusingly similar to the REDTUBE trademark); *Bright Imperial Ltd. v. Senja Dumpin*, WIPO Case No. D2009-1619 (finding the domain name <hqredtube.com> to be confusingly similar to the REDTUBE trademark); *Bright Imperial Ltd. v. Ho Nim*, WIPO Case No. D2010-0321 (finding the domain name <redtubehentai.com> to be confusingly similar to the REDTUBE trademark); and *Bright Imperial Ltd. v. PROXHOST International, Herr Carlos Torres*, WIPO Case No. D2012-1816 (finding the domain name <redtube8.net> to be confusingly similar to the REDTUBE trademark).
The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name; that the Respondent has not received a license or permission from the Complainant to use the REDTUBE trademark in any way or to register any domain name incorporating the mark. The Complainant submits that its own exclusive rights to the REDTUBE mark under the Policy are clearly established by virtue of the Complainant's trademark registrations for REDTUBE and its common law trademark rights. The Complainant cites Sydney Markets Limited v. Nick Raids trading as Shell Information Systems, WIPO Case No. D2001-0932 (domain name transferred where complainant had Australian trademark registrations); and Tuxedos By Rose v. Hector Nunez, NAF Claim No. 95248 (domain name transferred to complainant where complainant had common law trademark rights).

The Complainant argues that there is no indication from the publicly-available WhoIs database record for <redtubeporn.org> that the Respondent is commonly known by the name or mark REDTUBE or "Redtubeporn" and, thus, the Respondent has no rights or legitimate interests in the disputed domain name on that basis.

The Complainant states that the Respondent is not making any legitimate non-commercial or fair use of the disputed domain name. Instead, as explained in more detail below, the Respondent is generating revenue by using the disputed domain name as the address of a website, which targets the same class of consumers as the Complainant, to post videos and advertisements that direct visitors to the websites of Complainant's competitors. Such use is commercial and cannot be classified as legitimate, as it causes Complainant economic harm and gives economic benefit to the Respondent and Complainant's competitors. The Complainant cites Oly Holigan, L.P. v. Damir Kruzicevic, NAF Claim No. 97353 (respondent's use of domain name for a portal site which redirected consumers to commercial web sites did not demonstrate legitimate non-commercial rights or fair use).
The Complainant submits that the disputed domain name was registered and is being used in bad faith. The Complainant states that upon learning of the Respondent's registration and use of the disputed domain name, and in an effort to resolve this matter amicably, the Complainant sent a letter to the Respondent on November 8, 2011, by email to the address listed in the WhoIs database, requesting the immediate deactivation of the website to which the disputed domain name resolved, and further requesting that the Respondent transfer to the Complainant the disputed domain name and any others domains it owned containing the REDTUBE trademark. The Complainant received no response.

On October 23, 2012, the Complainant sent a follow-up letter reiterating its demands. The Complainant again received no response, and a further reminder was sent on November 8, 2012, which also met with no response. On January 24, 2013, in a final effort before filing this Complaint, the Complainant sent an email to the Respondent's company requesting the Respondent's cooperation with regard to the disputed domain name. As of the date of the Complaint, the Complainant had not received any response to its efforts to reach Respondent. The Complainant has annexed copies of the correspondence to the Complaint.

The Complainant has submitted printouts from the website to which the disputed domain name resolved as of February 5, 2013, attached as an exhibit the Complaint. On the website at the disputed domain name, the Respondent is displaying prominent advertisements of Complainant's competitors in vertical banners on the right side of the webpage. The Complainant states that if a user clicks on the advertisements, they are immediately directed to a competitor's website. The Complainant submits that the Respondent acquired and uses the disputed domain name to target the same class of consumers and users of Complainant's products and services. The Complainant submits that on information and belief, the Respondent receives revenues from the advertisements that appear on the website at the disputed domain name and pay-per-click revenue from directing consumers to the websites of Complainant's competitors by to free riding on the Complainant's reputation and goodwill in the REDTUBE mark. The
Complainant submits that the Respondent is therefore making use of the disputed domain name with intent for commercial gain and to misleadingly divert consumers and dilute the REDTUBE trademark. Specifically the Respondent is using the disputed domain name as the address of a competing website on which embedded videos from “www.videosz.com”, one of the Complainant's competitors.

