

A CRITICAL ANALYSIS OF THE REGULATORY FRAMEWORK RELATING TO CYBERSQUATTING IN INDIA

*Dr. Anis Ahmad**

*Nikki Kumar***

ABSTRACT

The advent of the internet has brought an explosion in the process of registration of domain names that has resulted in the issue of cybersquatting for financial gain. As per the WIPO data, the cases related to domain name disputes have dramatically increased. For the first time in 1999, the ICANN adopted a uniform policy framework (UDRP) to address the problem of cybersquatting for speedy disposal of domain name disputes. At the global level, only the United States of America has specific legislation to make cybersquatting a crime. In the Indian context, there is no specific legislation to tackle cybersquatting matters, the courts apply the various approaches as well as the common law principle of the trademark to resolve the disputes. The article wishes to critically analyze the international and national legal and policy frameworks related to cybersquatting.

Keywords: *Domain Name, Cybersquatting, ICANN, UDRP, Trademark.*

* Associate Professor, Department of Law, Babasaheb Bhimrao Ambedkar University, Lucknow (UP)-226025, India. <Anisbbau@gmail.com>

** Research Scholer, Department of Law, Babasaheb Bhimrao Ambedkar University, Lucknow (UP)-226025, India. <Nik.legal21@gmail.com>

INTRODUCTION

The amazing expansion of the Internet as a commercial medium has given rise to a new set of challenges in the field of intellectual property.¹ The last two decades have witnessed the extraordinary blast of the internet and the related upheaval of web-based business. With the increase in the popularity of the internet, companies have realized the importance of the web to expand their business. Now internet users and companies are rushing to register every possible combination of their business name as a domain name.²

Domain names are a simple and human-friendly form of an internet address that enables the user to easily locate and remember the address.³ With the increase in business on the internet, high-street retailers have gradually realized the potential of this vast market and have begun to integrate an online presence alongside their 'bricks-and-mortar' stores. On the other hand, new technology brings new opportunities to exploit, and as a result, a new breed of cybercriminals has emerged. Cybersquatting is a specific dispute that has gotten a lot of attention from the courts and that policymakers have been eager to address.⁴

¹ Kenneth Sutherland Dueker, "Trademark Lost in Cyberspace: Trademark protection for Internet addresses" 9 *Harvard Journal of Law* 483 (1996).

² Kevin Cheatham, "Negotiating a Domain Name Dispute: Problem Solving v. Competitive Approaches" 7 *Willamette Journal of International Law and Dispute Resolution* 35 (2003).

³ Shahid Alikhan & Raghunath Mashelkar, *Intellectual Property and Competitive Strategies in the 21st Century* 194 (Kluwer Law International, Netherland, 2nd edn., 2007).

⁴ Mairead Moore, "Cybersquatting: Prevention better than Cure?" 17 *International Journal of Law and Information Technology* 220 (2008).

Cybersquatters took advantage of the internet's growing importance and lack of business understanding, to register domain names that were identical to business trademarks. Businesses suffer financial losses as a result of cybersquatting and a tarnished reputation. The domain name dispute cases filed with the WIPO have increased dramatically over the years. According to data available at WIPO, in 2019 the WIPO registered 3693 cases, while in 2020 the cases increased to 4204, and the year 2021 witnessed a sudden surge in the cases and the number of disputes registered with the WIPO was 5128. As of June 2022, the WIPO has registered 2709 domain name dispute cases. WIPO saw another record year in domain name dispute filings, administering nearly 6200 complaints in 2023, an over 7% increase from 2022 and a 68% increase since the onset of the COVID-19 pandemic.⁵

For the speedy disposal of domain name dispute cases, the Internet Corporation for Assigned Names and Numbers (ICANN)⁶ in October 1999, adopted the Uniform Domain Name Dispute Resolution Policy (UDRP), designed to provide a quick resolution of domain name disputes. The UDRP permits a trademark owner to challenge any domain name that is confusingly similar or identical to his mark.⁷ It was created to give a reasonably rapid, efficient, and low-cost alternative to infringement or passing-off

⁵ Total number of cases per year, *available at*:

<https://www.wipo.int/amc/en/domains/statistics/cases.jsp> (last visited on December 31, 2023).

