

## DOMAIN NAME IN THE WORLD OF INTELLECTUAL PROPERTY

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### **ABSTRACT**

*A domain name is a term usually familiar with the area of coding, or generally computer science. A domain name is basically an internet address, a unique combination of words displayed on the address bar of a website. This displayed address is said to be that website's domain name. Using the said domain name, you can directly access the said website. The terminology domain name has recently gained a lot of impetus in the field of marketing and branding on online portals. This is because firstly they take the users directly to the desired website. Secondly, they make it feasible and convenient for the users to identify their desired brand from the other brands available on the web, making it very easy for the customer or the viewer to identify and access the brand. Thus, due to sudden growth in the e-commerce sector, these domain names haven't just remained website addresses but have evolved into business identifiers or business distinguishers and thereby fall under the ambit of trademarks under Intellectual Property.*

### **DEFINITION**

A domain name is a distinctive set of words or combination of words, letters, numbers, and characters that have a prefix and suffix attached to it. For e.g., [www.investopedia.com](http://www.investopedia.com) here Investopedia is the domain name, www is the prefix and .com is the suffix. The entire composition in general is addressed as a Domain name. The arrangement of the domain name can be split into two parts, one – top level domain(TLD) and the other a second level domain(SLD). In the above example, the expression .com forms the TLD, and Investopedia is the SLD. This Domain name is simply an address which is used to access a website. Nowadays with the rise of Commercial activities these domain names especially the SLD have been made user friendly and identical to business brands for easier identification of the brand by the viewers, thereby becoming an identifying and distinguishing factor of the business on the internet and hence have gained importance. This new understanding of domain names has been added to the legal definition of a domain name through *Satyam Infoway Ltd. vs. Siffynet Solutions*, the Hon'ble Court held that “A domain name is easy to remember and use, and is

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*chosen as an instrument of commercial enterprise not only because it facilitates the ability of consumers to navigate the Internet to find websites they are looking for, but also at the same time, serves to identify and distinguish the business itself, or its goods or services, and to specify its corresponding online Internet location”.*<sup>1</sup> This domain name can simply be understood, to be a unique combination that locates a website as well as distinguishes it from other websites, and helps the viewers in identifying the business enterprise or any enterprise, the said website is associated with.

## **IMPORTANCE OF DOMAIN NAMES IN TRADE**

The rapid evolution of online commercial activities has opened the door for several technical terms in the areas of marketing, advertising, and promotion of brands. The technical terms don't only comprise the domain name but also include meta tags, browser words, and many more technical terminologies which now play a vital role in the marketing of brands on the internet. These terminologies are used by the users for the identification of a particular brand they are in search of. Domain names in particular, play a very vital role as the first thing a person searches for while looking for a brand is the brand name itself or any name in its association and selects out of the options displayed, the results having a domain name either as the brand name or similar to it. Thus, domain names have become a very essential part of the commercial activities of businesses on the Internet. The domain names are no longer just internet website addresses but with time are being designated as business identifiers.

Journal of Legal Research and Juridical Sciences

## **ASSOCIATION WITH TRADEMARKS**

Domain names as are now known to be business identifiers are often considered to be a part of a trademark, as trademarks in themselves are visual identifiers that differentiate the products or services of one entity from those of others. Thereby trademark being an umbrella term is considered to now include domain names as well, this has been developed through common law judgments and through statutory interpretation and inference of provisions that have been explicitly stated under the statutes.

In the Indian domain, names are regarded as trademark entities, because as per the definition of trademark provided under section 2(zb) “*trademark*” means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one

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<sup>1</sup> (<https://indiankanoon.org/doc/1630167/>)

*person from those of others and may include the shape of goods, their packaging, and combination of colours”.*<sup>2</sup>

With a casual reading of the definition as well as with the knowledge that the domain name has now evolved to be business distinguishers, they do fall under the title of trademarks as was also held in *Satyam Infoway Ltd. v. Sifynet Solutions*<sup>3</sup> where an issue was raised as if the domain name can be considered a word which is capable of differentiating the trade/service which is supplied to the users on the internet and does the same confer any Intellectual Property Rights?

