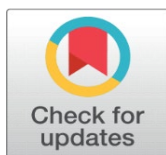


TRADEMARK AND DOMAIN NAME CONTEMPORARY ISSUES AND CHALLENGES IN INDIA

Anuj Kumar Tyagi ¹, Dr. Sarika Tyagi ²

¹ Research Scholar, Faculty of Law, Swami Vivekanand Subharti University, Meerut, India

² Associate Professor, Faculty of Law, Swami Vivekanand Subharti University, Meerut, India



DOI

[10.29121/shodhkosh.v5.i4.2024.4130](https://doi.org/10.29121/shodhkosh.v5.i4.2024.4130)

Funding: This research received no specific grant from any funding agency in the public, commercial, or not-for-profit sectors.

Copyright: © 2024 The Author(s). This work is licensed under a [Creative Commons Attribution 4.0 International License](#).

With the license CC-BY, authors retain the copyright, allowing anyone to download, reuse, re-print, modify, distribute, and/or copy their contribution. The work must be properly attributed to its author.



ABSTRACT

In ancient times, traders and businessmen used to mark scribbles for identification of their goods. With time, new techniques evolved to identify goods and trademarks were used for identification (related) or for the purpose of obtaining a certificate (legal). Both of these are considered advantages in terms of trade union views. Therefore, for obvious reasons, companies are investing time and money in their brands, and when such companies find that a fake domain name similar to its name or brand has been registered by cyber hackers called cyber-squatters, who register confusing domain names with popular brand names or symbols. trading, to sell them over time to legitimate owners for a profit, is a source of great concern to them. The value of a trademark is clearly indicated in the store (where the seller is not present) where the product is sold, depending on the strength of the trademark.

Keywords: Trademark, Cyber-Squatting, Squatter, Domain Name, Internet, Cyber Crime, Cyber Space

1. INTRODUCTION

Trademarks are a badge of origin and may have great economic value.¹ The first trademark laws in India was the Trade Marks Act, 1940 (5 of 1940). Prior to it, common law was left in charge of regulating trademark protection. However, the Indian Merchandise Marks Act, 1889, was passed into law in accordance with the U.K. Merchandise Marks Act, 1887.² Trademarks and domain names are unique from one another. A "trademark" is safeguarded by the legal system of the nation in which it is registered. As a result, a "trademark" may be registered more than once in various nations throughout the globe. On the other hand, a "domain name" is theoretically accessible regardless of the geographical location of the customers, for which the national laws may not be sufficient to successfully protect a domain name because the internet allows for access without any geographical limitations. International regulation of the domain

¹ Claire Howell & Benjamin Farrand, *Intellectual property law*, 5th Edn, (2017), Pearson Education Limited, Harlow, United Kingdom p.1.

² K C Kailasam & Ramu Vedaraman, *Law of Trademarks & Geographical Indications*, 4th edn Lexis Nexi Publication, New Delhi p.1.

name system was necessary to fill this gap.³ It has recognized that domain names has become associated with the nature of business and maintain the exclusivity of such business. In the virtual world, where commerce is conducted, the domain name identifies the business. It is therefore imperative that a domain name which has identified itself with the business should be allowed to maintain its exclusivity.⁴

2. TRADEMARKS

“Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.”⁵

According to section 2(zb) of “The Trademarks Act, 1999⁶ Trade marks mean

- 1) *“‘trademark’ means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and*
- 2) *In relation to Chapter XII (other than section 107), a registered trademark or a mark used in relation to goods or services to indicate or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and*
- 3) *in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark.”*

In case of Trans Tyres India Pvt Ltd v Double Coin Holdings Ltd,⁷ it is observed that:

“The conventional theory that a trademark connects, in the mind of the consumer, the goods to the source of manufacturer is inapplicable in today’s environment because modern global trading has assumed multi-channel modes of sale of goods in the market. Thus, in today’s global environment, the theory pertaining to a trademark would be that a trademark connects, in the mind of the consumer, the source wherefrom the goods enter the market, whatever may be the nomenclature of the source. It could be the agent, the distributor or even a person who purchases goods from a manufacturer and sells them in the market.”⁸

3. DOMAIN NAME

A name used to identify a person’s internet service is called a domain name.⁹ A domain name helps the consumers identify the source of the goods or services being offered by a particular website and hence serves a similar purpose as that of a trademark.¹⁰ A domain name is split into two numeric parts, commonly known as IP addresses, for example, 123.743.123.58, where “58” denotes a particular machine and “123” denotes the network, “743” and “123” denote the

³ *Satyam Infoway Ltd v. Sifynet Solutions Pvt Ltd*, AIR 2004 SC 3540

⁴ *Salt Lake Society For Hotel Management & Another v. Gazi Murshidul Arefin & Others*, LNIND 2021 CAL 548

⁵ K C Kailasam & Ramu Vedaraman, *Law of Trademarks & Geographical Indications*, 4th edn Lexis Nexis Publication, New Delhi p.122.