⁶ is a non-profit organisation, created in 1998 for the management of the Domain Name System (DNS).

⁷ Patrick D. Kelly, "Emerging Patterns in Arbitration Under the Uniform Domain Name Dispute Resolution Policy" 17 *Berkeley Technology Law Journal & Berkeley Centre for Law and Technology* 181 (2002).

proceedings. Apart from the UDRP, the United States of America has enacted the sui generis system i.e., the Anti cybersquatting Consumer Protection Act, 1999 (ACPA), making cybersquatting a crime. Whereas in countries like India and the United Kingdom, there is no specific legislation to tackle cybersquatting cases, the courts apply the common law principle of the trademark to resolve the dispute. Keeping in view the above facts, the present paper is a humble attempt to analyse the problem relating to cybersquatting and the existing legal framework at an international and national level to deal effectively.

CYBERSQUATTING: CONCEPTUAL FRAMEWORK

Whenever a trademark and a trading name of someone else are registered by an unauthorized or unconnected person as his domain name, it is called cybersquatting. The Anti cybersquatting Consumer Protection Act, 1999 of the United States defines cybersquatting as, “The registration, trafficking in, or use of a domain name that is identical or confusingly similar to a trademark or service mark of another that is distinctive at the time of the registration of the domain name, or dilutive of a famous trademark or service mark of another that is famous at the time of the registration of the domain name, without regard to the goods or services of the parties, with the bad-faith intent to profit from the goodwill of an other’s mark”.

The concept of cybersquatting also known as domain squatting, is the practice of registering domain names, especially well-known company or brand names or trademarks, in the hope of reselling them at a profit. It is used to describe an individual or company who intentionally purchases a

domain and holds that domain with the sole intention of selling it at a premium price. Cybersquatting is further divided into four categories, Typo-squatting (typo-squatters takes advantage of typing errors that consumers make while trying to visit websites, for example, the domain name for Google is “google.com”, thus typo-squatting maybe, ‘goggle.com’, ‘goole.com’, etc.), Name Jacking (is the registration of a domain name that is associated with any individual, who is a well-known celebrity or well-known public figure), Identity Theft (purchase a domain that was unintentionally not renewed by the previous owner) , and Reverse Cybersquatting (includes coercion and pressure to transfer the legitimate possession of a domain name to the person or organization that owns a certified trademark mirrored in the domain name).

The problem of cybersquatting impacts businesses in various ways. Firstly, the cybersquatters confuse and change the behaviour of the consumers. Secondly, it restricts the rightful owners of the business to expand their business across the globe. Thirdly, it causes a loss of revenue as it restricts businesses to engage in online transactions. Let’s analyze the approach of the USA, UK, India, and the ICANN’s Uniform Domain Name Dispute Resolution Policy (UDRP) in Tackling cybersquatting disputes.

DIFFERENT APPROACHES

(A) THE UDRP APPROACH:

Apart from the traditional litigation, the ICANN (managing authority for DNS) was also proactive in terms of tackling the cybersquatting

cases.⁸ In June 1998 the World Intellectual Property Organisation (WIPO) accepted the US government's proposal for the development of a consistent international approach to the resolution of domain name disputes. Within a year, WIPO published a report concluding that ICANN should create a uniform administrative procedure for the resolution of disputes concerning top-level domain name registration. ICANN adopted Uniform Domain Name Dispute Resolution Policy (UDRP)⁹ on August 26, 1999, and was implemented on October 24, 1999.

The UDRP sets out the legal framework for the resolution of disputes between a domain name registrant and a third party (a party other than the registrar) over the abusive registration and use of an Internet domain name in the generic top-level domains (gTLDs) and those country code top-level domains (ccTLDs) that have adopted the UDRP policy voluntarily.¹⁰

The UDRP is designed to resolve the dispute between the trademark holder and the domain name registrant. To initiate the administrative

⁸ Lisa M. Sharrock, "The Future of Domain Name Dispute Resolution: Crafting Practical International Legal Solutions from within the UDRP Framework" 51 *Duke Law Journal* 818 (2001).

