EVOLUTION OF PROBLEM

With India signing TRIPS (Trade Related Aspects of Intellectual Property Rights) and becoming member of WTO (World Trade Organization), Intellectual Property Rights as a subject has grown enormously in recent past in India. Intellectual Property is a creation of human intellect and forms an integral part of our life. Starting from an alarm clock that annoys us in the morning to an interesting novel that makes us dream at night, we are surrounded by the fruits of human creativity and inventions. In simple terms Intellectual Property is a product of human intellect, skill and labour.

Rights given to people over the creation of their mind are known as IPR. They usually give the creator an exclusive right over the use of his/her creation for a certain period of time. Intellectual Property Rights serve to protect inventions, business names, creativity and inventiveness. Being imperative tools for the economic and industrial development of the nation, the laws protecting them have assumed great importance in the era of globalization and privatization.

Globalization and commercialization of Intellectual Property activities have created multiple challenges. The process of globalization has not only paved way for evolution of international norms but also changed the face of the law protecting intellectual property. The trend of progressive harmonization of IP laws will lead to greater simplification and expediency in acquisition and protection of intellectual property. TRIPs has brought certain fundamental changes in the world of intellectual property.

Infringement in case of Intellectual Property is frequently connected to more than one State, either because the infringer or the right holder is located abroad or because the infringement has been committed in a different State. In these situations, to file a complaint, it is essential to determine which courts have jurisdiction over the case. The rules that determine court’s authority to deal with the case are known as jurisdictional rules. Jurisdictional rules are never decisive on the merits of the case. However, such rules provide for where to look for the decisions. Jurisdictional rules provide for the nexus between the State, activity and the person involved in any litigation.
STATEMENT OF PROBLEM

The ever escalating importance of trademark in international and domestic commerce is remarkable. Most obvious are the impact of electronic commerce and the growth of internet as a selling medium, a forum that transcends national boundaries and bears no physical location on ‘Main Street’.\(^1\) It is an axiomatic principle of Law that Trade Marks and the rules governing trademark cannot be detached from territoriality. However, commercialization and infringement of Intellectual Property in true sense have become multi-territorial.

The impact of jurisdictional problems is not limited to a particular branch of Law. It affects the very foundation of the framework of substantive and procedural laws. Consequently the jurisdictional challenges in today’s age of fast communication, have invited various viewpoints for their resolution including significant changes in the existing legal framework. Internet being one of the most significant changes in the field of information technology requires more than mere adjustment in the law governing it. One cannot overlook the requirement of appropriate changes in the law. Failure to do so would lead to new complex legal issues. Complex legal issues like jurisdictional issues that call for appropriate solutions require right approach of academicians, judiciary and legislators for suggesting the potential range of solutions. The solutions should not prove to be counterproductive opening path for further conflicts and confusions. To arrive at such a conclusion one has to go beyond the formal legal reasoning that requires inductive and deductive reasoning by relying on precedents, legal principles and statutes. This may not be appropriate to keep pace with technological changes that are taking place rapidly.

HYPOTHESIS

With the onset of globalization and rising multiplicity of stakeholders in the International Commercial field, the jurisdictional issues in trademark is reaching beyond municipal law and is becoming more complex and a specific guidelines on jurisdiction operable within municipal laws and beyond is the need of the hour.

RESEARCH FOCUS AND AIM

This research will focus on the discussion of Jurisdictional issues in the post TRIPs IP regime in India with particular reference to Trade Mark. In addition to looking into the legal nature of Intellectual Property Rights with particular reference to Trademark under the Indian regulatory system, particular but not exclusive focus will be on the interface between the Intellectual Property Rights and the challenges of the digital world. Major references will be made to the national and international legal considerations that this topic may raise.

The proposed study aims, based on a comprehensive examination of the jurisdictional issues, legal background and present regulatory systems in India, at studying the need, feasibility and appropriation of incorporating international IP standards regarding jurisdiction in cases of violation of Trade Marks. The researcher aims to introduce the core jurisdictional issues explored in more specific context and the type of concerns the judiciary and the legislators try to take into account to resolve them.

OBJECTIVES

The objectives of the study are to:

- Analyze the conceptual understanding of jurisdiction and the impact of technological development on conventional understanding of the concept.
- Examine the trends of harmonization of national law protecting Trade Marks.
- Examine the issues of private international law in multi-territorial trademark disputes.
- Compile and understand the private ordering regime in resolving the intellectual property disputes.
- Evaluate the impact of ubiquitous infringement on the issue of jurisdiction as prescribed in domestic and international law.
- Undertake the comparative analysis of legal framework and judicial trends in Japan, UK, US and India in case of trademark disputes.
Introduction

- Propose a possible solution in case of jurisdictional issues in trademark disputes arising in physical as well as virtual world.

