

Techno-Legal Interplay of Domain Names: A Study with Reference to India

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Abstract—Internet has unfolded its potential and its users are now quite convinced that it is a cost effective, flexible, efficient and viable option to carry out different business activities disregard of any physical or geographical boundaries. These intrinsic properties of Internet have raised innumerable legal issues that are difficult to resolve within the boundaries of existing legal régime which has a different scheme of things. Internet has impacted most of the branches of law more particularly Intellectual property jurisprudence which has engendered many IP issues including interplay of trademark and domain names. There is neither any separate legislation nor any express provision in the existing Trademark Act, 1999, which is relatively recent in origin and enacted at the time when these issues had seized the attention of the courts in other jurisdictions. A host of legal issues cropped by the intersection of trademark and domain names which have been left for the courts to decide. The courts in India have seized this opportunity and have laid down a number of principles. This paper appraises approaches adopted by Indian courts in resolving domain name disputes and compares them with theories evolved and established in other jurisdictions.

Keywords—DNS, Domain Name, Trademarks, Passing off and Judicial Approach.

I. INTRODUCTION TO DOMAIN NAMES

INTERNET is often described as a “network of networks” because it constitutes of hundreds of thousands of interconnected networks linking billions of devices around the world. These devices are identified on the Internet by a unique number that designates their specific location, thereby making it possible to send and receive messages and to access information from them using specific protocols. Among various other protocols, Internet uses an important protocol named Internet Protocol (IP) [1] which makes computers and other gadgets possible to instantly communicate with one another over a diverse range of physical links. An Internet Protocol Address [1] is the numerical address of the form 192.0.43.10 (IP Version 4) or 2001:500:88:200:0:0:0:10 (IP Version 6) by which a location in the Internet is identified. Computers on the Internet use IP addresses to route traffic and establish connections among themselves. E.g. when a request for a Webpage is sent from a client computer system to a Webserver, the client computer includes the IP address of the Webserver. To keep the identification of communicating

gadgets simple and mnemonic, Domain Name System (DNS) [2] has been developed. This system enables use of globally unique and easy-to-remember names for Webpages and mailboxes called domain names, rather than long numbers or codes (IP addresses), e.g. www.example.com instead of 192.0.43.10 (IP Version 4) or 2001:500:88:200:0:0:0:10 (IP Version 6). Users can also request resources like Webpages, mailboxes, files, etc. that are available on the server computer by specifying a unique Uniform Resource Locator (URL) which includes a protocol like HTTP, FTP, etc. to be used for accessing that resource. Further, DNS allows names to be separated from locations thereby permitting services and devices to be moved to different network locations, without the need for name change and without any effect on the way users visit or use websites.

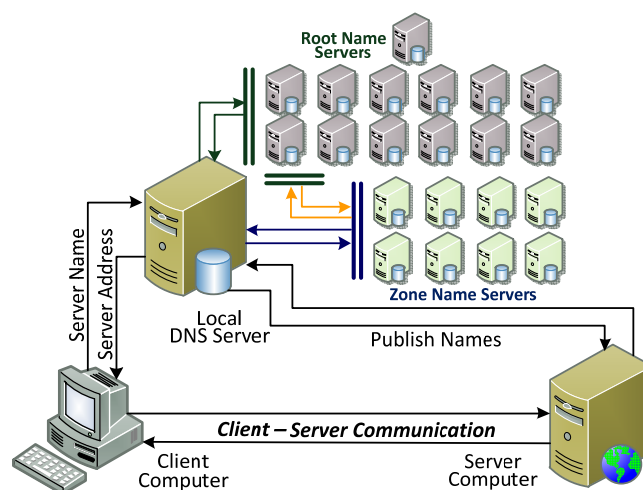


Fig. 1 DNS resolving Domain Name to IP Address

The purpose of the DNS as indicated by Fig. 1 is quite simple: it is a service running on different computers that looks up domain names and resolves them to an IP address so that clients that only know the domain names of the servers and not their IP addresses can communicate with them.

A DNS client called resolver sends DNS messages to obtain information about the requested domain name space. In response to DNS servers query on behalf of a DNS resolver the action that is taken is called recursion. A DNS server called Recursive Resolver recursively queries for the information asked in the DNS query. The authentication server responds to the query messages with information stored in Resource Records for a domain name space stored on the server. A server stores database that contains information

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about the domain name space stored on an authoritative server called zone. A Resource Record is a format used in DNS messages that is composed of the following fields: NAME, TYPE, CLASS, TTL, RDLENGTH, and RDATA. This process uses a FQDN (Fully Qualified Domain Name) which is the absolute name of a device within the distributed DNS database [3].

The abbreviation DNS is used to describe two related things: the Domain Name System and the Domain Name Service. The Domain Name System is the distributed database responsible for the domain name-to-IP address conversion and the Domain Name Service is the service offered by this system. Domain Names are somewhat similar to copyrights and trademarks, and are governed by an internet authority: Internet Corporation for Assigned Names and Numbers

(ICANN). In order to maintain credibility of Domain Names, their purchase and oversight is governed by several entities [4].

The domain name space is organized in the form of a hierarchy as shown in Fig. 2. The topmost level in this hierarchy is the root domain, which is represented as a dot (“.”). Next is the top-level domain (TLD). There is only one root domain, but there are many TLDs. Each TLD is called a child domain of the root domain. The root domain is the parent domain because it is one level above a TLD. Each TLD, in turn, can have many child domains. The children of TLDs are called second-level or enterprise-level domains. In a domain name representation, the symbol for the root domain usually is omitted.