⁹ Full text of UDRP is available at: <https://www.icann.org/resources/pages/policy-2012-02-25-en> (last visited on May 21, 2023).

¹⁰ WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP), available at: <https://www.wipo.int/amc/en/domains/guide/#:~:text=The%20UDRP%20Administrative%20Procedure%20is%20only%20available%20to%20resolve%20disputes,against%20a%20domain%20name%20registrant> (last visited on Oct 25, 2023).

proceeding under the UDRP the complainant must prove that each of these three elements is present:¹¹

- a. the registered domain name is identical or confusingly similar to a trademark or service mark in which the complainant has right, and
- b. the registrant has no rights or legitimate interests with respect to the domain name, and
- c. the domain name has been registered and is being used in bad faith.

To prove the bad faith of the registrant of a domain name, the complainant can give evidence to establish that, the registrant has registered the domain name primarily for selling or renting it to the complainant, or registered it to prevent the trademark owner from using the mark in a corresponding domain name, or registered it to disrupt the business of a competitor, or registered the domain name for the commercial gain by creating a likelihood of confusion in the minds of Internet users.¹²

The UDRP proceedings do not apply if the registrant can prove that he is known by the registered domain name, or he used the domain name in connection with a bona fide offering of goods or services, or there is a legitimate or non-commercial use of the domain name.¹³

¹¹ Uniform Domain Name Dispute Resolution Policy, Paragraph 4 (a).

¹² *Id.*, Paragraph 4 (b).

¹³ *Id.*, Paragraph 4 (c).

The proceedings under the UDRP are conducted by the service providers approved by the ICANN. Currently, there are six approved dispute resolution service providers. They are the [World Intellectual Property Organization](#) (WIPO) Arbitration and Mediation Centre,¹⁴ [National Arbitration Forum](#) (NAF)¹⁵, Asian Domain Name Dispute Resolution Center (ADNDRC),¹⁶ Czech Arbitration Court (CAC),¹⁷ Arab Center for Dispute Resolution (ACDR),¹⁸ and Canadian International Internet Dispute Resolution Center (CIIDRC).¹⁹ These service providers follow UDRP rules and as well as their own supplemental rules in resolving domain name disputes.

The remedies available under the UDRP proceedings are only limited to the cancellation of the domain name or the transfer of the domain name to the complainant,²⁰ it does not involve any monetary compensation to the complainant. If the administrative order is issued in the favour of the complainant, then the cancellation or transfer of the domain name will take place after ten business days

¹⁴ Available at: <https://www.wipo.int/amc/en/> (last visited on May 12, 2022). Approved on December 1, 1999.

¹⁵ Available at: <https://www.adrforum.com/> (last visited on May 12, 2022). Approved on December 23, 1999.

¹⁶ Available at: <https://www.adndrc.org/> (last visited on May 12, 2022). Approved on February 28, 2002.

¹⁷ Available at: https://eu.adr.eu/about_us/court/index.php (last visited on May 12, 2022). Approved on January 23, 2008.

¹⁸ Available at: <http://acdr.aipmas.org/default.aspx?lang=en> (last visited on May 22, 2023). Approved on May 18, 2013.

¹⁹ Available at: <https://ciidrc.org/> (last visited on May 22, 2023). Approved on November 7, 2019.

²⁰ *Supra* note 19, Paragraph 4 (i).

unless the penal is informed by the defendant that they are commencing a lawsuit against the complainant in a court of competent jurisdiction.²¹

Some Important Judgments Under UDRP

World Wrestling Federation Entertainment Inc. v. Michael Bosman²², was the first case decided by the WIPO under UDRP Rules. In this case, the domain name at issue is worldwrestlingfederation.com. The ‘WORLD WRESTLING FEDERATION’ is the registered service mark and the trademark of the complainant in the U.S. and is authorized to use and has used its mark in connection with entertainment services. The respondent registered the domain name ‘worldwrestlingfederation.com’ on October 7, 1999, with Melbourne IT, based in Australia. Three days after registering the domain name, the respondent contacted the complainant and offered to sell, rent, or otherwise transfer it to the complainant for valuable consideration. The complainant contends that the respondent has registered as a domain name a mark that is identical to the service mark and trademark registered and used by the complainant, that respondent has no rights or legitimate interests in respect to the domain name at issue, and that respondent has registered and is using the domain name at issue in bad faith, the respondent has not contested the allegations of the Complaint.