RESEARCH QUESTIONS

The main purpose of this study is to attempt to find a solution to the problems of trademark violations in the post-TRIPs era in India, focusing on the rules of jurisdiction. Following are the main research questions:

1. How to resolve the question regarding jurisdiction in cross-border trademark issues from a perspective of traditional private international law?
2. What is the role played by the emerging judicial trends in settling jurisdictional issues both at national and international levels?
3. Is it necessary to tailor international principles of jurisdiction, choice of law and enforcement of judgments making it suitable dealing with the Intellectual Property disputes, more particularly trademark violations?

RESEARCH METHODOLOGY

The entire research is purely doctrinal. It is descriptive and analytical by nature. The research is based on primary and secondary sources. Relevant material from primary sources is collected from statutory provisions of the relevant legislation and court decisions. In case of secondary sources, material is collected from scholarly commentaries, articles, research reports, policy papers, government documents etc.

The first stage of this research involved critical and theoretical examination of the literature that has emerged over a period of time years on the issues of jurisdiction in Intellectual Property Rights violations. Much of this literature is collected from a combination of primary as well as secondary sources. This stage of research is focused predominantly on secondary legal sources. The critical examination of this literature was undertaken in the second stage of research which was followed by the third and final stage of writing of this thesis.
LITERATURE REVIEW

The complexities of the issues on the jurisdiction are made out by the multifarious topics in which the available literature discussed below deal with. A few significant literatures reviewed concerning the Law of Trade Marks, Civil Procedure, Elements of Private International Law and International aspects of protection and enforcement of Trade Marks are mentioned below. Others are reflected in the Bibliography.

BOOKS


‘Conflict of Laws’ is gaining importance in India as there is increasing international trade, more cross border investments and with increasingly more Indians living and settling outside India. With this backdrop the book covers the subject extensively. It considers international conventions regarding private international law, the law in England, the law in some other common law countries and in India. The fundamental issues of private international law like jurisdiction, choice of law and enforcement of judgments are discussed clearly.


Commentary on the Code of Civil Procedure under this title is in 6 enlarged volumes. All the provisions under the Code of Civil Procedure are dealt with in a most comprehensive manner. The recent Amendment of 1999 and 2002 are elaborately discussed. This book highlights all essential aspects of jurisdiction and the same are discussed exhaustively with case laws.

David Lindsay, *International Domain Name Law, ICANN and the UDRP* (Hart Publishing 2007)

This book addresses the essential aspects of internet and domain name system with specific reference to ICANN and UDRP. The main areas of discussion are divided into 3 categories. Firstly it explains the historical account of the development of domain names and the domain name system (DNS). Secondly it highlights the history of the institutional
arrangements for making decisions regarding domain names and the DNS. Thirdly it deals with the *sui generis* international system for resolving disputes between Trade Marks owners and domain names holders, known as the Uniform Domain Names Dispute Resolution Policy (UDRP). Further the decisions made under the UDRP are also highlighted with the well explained UDRP procedural rules. Elaborate discussion is also found on origins of internet, ICANN, its structure and process.


This book is a compilation of essays by distinguished scholars. It deals with the global territoriality challenges being faced by the countries regarding trademark protection. This book with specific focus on trademark as a form of Intellectual Property Rights explores how the rise of international trade and globalization has changed the way trademark law functions. A well explained history of Trade Marks and territoriality makes the work a comprehensive piece of reference regarding current issues of protection and enforcement of Trade Marks globally. The challenges created by the apparent dichotomy between trade without borders and trademark laws with borders are the subject matter of this work.


This book analyses the private international law of Intellectual Property Rights. The discussions and deliberations on the subject are classified in three parts: a. jurisdiction, b. applicable law and c. recognition and enforcement of foreign judgements. In part one various aspects regarding creation and validity of Intellectual Property, entitlement and ownership, contracts in relation to the exploitation of IP, infringement, traditional rules of jurisdiction and jurisdiction under the European Community/ European Free Trade Association Rules, jurisdiction over internet infringement and reforms of jurisdiction are extensively discussed. Choice of law elements in international conventions, in creation and termination of Intellectual Property, infringement, and choice of law and the internet are elucidated upon by combining reforms on choice of law as well. The discussions in the first
Introduction

two parts are logically referred in part three on recognition and enforcement of foreign judgements.

This book elaborately discusses the entire gamut of Intellectual Property issues in the context of developing countries, particularly India. It explores the background and context of the negotiations on the Trade Related Intellectual Property Rights and post-TRIPS issues to the way forward for the developing countries in adapting legislation in the area.

The authors have endeavoured to deal with all the provisions of the Trade Marks Act, 1999 in as much details as possible, giving the relevant case laws in India. All the significant changes that new Act brought about like protection to service marks collective marks and establishment of Intellectual Property Board have been elaborately discussed. This book also covers all the new aspects of international registration of Trade Marks under the Madrid Protocol. Fundamental principles of law of Trade Marks in India are explained with clarity with reference to international conventions and case laws.