⁶ Enforced on 30th December 1999.

⁷ 2012 (49) PTC 209 (Del) (DB).

⁸ *Trans Tyres India Pvt Ltd v. Double Coin Holdings Ltd*, 2012 (49) PTC 209 (Del) (DB).

⁹ P Narayanan, *Law of Trademarks and Passing Off*, Fifth Edn, (Kolkata: Eastern Law House, 2000), 591.

¹⁰ *Satyam Infoway Ltd v Sifynet Solutions Pvt Ltd*, (2004) 6 SCC at 150.

sub-networks (www.nike.com). Because numeric addresses are more difficult to remember and programming has begun to take the role of memory errors, browsers like Internet Explorer automatically search up the numeric IP address that corresponds to the selected alphanumeric address when they get a request. Domain names have begun to take the role of numeric addresses because of this. Additionally, domain names currently serve as corporate identifiers that signify the connection between a certain web page and the information it contains and the alphanumeric variable utilised. The registration of domain names has significantly increased as a result of this.¹¹

Levels are used to categorise domain names. The "top level domain" (or "TLD") relates to the organization's geographic origin or its general kind.¹² Prior to the TLD, the domain name's "second level domain" (or "SLD") section usually refers to the organisation it is intended to represent. For instance, Tata should be referred to by www.tata.com. The problem mentioned above is mainly due to the old policies of the registration officer, NSI, the registrar, according to the original policy which first came in without questioning or confirming the choice of a particular name based on existing trademarks or any defamation of the business name. This combination between trademark and domain name law has led to so-called domain name disputes, divided into three categories of locals, parasites and twin hunters.

A cyber-squatter is referred to as a person who attempts to make money online by holding, reselling, or granting domain name licences to businesses who have invested millions of dollars in bettering their trademark's branding for the first time presented. Cybersquatting is described as the activity of registering a domain name with a trademark in order to benefit from selling it, often to the trademark owner. The trademark owner cannot register his trademark as a domain name as long as the cyber-squatter is the domain name's owner. Cybersquatters violate the trademark owner's legal right to use their brand in this way.¹³ Disputes over domain names are as old as its online registration system and are almost as old as the bad practice of cyber fraud. A fictional name coined by science fiction writer William Gibson, in search of a term to describe his vision of a global computer network, which includes all the people, equipment and resources in the world and where one can travel or "roam" through the visible space. Cyber-squatting is not fully defined under any law or applicable law like any other country in the world but a general definition that has been drawn from the wisdom of judging in this regard and the views of experts in the state Cyber laws can be said domain name for infringement of trademarks and service marks. Cyber-squatters, often come up with various and new ways to infringe on trademark legal rights. In addition, in view of the fact that e-commerce has grown exponentially over the years the organization was of the view that the lack of cyberbullying law could create a huge gap in e-commerce and therefore seeks to change the way it limits online consumer confusion. Investment by trademark owners and retained the positive interest associated with these trademarks. At the same time, India is facing a severe famine of cyber laws in this regard. Subsequent chapters will address the problem mentioned above, expand on the issues involved and propose a similar solution.¹⁴

4. TRADEMARK AND DOMAIN NAME

A trademark was marked for identification (related) or for the purpose of obtaining a certificate (regulatory). Both of these are considered advantages in terms of trade union views. However, trademark law has changed with changes in the commercial environment. A change in respect of a reinforced trademark from identification for the purpose of the manufacturer (sales marks) to the brand identifying marks of the consumer.¹⁵ This is especially so in view of the fact that today a product is often sold as a result of the presence of a trademark. In *Shredded Wheat Co v Humphrey Cornell Co* look at that; Indeed, product guarantees have a certain customer satisfaction that that particular customer or other such customers may have gained by using the item with that mark and indicating to the consumer intention that the good comes from a common manufacturer or source and consequently a certain quality.¹⁶ , it can be said that a

¹¹ N.S. Sreenivasulu, *Intellectual Property Law-Dynamic Interfaces*, 1st ed Lexis Nexi Publication, New Delhi.