The Complainant submits that the disputed domain name was registered in order to create an impression of association between the disputed domain name and the Complainant. Because the Complainant’s own website at the <redtube.com> domain name is, and has been, one of the most trafficked adult websites in the world, the Respondent must have been aware of the Complainant's REDTUBE mark at the time it registered the disputed domain name on April 12, 2011. Furthermore, because the Complainant’s website was, and is, one of the top adult sites in the world, anyone operating in the adult industry (including the Respondent) would undoubtedly be aware of its mark and domain name. The Respondent's registration of the disputed domain name that includes the Complainant's famous trademark and domain name, for services in the same industry, was plainly calculated to misappropriate and trade off of the goodwill developed by Complainant in the REDTUBE mark. As such, the Respondent's registration and use of the disputed domain name, with actual knowledge of Complainant's trademark for REDTUBE, is evidence of bad faith. See Ticketmaster Corp. v. Spider Web Design, Inc., WIPO Case No. D2000-1551 ("Actual or constructive knowledge of the Complainant's rights in the Trademarks is a factor supporting bad faith.").

Furthermore, the Complainant argues that any routine Internet search would have revealed the Complainant's website at the domain name <redtube.com> and its REDTUBE mark. Accordingly, there is no doubt that the Respondent either knew, or should have known, of the Complainant's prominent use of the REDTUBE mark. Ticketmaster Online-CitySearch, Inc. v. Alex Vlasov, NAF Claim No. 94739 (complainant's widespread use of its mark raises the
inference that respondent had actual or at least constructive notice of complainant's prior use of the mark); *Edmunds.com, Inc. v. Ult. Search Inc.*, WIPO Case No. D2001-1319 (respondent either knew or should have known of complainant's trademark rights since complainant was a well known online company and respondent was an operation in the domain name area). Further, a trademark search on the date of registration of the disputed domain name would have revealed the REDTUBE registered trademark in a number of countries around the world, owned by Complainant or its predecessor-in-interest. Failure to heed such constructive notice is evidence of bad faith. *Young Genius Software AB v. MWD, James Vargas*, WIPO Case No. D2000-0591 (respondent had a duty to check on the availability of complainant's trademark and failure to do so was evidence of bad faith).

The Complainant submits that it has no control over the nature and quality of any goods or services marketed or provided via the disputed domain name or any other activities that the Respondent may engage in with respect to the domain name. The Complainant submits that in the circumstances the Respondent's activity has no doubt deceived, and will certainly continue to deceive, Internet users; that the Respondent's activity has diluted and diminished the valuable goodwill associated with Complainant's REDTUBE mark; and any illegal activity occurring at website to which the disputed domain name resolves may tarnish the REDTUBE mark.

The Complainant finally submits that the Respondent's bad faith registration and use of the disputed domain name is demonstrated by each of the following: (a) the Respondent's registration and use of the disputed domain name to redirect and divert Internet users to third-party web sites in exchange for advertising revenues; (b) the Respondent's registration and use of the disputed domain name after having actual and constructive notice of Complainant's rights in the REDTUBE mark; and (c) the Respondent's lack of any rights or legitimate interests in the disputed domain name. The Respondent did not reply to the Complainant’s contentions.
The Complainant has furnished sufficient evidence of its rights in the REDTUBE trademark and service mark both through the above-mentioned trademark registrations and at common law through extensive use of the mark in the provision of adult website content since at least 2007. This Panel accepts the Complainant’s arguments that the disputed domain name <redtubeporn.com> is confusingly similar to the trademark REDTUBE in which the Complainant has rights. The disputed domain name is composed of four elements viz. the words “red”, “tube”, and “porn” and the gTLD “.org” extension. The Complainant’s trademark is distinctive and is composed of the words “red” and “tube” in combination. It is well established under the Policy that the gTLD “.org” extension may be disregarded for the purpose of the comparison under this element of the Policy.

The Panel finds that the additional word “porn” does not distinguish the domain name from the Complainant’s mark. Taken in combination the words “red” and “tube” constitute a distinctive trademark and are the dominant element of the disputed domain name because the word “porn” is generic and descriptive. In the present context the element “porn” is not only descriptive of the content on the Respondent’s website, to which the disputed domain name resolves, but is also descriptive of the business in which the Complainant has acquired a significant goodwill.

This Panel finds therefore that the disputed domain name is confusingly similar to the Complainant’s trademark and the Complainant has therefore succeeded in the first element, paragraph 4(a)(i) of the Policy.