Massimo Sterpi, Jacobacci Sterpi and others (eds), *Trade Mark Litigation* (2nd edition, European Law reference Series, Sweet & Maxwell 2013)
This book is an excellent compilation of law of Trademark in various thirty countries. A uniform structure in question-answer format is followed for providing information about sources of law, courts and administrative system, substantive law, parties to litigation, enforcement options, procedure in civil courts, preliminary remedies, final remedies, appeal procedure, litigation cost and forth coming legislation regarding trademark protection and enforcement mechanism in a given country. This book provides for legislation as well as precedents concerning all these aspects and latest developments.

International protection of marks and signs has become mandatory in the process of globalization. This book provides for a panoramic view of the legal situation in different countries and possibility of making a quick comparison of the various applicable laws. This book is divided into three sections: Law, marketing and appraisal. It deals with types of Trade Marks and signs, requirements of protection, statutory regulations, scope of protection, claims in case of infringement, infringement proceedings etc. Uniform structure is identified to provide information of fourteen countries. Material aspects of creation, protection and enforcement of Trade Marks in various countries are discussed elaborately. Such information provides the legal basis for a meaningful international trademark strategy in the states concerned.


This book is a collection of essays on the questions of jurisdiction. The focal point of this book is a question as to what might be understood in jurisprudence by way of a return to questions of jurisdiction. The approaches taken to jurisdiction in this book have not generally been limited to attempt either in justifying accounts of jurisdiction or in reconciling the exercise of jurisdiction with State policy or party interests. The essays consider afresh the ways in which philosophies of law and jurisprudence respond to the question of jurisdiction. There are three contributions in this book that considered jurisdiction as exercise of a technology of law. State, sovereignty and territoriality from the point of view of the jurisdiction have also been elucidated upon.

**ARTICLES:**


This article highlights the role of judiciary in effective enforcement of IPRs. Starting with the constitutional mechanism and Indian Legal system the writer traces the evolution of IP laws in India in order to prove that recognition of IPRs is not a new phenomenon. Courts
power under the existing legal framework as well as under TRIPs also forms the subject matter of this Article. The article is concluded by stating that the Courts while considering the question of grant of reliefs where parameters are not laid down in the statutory provisions will be guided by the norms accepted by the international community and would be justified in seeking guidance from the treaties and conventions on the subject so long they are not inconsistent with the municipal laws.


This Article presents a comparison which was written for the first meeting of the International Law Association (ILA) newly established (2010) Committee on Intellectual Property and Private International Law which was hosted at the Faculty of Law of the University of Lisbon in March 16-17, 2012. The comparison at stake concerns the rules on infringement and exclusive subject-matter jurisdiction posed or rejected, in case of exclusive jurisdiction by four sets of academic principles. Notwithstanding the fact that the rules in question present several differences, those differences in the majority of cases could be overcome by further studies and work of the ILA Committee, as the following comparison explains.


In this article the writer highlights that the rapid growth of the Internet has caused a serious collision between the efficient functioning of Domain Name Systems and the claims of trademark owners. U.S. Courts have recognized that domain names can have trademark implications. Trade Marks are important because organizations responsible for allocation and registration of domain names must take Trade Marks and trademark law into account. The International Trademark Association (INTA) sets forth principles that should apply to the use of Trade Marks in the Domain Name System. The writer’s comment focuses on how to accommodate the interests and rights of trademark owners in the DNS and in the overall administration of the Internet. Under the present domain system there can only be
one acme.com, putting the "ACME" owner who got there first and registered acme.com in an advantageous position. The DNS as it is presently structured allows no accommodations for different owners of the same mark. Network Solutions, Inc. is the best known example of an attempt to resolve the conflicts addressed in the article. All of these collisions of trademark law and the DNS have resulted in litigation. The article also addresses legal issues in addition to the technical trademark questions in the international arena. The major differences in national treatment of Trade Marks are in the areas of dilution, geographical terms, famous marks, rights of publicity, religious and social issues.


This article highlights that the international intellectual property norms are now being developed by a wide range of institutions - some national, some international, and some that do not fit neatly into either category; by bodies designed to address intellectual property; by trade and other bodies; and by actors public, private, and indeterminate. It is further stated that this new wave of international norm creation not only augments a growing body of substantive norms but also raises difficult structural questions about the future development of the international Intellectual Property system.