²¹ *Supra note* 19, Paragraph 4 (k).

²² WIPO Case No. D99-0001, available at:

<https://www.wipo.int/amc/en/domains/decisions/html/1999/d1999-0001.html> (last visited on June 3, 2023).

The panellist found that “it is clear beyond cavil that the domain name <worldwrestlingfederation.com> is identical or confusingly similar to the trademark and service mark registered and used by complainant, WORLD WRESTLING FEDERATION. It is also apparent that the respondent has no rights or legitimate interests with respect to the domain name. Since the domain name was registered on October 7, 1999, and since respondent offered to sell it to complainant three days later, the Panel believes that the name was registered in bad faith.” Accordingly, under Paragraph 4 (i) of the Policy, the Panel requires that the registration of the domain name <worldwrestlingfederation.com> be transferred to the complainant.

Lotto Sport Italia S.p.A. v. David Dent²³, the complaint was filed with the WIPO on December 14, 2016. The domain name in dispute is <lottoworks.com> and <lottostore.com>. The complainant is the manufacturer and distributor of the sportswear, and over the years, the complainant has sponsored several sporting events and professional players. The complainant holds the international trademark for LOTTO WORKS since 1974. The respondent is involved in the gambling industry and he started the business under the trade name “Trimark”, which operates lotto and casino games. The respondent registered the disputed domain in July 1998 and January 2011 respectively.

²³ WIPO Case No. D2016-2532, available at:

<https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2016-2532> (last visited on June 21, 2023).

The panellist found that the disputed domain name is identical or confusingly similar to the complainant's trademarks, the complainant has not authorized the respondent to use the LOTTOWORKS or LOTTO trademark, and there is no relationship between the complainant and the respondent which would otherwise entitle the respondent to use such trademark. The panellist further found that the use of the words 'store' and 'works' in combination with the word 'lotto' in the disputed domain name is not a generic phrase. For the foregoing reasons, and under Paragraph 4 (i), the Panellist orders that the disputed domain names be transferred to the complainant.

(B) THE U.K. APPROACH

In the United Kingdom, there is no specific legislation that deals with dispute resolution in connection with cybersquatting.²⁴ In the United Kingdom the Trade Marks Act 1994, is only the law that protects trademarks whether on the Internet or in reality. Essentially, there are two possible legal grounds on which the courts in the U.K. rely in addressing domain name disputes, i.e., trademark infringement and the principle of passing-off.

The domain name dispute governing principle laid down by the UK Supreme Court in the case of British Telecommunications

²⁴ Available at: <https://www.gov.uk/guidance/keeping-your-domain-name-secure> (last visited on June 21, 2023).

Plc and others v. One in a Million Ltd and others²⁵ the defendants had registered as domain names, several well-known trade names, associated with large corporations, including sainsburys.com, marksandspencer.com, and britishtelecom.com, with which they had no connection. They then offered them to the companies associated with each name for an amount, much more than they had paid for them. The court observed that,

"The history of the defendants' activities shows a deliberate practice followed over a substantial period of registering domain names which are chosen to resemble the names and marks of other people and are intended to deceive. The threat of passing-off and trademark infringement and the likelihood of confusion arising from the infringement of the mark are made out beyond argument in this case, even if it is possible to imagine other cases in which the issue would be more nicely balanced."

Apart from the UK courts, Nominet UK²⁶ also, resolve disputes relating to ccTLDs in the UK through its Dispute Resolution Service (DRS)²⁷ which is adopted by the Nominet on the line of UDRP. In *Tyson Foods, Inc. v. Sisusa Sphelele*²⁸ the dispute was

²⁵ (1999) E.T.M.R.

²⁶ manage and register domain names ending with .uk in the UK since 1996. Available at: <https://www.nominet.uk/domain-solutions/> (last visited on June 15, 2023).

²⁷ Available at: <https://www.nominet.uk/domain-support/uk-domain-disputes/> (last visited on June 15, 2023).

