
UNIT 12 DOMAIN NAMES

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12.1 INTRODUCTION

Originally the purpose of Internet domain names was to locate a web site on the Internet. But in today's world the importance of domain names has gone much beyond web site location. They are used to identify the goods and services which a particular company is offering, be it online or offline. So, domain names serve the purpose of trademarks. Registration of domain names being not as stringent as that of trademarks led to the practice of cybersquatting and disputes started emerging regarding their abusive registration. Courts have responded positively to such disputes and have resolved them by applying the principles of trademark and passing off laws. Alternatively, the remedy exists in the form of arbitration as well.

12.2 OBJECTIVES

After reading this unit, you should be able to:

- describe the term Domain Name and its different kinds;
- explain cybersquatting;
- discuss how domain name disputes can be resolved through courts;
- explain the process of resolving such disputes through arbitration under the UDRP rules; and
- compare between traditional litigation in courts and under arbitration rule.

12.3 WHAT IS A DOMAIN NAME?

A domain name is the address of a Web site like www.tata.com is the address of the famous business house Tata. The purpose of a domain name is to locate a Web page on the Internet. Every Web page has a unique address just in the same manner as every telephone has a unique number. If you want to call someone you need to dial that person's telephone number. In much the same way, if you need to access a Web site, you have to type out its IP number like 192.0.34.166. Since Web sites are very many, it is inconvenient to remember them by numbers, a system evolved under which a name is mapped to the concerned number or IP address. So, simply put, a domain name is the linguistic counterpart of what is known as an Internet Protocol (IP) address. Thus, today, instead of typing a numeral, one has merely to type in www.tata.com. Internet Corporation for Assigned Names and Numbers (ICANN), which is a non-profit corporation, has the overall responsibility for managing the Domain Name System.

12.4 TYPES OF DOMAIN NAMES

Every domain name ends in a top-level domain (TLD) name. TLD is the last part of a domain name; that is, the letters which follow the final 'dot' of any domain name. For example, in the domain name www.wikipedia.org, the TLD is org. Every TLD is either one of a small list of generic names (three or more characters), or a two characters territory code based on ISO-3166. So, broadly domain names are of two types — one, generic top-level domain (gTLD); two, country code top level domains (ccTLD).

12.4.1 generic Top-level Domain (gTLD)

A gTLD is a top-level domain used by a particular class of organization. These are three or more letters long, and are named for the type of organization that they represent (for example, .com for commercial organizations, .int for international organizations). But some of these gTLDs have become unrestricted, that means they no longer represent any particular type of organization and anyone could get a domain name under it. Like .com which can be registered by anyone even if the purpose is not commercial activity. The following gTLDs currently exist.

- .aero - for the air transport industry
- .biz - for business use
- .cat - for Catalan language/culture
- .com - for commercial organizations, but unrestricted
- .coop - for cooperatives
- .edu - for educational establishments
- .gov - for governments and their agencies in the U.S.A.
- .info - for informational sites, but unrestricted
- .int - for international organizations established by treaty
- .jobs - for employment-related sites

.mil - for the U.S. military

.museum - for museums

.name - for families and individuals

.net - originally for network infrastructures, now unrestricted

.org - originally for organizations not clearly falling within the other gTLDs, now unrestricted

.pro - for certain professions

.travel - for travel agents, airlines, hoteliers, tourism bureaus, etc.

gTLDs are governed directly under a centralized system by ICANN which means all terms and conditions are defined by ICANN with the cooperation of the gTLD registries.

Please answer the following Self Assessment Question.

Self Assessment Question 1

Spend 3 Min.

Define domain name?

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12.4.2 country code Top Level Domains (ccTLD)

ccTLD is used and reserved for a country. These are two letters long, and most of them correspond to the ISO 3166-1 standard for country codes. The administration of a ccTLD is left to the specific country concerned and thus each ccTLD policy setting out the rules for allocating domains is distinct from the other. ICANN has only a consultation role in these domain registries but is in no position to regulate the terms and conditions of how a domain name is allocated or who allocates it in each of these country level domain registries. The administration of domain names within the .in (Indian) category is overseen by Center for Development of Advance Computing, Mumbai (C-DAC), a scientific R&D institution under the Ministry of Communications and Information Technology. Some countries allow anyone in the world to acquire a domain in their ccTLD. Other countries allow only residents to acquire a domain in their ccTLD. There are over 243 ccTLDs in use currently.