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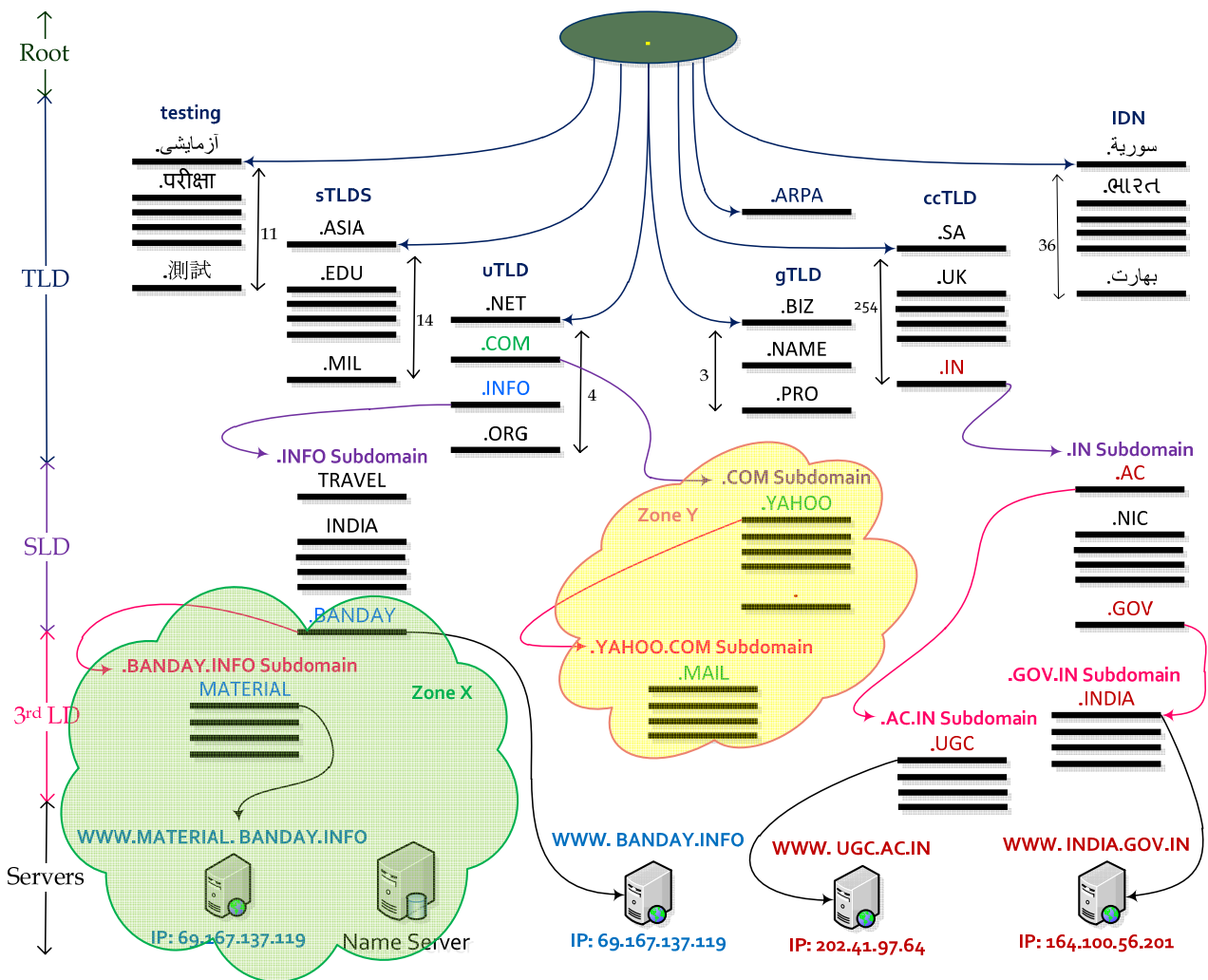


Fig. 2 Domain Name Space [5]

As shown in Fig. 2, there were 323 TLDs as on July 2011, categorized into the following types: i) testing – reserved for testing internationalized domain names, ii) sponsored top level domain (sTLD) – specialized domains with a sponsor representing a community of interest, iii) unsponsored top

level domain (uTLD) – generic domains without a sponsoring organization, iv) generic top level domain (gTLD) – generic domains, v) Country-code top level domains (ccTLDs) – domains associated with countries and territories, and vi) Internationalized top level domains (IDN) – domain names

represented by local language characters besides one *arpa* domain reserved exclusively to support operationally-critical infrastructural identifier spaces as advised by the Internet Architecture Board. There are billions of domain names registered as second or lower level domain names.

Besides various recent developments [5], [6] in DNS, ICANN [6] has secured Internet root by deployment of DNSSEC [7] protocol and has approved Internationalized Domain Names (IDN) [8], which are top level domain names that include characters used in the local representation of languages that are not written with the twenty-six letters of the basic Latin alphabet "a-z". An IDN can contain Latin letters with diacritical marks (such as accents) or may consist of characters from non-Latin scripts such as Arabic or Chinese. IDN top-level domain names offer many new opportunities and benefits for Internet users around the world by allowing them to establish and use top-level domains in their native languages and scripts. This year ICANN approved delegation of seven internationalized county code domain names to National Internet Exchange of India (NIXI) which are in Indian languages.