²⁸ Nominet Dispute Resolution Service, D00024418, available at: <https://secure.nominet.org.uk/drs/search->

regarding the registration of <tysonfood.co.uk> domain name. The complainant is a food giant based in the USA since 1935. The complainant demanded the transfer of the disputed domain name. The panel found that “Circumstances indicate that the Respondent is using or threatening to use the domain name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorized by, or otherwise connected with the Complainant”. Thus, the expert ordered the transfer of the domain name to the complainant.

(C) THE US APPROACH

Before 1999, trademark owners sued the cybersquatters under the Federal Trademark Dilution Act (FTDA). But lawsuits under FTDA were "expensive and uncertain,"²⁹ and for its application, the mark must be the famous one. To overcome this problem Congress in 1999 passed the Anti-cybersquatting Consumer Protection Act ("ACPA") to protect American consumers and businesses, promote the growth of online commerce, and provide clarity in trademark law by prohibiting cybersquatting.³⁰

[disputes.html?action.browseBasicSearchResults=y&sortAscending=false&sortColumn=&page=8](#) (last visited on June 15, 2023).

²⁹ J. Ryan Gilfoil, “A Judicial Safe Harbor Under the Anti Cybersquatting Consumer Protection Act” 20 *Berkeley Technology Law Journal* 187 (2005).

³⁰ Sue Ann Mota, “The Anti cybersquatting Consumer Protection Act: An Analysis of the Decisions from the Courts of Appeals” 21 *Journal of Computer Information Law* 355 (2003).

The ACPA provides a cause of action against the cybersquatters who register the domain names containing trademarks to profit from the marks. The ACPA has jurisdiction over both types of cybersquatters i.e., those cybersquatters who can be found, and on whom a United States court can assert personal jurisdiction and the second category of cybersquatters is those who cannot be found or are beyond the personal jurisdiction because they are located in the foreign countries (in rem action).³¹

The Trademark Provision of ACPA

The trademark provision of the ACPA imposes liability on the cybersquatters who can be found in the United States. To bring a lawsuit under the ACPA, an aggrieved party must prove all three elements required under the statute.³²

- (1) the plaintiff has a mark that is distinctive or famous,
- (2) the defendant's domain name is identical or confusingly similar to the plaintiff's distinctive or famous mark; and,
- (3) the defendant used and registered, the domain name with a bad faith intent to profit from the plaintiff's mark.

³¹ Bhanu K Sadasivan, "Jurisprudence Under The In Rem Provision Of The Anti cybersquatting Consumer Protection Act" 18 *Berkeley Technology Law Journal* 237 (2003).

³² 15 U.S.C. § 1125(d)(1) (A).

In the ACPA a court may order the forfeiture or cancellation and transfer of the disputed domain name to the owner of the mark,³³ in addition, the court can award statutory damages award of not less than \$1,000 and not more than \$100,000 per domain name.³⁴

The first case that was decided under ACPA was Sporty Farm L.L.C. v. Sportsman's Market, Inc.³⁵, the defendant (Sportsman's Market) - a catalogs company that uses the trademark and logo 'Sporty's' to classify its catalogs. Omega registered the domain name <sportys.com> and later sold it to its subsidiary Sporty Farm. The Sportsman claimed for trademark infringement under FTDA. The district court ruled in favour of Sportsman and issued an injunction forcing Sporty's Farm to relinquish all rights to Sportys.com.

In an appeal, the court applied the ACPA and found that "there was more than enough evidence on record to demonstrate bad faith. Neither Omega nor Sporty's Farm had at all intellectual property rights in sportys.com and Sporty's Farm did not begin use of the name in a bona fide offering of services or goods until after the litigation began". The court upheld the decision of the district court.

In Rem Action under ACPA

In rem jurisdiction of the ACPA allows the trademark owner to file a suit against the domain name, where the domain name

³³ *Supra* note 11, s. 3 (d)(1)(A).