This article essentially focuses on the principle of territoriality. It highlights as to how the principle of territoriality is undergoing a change in the global world detaching Trade Marks from nation-state boundaries. This article critiques the principle of territoriality in four ways. First, it is suggested that statements about trademark territoriality mask a variety of related propositions. In disaggregating the “principle of territoriality” into its component parts, it becomes apparent that different rules of trademark law possess a territorial character for different reasons. Second, it is argued that although the principle of trademark territoriality has nominally remained constant since the conclusion of the Paris Convention, recent developments at both the national and international level suggest that the principle
may have a different intensity today. Third, the article begins an investigation of the ways in which the principle of territoriality should be revisited in light of the globalization of markets and concomitant changes in modern marketing practices. Finally, the article briefly highlights the extent to which there is, or should be, an assimilation of the “territorial” and the “national.” Analysis of the choices facing trademark law might be better achieved by consciously separating nationality and territoriality. Recognition of the territoriality of goodwill is linked to the basic purposes of trademark law, while nationality-grounded doctrines are more likely driven by economic policy and by institutional issues such as the practical demands of current political structures. Recognizing this distinction would assist in highlighting where reform is likely to be evolutionary and where modification of political structures – whether judicial or administrative must first occur.


In this article a sketch of the contemporary international Intellectual Property system that accommodates and actively seeks to incorporate national judicial activity is prepared. This article is divided into three parts. Part one describes the classical architecture of the international Intellectual Property system and the basic conceptual and institutional pillars on which the system was built. The ways in which this system is changing and how the national courts are becoming more involved in the construction of international system is the subject matter of the second part. Part three makes suggestions regarding the mechanism that underline the Draft Hague Convention and how the Dryfuss-Ginsburg proposal might alter and enhance the emerging role of national courts in the development of the system of international IP law.


This article focuses on jurisdiction as a precondition for a court to adjudicate a controversy highlights the situation when a trademark registrant’s product has been counterfeited abroad and an action is to be initiated. In the first part jurisdiction as a major issue in such cases is discussed. Part two of the Article deals with the analysis courts employ in
exercising jurisdiction in cases involving foreign conduct in US. Part three illustrates as to how and why courts will only exercise jurisdiction when the entire infringement or at least part of it occurs in the US. In the last part the Act of State Doctrine which prohibits courts from exercising jurisdiction in certain trademark cases to avoid questioning a foreign nation’s acts performed within its own territory or under its own law is elaborately discussed.

This Article examines the new rules of trademark protection under TRIPS and compares them with existing Paris Convention rules as well as the rules of international agreements based on the Paris Convention. This article clearly states that the Paris Convention has stood the test of time. Its principles are now incorporated into TRIPS, defining the basic rules of protection of industrial property rights in international trade.

This article deals with jurisdiction of court to deal with Intellectual Property Rights disputes arising out of commercial transaction on internet. Within the fairly broad field of IPR the focus is on trademark as this area is witnessing major development at present. The article traces the difficult and different paths that common law courts traversed in trying to formulate a definitive test that would lend legal certainty in tackling the complex problem of courts exercising jurisdiction in disputes arising out of activities on the internet. The article further highlights the fact that the technology which is rapidly changing is at least two steps if not more, ahead of the law. The article very clearly states that a catch-up at present appears to be unachievable.

In this article, it is argued that the notion of territoriality as applied within classical framework of conflicts analysis is ambiguous. This ambiguity is not always troublesome
in the physical world. However, as acknowledged by the writer it leads to problematic situations in the cyberspace where transactions cross borders worldwide almost instantaneously. The writer has highlighted these to be strategic points at which legal theories are put to test. Territorial framework and the ambiguity of territoriality are the main issues of discussion in the article. The article is concluded with an argument that, in Intellectual Property, cross-border acts may best be localized for the purpose of resolving conflicts of laws, by considering consequences of judicial remedies.

Jurisdiction is also the locus for debates about community definition, sovereignty, and legitimacy. Moreover, the idea of legal jurisdiction both reflects and reinforces social conceptions of space, distance, and identity. Too often, contemporary frameworks for thinking about jurisdictional authority unreflectively accept the assumption that nation-states defined by fixed territorial borders are the only relevant jurisdictional entities, without examining how people actually experience allegiance to community or understand their relationship to geographical distance and territorial borders. In this backdrop the article exhaustively discusses the challenges that have arisen in the past few years concerning the extraterritorial assertion of legal norms or adjudicatory authority to activity that, in one way or another, creates effects across borders. The author has embraced the opportunity to interrogate the dominant assumptions underlying legal jurisdiction. Instead of focusing on doctrinal questions regarding how best to “solve” the specific jurisdictional dilemmas that have been raised to date, a step back is taken and a series of foundational questions are asked: What does it mean in social terms to assert jurisdiction? How are conceptions of jurisdiction related to the ways people experience physical space, territorial borders, distance, and community? Why should the nation-state be the only player on the field of legal jurisdiction? Are there other forms of community affiliations that the law might recognize? In the most elaborate and effective way these questions are answered with the final observation that whatever the answers to these imponderables, they will be reflected and constructed in the domain of legal jurisdiction.