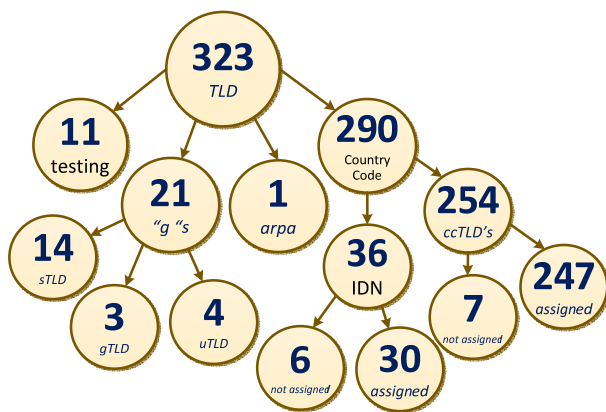


Fig. 3 Distribution of Top Level Domains (TLD)

Currently organizations and individuals around the world can register second-level and, in some cases, third-level domain names. The application for a new gTLD [9] is a much more complex process. An applicant for a new gTLD has to be applying to create and operate a registry business supporting the Internet's domain name system. This will involve a number of significant responsibilities, as the operator of a new gTLD is running a piece of visible Internet infrastructure.

A review of the issue of abusive domain name registration in relation to ICANN's lifting of registration restrictions, numerous forms of domain name abuses and the varied public and private remedies created to combat domain name registration abuse, and suggestion for an ideal and previously unarticulated approach to accommodate ICANN's new expansion policy in regard to domain name registration has recently been given by Borchert [10].

II. TRADEMARKS

The exponential growth in business together with

advertising which itself has turned in to a lucrative business has made distant sales possible. The concept of market overt of good olden days has vanished [11]. The market structure has altogether changed and so have business methods. The customers seldom have now that personal knowledge of manufacturers, producers or suppliers. The goods or services are now available in a variety of forms with varied features. This transformation has made source information more important than ever before. The consumers would prefer to have choice in goods or services. But once a range of alternatives is offered, he can make an informed decision only when he knows the relevant differences. To remove the possibility of differentiation is indeed to eliminate the incentive to provide goods of superior quality [11].

Every manufacturer or producer of goods or provider of services invests hard labor, time and money in carving out niche for his goods or service in an open market where already such or similar goods or services are available. These goods or services cannot be identified without any name. This name not only identifies goods and services but differentiates them with goods and services of similar description. This name can be represented by any symbol or representation or mark commonly known as trade name or trade mark. The precise function of the trade mark is to designate the trade origin of goods [11].

Trade mark means a mark capable of being represented geographically and which is capable of distinguishing goods or services of one person from those of others and may include shape of goods, their packaging and combination of colors. It is used in relation to goods or services [12] for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services. These marks can be broadly classified into four categories:

A. Generic Words

These words are used in common parlance and have no special significance to goods. These words are not entitled to protection under trademark law [13]-[15].

B. Descriptive Words

These words merely describe the goods or services and can only identify the product after the public comes to relate the product with a particular producer. These words are not per se entitled to protection, unless secondary meaning has been obtained by a descriptive mark which is possible only when consumers take it as a source identifier, rather than its descriptive meaning [16], [17].

C. Suggestive Mark

These marks give an idea about the usefulness of the products and identify their sources.

D. Invented Words

These words do not have dictionary meanings. They are arbitrarily selected and may or may not be having any meaning. The suggestive and invented words are inherently distinctive and are protected by the trade mark law regardless of secondary meaning [18], [19].

III. TRADEMARK INFRINGEMENT

The registration of trade mark in India is not compulsory and its protection is not dependent on registration. The registered trade mark is protected under the Trade Mark Act, 1999 [12] and the unregistered trademark is protected under Common law.

The infringement of the registered trademark takes place when a person who is not the registered proprietor or who is not having permission to use, uses in the course of trade a mark which is identical with, or deceptively similar to the trademark in relation to goods or services in respect of which the trade mark is registered. He is making use of the mark in such a manner as to render the use of the mark likely to be taken as being used as a trade mark.

A registered trade mark is also infringed when a mark is used in the course of trade but because of:

- a) Its identity with the registered trade mark and the similarity of the goods or services covered by such registered trademarks; or
- b) Its similarity to the registered trade mark and the identity and similarity of the goods or services covered by such registered trade mark; or
- c) Its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark; or
- d) Its likely to cause confusion on the part of public or which is likely to have an association with the registered trade mark [20]-[24].

Similarly, a registered trade mark is infringed by a person if he uses such registered trade mark as his trade name or uses such registered trade mark as a part of his trade name of his business concern or part of the name of his business concern dealing in goods or services in respect of which the trade mark is registered.

IV. COMMON LAW REMEDY OF PASSING OFF

Passing off action has roots in Common Law and stems from equitable action. This remedy is invoked to restrain the use of a name in circumstances in which the owner of that name might bring legal actions against unauthorized use of that name [25].

Passing off essentially prevents businesses from riding on the reputation or goodwill of the goods of another. The manufacturer or producer or packer or supplier or seller uses the features of another's business or trade products in such a way that consumers are confused as they are not able to differentiate the two products and they believe that his goods or business are those of the other persons [26].