³⁴ *Id.*

³⁵ 202 F.3d 489 (2d Cir. 2000).

registrant cannot be found or who does not reside within the United States. The owner of the trademark may file an in rem civil action against a domain name if:³⁶

- i) the domain name violates any right of the registrant of a mark registered in the Patent and Trademark Office or protected under section 43 (a) or (c) of the Lanham Act, 1946,
- ii) the court finds that the owner has demonstrated due diligence and was not able to find a person who would have been a defendant in a civil action.

The remedies of an in-rem action are only limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.³⁷

(D) THE INDIAN APPROACH

In India, no legislation explicitly refers to dispute resolution in connection with domain names. The Trade Marks Act, 1999 sought to be used for protecting the use of trademarks in domain names is not extra-territorial, therefore it does not allow for adequate protection of domain names.³⁸ However, in India, it is well settled that domain name disputes are to be resolved under the Trade Marks Act, 1999.

³⁶ *Supra* note 11, s. 3 (2)(A).

³⁷ *Id.* s. 3 (2)(B).

³⁸ *Supra* note 10 at 795.

The Indian Parliament has enacted the Information Technology Act, of 2000 to make way for the acknowledgment of electronic information and data. Even though the legislature tries to enact laws to keep pace with the technological changes, neither the Trade Marks Act, 1999 nor the Information Technology Act, 2000 deals with the matter relating to the domain names dispute.

The judiciary in India has noted the proliferation of cases relating to domain name disputes in India. The Indian courts have been consistent in applying the law relating to passing off domain name disputes.³⁹ In India, the disputes identifying with domain names have been managed under the trademark law, as done by the courts in the UK and USA. Let us analyze the approach of the Indian courts in dealing with cybersquatting cases.

The first domain name dispute case in India was of, YAHOO! Inc. v. Akash Arora & Anr⁴⁰, a lawsuit was filed by the plaintiff against the defendants seeking a decree of permanent injunction restraining the defendants from operating any business, selling, advertising, and/or dealing in any services or goods on the Internet or otherwise under the trademark and/or domain name ‘yahooindia.com’, or any other trademark and/or domain name that is identical with or deceptively similar to the plaintiff’s well-known trademark “Yahoo!”. The defendant contended that the “Yahoo!”

³⁹ *Id.* at 798.

⁴⁰ 1999 PTC (19) 201 (Del), available at: <https://indiankanoon.org/doc/1741869/> (last visited on June 25, 2023).

trademark/domain name purportedly belonging to the plaintiff was not at the time registered in India and therefore could not be used as a basis for an action about trademark infringement. The defendant also argued that the word “Yahoo!” is a general word that is neither unique nor invented and as such, did not possess an element of distinctiveness. It was further submitted that since the defendants had been using a disclaimer all along, there was no deception, and hence no action of passing off could be taken against the defendants. Refusing all contentions of the defendant the court awarded the interim injunction to the plaintiff and restrained the defendants from using the domain name yahooindia.com, the court observed:

“The services of the plaintiff under the trademark/domain name ‘Yahoo!’ have been publicized and written about globally. In an Internet service, a particular Internet site could be reached by anyone anywhere in the world who proposes to visit the said Internet site..., in a matter where services are rendered through the domain name on the Internet, a very alert vigil is necessary and a strict view is to be taken for its easy access and reach by anyone from any corner of the globe...there can be no two opinions that the two marks/domain names ‘Yahoo!’ of the plaintiff and ‘Yahooindia’ of the defendant are almost similar...and there is every possibility and the likelihood of confusion and deception being caused.”

The judgment in Yahoo! Inc. case was followed by the Bombay High Court in Rediff Communication Ltd. v Cyberbooth⁴¹, the court observed that,

“A domain name is more than an Internet address and is entitled to equal protection as a trademark. With the advancement and progress in technology, the services rendered in the Internet site have also come to be recognized and accepted and are being given protection to protect such providers of service from passing off the services rendered by others as their services.”⁴²

Supreme Court of India was presented with an occasion to ponder over domain name disputes in Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd⁴³, the principal question which came before the Supreme Court was whether the trademark law applies to Internet domain name disputes. 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

⁴¹ 1999 (19) PTC 201 (Del).

⁴² Rediff Communication Ltd. case, op cit, note 91, p 30.