¹² Ira S. Nathenson, *Showdown at the Domain Name Corral: Property Rights and Personal Jurisdiction Over Squatters, Poachers, and Other Parasites*, 58 U. Pitt. L. Rev. 991 (1997).

¹³ Monica Killian, *Cybersquatting and Trademark Infringement*, available at www.murdoch.edu.au/elaw/issues/v7n3/kilian73.html.

¹⁴ N.S. Sreenivasulu, *Intellectual Property Law-Dynamic Interfaces*, 1st ed Lexis Nexis Publication, New Delhi.

¹⁵ David Bainbridge, *Trademark Infringement, the Internet and Jurisdiction*, as in 4 ICFAI J Intel. Prop. Rights 17, 18 at section: 2.

¹⁶ *Shredded Wheat Co v Humphrey Cornell Co*, 250 Fed. 960, 963.

trademark is not just a symbol of interest but sometimes a builder of interest. The value of a trademark is clearly evident in the store (where the seller is not present) where the product is sold depending on the strength of the trademark.¹⁷

5. LEGITIMATE USE OF DOMAIN NAME

The legal use of a domain name is in the form of so-called 'competing rights users'. This is where there are two companies that use the same business name and wish to register their business name as a domain name. Such cases are more complex than cyber-squatting cases because both users have the legal right to use a domain name on the Internet. The decisions in these cases are therefore very straightforward and may depend largely on the registration of a domain name and on the opinion of the court. Another form of official use where both domain name users have a historical connection to the brand but works in a variety of industries. While this may lead to the suggestion that product diversity be purified by the registration of a trademark as a domain name by one of the users, the trademark law traditionally does not provide any prohibition against such use on account of a historical entity. The same assumption applies in cases of domain name disputes. In *Polaroid Corporation v Polard Electronic Corporation*¹⁸ an eight-item test was approved by the United States Court of Appeal for a second circuit to determine the confusion that could be labeled as follows:¹⁹

- 1) The power of the plaintiff's mark
- 2) Parallels of plaintiffs and defendants' marks
- 3) The competitiveness of products
- 4) Chances are that the plaintiffs will "close the gap" and offer products similar to the defendants
- 5) Real confusion between products
- 6) Good fidelity of defendants
- 7) Product quality of defendants
- 8) Consumer confusion.

In addition, to *Toyota 'R' Us Inc. v Feinberg*²⁰ the court relied on consumer intelligence through the Polaroid trial and said that as businesses were not close to competition consumers would have enough understanding to distinguish between the products of the two manufacturers. For example, the Lion of the days and the lions of the water pumps.²¹

6. UNLAWFUL INTRUDERS

Now a problem arises when a trademark owner decides and tries to register a domain name with a popular trademark as a second-tier domain and finds that the domain name involved is already registered, or sometimes, it could be an incident of conflicting legal interests, most of the time it was done with the intention of wall-mounting mala fide or the popularity of a particular brand by those registered domain names called cyber-squatters.

7. CYBER-SQUATTING

Cyber-squatting²², as already mentioned, is the practice "when one business registers a domain name that bears the name or trademark of another, usually famous or well-known, to prevent the legal user from registering his or her proper

¹⁷ N.S. Sreenivasulu, *Intellectual Property Law-Dynamic Interfaces*, 1st ed Lexis Nexis Publication, New Delhi.

¹⁸ 368 US 820, 1961.

¹⁹ *Polaroid Corp v Polard Electronics Corp*, 368 US 820, 1961.

²⁰ N.S. Sreenivasulu, *Law relating to Intellectual Property, First edn*, (Bloomington, Indiana, USA: Penguin-Partridge Publications, 2013), p.137.

²¹ N.S. Sreenivasulu, *Intellectual Property Law-Dynamic Interfaces*, 1st ed Lexis Nexis Publication, New Delhi.