The Common Law courts in 16th century laid foundation of Passing off doctrine by showing willingness to recognize trade reputation as an incorporeal property [27]. This doctrine was, however, given concrete shape by Lord Diplock in *Erven Warnink B. and Another v. J. Townsend & Sons (Hull) Ltd* [28], commonly called as *Advocate's Case*. The court laid down that passing off action cannot be claimed unless five conditions are satisfied. These are:

- a) The trader against whom an action has been filed has made a misrepresentation,
- b) Misrepresentation has been made by the trader in the course of the trade,
- c) This misrepresentation has been made to likely customer of his or ultimate consumers of goods or services supplied by him,
- d) The misrepresentation has a potential to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence), and
- e) Results into an actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.

The courts in India have shown willingness to borrow this Common Law remedy. In *Daimler Benz Aktiengesellschaft and Anr v. Hybo Hindustan* [29], the passing off action was invoked. The Plaintiff, a well-known German Car manufacturer, owned the trademark 'BENZ' with three pointed star in a ring. The defendant was carrying on the business of undergarments. He used VIP-Benz in combination with the three pointed human figure in a ring. This was objected by the plaintiff and the objection was upheld by the court. The court gave fullest effect to the passing of action. The court applied not only the above stated Common Law principles but also held that the plaintiff need not prove that there was common field of activity between him and the defendant.

Now the question to be answered is; are the above stated legal provisions or the tests of infringement or passing off action sufficient enough to address new generation of disputes, popularly called domain name disputes. Pertinent to mention here is that the Trade Mark Act, 1999 [12], in spite of the fact that it has been enacted at the time when domain name disputes had already knocked at the doors in other jurisdictions, it does not provide any express provision for domain names. This legal handicap; however, did not come in the way of resolution of domain name disputes in India. The courts in India have already decided a good number of cases involving domain names. Their approach and the legal principles established in the process are discussed in the next part of this paper.

V. DOMAIN NAME DISPUTES

Internet has come with manifold promises and has proved a viable, cost effective medium that has bridged the distance which was coming in the way of businesses who were interested in extending their reach offshore. It is now increasingly turning to be an ultimate marketing tool in computer age [30].

Internet now facilitates execution of multifarious transactions and businesses have discovered it an invaluable environment for promoting and selling of goods and services [31]. Consumers have found it easily accessible and convenient to effect transactions.

The above advantages cannot be fully reaped because of the technological constraints. Domain names are based on the principle of "first come first serve" basis and are not caps

sensitive. There is no mechanism in place to establish identity of the person interested in registering any name and due to technological constraints, one name can be registered only once in a top level domain name e.g. there will be only one www.bata.com

The dispute arises when the registrant uses the trade mark of somebody else as a domain name by another company or when the registrant is using a domain name confusingly similar to the trade mark of another company or when two or more companies, each with legitimate claims to the name, want to use the same name in their domain names.

VI. APPROACH OF THE INDIAN COURTS

A. Domain Name -Trade Mark: A Symbiotic Relationship

The courts in India have been consistently propounding that domain names and trademarks are analogous [32]. The domain names perform the same function in cyberspace which the trade names perform in real space. The Titan Industries Limited v. Prashanth Koorapati and Ors [33] marks the watershed in the history of the trade mark jurisprudence in India as it is the first case decided by any Indian court which accorded trade mark protection to domain names. In this case, the plaintiff had registered TANSHIQ as his trade mark for the production and marketing of Jewelry and watches since 1994 and had registered this trade mark in 23 countries. The defendant had registered 'tanshiq.com' as its domain name which was based on the plaintiff's trade mark. The plaintiff objected the use of its trade mark as a domain name by the defendant on the ground that the domain name is squarely based on his registered trade name. The consumers would tend to believe that the defendant is an affiliate of the plaintiff. It is likely to cause confusion and deceive the public and will ultimately divert business traffic to the defendant. This would give an unfair advantage to the defendant who would be able to cash the reputation and goodwill of the plaintiff which would cause financial loss to him.

An ex parte ad-interim was issued by the court against the defendant restraining him from registering a name or operating any business, manufacturing, selling or offering for sale, or advertising any goods under the name TANSHIQ or any other name deceptively similar thereto; or including the word TANSHIQ as an essential feature of a domain name on the Internet. The court also restrained him from conducting any activities with the name TANSHIQ that could lead to passing off the business and goods of defendant as those of plaintiff.

B. Common Law Remedy of Passing off Action and Its Applicability to Domain Name Disputes

The decision of Yahoo Inc. v. Akash Arora and Netlink Internet Services [34] marks the beginning of the application of passing off doctrine to domain name disputes. This is the first case in India in which passing off action was invoked for the resolution of domain name disputes. The proprietor of the Global Internet media search and information network filed a suit against the defendant for passing off their services on the

Internet as that of the plaintiff's services by adopting the domain name yahoo.com.