The Panel finds that the Complainant has made out a prima facie case the Respondent has no rights or legitimate interest in the disputed domain name. The Complainant has provided evidence that it is the owner of the REDTUBE mark and has acquired a substantial reputation, around the world, in the trademark through its website to which its <redtube.com> domain name resolves. The Complainant’s website has received billions of visitors and is ranked among the
most popular websites in the world. The Complainant has asserted that it has not
granted any rights or licence to the Respondent to use its trademark or any mark
or domain name similar to its trademark. Furthermore on the evidence available
the Respondent is not known by the disputed domain name <redtubeporn.org> or
any similar name. The Respondent is making a commercial use of the disputed
domain name, but not a legitimate non-commercial use as it is taking advantage of
the Complainant’s trademark and reputation and such use cannot be considered
fair or legitimate.

It is well established that when a complainant makes out a *prima facie* case
that a respondent has no rights or legitimate interest in the domain name the
burden of production shifts to the respondent. In the present case as there has been
no Response filed and no other communications from the Respondent. Therefore
the Panel finds that the Respondent has failed to discharge the burden and the
Complainant is entitled to succeed in the second element, paragraph 4(a)(ii) of the
Policy.

On the evidence before this Panel the Complainant has acquired a
substantial reputation in the REDTUBE mark in the provision of adult content
materials over the Internet. This Panel accepts the Complainant’s argument that it
is unlikely that the Respondent was not aware of the REDTUBE mark and the
Complainant’s associated reputation when the disputed domain name was
registered. In fact, the adoption of the combination of the Complainant’s
REDTUBE trademark and the word “porn” as a domain name indicates that not
only was the Respondent aware of the Complainant’s reputation, but that the
disputed domain name was chosen because of its similarity with the
Complainant’s trademark, website address and domain name. This Panel finds that
on the balance of probabilities the disputed domain name was chosen and
registered in bad faith order to take predatory advantage of the Complainant’s
reputation.
Furthermore on the evidence before this Panel, it appears that by maintaining the website to which the disputed domain name resolves the Respondent is using the disputed domain name in bad faith in an intentional attempt to attract, for commercial gain, Internet users to the Respondent’s web site by creating a likelihood of confusion with the Complainant's REDTUBE mark as to the source, sponsorship, affiliation, or endorsement of the web site or of a product or service on that web site. In the circumstances, this Panel finds that the disputed domain name was registered and is being used in bad faith and having succeeded therefore in the third and final element in paragraph 4 of the Policy, the Complainant is entitled to succeed in this Complainant.

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <redtubeporn.org> be transferred to the Complainant.

Cash Converters Pty Ltd. v. Rui Zhang Case No. D2013-0724

The Complainant is an Australian company that operates pawn broking outlets. It owns six Australian trademarks, two United Kingdom trademarks and five United States of America (US) trademarks containing the terms “cash converters” in capital letters, either in a specific font or plain block letters, alone or in combination with graphic elements. The various marks designate products and services in international classes 9, 35, 36, 38, 39 and 42. The earliest trademark was filed on May 16, 1989 in Australia, and the marks have all apparently been duly renewed and are currently in effect according to the printouts from the databases of the corresponding trademark offices that were submitted by the Complainant.

The Complainant’s marks include the following:

- UK registration No. 1 463 232 cash converters of May 2, 1991;
- Australian registration No. 610 704 cash converters ca$h converters of August 31, 1993;
- Us registration No. 1 991 782 cash converters of June 20, 1994;
Australian registration No. 806 655 cash converters of September 10, 1999.

All of the trademarks were filed before the disputed domain name <wwwcashconverters.com> was registered on October 7, 2010. The Complainant also claims trade name rights in the terms “cash converters” and owns various domain names with the terms “cash converters”. The evidence shows that the website that appears at “www.wwwcashconverters.com” contains links to websites offering loans, fast cash, emergency cash, cash for diamonds, loan deals, quick cash and small loans.

The Complainant asserts that the registered CASH CONVERTERS trademarks are distinctive since the words “cash converters” do not constitute a common phrase, have no dictionary meaning, and the marks have acquired secondary meaning as a combination of terms referring to the Complainant and its business in Australia. The Respondent has no relationship with the Complainant and has no permission from the Complainant to use any of Complainant’s trademarks, nor is it commonly known by the disputed domain name.