Most corporations apart from registering their trade names and some of their core brands as gTLD's, also register them as ccTLD's in certain select countries where they foresee business potential. For example, *Yahoo.com* is a gTLD. However, *yahoo.co.in* is a ccTLD registered in India and *yahoo.co.fr* is a ccTLD registered in France.

Please answer the following Self Assessment Question.

Self Assessment Question 2

Spend 3 Min.

What are the different kinds of domain name?

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12.5 DOMAIN NAME DISPUTES – CYBERSQUATTING

The original role of a domain name was no doubt to provide an address for computers on the Internet. But the Internet has developed from a mere means of communication to a mode of carrying on commercial activity. With the increase of commercial activity on the Internet, domain names are also used as business identifiers. They have a significant impact on online brand building, advertising, search engine optimisation, etc.

Any business entity, for example, would prefer its own trade mark to be used as domain name since people recognise the trade mark. So Bata would prefer www.bata.com for the purpose of marketing its products and, even the consumers would relate www.bata.com with the famous company Bata that deals in shoes. But, as opposed to the physical world where two or more trademarks are capable of co-existence, the medium of the Internet does not allow for more than one domain name registration. Domain names have become akin to trade marks but the process of registration of a domain name is not the same and as stringent as that of registration of a trademark. The system is based on first-come-first-serve basis. Anyone can approach a Domain Name Registrar and register any available domain name. So, if the company Bata has not registered www.bata.com anyone else could just register that name in his favour. So, it becomes important for business entities to procure domain names that correspond with their trade marks. But there is another problem. There are various top level domains and various combinations thereof under which you could register your trademark. Like Bata could register as www.bata.com or www.bata.org or www.bata.net or www.bataindia.com. So, there could be numerous combinations that have a relation to a trademark and it is not possible for a business entity to procure all those combinations.

This leads many a time to what are commonly referred to as “abusive registrations” i.e. registration by a person of a domain name containing a trademark, in which such person/entity has no legitimate right or interest. The practice of registering and claiming rights over Internet domain names that are, arguably, not for the taking is known as cybersquatting. The cybersquatter then could offer the domain to the person or company who owns a trademark contained within the name at an inflated price. Cybersquatters usually ask for prices far greater than that at which they purchased it. Some cybersquatters put up derogatory remarks about the person or company the domain is meant to represent in an effort to induce the subject to buy the domain

from them. And some use such domain name in competition with the company which the domain is meant to represent. All this and much more is aimed at taking an unfair advantage of someone's trademark. Many cybersquatters also register many variants of a popular trademarked name, a practice known as typosquatting.

Please answer the following Self Assessment Question.

Self Assessment Question 3	<i>Spend 3 Min.</i>
What is cybersquatting?	
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12.6 DISPUTE RESOLUTION

In case of cybersquatting, the potentiality of the harm is far greater because a wrong could be easily propagated to every corner of the world. It would be highly unreasonable to allow such persons to continue their practice of cybersquatting. So, it becomes imperative for law to address such a situation. For resolving disputes which arise out of cybersquatting in relation to gTLDs there exist two separate routes — one, the normal court litigation route and the other is the arbitration route.

12.6.1 Litigation in Courts

One has to litigate domain name disputes before a court of law—the cause of action would be one in passing off or trademark infringement, depending on whether the trademark was registered or not. If one is successful in obtaining a court order, then one could furnish a copy of such order to the registrar who would transfer the domain name.

One of the earliest and most significant cases in the Indian context has been *Yahoo! Inc. v. Akash Arora & Anr.* [1999 PTC 201] where the Internet search engine Yahoo! Inc. sued a cybersquatter who had not only copied the domain name 'www.Yahooindia.com' but had used Yahooindia as a trademark in a similar script on its Web site by offering directory services with information specific to India, and was passing itself off as an extension of Yahoo. The Delhi High Court granted an injunction restraining him from using Yahoo as a part of his domain name or as a trade mark. Specifically, the court held that trade mark law applies with equal force on the Internet as it does in the physical world. The courts in India had occasions to decide many other cases on similar reasoning.

Satyam Inforway Ltd. v. Sifynet Solutions (P) Ltd. [2004 (28) PTC (SC) 566] case is the first one from the Supreme Court of India dealing with legal protection of domain names and has given seal to the law laid down by the High Courts in various cases that the domain names are entitled to legal protection equal to that of a trademark.