The plaintiff contended that YAHOO is his trade name which has been registered in 69 countries and its registration is pending in India. Its domain name yahoo.com is based on its trade name and has been registered in 1995. It was claimed that the defendant has registered yahooindia.com and its 16 variations using yahoo in 1997. The issues raised by the plaintiff were not conceded by the defendant instead he raised counter arguments, the resolution of which has set future direction in India. The defendant challenged the basic premise and stated that the:

- a) Domain name cannot be equated with the trademark;
- b) Domain names are address of websites. These websites are vehicles of information. The provider of information is in essence provider of service. Services do not enjoy trade mark protection in India. This case was decided when the Trade and Merchandise Marks Act, 1958 [35] was in force. This Act did not protect service marks. This Act was repealed by the Trade Marks Act, 1999 [12];
- c) The defendant has posted disclaimer on its website which would remove any possibility of confusion;
- d) The defendant is offering only India specific content whereas plaintiff is not confined to any one country; and
- e) Internet users are literate people who usually know the difference between the two websites.

The above arguments were considered by the court. The court rejected these arguments inter alia, on the grounds that the trade mark law applies equally to domain names on the Internet. The court admitted that the present case is not for an action for infringement of a registered trademark, but only for an action for passing off. The law relating to passing off is well settled. The court ruled that even if it is accepted that domain name is a service mark and not the trade mark, there are a good number of cases supporting the view that the service marks do fall within the domain of the passing off action [36], [37].

Recent opinion of the English court expressed in Marks & Spencer v. One in a Millions [38] was borrowed for the resolution of the present case in which it was held that with the advancement and progress in technology, services rendered on the Internet have also come to be recognized and accepted and are given protection, so as to protect such provider of service.

Regarding the issue of effect of disclaimer on consumer confusion the court invoked the ratio of an American case laid down in Jews for Jesus v. Brodsky [39]. It was laid down that due to the nature of Internet use, defendant's appropriation of plaintiff's mark as a domain name and home page address cannot adequately be remedied by a disclaimer. It was also observed that considering the vastness of the Internet and its relatively recent availability to the general public, many Internet users are not sophisticated enough to distinguish between the subtle differences in the domain names of the parties.

The court took help from the Supreme Court's ruling in N. R. Dongre v. Whirlpool Corp. [40] in which protection was

accorded to the dictionary words. The court in the instant case rejected the argument that “yahoo” is a dictionary word which cannot be given trade mark protection and held that the words that have acquired uniqueness and distinctiveness are entitled to protect even though they have dictionary meaning. It was added that such words have come to receive maximum degree of protection by courts. The court concluded that keeping in view the ease of access to Internet from all parts of the globe, a strict stand against copying should be taken as the potential of harm is far greater in cyberspace than it is in real space.

The plaintiff in Rediff Communication Ltd v. Cyber booth and another online media company [41] carrying on the business of communication and providing service through the Internet since 6th January 1997. It had registered its trademark as a domain name “Rediff.Com” in 1997. The defendants had got registered the domain name “Rediff.com” on 31st Jan. 1999. The plaintiff objected the domain name of the defendant on the grounds that establishing and broadcasting a web page on the Internet with the title “RADIFF” is clearly intended to cause members of the public to believe that the defendants are affiliated with the plaintiff. It was also contended that the adoption of word “RADIFF,” by the defendant which is deceptively similar to the plaintiff’s trade name and style has been done with deliberate intention to pass off the defendant’s business, goods and services of those of the plaintiff’s and thereby illegally trade upon the reputation of the plaintiff.

The defendant inter alia, contended that the word “REDIFF” is coined by taking the first three letters of the word ‘radical’; the first letter of the word ‘information’; the first letter of the word ‘future’ and the first letter of the word ‘free’. The plaintiff’s website is titled ‘rediff on the net’, whereas the defendant’s website is titled “RADIFF ONLINE”. The plaintiff’s website is more in the nature of a “web newspaper” and provides various services from news to shopping whereas the defendant’s website mainly provides hypertext links to its advertiser’s website. If the two websites are put together, it is quite clear that their “look and feel” is different. It was also contended that the users of the computers are educated people. There is no possibility of any confusion being made by an Internet user in the two names.

The court took the help of the rulings expressed in American Civil Liberties Union v. Reno [42]; Marks and Spencer PIC v. One in a Million [43]; and Cardservice International Inc. v. McGee [44] and held that the Domain names are not only source of information but are of immense importance and valuable corporate asset. A domain name is more than an Internet address and is entitled to equal protection as trade mark.

The court relied on the above mentioned landmark Advocate’s case and other decisions [45], [46], [47] to make a case for the application of passing off doctrine and held that when both the impugned domain names are considered, they being almost similar in nature, there is every possibility of Internet user being confused and deceived in believing that both the domain names belong to one common source and connection although two belong to two different persons.

The court reached to the conclusion that the areas of

operation of the plaintiff and the defendant are clearly similar and overlapping. The only motive in adopting the domain name “RADIFF” was to usurp the reputation of the plaintiff and use it for the sale of its own goods. The court added that once the intention to deceive is established, there is no need for the court to make further enquiry about the likelihood of confusion.

The court applied passing off principles strictly in Online India Capital Co Pvt. Ltd & Anr v. Dimensions Corporate[48], and refused to grant relief in favor of plaintiff. In this case plaintiff No. 2 had registered “www.MUTUALFUNDSINDIA.COM” and assigned it to plaintiff No 1. The defendant had six or seven months later registered www.mutualfundsindia.com as its domain name which was objected by the plaintiff.

The plaintiff took the help of decisions handed down in yahoo (Supra) and Rediff (Supra) in support of its contention that the use of its domain name by the defendant is likely to deceive or cause confusion and divert the business of the plaintiff to the defendant.

