

## TRADEMARK CYBER-SQUATTING LAWS IN INDIA

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### ABSTRACT

As defined by the National Institute of Standards and Technology, “cybersquatting is registering an Internet domain name that is likely to be desired by another person, corporation, or organisation in the hopes of selling it to them for a profit. It entails the registration of trademarks and trade names as domain names by third parties that do not have any rights in the aforementioned names, therefore it is illegal.” In this article, the author examines the concepts of domain names and cybersquatting, as well as their legal implications in India and on a global scale. During the previous decade, cybersquatting has expanded dramatically, and it has had disastrous consequences for the rights of intellectual property holders. This page will present an overview of the issue and the elements that contribute to it, as well as examples of cybersquatting cases, forms of cybersquatting, and the legal landscape in India and other countries.

**Keywords:** Trademark, Cyber-Squatting, Domain.

### INTRODUCTION

The intellectual property right is a type of legal right that the owner has that protects their creation, invention, symbol, or design, among other things, so that they can enjoy their property without being disturbed by others by prohibiting a third party from using or copying them for a specified period of time. Intellectual property is an intangible asset that is created as a consequence of human ingenuity. There are many different sorts of Intellectual Property, such as patents, trademarks, and copyright, among others. A person's intellectual property right grants him or her the exclusive right to utilize his or her invention, which implies that no one else may duplicate or use that invention without the prior consent of the creator.

Intellectual property rights confer ownership of an inventive product on the individuals who have acquired these rights. A trademark is defined as a name, symbol, or word that distinguishes one person's products from those of another in accordance with intellectual

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property legislation. It serves as a marketing tool for the company, assisting in the expansion of the company's financial capabilities. Because of technological advancements, practically all corporate organisations are now able to conduct their operations on the internet as well. They will need a domain name in order to do this. The domain name is the address of a company or organization's website, which allows web users to quickly locate a company or organisation on the internet. A name computer has no notion where to search for a web page if it does not have a domain name. As a result, a domain name is often considered a brand, and it should be trademarked to protect it from being misappropriated. Cybersquatting is an issue that almost every online business organisation with a well-known domain name has to deal with on a regular basis.

## **CYBERSQUATTING**

Cybersquatting is the activity of acquiring domain names that are similar to the names of existing companies with the intention of reselling the names to such firms for a profit. As a result of this activity, cybersquatters or domain squatter register trademarks, trade names, company names, and other similar names with the purpose of earning from the goodwill associated with someone else's brand and then selling the domain name back to the original owner for a profit.

## **DOMAIN NAME**

The domain name is a one-of-a-kind moniker that is used to distinguish a certain website from others. In order to view a specific website, a person must put the website's address into the browser's URL bar (also known as the address bar). It is comprised of two distinct parts. In the case of whatsapp.com, the domain name is comprised of the website's name (WhatsApp) and the domain name extension (.com). It may be any combination of characters and digits, and it may be used in conjunction with any of the numerous domain name extensions, such as .com, .net, and others, to create a unique website address. A domain name facilitates the process of locating a certain web page and sending emails. Without a domain name, a computer would have no way of knowing where to seek a web page, and e-mail routers would be unable to transmit emails. It is absolutely necessary to register a domain name before one may begin using it. Every website has a unique domain name, which means that no two websites may have the same domain name at the same time.

## **HISTORY OF CYBERSQUATTING**

The well-known practice of cybersquatting comes into play since most commercial organisations are unaware of the extent to which their operations might be conducted on the internet.<sup>1</sup> For the time, cybersquatters took advantage of the situation and registered domain names in the names of well-known corporations with the goal of reselling such domain names to the corporations at a substantial profit. Panasonic, Avon, and Hertz are just a few of the organisations that have been the victims of cybersquatting in the past. However, the possibility for cybersquatting is reducing as more and more businesses recognise the worth of domain names and consider them as high-priority assets.

“The administration of top-level domain names is overseen by the Internet Corporation for Assigned Names and Numbers (ICANN), which serves as a domain name regulatory authority. It is necessary to contact the administrator of the TLD in order to get a domain name; if the exact desired domain name has not already been allocated to another person, the name will only be granted once it has been verified that it has not previously been granted to another person.” There is a precise registration procedure that must be followed. The Internet Assigned Numbers Body (IANA) is the major internet authority responsible for allocating IP addresses and domain names via the IANA.