The court opined that the domain name is defined to be a website address but due to an increase in internet commercial activities, it has gained a different value of being an identifier and distinguisher of business enterprises. It is used in quite a few commercial activities like for trade, promotions, and advertisement on the web has made domain names more valuable. Its involvement in trade and commerce has given it a designation under trademarks. The court also stated that domain name would also be considered as providing a service on the web/internet and thereby also come under service marks. In India domain names are governed under trademark law itself, the Trade Mark Act, 1999, and Trade Marks Rules, 2002.

### **TRADEMARK REGISTRATION FOR DOMAIN NAME**

Domain names are registered in Domain Name System (DNS) nationally as well as internationally, in accordance with the rules and procedures of DNS. DNS basically stores these domain names and once accessed by the users i.e., once the domain name is clicked, it directs the computer to the website and the domain name changes to an IP address this conversion or transformation is done by the Domain Name System. The DNS is basically a directory, which regulates the forming and accessing of domain names. Any name registered under this system is said to be a domain name i.e., any name which is registered in this system becomes a domain name. This is simply the registration of domain names in their capacity of being a website address.

Now registration of domain names with respect to them being business promoters, distinguishers, and identifiers is not governed by a separate statute nationally nor is there a separate global treaty that deals with domain names exclusively. Hence nationally, and to a certain extent international domain name is considered to be under the trademark category of

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<sup>2</sup> The Trademark Act, 1999. (<https://indiankanoon.org/doc/1190072/>)

<sup>3</sup> (<https://indiankanoon.org/doc/1630167/>)

intellectual property and not under a category of their own. Nationally domain names are governed by the Trade Marks Act, 1999<sup>4</sup>, and the Trade Marks Rules, 2002<sup>5</sup>. Internationally the trademarks are registered under the Internet Corporation for Assigned Names and Numbers (ICANN).<sup>6</sup>

## **REGISTRATION CRITERIA'S**

The domain names are registered as a trademark only if they are really the subject matter of their business identification on the internet.

The registration of domain names as is done in accordance with it being a trademark has to fulfill all the requirements present for the registration of trademarks<sup>7</sup>:

- uniqueness - are not generic or suggestive, or of any sort with respect to section 9 of the Act.<sup>8</sup>
- distinguishing factor-it is of such a composition that it distinguishes the goods/ service provided by the individual or entity from that of the other.
- source of identifier- It is of such a combination that on reading or viewing the same a person associates it to its source, brand.

It should not also be violative of the provisions of section 11 of the Act.<sup>9</sup>

The domain names would be granted registration only if the essentials of a trademark are fulfilled and once provided with registration all the rights which flow to a trademark owner can be retained by the owner of such domain names.

## **DIFFERENT MANAGING BODIES INVOLVED WITH RESPECT TO DOMAIN NAMES**

DNS- Domain Name System. A computer system that sources out domain names that are which allow individuals to create domain names. A system in which any name registered if accepted

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<sup>4</sup> Trademark Act, 1999 would be henceforth referred to as "the Act".

<sup>5</sup> The Trade Mark Rules, 2002 would be hence forth referred to as "Rules of 2002".

<sup>6</sup> (<https://www.icsi.edu/media/webmodules/publications/9.4%20Intellectual%20Property%20Rights.pdf>)

<sup>7</sup> ([https://legislative.gov.in/sites/default/files/A1999-47\\_0.pdf](https://legislative.gov.in/sites/default/files/A1999-47_0.pdf))

<sup>8</sup> (<https://indiankanoon.org/doc/1158841/>)

<sup>9</sup> (<https://indiankanoon.org/doc/1558275/>)

by the System becomes a domain name. The system is the middleman through which on clicking on the domain name you go to a website, DNS facilitates that, the transformation.

ICANN- Internet Corporation for Assigned Names and Numbers. It is a private, non-government, non-profit corporation having participants from all over the world. It was formulated with the objective to keep the Internet secure and stable. It is responsible for the management and functioning of the domain name system as well as the protection of domain names.

UNDRP- Uniform Domain Name Dispute Resolution Policy. The policy was formulated by ICANN on the recommendation of WIPO for the protection of domain names throughout the world.