The Complainant asserts that the Respondent’s registration and use of the disputed domain name violates the Complainant’s rights in the registered CASH CONVERTERS trademarks, and that the disputed domain name is used by the Respondent solely to attract Internet users by creating a likelihood of confusion. In this context, the Complainant argues that <wwwcashconverters.com> is identical or confusingly similar to the CASH CONVERTERS trademarks, and that the only difference between the Complainant’s trademarks and the disputed domain name is the use of the letters “www”. The Complainant offers further detailed analysis in support of its case and points to previous UDRP decisions that have ordered the transfer of other domain names filed by the Respondent (four cases) or ordered the transfer of domain names with the terms “cash converters” from other respondents to the Complainant (four cases out of ten brought by the Complainant). The Respondent did not reply to the Complainant’s contentions.
The disputed domain name incorporates the words “cash converters” of the CASH CONVERTERS trademarks. The verbal element alone of the CASH CONVERTERS trademarks is composed of two words that together are strongly evocative of and may even seem descriptive for financial services such as pawn broker services. However, the terms “cash converters” are not a common expression or a combination of words in accordance with ordinary rules of grammar that together describe a pawn broker, nor is there any evidence before the Panel (i) that this combination of words had become a descriptive phrase in common or professional parlance in any of the three countries where the Complainant filed its marks before those marks were filed, or (ii) that this combination has become a generic phrase for pawn brokers since then.

The Complainant indicates that previous UDRP panels have also found that the marks are or have become sufficiently distinctive to be protected. The Panel finds that the trademarks are distinctive or have become distinctive for the products and services covered by the marks for the purposes of the present dispute.

The disputed domain name <wwwcashconverters.com> only differs from the CASH CONVERTERS trademarks in details that do not diminish the risk of confusion resulting from the similarity to the trademarks in which the Complainant has rights. Specifically, and in line with the UDRP cases cited by Complainant, the mere addition of the letters “www” to the terms “cash converters” is not sufficient to dispel the confusing similarity between the CASH CONVERTERS marks and the disputed domain name. When viewed in light of Respondent’s prior UDRP cases as respondent, it appears that the use of the letters “www” may in fact have been intended to achieve this result. The Panel is satisfied that the disputed domain name is confusingly similar to the Complainant’s CASH CONVERTERS trademarks for the purposes of the Policy.

The Respondent has chosen not to reply to the Complaint and the Panel has found that the Complainant has made a prima facie case that the Respondent
lacks rights or legitimate interests and has found no indication in the evidence that the Respondent claims or could have claimed rights or legitimate interests of its own in the terms “Cash Converters”. To the contrary, the Respondent’s track record as respondent in previous UDRP cases indicates that it has repeatedly filed third party marks as domain names with typographical errors or in combination with non distinctive terms. Since the Respondent has no permission from the owner of the CASH CONVERTERS marks, its use of the disputed domain name is without rights or legitimate interests. The Panel considers that in the present case the Respondent does not have any rights or legitimate interests in the disputed domain name.

The Respondent’s use of a webpage with links to various pawn brokerage and loan operators for small loans for individual borrowers, which are services competing with those of the Complainant, indicate that the Respondent registered and is using the disputed domain name in bad faith.

In view of the above, the Panel also finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s marks as per paragraph 4(b) (iv) of the Policy. For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <wwwcashconverters.com> be transferred to the Complainant.

Segis SPA v. Kwon Tong Wan  Case No. D2013-0725

The Complainant is an Italian company and a worldwide leader in the design and production of innovative, quality seating products for the contract furniture industry. It owns a large number of registered trademarks that include the term “Segis” alone, and that incorporate the term “Segis” with other elements. The Complainant also owns the following trademark and domain name registrations:
<table>
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<th>Country:</th>
<th>Reg. No.:</th>
<th>Reg. Date:</th>
<th>Int'l Class:</th>
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<td>SEGIS</td>
<td>Italy</td>
<td>801251</td>
<td>March 21, 1997</td>
<td>20</td>
</tr>
<tr>
<td>SEGIS DELIGHT MULTIPLA</td>
<td>International</td>
<td>861669</td>
<td>July 1, 2005</td>
<td>20</td>
</tr>
<tr>
<td>SEGIS DELIGHT MULTIPLA</td>
<td>China</td>
<td>G929310</td>
<td>May 15, 2007</td>
<td>20</td>
</tr>
<tr>
<td>SEGIS DELIGHT MULTIPLA</td>
<td>United States of America</td>
<td>3,395,175</td>
<td>March 11, 2008</td>
<td>20</td>
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<tr>
<td>SEGIS DELIGHT MULTIPLA</td>
<td>European Community</td>
<td>005573365</td>
<td>August 29, 2008</td>
<td>20</td>
</tr>
</tbody>
</table>

Domain Name:

- <segis-usa.com>
- <segis-eu>
- <segis.it>
- <segis.fr>
- <segis.nl>
- <segis.cn>
- <segis.vn>

The Respondent is a college graduate in Republic of Korea.
The disputed domain name was created on August 23, 2005.