²² Richard Haynes, *Media Rights and the Intellectual Property*, Edinburgh University Press, Edinburg, Scotland, 2005), p.113.

domain name or hope of making a profit on the market.”²³ There is no indication that the link between domain names and trademarks is better online than cyber-squatting. The advent of internet and e-commerce has proven the effectiveness and robustness of brands and brands to gain competitive advantage in global markets.²⁴ Today, the most common way for a consumer who wants to get information about a particular product or to access and access a particular service offered by an online company is to type a domain name containing the company name or type of product they want because in the web browser address bar and press enter. That’s why, companies and business organizations want to register domain names that are easy to remember and put in a famous trademark or company name. Domain names create the image and reputation of a particular company or organization in the global marketplace and give them ownership of marketing and educating people about their products and services through advertising. Also, it assures consumers that they are dealing with the intended source of goods when there is no physical examination and, therefore, serves as an indicator of origin as well. So, for all intents and purposes, domain names, in cyberspace, perform all the functions performed by a trademark in the physical world. Illegal cyber fraud is in the following forms, among others. As it was held in *Saty Infoway Ltd v Sifynet Solutions Private Ltd*²⁵, where the hon’ble judge stated explicitly, after a detailed discussion, that a domain name can have all the features of a Trademark.²⁶

8. CYBER-SQUATTING IN INDIA

India is a tyro in this global cyber era and India, cyber laws are not improved as it should be in this era of increasing cyber-crime and other online threats such as cyber-squatting, trademark infringement, domain name disputes and other security threats. If an Indian citizen falls into this vicious cycle called cyber-squatting, his options are limited, unlike in the US where there are developed and detailed laws regarding trademark protection and the prevention of cyber hacking to increase cybercrime protection and trademark infringement. online. The problem with the Indians is that no specific act or law regarding online trademark infringement has been made yet. India's cyberspace law, the Information Technology Act 2000 as amended in 2008 and 2015 also fails to address problems related to Intellectual Property, domain name disputes, trademark infringement and cyber fraud.

However, the silver lining in the cloud has been a spectacular and artistic role played by Indian courts in shaping cyber laws while dealing with cybercrime in India. For example, in *Yahoo Inc. v Aakash Arora and Others*²⁷ where a cyber-squatter named Aakash Arora, registered a domain name (www.yahooindia.com) that was confusingly similar to the domain name Yahoo Inc. (www.yahoo.com) and used it as a trademark on his website and by providing guidance services similar to those provided by the complainant on his website, he identified himself as an extension of yahoo.com in India, as a trademark and specifically stated that the trademark law operates with equal force on the internet as it does in the physical world and considers, the freedom to copy and facilitate access to any part of the world, cyber related property. Also, in the case of *Info Edge (India) Pvt Ltd v Shailesh Gupta*²⁸, it was stated that a website that uses a domain name, similar to that of the plaintiff, for commercial purposes, may result in the domain name being deliberately chosen to attract the Applicant's Internet Users. Another case, where, for the first time, the dispute over the protection of domain names online at the Apex court door was, *Satyam Infoway Ltd v Sifynet Solutions Pvt Ltd*,²⁹.

²³ Vivek Sood, *Cyber Law Simplified*, (New Delhi: TATA McGraw Hill,(2001), 228.

²⁴ Monica Killian, *Cybersquatting and Trademark Infringement*, Available at www.murdoch.edu.au/elaw/issues/v7n3/kilian73.html, Visited on- 15/10/2021

²⁵ (2004) 6 SCC .

²⁶ N.S. Sreenivasulu, *Intellectual Property Law-Dynamic Interfaces*, 1st ed Lexis Nexi Publication, New Delhi.

²⁷ 1999 PTC 201.

²⁸ (2001) 24 PTC 335 (Del).

²⁹ (2004) 6 SCC 145.

*At Rediff Communications Ltd, v Cyberbooth*³⁰, the plaintiff, portfolio owner and domain name known as rediff.com filed to block the defendant, who registered the domain name "rediff.com". Given the identical nature of the work, the judge determined that there was a "clear purpose to deceive" and granted interim aid to the complaint. The judge determined that the domain name should have the same level of trademark protection as the Internet address since it is more valuable.³¹ In another case, *Titan Industries Ltd v Prashanth Koorapati*.³², Tanishq.com was registered by the defendant. Tanishq is a trademark that the plaintiff's firm has been using in connection with its watch. The plaintiff's company filed a complaint because it believed the defendants' use of the domain name would cause confusion and deceit, harm the plaintiff's reputation, and cause other harm. A temporary injunction prohibiting defendants from using the word "TANISHQ" online or in any other way that might lead to the transfer of the defendants' business and property as the plaintiff's business and assets was ordered by the Supreme Court of Delhi. The defendant chose not to challenge the High Court's ruling.