⁴³ 2004 PTC (28) 566 (SC), available at: <https://indiankanoon.org/doc/1630167/> (last visited on June 25, 2023)

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 customers. It is apparent, therefore, that a domain name may have all the characteristics of a trademark and could find an action for passing off.”

The Court further added that in India, there is no specific legislation that refers to domain name dispute resolution. The Trade Marks Act, 1999, does not have an extra-territorial application and may not allow for the protection of domain names. This doesn't mean that domain names are not to be legally protected under the Trade Marks Act, 1999, and the laws relating to passing-off.

The functions of the National Internet Registry (NIR) were delegated to the NIXI in 2004. The NIR has been named as Indian Registry for Internet Names and Numbers (IRINN). With the increase in cybersquatting cases in the country, the NIXI has adopted the IN Domain Name Dispute Resolution Policy (INDRP).⁴⁴ The INDRP was written by international norms (from the World Intellectual Property Organization) and the provisions of the Information Technology Act of 2000. The INDRP governs trademark disputes using domain names that finish in .IN or .Bharat, such as Tata.in,

⁴⁴ Available at:

https://www.registry.in/system/files/IN_Domain_Name_Dispute_Resolution_Policy.pdf
(last visited on May 21, 2023).

sony.in, or apple.bharat, etc. The INDRP is supplemented by Rules of Procedure⁴⁵, which describes the fees, communications, how to respond to a complaint, how to file a complaint, and the other procedures that can be used in processing a complaint.

NIXI has been able to transparently and efficiently resolve over 1177 cases in its nearly fifteen years of existence. An examination of the dispute resolution procedure, as well as the results rendered under the INDRP regime, reveals that the number of decisions rendered in favour of the complainants has decreased slightly. According to a recent examination of cases submitted and decided over the last 15 years, the Complainants or Right holders received a substantial percentage of favourable decisions (almost 97 percent).⁴⁶

Some important judgements under INDRP

The first case that came before the INDRP arbitral tribunal was, Rediff.com India Ltd. v. Abhishek Verma and Advance Media⁴⁷ the dispute was regarding the registration of the domain name “rediff.in” by the respondent. The complainant argued that the domain name ‘rediff.in’ is confusingly similar and identical to the complainant’s trademark, ‘rediff.com’, rediffmail.com, etc. The complainant

⁴⁵ Available at: <https://www.registry.in/indrp-rules-of-procedure> (last visited on June 25, 2023).

⁴⁶ Ibid.

⁴⁷ INDRP/001, April 3, 2006, available at: <https://registry.in/Policies/DisputeCaseDecisions>. (last visited on May 16, 2023).

further argued that the registration of the domain name 'Rediff.in' by the respondent was in bad faith and to gain monetary benefit.

The Arbitral Tribunal concluded that "the respondent registered the alleged domain name mainly to sell or otherwise transfer it to the complainant and there is no nexus between the word 'rediff' and the respondent's firm's name. Without any such proof, it can be deduced that the respondent deliberately endeavoured to draw in Internet users to the proposed site by confusing the complainant's name. After going through the fact that "the purpose of registering the domain name by the registrant is renting, transferring or otherwise selling the domain name registration, to the complainant who is the owner of the trademark." Finally, the arbitral tribunal ordered the transfer of the domain name to the complainant.

In *Maruti Suzuki Ltd. v Nitin Bhamri*,⁴⁸ the dispute was regarding the registration of the domain name 'marutisuzukieeco.co.in' by the respondent. The complainant argued that the domain name is similar and identical to the complainant's trade mark and it will cause confusion in the mind of the innocent internet user and divert the customers from the complainant's websites.

The Arbitrator observed that the minor addition of the word 'eeco' to the complainant's trademark is insufficient to avoid similarity. The Arbitrator found that the respondent registered the disputed

⁴⁸ INDRP/137, April 24, 2010, available at: <https://selvams.com/indrp-domain-name-dispute-cases/indrp137/> (last visited on May 25, 2023).

domain name with the intent of attracting Internet users to the respondent's website or other online locations by creating a likelihood of confusion with the complainant's trade name or trademark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or online location. The tribunal ordered the transfer of the domain name to the complainant.