The focus of this Article is the Trade Marks Act, 1999. The Article further highlights the important changes that are brought about by the new Act of 1999. It also clearly states as to how under the new Trade Marks Act, various new forms of Trade Marks are recognised. Further, scope of improvement in the existing legal framework is also pointed out as the Act still, does not recognise the marks of the new era as movements’ marks, smell marks, sound marks etc.


Jurisdictional sphere of cyberspace is the central point of this article. The article highlights as to how a single transaction may involves laws of at least three jurisdiction, viz., the laws of the state in which the user resides, the laws of the state where the server hosting the transaction is located and the laws of the state which apply to the person or business with whom the transaction takes place. The writer elaborately discussed the definition of internet, origin of such disputes, international jurisdiction over internet, infringement of Trade Marks and domain names on internet, exemplary decision of the courts in this regard.


The article focuses on how the face of trade mark law in US has undergone a major change in the recent past. This article is an attempt to make sense of the Supreme Court’s decision in KP Permanent Make-Up. It also examined whether the decision of the Supreme Court of US is consistent with the decisions of courts in other jurisdictions on the issue of the applicability of the fair use defence. Attempt is made in this article to examine whether the decision is consistent with the obligation of the United States under two major multilateral Trade Mark treaties: the Paris Convention for the Protection of Industrial Property (Paris Convention) and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) of the World Trade Organization (WTO). The article in great detail
discusses the Law of Trade Mark in US. It also compares the jurisdiction of courts in UK and European Court of Justice.

This article revolves around the Law to Amend Certain Parts of the Code of Civil Procedure and the Civil Provisional Remedies Act of Japan. It discusses how prior to the new law there was no law to regulate international jurisdiction. In absence of any specific legislation the judicial perspective which was followed is also the subject matter of discussion in the Article. The article concludes that the New Law has created several new grounds based on which foreign parties can be sued in Japan.

SCOPE AND LIMITATION OF RESEARCH

The central point of the research is the concept of jurisdiction. The research is confined to the issues relating to the civil jurisdiction and excludes criminal jurisdiction. The researcher undertakes to study only the jurisdictional issues that may arise in the trademark violations. Jurisdiction conceptually is a single issue. However, to deal with this there are only three referral points i.e. national laws, international instruments and the specific specialised statutes. In this context, this thesis deals with only these referral points. The research will further assess the effectiveness of the traditional norms of jurisdiction in the era of internet and examine the current state of legal framework concerning the protection of Intellectual Property Rights with particular reference to trade marks. The dispute settlement mechanism under the WTO cannot be invoked in these cases as the IP issues relating to trademarks are of distinct nature and are not covered under the general dispute settlement mechanism of the same.

The research is conservative as it largely relies on the past decisions, concepts, legal structure, traditions and practices to evaluate the present problem. This thesis attempts to study the questions/issues of jurisdiction in the area of trademark violations. The scope of the research is kept limited to an extent of trademark violations in
post TRIPS era in India. There are many issues which have already come to surface and there are many which will come to surface over a period of time. It is noteworthy that all these issues are touching the globalization of trade and commerce. The relation between the globalization and the principle of territoriality is full of complexity to understand. The researcher has put in maximum effort to overcome this limitation by referring to as much relevant literature as available on the subject matter.

**SIGNIFICANCE OF RESEARCH**

Many areas of Law are affected by qualitative and quantitative problems. The qualitative problems have an immediate bearing upon the law; they give rise to new problems and novel disputes that require relatively immediate adjustment and accommodation in the existing legal framework. This is inevitable by nature. On the other hand the quantitative problems have a more distant and diffuse impact upon the Law, in the sense they do not lead to a dispute which are in any way novel. Paradoxically, while their long term impact upon the Law is potentially more fundamental because they attack the very root of certain legal regimes, ostensibly no legal changes are required. In such cases the burden is on the judiciary to resolve the situation through appropriate interpretation of the existing legal principles. The issue of jurisdiction in the area of Intellectual Property are such a quantitative problem which has distant impacts. This study will not only contribute to the existing knowledge bank but also make certain suggestions for future framework to understand certain theoretical and doctrinal aspects of the problem. Since such a study will be conducted from Indian perspective considering national and international regulations including international conventions and treaties, it is hoped that the study will be able to provide a reference for adapting Indian system to the norms of International Jurisprudence in IPR cases. It is worthy to mention that the suggestion here is not to adopt the international policy for jurisdiction that will evolve through experience over a period of time but to adapt the Indian legal system as per the international norms that are necessary to be taken into consideration.
CONTRIBUTION MADE

The study will contribute to the knowledge bank available on jurisdictional issues in post-TRIPS IP regime, especially in Trade Mark disputes in India. The gap in the existing literature will be filled through this research as the researcher at the end has made certain suggestions on the compartmentalised format of the jurisdictional issues. It is hoped that the proposed suggestions and recommendations will help make out a scheme that will lead to a unified policy on the same in future.