INDRP-.IN Domain Name Dispute Resolution Policy. The Ministry of Information Technology adopted this policy in consonance with UNDRP. This only allowed domain names with extensions .in and .co.in registration but now irrespective of such contention registration is granted, if the trademark requirements as per the act, common law, and rules are fulfilled by the domain name claiming registration.

NIXI- National Internet Exchange of India. The organisation is entrusted with the registration of the domain names and is responsible to maintain the.IN registry. The law has developed much in the field of a domain name, in recent years and has made it very feasible for business enterprises, individuals, commercial entities, or any sort of organisation, in general, to register their domain names on fulfilling the required essentials and gain the rights which flow from them.

## **PROTECTION OF DOMAIN NAMES**

Domain names being business identifiers need protection from malafide practices carried out by entities to own profit under the well-established trademark or to create confusion amongst the viewers, with respect to the source of the website. These deceitful entities try to generate huge revenues through advertisements on these fake websites. These actions carried out by entities to deceive the public at large need to be checked as well as justice has to be done towards the loss of business incurred by the well-established entities or even upcoming entities or any trademark proprietor in the e-commerce sector.

Domain names aren't protected under any law in India, that is no explicit law or any law is mentioning the protection of domain names but they derive protection from the Act and Rules of 2002, as it is designated as a trademark or a service mark through common law judgements. A reference can be made to *Satyam Infoway Ltd. vs. Sifynet Solutions Pvt. Ltd* which held “ *As more and more commercial enterprises trade or advertise their presence on the web, domain names have become more and more valuable, and the potential for dispute is high. It is apparent, therefore, that a domain name may have all the characteristics of a trademark and could find an action for passing off.*”<sup>10</sup>

In the recent matter of *Sporta Technologies Pvt. Ltd. and Anr. v. Virat Saxena* the Hon'ble Court held that using the domain name “dream11.bet” by the defendant is capable of causing confusion and association of it to the original mark of the plaintiff and thus were held liable for infringement and passing off.<sup>11</sup>

*The domain names that seem to have the characteristics of a trademark would be protected the same way a trademark is protected.*

### **PROTECTION OF REGISTERED DOMAIN NAMES**

*Domain names that are registered through ICANN after the adoption of the UNDRP as well as with respect to other trademark treaties can be protected globally against infringement or passing of or both. They are treated the same way a registered trademark would be dealt with, though the procedures, authorities, and management of registration are different on an international level the essentials of registration, as well as the criteria of protection, are in consonance with those of a trademark. Nationally a registered domain name can avail all the protections the trademark can under the Act and the Rules of 2002. Even nationally the procedure of registration and authorities managing the registration of domain names can differ, now since the 2005 amendment domain names having any expression and not just .in and .co.in can be registered through the INDRP or the Act itself and the registered domain names are maintained by NIXI (National Internet Exchange of India). Registered trademark proprietors can sue for infringement or passing off or even for both similarly even domain name proprietors can avail these rights to sue and the right to claim various remedies with respect to them like injunction, damages, interim injunction, and many more.*

<sup>10</sup> ((<https://indiankanoon.org/doc/1630167/>))

<sup>11</sup> ([https://www.livelaw.in/pdf\\_upload/dream11-trademark-446618.pdf](https://www.livelaw.in/pdf_upload/dream11-trademark-446618.pdf))

## PROTECTION OF UNREGISTERED DOMAIN NAMES

Unregistered domain names can claim prior use and well-known marks defense for the protection of their domain names. Here as being unregistered, they would have to show their existence in the commercial market prior to that of the defendants for availing of the passing off common law remedy, if the disputed domain name satisfies the essentials of being a trademark. Unregistered domain names only have protection against passing off and not infringement as they are protected the same way unregistered trademarks are protected. The protection of unregistered trademark has developed in common law on passing off principle as the Act under section 27(1)<sup>12</sup> which specifically say that to avail protection against infringement the trademark must be registered.