The court showed complete agreement with the contention of the defendant that the “MUTUALFUNDINDIA” is a descriptive / generic word and is not entitled to trade mark protection. The court heavily relied on the rulings of House of Lords in Office Clearing Services Ltd. v. Westminster Windows and General Cleaners Ltd. [49], where House of Lords did not accord protection to word “Office clearing” and on the decision of other Indian cases [50], [51] to conclude that the plaintiff’s domain name is descriptive of the services offered by him. The plaintiff has failed to show that this descriptive word has acquired a secondary meaning which is a pre-condition for granting protection to such words. The court also distinguished the present case from yahoo (Supra) and Rediff (Supra) on the grounds that in latter cases domain names had acquired distinctiveness which is missing in the present case.

C. Application of Doctrine of Trade Dilution

Cyber squatting has seized the attention of the courts in other jurisdictions. In India, Tata Sons limited v. Manu Kosuri & Ors [52], is the first case decided by any Indian court on Cybersquatting. Surprisingly, the court did not decide this case on the legal principles established by the courts in other countries. This case has recognized, for the first time, “trade dilution” as a ground to object domain name registration. In this case, defendant had registered a good number of domain names incorporating the word TATA which was objected by the plaintiff.

An ex parte order was issued by the court against the defendant and held that the domain names or Internet sites are entitled to protection as a trade mark because they are more than a mere address. The rendering of Internet services is also entitled to protection in the same way as goods and trademark law applies to activities on Internet. It was also held that the defendant shall not use the word TATA or any other name/mark which is identical with or deceptively similar to the plaintiff’s trade mark TATA or containing the word mark

TATA on the Internet or otherwise causing dilution of the trade mark TATA.

D. Invocation of Principles of UDRP

A path breaking judgment was pronounced in *Acqua Minerals limited v. Pramod Bose & Anr* [53] that marks a new era for domain name protection. The decision in this case is a trend setter in many respects. The plaintiff claims to be registered proprietor of the trade mark BISLERI which is extremely well known in India. It is one of the first marks introduced for bottled mineral water in India. It was contended that the word BISLERI has no dictionary meaning and is an Italian surname which is entitled to the highest degree of protection. The defendant has unlawfully registered bisleri.com as its domain name in 1999 which is bound to cause confusion to consumers. The plaintiff also argued that the defendants have already their own domain name namely info@cyberworld.com and are merely using the domain name of the plaintiff in order to trade in it and/or to pressurize the plaintiff to part with huge sums of money for the same. The defendant did not respond in spite of several summonses.

Relying on the dictionary meaning, of the word "Domain" which means territory or property, the Delhi High court held that if an owner or possessor of a trade mark has prior and exclusive use and lone claim over the trade mark, he attains not only superior title but absolute ownership thereof. This is what is the genesis of the word "domain" and when the property or the territory (which is another meaning of the word domain) or the activity relates to a trade or commerce and has been given the name or mark under which the commercial activities are identified with and carried out under the said name the user or owner thereof has a domain over it and therefore such a domain name has the same protection as any trade name has been provided under the Trade and Merchandise Marks Act, 1958. This Act has been now replaced by the Trade Mark Act, 1999. Any person who traverses into other territory that is, tries to usurp his domain name or in other words trade name which is used in the course of a trade is guilty of infringement of the said name if it is registered and, if not, is liable for passing off action. The court made it clear 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 with registering authority under Trade and Merchandise Marks Act or for a passing off action as are applicable in respect of the trade mark or name.

The court did not look into the principles of trademark jurisprudence but invoked the principles of Uniform Domain Name Dispute Resolution Policy [54]. This policy prohibits registration of domain names in bad faith. There is a presumption that bad faith element is present if it is proved that:

a) the registration of domain name is primarily for the purpose of selling or renting or otherwise transferring the domain name registration to the complainant, who is the owner of the trade mark or service mark or the competitor of that complainant;

b) the domain name is registered to prevent the owner of the trade mark or service mark from reflecting the mark in the corresponding domain name.

While invoking this policy, the court reached to the conclusion that registration of the domain name by the defendant is clearly in bad faith. The act of the defendants not only constitutes the infringement of the plaintiff's right but also constitutes passing off act as it is likely to result in dilution of the trade mark "Bisleri". The plaintiff has no control over the use of the said domain name in spite of the fact that the trade name "Bisleri" is the exclusive trade mark of the plaintiff. This case is landmark in this sense also that Cyber squatting has been recognized as a ground for objecting registration of domains name unlike TATA Sons limited (Supra) where court has failed to seize this opportunity. The court concludes that the domain name "Bisleri" was chosen by the defendants with malafide and dishonest intention and as a blocking or squatting tactic.

The Supreme Court in *Styam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.* [55] gave mandate to the subordinate courts to follow UDRP which was reasoned as; a domain name is potentially accessible irrespective of the geographical location of the consumers. The outcome of this potential for universal connectivity is not only that a domain name would require worldwide exclusivity but also that national laws might be inadequate to effectively protect a domain name. The lacuna necessitated international regulation of the domain name system. This international regulation was effected through WIPO and ICANN. India is one of the 171 states of the world, which are members of WIPO. This has established a system of registration, while this registration may not have the same consequences as registration under the Trade Marks Act, 1999; nevertheless it at least evidences recognized users of a mark. Besides, the UDRP is instructive as to kind of rights which a domain name owner may have upon registration with ICANN accredited registrars.