## TRADEMARK CYBERSQUATTING IN INDIA

For the first time in many industrialized nations, India does not have a separate domain name protection law and actions involving cybersquatting are determined and dealt with under the Trade Marks Act, 1999. The Supreme Court of India has stated in *Satyam Infoway Ltd vs Sifynet Solutions Pvt. Ltd.*<sup>2</sup> that the government should be held accountable “India does not have any statute that specifically relates to dispute settlement in the context of domain names, and this is a problem. However, even though the operation of the Trade Marks Act, 1999 is not extraterritorially applicable and may not provide adequate protection for domain names, this does not rule out the possibility of domain names being legally protected to the extent possible under the laws relating to passing off.”

<sup>1</sup> Singh & Associates, *Cyber-Squatting Laws in India*, <https://www.mondaq.com/india/trademark/208840/cyber-squatting-laws-in-india> (last visited on 14 June, 2021).

<sup>2</sup> *Satyam Infoway Ltd vs Sifynet Solutions Pvt. Ltd.* AIR 2004 SC 3540

## UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP)

“A Uniform Domain Name Dispute Resolution Policy (UDRP) has been established by the Internet Corporation for Assigned Names and Numbers (ICANN), a domain name regulating organisation, to deal with complaints concerning bad faith registrations (Cybersquatting).” It is the procedure for resolving disputes over the registration of domain names on the internet. All generic top-level domains are covered by the UDRP (.com, .net, .org, etc.). It lays forth the terms and circumstances in the event of a dispute over the registration and use of an Internet domain name between the registrant and anybody other than the registrar. The following are some of the UDRP providers:

“1. The Asian Domain Name Dispute Resolution Centre (ADNDRC)

2. National Arbitration Forum (NAF)

3. World Intellectual Property Organization (WIPO)

4. Czech Arbitration Court, Arbitration Center for Internet Disputes

5. The Arab Center for Dispute Resolution (ACDR)”

“In order to prevail in a UDRP process, a complainant must ensure that the following components are present: that the domain name in dispute is identical or confusingly similar to a trademark or service mark in which the complainant has rights; The registrant of the domain name does not have any rights or legitimate interests in the domain name.” In a UDRP process, the panel will examine a number of elements in determining whether or not there has been bad faith (Cybersquatting).<sup>3</sup> For further information, please see the following: To determine whether the registrant's registration of the domain name was principally intended to facilitate the sale or other transfer of the domain name registration to the complainant, who is the registered trademark or service mark holder; To determine if the registrant's registration of the domain name was done mainly for the aim of interfering with a competitor's company. “Many jurisdictions allow a losing party to file a lawsuit against the losing party's domain name registrant under local law, and if a domain name registrant loses a UDRP proceeding,

<sup>3</sup> John Mckeown, How To Use UDRP Proceedings To Fight Cybersquatting And Cyberpiracy!, <https://www.mondaq.com/canada/trademark/1005666/how-to-use-udrp-proceedings-to-fight-cybersquatting-and-cyberpiracy> (last visited on 14 June, 2021).

the registrant is required to file a lawsuit against the losing party's trademark holder within ten days in order to prevent ICANN from transferring the domain name.”<sup>4</sup>

### **IN DISPUTE RESOLUTION POLICY (INDRP)**

It is under the jurisdiction of the National Internet Exchange of India, often known as NIXI, that the top-level domain is administered. As a result, the .IN Dispute Resolution Policy and the INDRP Rules of Procedure are responsible for resolving disputes involving .in domain names in India. “A complaint to the .IN Registry may be filed for any of the following reasons, according to the regulations of the INDRP, by any person who believes that a registered domain name interferes with his or her legitimate rights or interests. The domain name in dispute is identical or confusingly similar to a trademark or service mark in which the complainant has rights; the domain name registered by the registrant does not have any rights or legitimate interests in the domain name; the domain name in dispute must be registered and the domain name is being used in bad faith; the domain name in dispute must be registered and the domain name is being used in bad faith.”