The Complainant contends that it owns rights in the SEGIS mark and that the disputed domain name is identical to its mark. The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. In particular, the Complainant contends that (i) it has not consented to the use of the SEGIS mark; (ii) it has not authorized the use of the SEGIS mark in a domain name; and (iii) there is no connection between it and the Respondent. The Complainant further contends that the Respondent has not made any use of, or demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services; is not commonly known by the disputed
domain name; and is not making legitimate non-commercial or fair use of the disputed domain name.

Finally, the Complainant contends that the Respondent has registered and uses the disputed domain name in bad faith on the grounds that he was presumably aware of the registration of the Complainant’s SEGIS trademark for various reasons. First, because the Complainant’s trademark registration in Italy preceded the initial registration date of the disputed domain name. Second, the Complainant’s International registration covering the Republic of Korea preceded the renewal registration dates of the disputed domain name. Finally, the Complainant contends that the Respondent presumably conducted research in order to come up with the name “segis” because that term is not a common word nor does it have a common meaning. The Complainant also contends that the Respondent registered and uses the disputed domain name in bad faith on the grounds that the Respondent has not used the disputed domain name to resolve to an active website. For these reasons, the Complainant requests that the disputed domain name be transferred.

The Respondent claims that the disputed domain name was coined by himself and his friends who were planning to operate a website. Specifically, the Respondent claims that the disputed domain name is an acronym for “Se Eun Geographic Information System.” According to the Respondent, the name “Se Eun” is his girlfriend’s first name.

The Panel has noted communications from the Complainant and the Respondent regarding the language of the proceedings. According to the Rules,
the language of the registration agreement should be the language of the proceedings, unless there is an agreement between the parties for a different language to be the language of the proceedings or if the panel determines otherwise in accordance with paragraph 11 of the Rules. In such a case a complainant should typically provide satisfactory evidence of an agreement between the complainant and the respondent to the effect that the proceedings should be in the language other than that of the registration agreement, translate the Complaint into the language of the registration agreement, or submit a request for the proceedings to be in a language other than that of the registration agreement with further evidence as to the reasons for this. The panel has discretion to decide on the language of the proceedings.

In this case, the Panel finds that English should be the language of the proceedings for the following reasons:

- The disputed domain name consists exclusively of a word written in English.
- The Respondent has sufficient knowledge of English to be able to understand the nature of these proceedings. This is evident from (1) the exchange of correspondence in English between the Complainant and the Respondent regarding the possible transfer of the disputed domain name; and (2) the fact that the website under the disputed domain name is in English.
- The Complainant would incur considerable further expense and inconvenience in retaining the services of a translator.

The Panel finds that in the circumstances of this case this amounts to sufficient evidence of the Respondent having command of English necessary to be able to understand the nature of these proceedings. Consequently, the Panel finds that it is appropriate to issue the Decision in English. In the present case, the Panel finds that the Complainant has established that the Complainant owns rights in the SEGIS mark.
First, the SEGIS mark was used by the Complainant since at least March 21, 1997, the date on which the said trademark was registered in Italy and the goods claimed by said registration are directly related to its core business.

Second, the Complainant owns various other registrations for the SEGIS mark in multiple jurisdictions throughout the world, including an international registration covering the Republic of Korea.

Finally, the sole word consisting of the disputed domain name “segis” is identical to the SEGIS mark owned by the Complainant.

Accordingly, the Panel finds the disputed domain name to be confusingly similar to the Complainant’s SEGIS mark, and therefore concludes that the Complainant has satisfied is burden of proof under paragraph 4(a)(i) of the Policy.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name.

According to paragraph 4(c) of the Policy, the following circumstances, if proved, demonstrate a respondent’s rights or legitimate interests in a domain name:

• The respondent used or demonstrably prepared to use the domain name or corresponding name in connection with a bona fide offering of goods or services prior to notice of the dispute; or

• The respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if it has not acquired trademark rights; or

• The respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the complainant’s marks.

A respondent may elect to show rights and legitimate interests, non-exhaustively, by producing proof under paragraphs 4(c) (i)-(iii) of the Policy. The Respondent did not make any direct claim of a right or legitimate interest in the disputed domain name.
First, the Respondent merely stated how he and his friends came to create the name “segis” in connection with a domain name that was planned to resolve to a website for their future business. However, the Respondent did not provide any evidence on the record that the “segis” name was created under such circumstances. He could have provided, for example, notarized statements from his friends and/or from his girlfriend attesting to the facts he claimed, and yet he did not. He could have explained the activities and undertakings that he and his friends had commenced in order to move forward with starting their prospective business, he could have explained the nature and purpose of the prospective business, he could have explained the significance of the name “Geographic Information System,” etc., and yet he did none of them. Given these circumstances, there can be no reasonable conclusion but to find that the Respondent was not planning to engage in a *bona fide* offering of goods/services under the disputed domain name, and was not otherwise planning to engage in legitimate business activities.