E. Domain Names Identical and Deceptively Similar to the Trade Marks

The name of DR. REDDYS laboratory is well known in the medical and medicine circles. It has earned name and fame and this name was subject to litigation in *Dr. Reddy's Laboratories ltd v. Manu Kosuri & Ors* [56]. In this case, the defendant had registered "dreddyslab.com" as its domain name which is based on the trade mark/domain name DR. REDDYS of the plaintiff. The plaintiff argued that DR. REDDYS is a personal name of the plaintiff company's founder and its use as a trade mark in relation to pharmaceuticals is completely arbitrary. It has the capacity to clearly distinguish its activities from those of other traders. The registration of this trade mark is pending but "dreddys.com" has been already registered as a domain name in 1999. The domain name of the defendant is deceptively and confusingly similar to the domain name of the plaintiff.

The court observed that the domain names of the opposite parties are almost similar except for use of the suffix "lab.com" in the defendant's name. The degree of the

similarity of the marks usually is vitally important and significant in an action for passing off as in such a case, there is every possibility and likelihood of confusion and deception being caused. Considering both the domains, it is clear that 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 plaintiff although the two domain names belong to two different concerns.

The plaintiff raised many issues relevant to UDRP but the court did not give any thought to them. Instead, it was found convenient to decide the case on the basis of other issues.

The Bombay High Court in *International Association of Lions Club v. National Association of Indian Lions* [57] did not dwell on the issue of distinctive character of the mark. The plaintiffs contended that they are members of internationally known lions club and defendant has registered the words lions club as its domain name. The defendant's argument was that he and his associates were members of the lions club. Being dissatisfied with the functioning of the club, they decided to form another lions club and registered it on Internet. The court held that if the defendants club came into existence because of the dissatisfaction with the plaintiffs functioning, then they would have tried to distance themselves from the plaintiff's and they would have adopted a name which could not be remotely connected to the plaintiff. The use of the word 'Lion' in the name of the organization of the defendants shows their intention to pass off their organization that of the plaintiff.

A well-known website naukri.com was litigated in *Info Edge (India) Pvt. Ltd. v. Shailesh Gupta* [58], wherein the plaintiff had registered its domain name naukri.com in 1997 and defendant registered naukari.com and jobsourceIndia.com in 1999 which was objected by the plaintiff on the ground that it is identical to or deceptively similar to his (plaintiff's) domain name/ trademark. The dishonesty on the part of defendant is writ large as confusion is sought to be created by the defendant by diverting the Internet traffic from the website of the plaintiff to the website of the defendant. The defendant contended that word "naukri" is a generic word which cannot be protected by trademark law. It was further contended that adjectives are normally descriptive words and nouns are generic words. This contention of the defendant was rejected by the court by concurring with the opinion of Mac Carthy [59], who said, "parts of speech test does not accurately describe the case law result". Therefore, such a criteria cannot be accepted as a safe and sound basis to ascertain as to whether a particular name is generic or descriptive. The court opined that even generic word is entitled to protection where it has attained distinctiveness and is associated with the plaintiff for considerable time.

The attention of the Supreme Court was invited for the first time in *Styam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.* [60] to resolve domain name dispute. In this case appellant had registered a number of domain names like www.sifynet; www.cifymall.com; www.sifyrealestate.com. Respondent had registered domain names www.sifynet.net and www.sifynet.com, which was objected by the appellant in the

city civil court on the ground of passing off. The court granted injunction that was stayed by the High Court. In the instant appeal, it was contended by the appellant that the word "Sifty" is a coined word which was coined by using elements of its corporate name, 'Satyam Infoway'. A wide reputation and goodwill is associated with this name. In order to cash on this trade name, the respondent decided to register domain names which are identical to and confusingly similar to his (Appellant's) domain name.

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

The Supreme Court approved all the opinions propounded by different High Courts relating to Domain Name disputes. The court with great emphasis stated that over the last few years the increased use of the Internet has led to a proliferation of disputes resulting in litigation before different high courts in this country. The courts have consistently applied the law relating to passing off to domain name owners. No court in India has taken contrary view. The law has been correctly applied.

Back to the facts of the present case, the apex court held that given the nature of the business, it is necessary to maintain the exclusive identity which a domain name requires. In other words, either "Sifty" or Sify" must go. Apart from being prior user, the appellant has adduced sufficient evidence to show that the public associates the trade name SIFY with the appellant. The High Court, while dealing with this case, was persuaded to give verdict in favor of the appellant (now respondent before Supreme Court) on the ground that fields of activity of the opposite parties were different, irreparable loss will be caused to the appellant if injunction is not granted and respondent has another domain name. The Supreme Court while narrating the High Court's decision laid down that a deceptively similar domain name may not only lead to a confusion of the source but the unsought for services. On the High Courts' finding that no prejudice would be caused to the appellant because it had another domain name, the apex court said, it was a consideration which might have been relevant if there was a case of bonafide concurrent use and where the right to use was co-equal.