The appellant, which was incorporated in 1995, registered several domain names like www.sifynet.com, www.sifymall.com, www.sifyrealestate.com, etc. in June 1999 with ICANN. The word 'Sify' is a coined word which the appellant claimed to have invented by using elements of its corporate name, Satyam Infoway. The respondent, on the other hand, started carrying on business of Internet marketing under the domain names www.siffynet.net and www.siffynet.com from June 2001. A suit was filed by the plaintiff on the basis that the respondent was passing off its business and services by using the appellant's business name and domain name. An application for temporary injunction was also filed which was allowed by the trial court but on appeal reversed by the High Court. The plaintiff/appellant preferred a special leave to appeal before the Supreme Court. Leave was granted.

The first question for consideration of the Court was that whether a domain name is just an Internet address or is an instrument that could distinguish between goods and services made available through different businesses. In other words is it mere address or a 'business identifier'? The respondent contended that a domain name could not be confused with 'property names' such as trademarks and is merely an address on the Internet. While describing the overall importance of domain names on the Internet the court answered the question in the affirmative and said: "The Internet has developed from a mere means of communication to a mode of carrying on commercial activity. With the increase of commercial activity on the Internet, a domain name is also used as a business identifier." Thus a domain name may pertain to provision of services within the meaning of Section 2(Z) of the Trade Marks Act, 1999.

Next and the main question for the consideration of the Court was whether Internet domain names are subject to the legal norms application to other intellectual properties such as trademarks. It was also submitted by the respondents that registration of a domain name with ICANN does not confer any intellectual property right; that it was a contract with a registration authority allowing communication to reach the owner's computer via Internet links and channelled through the registration authority's server and that it was akin to registration of a company name which is a unique identifier of a company but of itself confers no intellectual property rights. After reiterating the principles of passing off, the Supreme Court observed, "The use of the same or similar domain name may lead to a diversion of users which would result from such users mistakenly accessing one domain name instead of another. This may occur in e-commerce with its rapid progress and instant (and theoretically limitless) accessibility to users and potential customers and particularly so in areas of specific overlap. Ordinary consumers/users seeking to locate the functions available under one domain name may be confused if they accidentally arrive at a different but similar website which offers no such services. Such users could well conclude that the first domain-name owner has misrepresented its goods or services through its promotional activities and the first domain-owner would thereby lose its custom. It is apparent, therefore, that a domain name may have all the characteristics of a trademark and could found an action for passing off."

But which law would apply to a domain name dispute before the courts. Does any statute in India talk about domain names and consequent disputes that may arise? The court also discussed this issue and said, "As far as India is concerned, there is no legislation which explicitly refers to dispute resolution in connection with domain names. But although the operation of Trade Mark 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.”

After looking into the evidence, the Supreme Court reached a *prima facie* conclusion that the appellant had been able to establish the goodwill and reputation claimed by it in connection with the trade name ‘Sify’. Apart from the close visual similarity between ‘Sify’ and ‘Siffy’, the Court held that there was phonetic similarity between the two names as well. The addition of ‘net’ to ‘Siffy’ did not detract from this similarity. It was also noticed by the Supreme Court that admittedly, the appellant was the prior user and had the right to debar the respondent from eating into the goodwill, it may have built up in connection with the name.

12.6.2 The Arbitration Route – UDRP

Domain name disputes are typically resolved using the Uniform Domain Name Resolution Policy (UDRP) developed by ICANN. Under UDRP, most types of trademark-based domain-name disputes must be resolved by agreement, court action, or arbitration before a registrar will cancel, suspend, or transfer a domain name. The policy offers an expedited administrative proceeding for trademark holders to contest “abusive registrations of domain names”. UDRP currently applies to all .biz, .com, .info, .name, .net, and .org top-level domains, and some country code top-level domains. The intention is to create a process that is faster and cheaper than the legal system.

According to the policy, complaints are submitted to “approved” dispute-resolution service providers, which can be corporations or non-profit organizations. Currently, the following four are the only authorized providers:

- World Intellectual Property Organization (WIPO)
- National Arbitration Forum (NAF)
- CPR Institute for Dispute Resolution
- Asian Domain Name Dispute Resolution Centre (ADNDRC)

Each provider has a list of panelists from which either one or three are chosen to decide a particular dispute. The policy is incorporated by reference into the registration agreement that the registrant had with the registrar at the time of registering its domain name. By virtue of the incorporation of the UDRP into the registration agreement, the registrant submits itself to the jurisdiction of the approved dispute resolution providers and binds itself to the UDRP.