Second, as to paragraph 4(c) (ii) of the Policy, the Respondent in his Response to the Complaint does not assert that he is commonly known by the disputed domain name and there is no evidence in the record to indicate such.

Finally, as to paragraph 4(c) (iii) of the Policy, the Complainant has claimed that the disputed domain name does not resolve to an active website, and in fact, the only content in the website is the statement “This domain is renewed every year automatically.” The Respondent did not dispute this claim. Accordingly, this Panel is of the position that the Respondent is not engaged in the activity set forth in this paragraph 4(c) (iii) of the Policy.

For these reasons, the Panel finds that the Respondent is not found to have a right or legitimate interest in the disputed domain name, as this concept is understood to mean pursuant to paragraph 4(c) of the Policy.

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following conduct is sufficient to support a finding of bad faith:
• circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
• you have 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, provided that you have engaged in a pattern of such conduct; or
• you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
• by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

The Complainant raises a number of previous UDRP decisions to support its arguments that the Respondent registered the disputed domain name in bad faith and that it is being used in bad faith. In the first argument, the Complainant claims that the Respondent had a duty to check and to ensure that its domain name would not infringe upon another’s mark at the time it sought registration and at each time the registration is renewed. Although the Complainant does not affirmatively state that the Respondent failed to meet its duty to check, the Complainant appears to be taking the position that had such check(s) been conducted, the Respondent would have known about the Complainant and its SEGIS mark, and that the registration of the disputed domain name would infringe its mark. Some UDRP panels have indeed found that in certain circumstances there may be an affirmative obligation on registrants more generally to make reasonable good faith efforts to avoid registering and using a domain name that is identical or confusingly similar to a mark held by others, for example, through an
Internet search on the domain name through Google or Yahoo!. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0), paragraph 3.4. However, even if we assume arguendo, that the foregoing is the Complainant’s line of argument, the Panel is un-persuaded, largely because there is nothing in the record to support the claim that the Respondent failed to meet its duties/obligations in connection with the proper registration of the disputed domain name, let alone a failure that would rise to the level of bad faith. Further, it must be noted that the term “segis” is a term that is used by others in the public in connection with different subject matters. This is readily confirmed by a cursory check of the Internet. For example, the term “segis” has been found to be widely used as an acronym for “Solar Energy Grid Integration Systems,” in connection with a United States government sponsored solar energy project. Another example is the use of the term “segis” as a trademark for a smart grid inverter. As such, the logic used by the Complainant here, namely that had the Respondent conducted a check, it would have known about the Complainant, is not persuasive, since a check would likely have resulted in finding different uses of the name “segis” by different parties in connection with different subject matters. The Panel also notes that even when some UDRP panels found bad faith registration on the ground that the respondent should have known the complainant’s registered marks, they are less inclined to find it when the complainant’s trademark is less well-known or corresponded to a common word. In this case, the Complainant has not provided enough evidence of showing that its mark was so well-known that the Respondent must have known of the Complainant’s SEGIS mark.

Furthermore, the Complainant did not claim that the Respondent’s prospective business is somehow related to its business, and in fact, there is nothing in the record to suggest same. It is therefore not possible to make any reliable determination as to whether the Respondent must have known that the disputed domain name could be an infringement of the Complainant’s SEGIS mark.
In the Complainant’s second argument – that the Respondent’s passive holding of the disputed domain name can infer bad faith – the Panel notes that while this has been recognized by the panels in other UDRP decisions, such factor is but a single consideration among others, and that an ultimate finding of bad faith involved a finding of a number of cumulative, supporting circumstances. In this case, however, there is no evidence on the record that shows, for example, that the Respondent attempted to sell or to contact the Complainant as the trademark holder; that the Complainant’s SEGIS mark is well-known; that the Respondent failed to respond to the Complaint; or that the Respondent attempted to conceal his identity, all of which factors were outlined in the Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, as cited by the Complainant in its Complaint.

Further, the record does not support a finding of any circumstances under paragraph 4(b) of the Policy that evidence registration and use of the disputed domain name in bad faith. Specifically, there is no evidence of the existence of any of the four circumstances under 4(b)(i)-(iv) of the Policy, as summarized above.

