

PROTECTION OF DOMAIN NAME AS A TRADEMARK

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Abstract:

In modern era, Intellectual Property (IP) is recognized as a property all over the world and there is a huge scope and protection for the person's, who invented or produced any lawfully allowed intellectual outcome from his/her effort, capital and time. The person's are allowed to enjoy monopoly right over their invention or for any work for certain years. Intellectual Property is allowed inventor or author or owner of the work exploit commercially or allow others to exploit commercially. In the era of evolution of Internet, E-Commerce and Information Technology there is a scope for domain name under trademarks. Holding and registering a domain name for a company is as much important as holding and registering the name and logo of the company. So it is very necessary to know about domain name, its protection and legal issues in this article.

Keywords: Intellectual Property, Domain Name, Trademark, Internet, E-Commerce.

1. Introduction:

The term Intellectual Property has undergone a drastic change with the emergence of new ideas and new concepts being developed with the passage of time. Evolution of the Internet has increased the scope of communication and information owing to the development of a number of websites. There are various websites dealing with different topics, which provide information. Some website provides information with relating to services, education, shopping, mailing, entertainment, etc through online with the help of domain name and internet. With the help of domain name there a great scope for E-Commerce. To reach these electronic platform in the cyber world, World Wide Web, E-mails, Fax, etc. are recognized as an internet tools.

Domain name are a simple form of Internet address, designed to serve the function of enabling users to locate sites on the Internet in an easy manner. Domain names may be registered in spaces known as generic top level domains;¹ (gTLDs) Such as Com, organ, net, or in the Country Code top-level domains² (ccTLDs) South Africa.

As Commercial activities on the Internet have increased, domain names have an acquired significance as business identifiers and, as such have come into Conflict with the System of business identifiers that Protected

¹ A generic top-level domain (gTLD) is one of the categories of top-level domains (TLDs) maintained by the Internet Assigned Numbers Authority (IANA) for use in the Domain Name System of the Internet.

² A country code top-level domain (ccTLD) is an [Internettop-level domain](#) generally used or reserved for a [country](#) (a sovereign state or a [dependent territory](#)).

by intellectual property rights³ namely, geographical indications and the developing field of personality rights. The tension between domain names and intellectual property rights has led to numerous problems that raise challenging policy question. The domain names System is largely privately administered and gives rise to registrations that result in a global presence, accessible from anywhere in the world.

There are now more than 15.7 million domain names registered worldwide, with over 13.5 million of these names registered in the gTLDs (. com,. net and . org).Any person may obtain an Internet address (domain name) for his own web pages. There are certain (gTKDs) Such as ‘.com’, ‘.org’ and ‘.net’ and country code top level domains (gTLDs) .UK (United Kingdom) .de (Germany) .fr (France). JP (Japan). US. (USA) etc. within country code domains.

The WIPO⁴has to be recommended on Internet domain name 28 June 2000. The member states to develop, through a consultative process, recommendations on means of dealing with the ‘bad faith’ abusive, misleading @ unfair use’ within the Internet domain name system (DNS) of identifiers that form the basis of certain naming system used in the real or non –virtual world.⁵

The identifiers spaced were:

- Personal names.
- International nonproprietary names (INNS) for pharmaceutical substances.
- The names of intellectual intergovernmental organizations.
- Geography indications, Geographical forms, or indications of source and Trade names.

The request was subsequently endorsed by the WIPO general Assembly, the constituent organ of the member states of WIPO. The request established three process criteria for WIPO’S work.

- It was specified that this activity should take full advantage of WIPO’S prior work.
- The activity should build on existing and ongoing discussions.
- The request indicated that the activity should allow... for a process of consultation with WIPO members and all interested stakeholders

This article addresses the impact of digital economy on the intellectual property system, namely trade mark and related rights; each of intellectual property disciplines is confronted with new issues generated by the emergence

³ Intellectual property (IP) is a term referring to a number of distinct types of creations of the mind for which property rights are recognised--and the corresponding fields of law. Under intellectual property law, owners are granted certain [exclusive rights](#) to a variety of intangible assets, such as musical, literary, and artistic works; discoveries and inventions; and words, phrases, symbols, and designs. Common types of intellectual property include [copyrights](#), [trademarks](#), [patents](#), [industrial design rights](#) and [trade secrets](#) in some jurisdictions.