In the event that a trademark holder considers that a domain name registration infringes on its trademark, it may initiate a proceeding under UDRP. The UDRP permits complainants to file a case with a resolution service provider, specifying, mainly, the domain name in question, the respondent or holder of the domain name, the registrar with whom the domain name was registered and the grounds for the complaint. Paragraph 4 of UDRP states the three elements that have to be established by a complainant to obtain relief. These elements are:

- Respondents domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;

- Respondent has no right or legitimate interest in respect of the domain name; and
- Respondent's domain name has been registered and is being used in bad faith.

Apparently, the main requirement under the policy is that the domain name of the complainant "should have been registered and used in bad faith". The policy stipulates certain "inclusive" factors for determining "bad faith registration and use" which are as follows:

- Registering the domain name with the primary purpose of subsequently selling it at a profit.
- Registering the domain name primarily for the purpose of disrupting the business of the competitor.
- Registering the domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name.
- Using the domain name to attract Internet users to one's Web site by creating a likelihood of confusion with the complainant's trademark.

However, such factors are, only inclusive and not exhaustive and the arbitration panel has the discretion to rely upon other factors to determine "bad faith". The respondent is offered the opportunity to defend himself against the allegations. The provider appoints a panelist who decides whether or not the domain(s) should be transferred.

Using the resolution provider WIPO for resolution of a case involving one to five domain names, with a single panelist, the current cost is US\$ 1,500; for three panelists, the total cost is US\$ 4,000. For six to ten domain names, the current cost is US\$ 2,000 for a case involving a sole panelist and US\$ 5,000 for a case involving three panelists.

A domain name after the dispute is resolved could either be transferred or the complaint could be denied. It is also possible to seek cancellation of the domain name. There are no monetary damages applied in UDRP domain name disputes, and no injunctive relief is available. The accredited domain name registrars – which have agreed to abide by the UDRP – implement a decision after a period of ten days. The panel decisions are mandatory in the sense that accredited registrars are bound to take the necessary steps to enforce a decision, such as transferring the name concerned. However, under the UDRP, either party retains the option to take the dispute to a court of competent jurisdiction for independent resolution. But this option is exercised very seldom.

Thousands of cases have been decided by the dispute resolution providers using the UDRP. It is neither possible nor desirable to list all those cases here but it would suffice to discuss a few.

In *Osho International Foundation v. Osho Dhyam Mandir* [Claim Number: FA0006000094990], Osho International Foundation (OIF), filed a complaint with National Arbitration Forum (NAF) against Osho Dhyam Mandir (ODM) based in Delhi, for the domain name www.oshoworld.com. Claiming to be rightful owner of the trademark 'Osho' by virtue of its registration with the United States Patent and Trademark Office, OIF pleaded for the transfer of the domain name from Osho

Dhyan mandir to OIF as OSHOWORLD.com is confusingly similar/identical to the complainants OSHO.com, OSHO.net and OSHO.org. ODM in its response pointed out the fact that Osho is not a valid trademark for materials by or regarding Osho. ODM maintained that as followers of Osho, ODM has an internationally recognised right to use the term Osho. NAF decided in favour Osho Dhyan Mandir to retain the domain name www.oshoworld.com. The Arbitrator observed that “To grant OIF’s request for relief would be to permit virtual monopolisation on the Internet by Complainant of any domain name which includes the name of a great spiritual teacher and leader.” While making no judgment on the relative merits or validity of the world’s religions or spiritual movements or any leader thereof, the penalist found that permitting this would be as improper as doing the same with Christianity, Judaism, Islam, Zoroastrianism, Hinduism, Buddhism, Taoism, Confucianism, Shintoism or any of the several hundred other of the world’s religions and/or spiritual movements.

In, *Tata Sons Ltd. v. The Advance Information Technology Association* [Case No. D2000-0049] the dispute was on the domain name www.tata.org. The word “TATA” was the corporate name and trade mark, of the complainant and its group of companies. The complainant and its group companies had interests in a diverse field of activities like automobiles, chemicals & pharmaceuticals, consumer products, metal, IT, etc. The Respondent was the registrant of the domain name www.tata.org with NSI but did get the Web site activated.