In conclusion, the Panel finds that the Complainant has not established that the disputed domain name “has been registered and is being used in bad faith” by the Respondent. For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Complaint is denied.

**Summation**

A perusal of above discussion leads us to the conclusion that the technological changes bring challenges to the basic principles of Intellectual property laws and internet and the digital revolution poses complex problems for their protection. There are various steps already a boot to tackle the domain name dispute, especially cybersquatting on International level. As far as India is concerned, there is no legislation which explicitly refers to the domain name disputes; the law is yet to be developed unlike the USA. It is only governed by the
Trade Mark Act 1999, which does not have any express law on the point of
domain name disputes. However, the Information Technology (Amendment) Act
2008 provides punishment for cheating and personating by means of any
communications device or computer. There is still an urgent need for definite laws
in this field.
Notes & References


2. The first ccTLD dispute resolution policy was introduced by Nominet (the ccTLD registry for the UK) in April 1997. See also E Taylor, Keeping Your Good Name, Business Net- works (Aug./Sept. 2001), 38


10. The variation on the UDRP for the liclgiuin ccTLD includes this element, which surely invites abuse in the same way as NSI’s policies did

11. Sec UDRP Rule 4(a)(ii),(iii)

12. Sec UDRP Rule 4(a)(i)


14. Id.

15. Id.

16. Ibid. P. 25


20. This is because there is never a suit for damages against a domain name owner. Only for specific performance involving transfer of a domain name, i.e., no financial liability-Carl Oppedahl, “Analysis and suggestions regarding NSI Domain Name trademark Dispute Policy” at http://www.patents.com/nsi/iip/shr. (viewed on 20.03.2013)

21. Domain names that have been put on hold include <dc.com>, <Newton.com> and <the gap.com>.


23. Supra note 18 at p. 243.


26. Suptra Note 18. p. 243


28. For complete plan visit http://www.gtld-mou.org. (viewed on 28.03.2013)

29. See, Oppedahl, supra note 25. This article lists several economic reasons as to why the IAHC proposal is unworkable.

30. The plan is available at http://www.netsol.com/papers/Internet.html. (viewed on 22/03/2013)

31. Supra note 18, at p 244.
33. “Domain Name Dispute and Cyber Squatting” by Ranjan K. Mishra, 20th July 2010. (viewed on 28.03.2013)
35. Supra Note 32.
38. Id.
39. Id.
40. Id.
41. Id.
43. See, http://www.icann.org (viewed on 18/04/2013)
44. Supra Note. 17 p. 100
45. Ibid P. 100-101
47. Id, Also see (www.nixi.in, www.ispai.com)
48. 2006 (33) PTC 597 (NIXI) IN Registry, National Exchange of India (NIXI)
49. Supra note 17 pp. 101
50. 2006 (33) PTC 631 (Del)]
52. 2007 (35) PTC 177 (Del)
53. 2011 (45) PTC 96 (Del)
54. 2010 (42) PTC 361.
55. http://www.icann.org/udrp/cedrp-policy.html. (viewed on 03.03.2013)
57. Id.
61. http://www.icann.org/eu/udrp-policy.html. (viewed on 03.03.2013)
63. http://websvr01.afilias.info/register/dispute_resolution/sunrise_challenge-policy. (viewed on 03.03.2013)
64. http://www.arbiter.wipo.int/domains/gtld/biz/stop/index.html. (viewed on 03.03.2013)
65. http://www.arbitr.wipo.int/domains/gtld/name/index.html. (viewed on 03.03.2013)
66. http://www.icann.org/tlds/agreements/sponsored/sponsorship-agmt-arr12-08sep01.html. (viewed on 03.03.2013)
68. FSR 265, 1988, (1977)
71. 42 USPQ 2d 1850.
73. 985 F. Supp. 949 (C.D. Cal 1997), aff’d 194 F. 3d 980 (9th Cir. 1999).
74. 141 F. 3d 1316 (9th Cir. 1998).
75. 947 F. Supp. 1227, 1240 (N.D. III, 1996)
77. Ibid at Page 416.

78. Cyberspace is a domain characterized by the use of electronics and the electromagnetic spectrum to store, modify, and exchange data via networked systems and associated physical infrastructures. In eITect, cyberspace can be thought of as the interconnection of human beings through computers and telecommunication, without regard to physical geography. William Gibson is sometimes credited with inventing or popularizing the term by using it in his novel of 1984, Neuromancer. See [http://www.searchfsoa.com](http://www.searchfsoa.com).