### PROTECTION

Domain names are given protection whenever there has been unauthorised use of these marks. The following are considered to be the unauthorised use of domain names:

**Infringement:** Infringement is defined under section 29 of the Act<sup>13</sup> in accordance with which if a person not the proprietor of a trademark or has not been granted any sort of permission by the proprietor to use and uses the same or uses a mark similar to such trademark irrespective of knowing if such action of his would cause confusion amongst the target audience. If actions similar to the ones described above are done with respect to a domain name the registered proprietor of the trademark, domain name here, has the exclusive right to sue for infringement of the trademark as per section 28(1) of the Act<sup>14</sup>. Domain names have been given this protection under the Act by the Courts, a reference can be made to the *Rediff Communication Limited v. Cyberbooth & Anr.*<sup>15</sup> Where in the court observed that by using a similar domain name the defendants has infringed upon the plaintiff's registered domain name.

**Passing off:** Passing off is a common law remedy laid down under *Perry v Truefitt* which is based on the principle that “*nobody has the right to represent his goods as the goods of somebody else.*”<sup>16</sup> When a domain name identical or similar to that of the other business entity,

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([https://indiankanoon.org/doc/1580823/#:~:text=\(1\)%20No%20person%20shall%20be,of%20an%20unregister@d%20trade%20mark.](https://indiankanoon.org/doc/1580823/#:~:text=(1)%20No%20person%20shall%20be,of%20an%20unregister@d%20trade%20mark.))

<sup>13</sup> (<https://indiankanoon.org/doc/84096/>)

<sup>14</sup> (<https://indiankanoon.org/doc/667743/>)

<sup>15</sup> 1994 (4) BomCR 278 (<https://indiankanoon.org/doc/806788/>)

<sup>16</sup> 49 E.R. 749 (1842) 5 Beav. 66

is used and is creating an impression that the identical or similar domain name is of the latter then it is said to be passing off. This is the only remedy available to trademarks that are not registered because Section 27 (1) of the Act<sup>17</sup> states that no person shall have the right to sue for the infringement of an unregistered trademark. In *Yahoo!, Inc. vs. Akash Arora & Anr*<sup>18</sup>. As the domain name yahoo.com wasn't registered in India though being registered in other countries the defendants were made liable for passing off and not infringement.

**Cybersquatting:** Cybersquatting hasn't been defined under any statute nor has there been any reference to cybersquatting in any of the statutory laws. This is a recent concept being evolved, the Kerala High court in the case of *Pen Books Pvt. Ltd. v. Padmaraj* for the very first time defined the act of cybersquatting as "Obtaining fraudulent registrations with an intent to sell the domain name to the lawful owner of the domain name at a premium"<sup>19</sup>. When an entity tries to register a domain name similar to that of a domain name or trademark of a well-known business enterprise with the mere intention to cause confusion amongst the public to such an extent that the business enterprise has to pay them off and buy the domain name, this is called cybersquatting. It doesn't have specific reliefs defined to it as there are for infringement and passing off under Section 135 of the Act<sup>20</sup> but is for now covered under passing off and infringement.

These are a few of the discovered common unauthorised actions against which domain name proprietors have certain rights and reliefs.

## CONCLUSION

Domain names have developed a distinctive meaning through the growth of the e-commerce sector, this unique characteristic of distinguishing the goods/services provided by an entity from those of others have made them fall under the ambit of trademark and eventually in the world of Intellectual property. Domain names are an evolving set of Intellectual property that is gaining much impetus and importance, there are new aspects of these sects being discovered like cybersquatting which might make cybercrime rules also applicable if certain facts and circumstances of the case touch those laws, and as the design was carved out to be a separate

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<sup>17</sup> (<https://indiankanoon.org/doc/262896/>)

<sup>18</sup> (<https://indiankanoon.org/doc/1741869/>)

<sup>19</sup> (<https://indiankanoon.org/doc/411013/>)

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([https://indiankanoon.org/doc/114856/#:~:text=\(1\)%20The%20relief%20which%20a,any%20order%20for%20the%20delivery%2D](https://indiankanoon.org/doc/114856/#:~:text=(1)%20The%20relief%20which%20a,any%20order%20for%20the%20delivery%2D))



intellectual property from patents, Domain names might result into being a separate category of Intellectual Property.