The apex court did not discuss in detail effect of registration of domain name in two different top level domains. The court made simply a passing reference by holding that "apart from the close visual similarity between 'Sify' and 'Sifty' there is phonetic similarity between the two names. The addition of 'net' to 'sifty' does not detract from this similarity. This issue has already been discussed in other jurisdictions and courts have expressed conflicting opinions. In *Avery Dennison Corp v. Sumpton* [61], the plaintiff registered his trademark as domain name in <.com> whereas the defendant registered plaintiff's trademark as his domain name in <.net>. The court held that Internet users now well know the difference between

the two top level domains. The distinction is so well recognized among the Internet users that the defendants' domain name would hardly cause any dilution of the plaintiff's trademark. As against this, in two subsequent decisions in *Playboy Enterprises International Inc. v. Global Site Design, Inc.* [62] and *Washington Speakers Bureau, Inc. v. Leading Authorities, Inc.* [63] opposite decisions were given. It was laid down that once trademark of the plaintiff is registered by the defendant as his sub domain, consumers will be confused as to source and the difference in the top level domain name will not eliminate that confusion.

The *TATA Sons limited and Anr v. Fashion ID limited*[64] is the first case which was decided after the Supreme Court's ruling (Supra). In this case, the defendant had registered 'tatainfotecheducation.co,' and was dealing in gambling and other nefarious activities harmful to the corporate image of the plaintiff who was owner of the trade name TATA. The case was decided ex parte. The cost of Rs 1 lakh was awarded in favor of the plaintiff which is significant move in itself and a strong message to the cyber squatters who try to cash on the reputation and goodwill of the owners of the trade mark. Invoking the ratio of the Supreme court's ruling, the Court held that the defendant, its servants, agents and assignees and all others acting on behalf of the defendant are restrained from conducting any business or dealing in any manner including using the impugned domain name or any name comprising of the same or deceptively/ confusingly similar to it.

In *Zee Telefilms Ltd. & Ors v. Zee Kathmandu & Ors* [65], the defendant registered domain name identical to the trademark "Zee" of the plaintiff. The plaintiff's claimed that the word "Zee" is arbitrary and fanciful word which has been adopted by the plaintiff's in the year 1992 for all its business activities in India and abroad and thus it is not open for the defendants to have got the same name registered as their domain name. The court not only accepted this contention but suggested that a mechanism should be globally put in place wherein the registered trademark holders should be asked to register the mark with the ICANN accredited registrars with a stipulation that in case any person seeks to register a domain name consisting of the registered mark, no objection would be required to be obtained from the owner of the registered mark.

VII. CONCLUSION

Internet has over the period of time proved a viable medium for businesses to effectuate multifarious transactions right from the supply of raw material till the delivery of the finished product. Internet has also proved a very cost effective and efficient advertising tool. The consumers as well as businesses now turn to Internet because they have found it a convenient medium to shop. This information for consumer is available on different websites. These websites have unique addresses called domain names. The information seekers must either know domain name of the site which they are looking for or they have to enter key words in search engines. If they have to enter key words, they will invariably try for the already established trade name of the trader. Businesses would always

prefer to have their domain names based on the trade name by which they are known to their consumers. It has been now observed that the domain names that are based on a well-known trademark or trade names are being registered by those who are not in any way associated with these trade names with an object to confuse consumers who will take it as the associate of the such trademark owner or will resell the domain name to the true owner of the trade mark at some exorbitant price. The logical objections of the trade mark owners are:

- a) Why should a person be allowed to cash on the reputation in the cyberspace earned by the trade mark of another person in real space?
- b) Why should a business man be allowed to pass on his goods as that of the other?

Neither should he be allowed to usurp the trade name of the other and use it as a domain name nor to use domain name which is closely identical with or confusingly similar to the trade mark of the other.

The above issues came up for judicial determination throughout globe. The courts in India have taken law in a right direction in spite of the absence of specific legislation on the subject. The interpretation accorded by the Indian courts is in line with the opinions expressed by the courts in trans-national jurisdictions. The courts in India have consistently now held that the domain name is not merely an address but an effective source identifier with all the trappings of a trade mark. The courts have likened domain names with trademarks and accorded them trademark protection.

It has been now made abundantly clear that the principles of infringement and passing off applicable in real space are equally applicable to cyberspace. Similarly, the tests laid down by the courts to determine whether the mark in question is identical with or confusing similar to the trademark of the plaintiff or the circumstances resulting in the consumer confusion have been applied to domain name disputes as well.

The Delhi High court has been on the fore front of resolving domain name disputes. It has come up with a fruitful suggestion relating to jurisdiction of the courts in case of domain name disputes. It has been made clear that every court shall have jurisdiction to try domain name dispute in view of the fact that a website can be accessed from any place.

In one of the decisions, the Delhi High Court, (Supra) has suggested that there should be cooperation amongst the comity of nations requiring registered trademark owners to register these marks as domain names with the accredited Registrars of ICANN. If then one tries to register a domain name based on such registered trade mark, he may be asked to produce no objection from the trademark owner. This suggestion may reduce litigation but will not eliminate it altogether. Furthermore, there is no reason to confine it to only registered trademarks. An alternative to this suggestion is that all the marks, whether entitled to protection under trade mark law or under common law remedy of passing off, be registered with the Registrar. Anyone interested in registering such mark or its variant as domains name, whether registered under the same or different top level domains, be asked to get no objection

from the owner of such mark.

All the decisions handed down by the courts till date have received approval of the Supreme Court. However, the apex court has itself failed to seize an opportunity to set at rest the controversy relating to the effect of the registration of the domain names in two different top level domains. The apex court did not decide it authoritatively but made only a reference to it. This issue has caught attention of the courts in other jurisdictions where courts have not shown unanimity on this point.

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