### **ROLE OF JUDICIARY IN CYBERSQUATTING CASES**

The Trade Marks Act 1999, as previously noted, governs the instances of cybersquatting, and the cases are determined and dealt with in accordance with the Trade Marks Act 1999.<sup>5</sup> In any other matter under the Trade Marks Act of 1999, the aggrieved party has the option of pursuing one of two types of redress. They are as follows:

- Infringement remedies- According to the Trademark Act, 1999, the remedy for trademark infringement is only accessible to the trademark owner if the trademark is registered.
- Remedy of Passing off- When it comes to the remedy of passing off, however, there is no need for the owner to register a trademark in order to use the remedy.

### **SOME LANDMARK JUDGEMENTS**

<sup>4</sup> WIPO, ‘Wipo guide to UDRP’, <https://www.wipo.int/amc/en/domains/guide/> (last visited on 14 June, 2021).

<sup>5</sup> Trade Marks Act 1999, <https://ipindia.gov.in/writereaddata/Portal/ev/TM-ACT-1999.html> (last visited on 14 June, 2021).

- **Rediff Communication Limited v. Cyber booth and Anr.**<sup>6</sup>

A preliminary injunction was issued by the Bombay High Court in this case, prohibiting the defendant from using the domain name “RADIFF” or any other similar name in the future, as When both domain names are examined, it was found that internet users may be misled and misled into thinking that both domain names are linked to the same common source and connection.

- **Sbicards.com v. Domain Active Property Ltd.**<sup>7</sup>

The World Intellectual Property Organization (WIPO) ruled that Sbicards.com be transferred to an Indian company from an Australian organisation that had stolen the domain name with the intention of subsequently selling it at a profit to a subsidiary of the State Bank of India. The board agreed with the argument made by SBI Card lawyers that "the Australian company was in the business of acquiring and selling domain names via its site" according to the board.

- **Aqua Minerals Limited v. Mr. Pramod Borse & Anr**

A trademark “bisleri” had been registered in India by the plaintiff in this case, which made him the registered owner of the brand. The defendant Mr. Pramod Borse & Anr registered the domain name www.bisleri.com in its name, which is the subject of this lawsuit.” The Delhi High Court ruled that the defendant had committed trademark infringement and granted the plaintiff permission to seek the transfer of the website that was registered in its name.

- **Yahoo!, Inc. vs Akash Arora**<sup>9</sup>

This was the first instance of cybersquatting to be brought before the Indian Courts in the country. “In this particular instance, the defendant was providing Internet-related services under the domain name yahooindia.com, which is confusingly similar to the plaintiff's trademark Yahoo.com, which was confusingly similar to the defendant's trademark Yahoo.com., When it comes to bringing a passing off action, the court noted that the degree of resemblance between the marks is critical and substantial and that in this instance there is

<sup>6</sup> Rediff Communication Limited v. Cyber booth and Anr. AIR 2000 Bombay 27.

<sup>7</sup> Sbicards.com v. Domain Active Property Ltd (2005 (31) PTC 455)

<sup>8</sup> Aqua Minerals Limited Vs Mr. Pramod Borse & Anr AIR 2001 Delhi 463, 93 (2001) DLT 203

<sup>9</sup> Yahoo!, Inc. vs Akash Arora 1999 IIAD Delhi 229, 78 (1999) DLT 285



every prospect and probability that confusion and deceit would be produced by the markings. After taking a look at both domain names, it is clear that the two are identical or similar in nature, and there is a good chance that an Internet user will be confused and deceived into believing that both domain names belong to the same owner, when in fact the domain names belong to two different individuals. The plaintiff was successful in obtaining an interim injunction prohibiting the defendant from using the domain name Yahooindia.com or any other trademark or domain name that is confusingly similar to the plaintiff's brand in the future.”

## CONCLUSION

The practise of cybersquatting is becoming more prevalent as the number of internet businesses grows. To penalise those who commit this crime, more stringent legislation is necessary. The government of India, like many other nations, should enact specific legislation to deal with these kinds of crimes in order to prevent them from recurring again. An additional alternative for the plaintiff to seek statutory damages should be made available to him or her. Legislation should be passed to safeguard the rights of trademark owners in the virtual world as well, as a result of which such rights will be effectively protected.