DEFINITION OF KEY CONCEPTS

**INTELLECTUAL PROPERTY:** Intellectual property (IP) refers to creations of the mind, such as inventions; literary and artistic works; designs; and symbols, names and images used in commerce. WIPO has classified intellectual property into two groups, i.e. Industrial property consisting of patents, Trade Marks, designs, geographical indications etc. and Copyrights and related rights. For the researcher, IP is a product of human intellect, skill and labour.

**TRADEMARK:** “trade mark” 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 shape of goods, their packaging and combination of colours.

**JURISDICTION:** Jurisdiction, as per Black’s law dictionary is court’s power to decide a case or issue a decree can be termed as jurisdiction. As provided in the Halsbury’s Law of England by jurisdiction is meant the authority by which a court has to decide matters that are litigated before it or to or to take cognizance of matters presented to it in a formal way for its decision.

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3 Section 2 (zb), Trade Marks Act, 1999.
**RENVOI:** It’s a French term, ‘ren-voy’. The doctrine under which the court is resorting to foreign law adopts as well the foreign law’s conflict-of-laws principles; which may in turn refer the court back to the law of the forum.\(^6\)

**CHOICE OF LAW:** Designation of the jurisdiction whose law will govern the interpretation of the dispute.

**RIGHT:** The term ‘right’, in a civil society is defined to mean that a man is entitled to have or to do, or to receive from others, within the limits prescribed by law.\(^7\)

**CYBERSPACE:** The term cyberspace originated by author William Gibson in 1982 in his novel *Neuromancer.* The term cyberspace is currently used to describe the whole range of information resources available through computer networks which is known as internet.\(^8\)

**VIRTUAL WORLD:** A virtual world is a computer-based online community environment that is designed and shared by individuals so that they can interact in a custom-built, stimulated world.

**INTERNET:** "Internet" refers to the global information system that (i) is logically linked together by a globally unique address space based on the Internet Protocol (IP) or its subsequent extensions/follow-ons; (ii) is able to support communications using the Transmission Control Protocol/Internet Protocol (TCP/IP) suite or its subsequent extensions/follow-ons, and/or other IP-compatible protocols; and (iii) provides, uses or makes accessible, either publicly or privately, high level services layered on the communications and related infrastructure described herein."\(^9\)

**META TAG:** A ‘meta tag’ or ‘meta data’ is a keyword or phrase embedded in a website’s HTML(hypertext mark-up language) code as a means for Internet search engines to identify and categorize the contents of the website. Meta tags are not visible to normal users on the website itself (although they can be made visible together with the source code of the page), however, a search engine seeking particular keywords will find and list that particular site. Meta tags can be compared to sign posts or indices, which lead one to what he is looking for, along with what he is also not looking for. It is a combination of two

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\(^6\) ibid (n 4) 1412.

\(^7\) Law Lexicon (4th edn, 2010) vol 5, 5985.

\(^8\) ibid (n 4) 1709.

ordinary words meta and tag, meaning respectively "denoting position" and "label". Meta tags as embedded in the HTML code remain invisible to the internet user.\textsuperscript{10}

**Hyperlink:** It is a link from a hypertext document to another location, activated by clicking on a highlighted word or image.

**Cybersquatting:** It is an act of reserving a domain name on the internet, especially a name that would be associated with a company’s Trade Mark, and then seeking to profit by selling or licensing the name to the company that has an interest in being identified with it.\textsuperscript{11}

**Domain Name:** Domain names are the human-friendly forms of Internet addresses, and are commonly used to find websites.\textsuperscript{12} A domain name also forms the basis of other methods or applications on the Internet, such as file transfer or email addresses.

**Cause of Action:** Cause of action generally means bundle of facts which the plaintiff must prove in support of his right to the judgement. It has dual meaning, one relevant to jurisdiction and other to the basis of claim.\textsuperscript{13}

**Domicile:** It refers to the place where one has permanent residence to which, if absent, he has the intention to returning.\textsuperscript{14} Domicile is the legal relationship between an individual and a territory with a distinctive legal system which invokes that system as his personal law.\textsuperscript{15}

**CHAPTER SUMMARY**

The thesis is structured in seven chapters.