80. 202 F. 3d 489 (2d Cir. 2000)


82. 113 F Supp. 2d 915 (E.D. Va. 2000)

83. 115 F. Supp. 2d 1108 (D Minn. 2000)

84. 55 U.S.P.Q. 2d (BNA) 1620 (S.D.N.Y. 2000)


86. Ibid at pp-247.


88. See http://www.icann.org/udsp/udrp-policy, (viewed on 05/04/2013.)

89. Supra not 87

90. Ibid.


92. Id

93. Id

94. Domain Name Protection In India, By praveen Dalal (Also see www.navi.org)

95. Id
96. Domain Name Dispute Resolution in India, By-Majumdar and Company. (Also see. www.majumdarindia.com) (viewed on 05.03.2013)

97. Id

98. 1990 Suppl SCC 727

99. Supra note 94.

100. Section 27.

101. Sections 2 (1) (m) and 2 (1) (z) respectively.

102. Section 2 (2) (b).

103. N.R. Dongre v. Whirlpool Corporation 1996 (PTC) (16) 583 (SC)


105. Section 31.


107. Section 154 and 155.

108. MIPR 2010 (3) 0067

109. Section 9 stipulates that the trade marks which are devoid of any distinctive character or which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, intended purpose, values, geographical origin or the time of production of goods or rendering of the services or other characteristics of the goods or service or which consists exclusively of marks or indications which have become customary in the current language or in the bonafide and established practice of the trade shall not be registered, unless it is shown that the mark has in fact acquired a distinctive character as a result of use before the date of application. It also provides that a mark shall not to be registered as trademarks if (i) it deceives the public or causes confusion, (ii) it contains or comprises of an\ matter likely to hurt the religious susceptibilities, (iii) it contains scandalous or obscene matter, (iv) its use is prohibited. It further provides that if a mark consists exclusively of (a) the shape of goods which from the nature of goods themselves or (b) the shape of goods which is necessary to obtain a technical result, or (c) the shape
which gives substantial value of the goods then it shall not be registered as trade mark.

110. Section 31(2) stipulates that a registered mark shall not be held as invalid on the ground that it was not a registerable trade mark under Section 9 except upon the evidence of distinctiveness and that such evidence was not submitted to the registrar before registration, if it is proved that the trade mark had not been so used by the registered proprietor or his predecessor in title as to have become distinctive at the date of registration.

111. 1999 PTC (19) 201
112. AIR 1970 SC 1649.
113. AIR 2000 Bom 27
114. 2001 PTC 859.
115. 2001 PTC 432 (Del.)
116. 2001 PTC 619 (Del.)
117. 2006 (32) PTC 537.
118. High Court of Delhi, CS (OS) 1289/2008.
120. Supra Note 76, at p. 419.
125. WIPO Case NO. D2000-0497
126. WIPO Case No. D2000-0248
127. WIPO Case No. D2000-0053
128. WIPO Case No. D2002-0007
129. WIPO Case No. D2002-0881.
132. RDNH, defined in the UDRP rules as "using the policy in bad faith to attempt to deprive a registered domain name holder of a domain name".
133. WIPO Case NO. D2000-0477.
134. WIPO Case No. D2000-0479.
142. Ibid page 103
143. Id
144. Ibid page 104
145. Salim Akhtar & Shweta Jain Protection of Domain Names in India and Abroad, Printed at : Aligarh Muslim University Press, page-86.
148. Civil Action Number 97-1190, Id.
149. Supra Note 137
150. Id.
151. Supra not 141 page 108
152. Id.
154. Supra Note 137.
156. Ibid.
157. Ibid.
159. www.wipo.int/amc/en/domains/statistics/domains.jsp (viewed on 06.06.2013)
160. www.wipo.int/amc/en/domains/statistics/domains.jsp (viewed on 06.06.2013)
161. www.wipo.int/amc/en/domains/statistics/domains_avrg.jsp (viewed on 06.06.2013)
162. www.wipo.int/amc/en/domains/statistics/countries_a-zjsp (viewed on 06.06.2013)
163. www.wipo.int/amc/en/domains/statistics/legalindex.jsp (viewed on 06.06.2013)
165. WIPO Case No. D99-0001.
166. WIPO Case No. D2000-1713.
168. WIPO Case No. D2000-0009
169. WIPO Case No. D2000-0364.
170. WIPO Case No. D2000-0835.
171. WIPO Case No. D2009-0405.
172. WIPO Case No. D2000-0548.
Paragraph 15 (a) of the Rules provides that the Panel shall decide a complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the Panel deems applicable.