The complainant contended that potential customers would be induced to subscribe to the services offered by the impugned Web site believing them to be coming from or authorized by the complainant. Since the Web site was not activated even though it was registered for three years, it was found by the resolution provider ‘WIPO’ that the respondent is merely ‘hoarding’ the said domain name. It was further observed that even if a Web site under the said domain name had been activated, in the facts and circumstances of the case, it would still constitute dishonest adoption and misappropriation. It was also brought on record that the complainant had successfully obtained orders from courts in India in relation to domain names wherein Courts have granted orders of injunction against the defendants therein from using the domain names <tatagroup.com>, <bodacious-tatas.com>, <jrdtata.com>, <tatatata.com>, <tatahoneywell.com>, <tatateleservices.com>, <tatahydro.com>, <tatawestside.com>, <tatatimken.com>. Though these disputes were still pending at the time the decision was rendered, it was observed that they were prima facie evidence of the recognition of the complainant’s rights in the TATA name/mark. The panel decided that the respondent’s domain name www.tata.org was identical to the trade mark TATA in which the complainant had trade mark rights and the respondent had no legitimate interest in the said domain name. Terming the registration of www.tata.org as an instance of “bad faith registration”, the panel decided that the domain name should be transferred to the complainant.

12.6.3 Dispute Resolution: Traditional Litigation in Courts v/s Arbitration under UDRP

The advantage of ICANN’s dispute resolution system is its speed. Respondents must reply to a complaint within 20 days, and once the submissions are complete the panel has 45 days to issue its decision. A domain name case filed with WIPO is normally concluded within two months. There are no in-person hearings, except in extraordinary cases. The parties have the option of a panel of one or three arbitrators, selected from a list of ICANN-approved experts in intellectual property matters.

- ii. the Registrant has no rights or legitimate interests in respect of the domain name;
and
- iii. the Registrant's domain name has been registered or is being used in bad faith.

The Registrant is required to submit to a mandatory arbitration proceeding in the event that a complainant files a complaint to the .IN Registry, in compliance with this Policy and Rules thereunder.

The IN Registry shall appoint an Arbitrator out of the list of arbitrators maintained by the Registry. The Arbitrator shall conduct the Arbitration Proceedings in accordance with the Arbitration & Conciliation Act, 1996 as amended from time to time and also in accordance with this Policy and rules provided thereunder.

Let us now summarize the points covered in this unit.

12.8 SUMMARY

- A domain name is the linguistic counterpart of what is known as an Internet Protocol (IP) address.
- Broadly domain names are of two types — one, generic top-level domain (gTLD); two, country code top level domains (ccTLD).
- Domain names have acquired the same importance as that of trademarks for identifying a business or an entity.
- Bad faith registration of a trademark belonging to another is known as cybersquatting.
- Mainly, domain name disputes could either be resolved by litigation in a court of competent jurisdiction or referring the matter to arbitration under the UDRP.
 - The Supreme Court of India is of the view that Law of trademarks and passing off applies to domain name disputes.
 - Domain name disputes could also be referred to resolution by arbitration under the UDRP.
 - In India, for the .IN category disputes could be referred to arbitration under the dispute resolution policy framed by C-DAC.

12.9 TERMINAL QUESTIONS

1. Write a note on the case *Satyam Inforway Ltd. v. Sifynet Solutions (P) Ltd.* [2004 (28) PTC (SC) 566].
2. What do you mean by cybersquatting? What are the reasons for its prevalence in cyberspace?
3. Write a detailed note on the UDRP as to how domain name disputes could be resolved under this policy.

12.10 ANSWERS AND HINTS

Self Assessment Questions

1. A domain name is the address of a website like www.tata.com is the address of the famous business house TATA. The purpose of domain name is to locate a webpage on the Internet.
2. a) generic top level domain (gTLD)
b) Country code top level domain (ccTLD).
3. The practice of registering and cleaning right over internet domain names that are arguably not for the taking is known as cyber squatting.
4. See sub section 12.5.3.

Terminal Questions

1. Refer to section 12.5 of the unit.
2. Refer to section 12.4 of the unit.
3. Refer to sub section 12.5.2 of the unit.