**CHAPTER 1: JURISDICTION: A CONCEPTUAL ANALYSIS**

\begin{itemize}
\item \textsuperscript{10} Consim Info Pvt. Ltd. v. Google India Pvt. Ltd. and Ors, 2011 (45) PTC 575 (Mad).
\item \textsuperscript{11} ibid (n 4) 444.
\item \textsuperscript{12} Frequently asked questions: domain names <http://www.wipo.int/amc/en/center/faq/domains.html#1> accessed April 2015.
\item \textsuperscript{13} Jay Jee Service Station, Bangalore v. Syndicate Bank, AIR 1998 Kant 249, 253, para 10.
\item \textsuperscript{14} Article 5 Constitution of India.
\item \textsuperscript{15} Halsbury’s Laws (4th edn, 2010) vol 8 para 421, 318.
\end{itemize}
First chapter deals with the conceptual analysis of the notion of jurisdiction as it exist. It analyses the concept of jurisdiction by going through various aspects of jurisdiction such as meaning, nature, importance, and classification. The distinction between jurisdiction and place of suing as well as exercise and existence of jurisdiction are also briefly highlighted. Jurisdiction as an aspect of state sovereignty and from the perspective of the rules of private international law is also analysed. Further the chapter deals with the scope of jurisdictional powers of various courts and tribunals under the Code of Civil Procedure, 1908 and the Trade Mark Act, 1999. Elaborate discussion on the Law of Trademark in India especially in the post TRIPs regime is undertaken by providing comparative analysis between the Trade and Merchandise Marks Act, 1958 and the Trade Marks Act, 1999, in order to set the discussion in right perspective.

CHAPTER 2: INTERNATIONAL SYSTEM OF TRADEMARK PROTECTION: AN ANALYSIS

This chapter elaborates upon the international system of trademark protection. It deals with various international instruments related to trademark protection. Special emphasis is given to the Paris convention and the TRIPs. Apart from these two multilateral treaties the chapter discusses Madrid system for the International Registration of Marks, Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957), Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks (1973), The Trademark Law Treaty (1994) and the Singapore Treaty on the Law of Trade Marks (2006). The chapter deals with the main purposes of these international instruments affecting trademark which is to grant better protection of rights for various types of marks, harmonization of laws and efficient system for multilateral filing for global protection.

CHAPTER 3: JURISDICTIONAL ISSUES IN TRADEMARK VIOLATIONS: ASPECTS OF PRIVATE INTERNATIONAL LAW

In this chapter the researcher has tried to analyse the interface between Intellectual Property Rights and the rules of private international law. The mutual relation between these two important branches of law has been recognized. The large number of Trade Mark disputes
implicating the issues of private international law is limitless. Private International Law at times seems to be more complex compared to the simpler rules of jurisdiction and choice of law. The researcher has not only tried to understand the interface between these two branches but has also tried to study the need of statutory regulation of the two. The chapter discusses three key issues in private international law which requires serious consideration in order to understand the complex relation between these two interesting branches of law. These issues are about jurisdiction, choice of law and enforcement of judgments. The current chapter also deals with the Jurisdictional solution provided by the Hague Convention of Choice of Court Agreement, 2005. The rule making activities that has occurred outside legislatures in form of reports by American Law Institute’s proposed draft on Intellectual Property: on Principles Governing Jurisdiction, Choice of law and Judgments in Transnational Disputes; WIPO sponsored Prof. Dreyfuss & Prof. Ginsburg’s draft on Convention on Jurisdiction and Recognition of Judgments in Intellectual Property Matters; The European Max Planck Group on conflict of laws in IP (LLIP) Japanese Transparency Proposal and Waseda Proposal is also the subject-matter of this chapter.

CHAPTER 4: JURISDICTIONAL ISSUES IN VIRTUAL WORLD: FACTS AND CONCERNS

Preoccupation of Law and technology has compelled the researcher to analyze the technology underling the legal phenomenon as this technology has paved way for the existing legal problems, which is also the subject matter of research. Internet has affected Law in many ways. In this chapter the impact of internet and technology on law and regulatory framework is discussed. The chapter has a wide canvas where evolution of internet, various uses of trademark over internet, interface between trademark and domain name are discussed at length. The researcher has made an attempt to identify the issues of jurisdiction while discussing remedial recourse in case of disputes in the virtual world. How the doctrine of territoriality is being confused in the cyberspace is also highlighted.

CHAPTER 5: COMPARATIVE ANALYSIS OF LEGAL FRAMEWORK ON JURISDICTIONAL ISSUES IN TRADEMARK DISPUTES IN JAPAN, UNITED KINGDOM AND UNITED STATES
Globalisation can progress if there is minimum conflict in laws between countries and there exists a more or less similarity or parity between them. It, therefore, becomes important to get a comparative perspective on law not only for minimizing conflict but also for adopting the best practices upon a given subject matter. The present chapter deals with the comparative analysis of the trademark protection in Japan, UK and US. The researcher in this chapter is making a specific attempt to study the legislative and the judicial approaches in these countries in dealing with the issues of jurisdiction that may arise in the trans-border trademark issue in physical as well as virtual world. It is worthy to mention that while drawing comparison the entire scheme of the trademark legislation of Japan, UK and US is not minutely analyzed. Relevant aspects of the legislation of respective countries that are corresponding to the scheme of the research are only considered. The researcher would like to explain the rationale for the specific preference for these three countries for comparative analysis. Firstly, the US has one of the most comprehensive systems consisting of numerous special statutes for protection and enforcement of Trade Marks. Secondly, India being a colony of the UK shares many similarities with regard to overall legal system and its functioning. It is noteworthy that the Indian Trademark legislation has many provisions that are influenced by the Trade Mark Act, 1994 of the UK. Lastly, in order to get a comprehensive analysis on the subject matter analysis of both the legal system i.e., common and civil law was a sine qua non. Therefore the researcher opted to look at the legal system and legislative and judicial framework of Japan which follows the principles of civil law system. The researcher is well aware of the fact that Germany and France have one of the oldest and developed legal systems based on the same principles of civil law system. However, preference is given to Japan as it is an Asian country.