In *SBI Cards and Payment Services Private Limited v Domain Active Pty Ltd*,³³ the domain name was hijacked by an Australian firm in the hopes of later selling it for greater money, but the World Intellectual Property Organization ruled that it be given to an Indian corporation. in a business that is a part of the State Bank of India. The State Bank of India (SBI), which has been around for more than 200 years, was said to have partnered with GE Capital Services to launch SBI Cards and Payment Services Private Ltd in 1998. The SBI Card advisers' concern that "an Australian firm was in the process of buying and selling a domain name through its website www.domainactive.com" was appreciated by the panel. The panel determined that an Australian firm registered the domain name sbicards.com with the goal of blocking the trademark or trademark owner from using the marking as a related domain name after reviewing an appeal submitted to SBI cards.

In *Bennett Coleman & Co Ltd v Steven S Lalwani*³⁴, the first legitimate domain name triumph for an Indian corporation went to the Economic Times. Bennett Coleman & Co Ltd., Steven S. Lalwani, and the Long-Distance Telephone Company were the subjects of proceedings decided by the WR Cornish Panel (WIPO) Arbitration and Mediation Center on March 11, 2000. The former complainant in both matters was Bennett Coleman & Co Ltd. The complainant has held the domain names www.economictimes.com and www.timesofindia.com since 1996, and he uses them to publish his publications online.

On March 28, 1973, the complaint filed a "The Economic Times" label for newspapers, journals, periodicals, novels, and other literary works in India. On July 30, 1943, the complainant registered a "The Times of India" mark for comparable items. On the other hand, US citizen Steven S. Lalwani registered the domain name www.theeconomictimes.com at Network Solutions in 1998. It is interesting to notice that Long Distance Telephone Company, with the same address as Steven S. Lalwani, 16 Victoria Terrace, Upper Montclair, NJ 07043, USA, also registered the domain name www.thetimesofindia.com with Network Solutions. As the identical earlier registration was accessible, Network Solutions, the sole inventor of the TLDs (Top Level Domains), has legitimately registered the aforementioned domain names. Naturally, Network Solutions does not place any limitations on the registration of domain names. According to the ruling, the plaintiff enjoys a solid reputation in newspaper articles that are published in print, electronic, and portable versions for everyday usage.

In August, 2009, *Mahindra & Mahindra Ltd, (M&M)*³⁵ won a cyber hacking case at the World Intellectual Property Organization (WIPO) against a US man, who used the word 'Mahindra' on an Internet site. Defendant, Zach Segal was using the domain name 'mahindraforum.com' when the Indian group argued that the name was similarly confused with its trademark 'Mahindra' and that a Florida person had no legal rights or interests. M&M argued that "the opposing domain name was registered and used in bad faith primarily to sell, rent" or otherwise transferring it to a company or its competitor for financial gain. The WIPO Mediation and Mediation Center, while instructing Segal to transfer the controversial online site to M&M found that the domain name was chosen and correctly cited for its potential sales

³⁰ AIR 2000 Bom 27.

³¹ N.S. Sreenivasulu, *Intellectual Property Law-Dynamic Interfaces*, 1st ed Lexis Nexis Publication, New Delhi.

³² *Titan Industries Ltd v Prashanth Koorapati* Case No. D2000-1793, WIPO.

³³ 2005 INDLAW WIPO 485

³⁴ Cases No D2000-0014 and 2000-0015, WIPO.

³⁵ *Mahindra & Mahindra Ltd, (M&M) v Zach Segal*, WIPO Arbitration and Mediation, Available at <http://sify.com/finance/m-amp-m-wins-cybersquatting-case-at-wipo-news-corporate-jitrCcdfcd.html>.

value to mislead Internet users who are familiar with the plaintiff's known and controversial plaintiff's credentials. It has disclosed that the use of cyber squatting is a legal requirement to purchase and officially record an address on the Internet which is the name of an existing company or person, with the intention of selling it to the owner for amount.

9. CONCLUSION

There is therefore no reason to believe that the trademark law that forms part of the intellectual property law is not sufficient to deal with changes in commerce. Given the potential for trademark infringement in the new Internet commerce, trademark law must be sufficiently available to adapt to new types of trademark infringement. Second, there is enough criminal law to deal with almost all forms of cyber fraud as described above. Under no circumstances is there any need to add the wisdom of judging that is a legal error. It may be the case in the United States that a ban on trademark owners has forced the government to enact legislation to deal directly with the "case" of cyber hacking but that action has the potential to limit freedom of expression. Moreover, there is no need to follow in the United States steps in this regard due to the more advanced state of 'stare decisis' in India where due recognition is given. Simply put, there is no reason to distrust judges that they will deal with new forms of violation and apply the same principles to the established rules of trademark law.