In *Sazerac Brands, LLC v. Dean Chandler*⁴⁹, the registrant claimed to have registered in order to create an alumni network for the McMaster Faculty of Engineering, which he said has been known as the 'Fireball Family' since 1995. The registrant also mentioned that he was an interested astronomer and that fireballs were often where the college was located. The arbitrator noted that the registrant's mark was identical to the complainant's and that the registrant had failed to demonstrate a reasonable interest in the domain name through use. Furthermore, the registrant's explanation for using the disputed domain name looked to be a spur-of-the-moment decision. The arbitrator held:

“Tribunal is of the view that the Respondent has been unable to prove that it has been using the mark ‘FIREBALL’ or the disputed domain name ‘fireball.in’ in connection with a bona fide offering of goods or services. The Complainant has thus proved that the Respondent has no rights or legitimate interests in the disputed domain name”.

⁴⁹ INDRP/1243, available at: <https://www.algindia.com/lack-of-use-indicates-lack-of-legitimate-interest-in-domain-name/> (last visited on May 26, 2023).

Accordingly, the disputed domain name <fireball.in> was transferred to the Complainant.

Conclusion

At the Internet's origin, few might have anticipated its quick development. Likewise, only a few would have imagined that the next race for gold would be in valuable domain names. The internet has provided an opportunity for cybercriminals to commit cybercrime, cybersquatting is one such cybercrime committed by cybersquatters. The problem of cybersquatting has received the attention of the governments of several countries and requires serious attention.

Apart from the traditional methods, ICANN's dispute resolution policy (UDRP) has established itself as an effective tool to tackle cybersquatting. UDRP promotes a quick, efficient, and cost-effective mechanism to resolve cybersquatting cases. Apart from the ICANN's UDRP, the USA is the first and only country in the world that has enacted ACPA, special legislation for the protection of businesses from cybersquatters. Whereas, the United Kingdom lacks any specific legislation on cybersquatting. The courts in the U.K. apply the trademark infringement and the passing-off principle of the Trade Mark Law of 1994 to resolve the cybersquatting disputes.

While in India the Information Technology Act of 2000 is India's only cyberspace legislation, and it makes no provision for dealing with trademark-domain name issues. Furthermore, the Trademark Act of 1999 contains no provisions regarding domain names. Nonetheless, some domain

name conflicts are being decided by Indian courts under the Trademark Act. With the increase in cybersquatting cases, NIXI has adopted the INDRP, it is only applicable on the domain name ending with .in or .bharat.

The following suggestions are recommended:

The domain name registrars follow the first-come, first-served policy for the registration of the domain name. Before registering the domain name, the registrar should advertise the application for the registration of the domain name, to allow the public to oppose the registration of the domain name. This will help in reducing the cybersquatting cases.

It is suggested that the WIPO member nations should take the initiative to develop a global convention like the Paris Convention, etc which particularly deals with the domain name system, its registration, dispute resolution mechanism, etc., so that member states can enact the local law parallel to the convention and it will also bring the uniformity of law governing the domain name system.

It is also suggested that, like that of the United States, Anti-Cybersquatting Consumer Protection Act (ACPA), 1999, India should also enact the law to prevent cybersquatters from registering domain names similar or identical to trademarks to sell them to the trademark holder. The INDRP adopted by the NIXI for tackling the cybersquatting cases is not shaped in law by the competent legislature, thus not making it mandatory to follow. To make INDRP more effective, the inconsistency between the UDRP and INDRP must be removed.

The UDRP stands to be useful in resolving domain name dispute cases, but certain limitations under UDRP need to be fixed. It is suggested that the following changes be made to the UDRP:

- i) the UDRP has limited applicability to gTLDs and some ccTLDs, provision should be made for the universal applicability of the UDRP to all domain names.
- ii) There is a need to tackle inconsistent panel decisions and the tribunal must follow the doctrine of precedent.
- iii) A review mechanism should also be introduced in the UDRP so that the aggrieved party can file for the review of the award.
- iv) The period of 10 days to file the lawsuit in the court of mutual jurisdiction by the losing party should also be increased, as it takes time to develop a consensus between the party and to find an expert lawyer in the concerned field.