CHAPTER 6: EMERGING JUDICIAL TRENDS IN INDIA

The objective of this chapter is to analyse the judicial approach on jurisdictional issues relating to trademark violations in India. The creative and progressive intervention of the judiciary in the matters involving more than one state is also referred in this chapter. An attempt in made here to analyze judicial decisions on applicability of rules of jurisdiction in case of trademark violations in India. A specific endeavour is made to understand the Indian judicial approach in actual cases of trademark violations. The legislative framework provides for the black letter of law on trademark protection, which cannot be understood
in proper perspective without judicial interpretation of the same. It is worthy to mention that it is neither practical nor necessary to narrate all the reported cases on the issue. Selected cases are taken as they convey the main principles that are relevant to the research framework. Further to ensure that the focus of the research is not lost the researcher has tried her best to explain only the relevant aspect of the judgment leaving the ancillary issues aside. The chapter further tries to address the question of judiciary lagging behind in meeting the demands of technocratic society.

CHAPTER 7: CONCLUSIONS AND SUGGESTIONS

The findings in the concluding chapter are that the prerequisites of protecting Trade Marks in various jurisdictions are more or less harmonized but the enforcement of the same in those states still remains diverse. In almost all countries rules of jurisdiction whether substantial or procedural as applicable to trademark disputes significantly differ. The Trade Mark rights are territorial by nature which leads to complex issues of jurisdiction once the same is used outside the territorial limits. Jurisdictional issues in enforcing trademark rights have become inevitable as there exists an international trademark system that grants rights over a particular trademark in more than one country concurrently. Efforts to develop private international law of Intellectual Property Rights are much recent due to globalization and advent of internet. The rules of private international law differ from country to country. This discrepancy is the main source of uncertainty in addressing and resolving multi territorial trademark disputes. In Indian legal system for determining an appropriate court of jurisdiction the rules are laid down in the Code of Civil Procedure, 1908 section 16 to 21. Trade Marks Act, 1999 being a special statute prescribes for special provisions with regard to jurisdiction of court under section 134. This provision is a deliberate departure from the traditional rules of jurisdiction under the Code of Civil Procedure, 1908. There have been cases in the beginning where there was confusion regarding applicability of special provisions and the traditional rules as provided under the Code of Civil Procedure, 1908. However, this confusion is very well removed by the appropriate judicial interpretation of the relevant provisions under the Trade Marks Act, 1999 as well as under the Code of Civil Procedure, 1908. The special provisions under Section 134 of the Trade Marks Act, 1999 are in addition to the general rules under section 20 of the Code of Civil Procedure, 1908. However, it is considered that the provisions
under the Code of Civil Procedure, 1908 constitutes a ‘grundnorm’ the ethos and essence of which percolates through all other statutes. On the issue of jurisdiction in the virtual world the courts around the globe are facing a common question as to whether to develop a novel legal framework to address such complex issues or to look for an adequate answer by identifying analogous legal rules and judicial pronouncements that are available in the most pertinent fashion. In absence of any specific legal framework applicable to cyberspace, traditional principles of domestic and international jurisdiction are developed and adopted. Considering the non-availability of specific legislation and prescribed procedural norms, much reliance is placed on the judicial pronouncements. From the Indian perspective, it is concluded that our current territorially based rules for jurisdiction and conflict of laws were developed in an era when physical geography was more meaningful than it is today. Restriction of territorial jurisdiction being placed by codified laws, further expansion of personal jurisdiction beyond those lines require appropriate amendments in Section 19 and 20 of the Code of Civil Procedure to incorporate the Objective territoriality principle, i.e. the Effects test. This is so because judicial precedents of lower courts and foreign courts do not have binding authority on the Indian Courts. Considering the growing involvement of non-residents in cases of Trade Mark infringement, passing off and domain names owed to the ever-increasing horizon of globalization of businesses and internet connectivity, we need definitive law in this matter.
At the end of this chapter the researcher has made a few suggestions through which a better legal framework for protection and enforcement of trademark rights in the physical as well as virtual world in India may be created.