⁴ The World Intellectual Property Organization (WIPO) is one of the 16 specialized agencies of the [United Nations](#). WIPO was created in 1967 "to encourage creative activity, to promote the protection of intellectual property throughout the world."

⁵ Ibid

of the internet and electronic commerce. This topic also addresses domain names and their relation to trademarks, analyzing the intensive work that WIPO has begun in this area.⁶

The trademark symbolized as the ® and ™, is the distinctive sign or indication which is used for signifying some kind of goods or/and services and is distinctively used across the business organization or by an individual for identifying and uniquely classifying the source or their products and/or services among consumers and making a distinction of its products or services from the other entities. One of the part of the intellectual property law, trademark signifies to the name, word, phrase, logo, image, design, symbol or combination of any or all of these elements.

The trademark grants rights to the owner which in turns may take or can commence legal proceedings in case of infringement of trademark. However registration is not compulsory in trademark. The owner of common law trademark can also file the suit but in case of the unregistered mark, the protection granted will only be confined only to that geographical area within which it has been used or in that area into which it is expected to be expand.

Informally the term 'trademark' is used for distinguishing those characteristics or attributes which helps in identifying any individual. When the word 'trademark' is used in context of services rather than products, it may call Service Mark.⁷

2. Meaning of Domain Name:

A domain name is primarily used to identify and locate computers on the internet. It can be likened to an address on the global computer network. Just like every person has a name and telephone number, every computer connected to the internet has an Internet Protocol (IP address) of its own.⁸

The Domain Name System (DNS) serves the central function of facilitating users' ability to navigate the Internet. It does so with the aid of two components: the domain name and its corresponding Internet Protocol (IP) number. A domain name is the human-friendly address of a computer that is usually in a form that is easy to remember or to identify, such as www.wipo.int. An IP number is the unique underlying numeric address, such as 192.91.247.53. Distributed databases contain the list of domain names and their corresponding address and perform the function of mapping the domain names to their IP numeric addresses for the purpose of directing requests to connect computers on the Internet. The DNS is structured in a hierarchical manner which allows for the decentralized administration of name-to-address mapping.⁹

In the case of *Reno v. American Civil Liberties Union*,¹⁰ Judge Mokenna has explained the Internet address system, as follows; each host computer providing Internet services (site) has a unique Internet address. Users

⁶ Ibid

⁷ www.legalindia.in/intellectual-property-rights-ipr

⁸ Pankaj Jan and Pandey Sangeet Rai, "Copyright and Trademark Laws relating to Computer", p-89

⁹ <http://legalserviceindia.com/articles/cddisp.htm>

¹⁰ 521 U.S.844, 117 S. Ct. 2329 (1997)

seeking to exchange digital information with a particular internet host require the host's address in order to establish a connection. Hosts actually possess two fungible addresses a numeric IP address and alphanumeric Domain name, with greater mnemonic potential.¹¹

In the case of *People Interactive (India) Pvt. Ltd. v. Vivek Pahwa & Ors*,¹² the Bombay High court gave a proper definition of the term "domain name" that a "domain name" is the territorial address of a business on the internet where, it directs a user to a particular part of the web where the particular domain name of the registrant stores and display all the necessary information, offers and service available on the internet.

As a layman's term, domain names are user-friendly names that are easily identifiable, remembered and help to distinguish one website/web address from another's website/web address. Since they are easily remembered, they are being used as business identifiers and are being used to attract potential customers to their websites.

A domain name can be categorically divided into two levels:

- I. **Top-level domain (TLD)** – TLD exists at the extreme right of the Universal Resource Locator (URL). In the case of 'www.hotmail.com', 'com' is recognized as TLD. TLDs usually come in two types, Generic TLD (gTLD) and Country Code TLD (ccTLD). Generic TLDs describes the type of organization, which has the domain name. They are '.com' – commercial organizations, '.org' – non-profit organization, '.int' – international organisations, '.edu' – educational institutions, '.gov' – government bodies., ect. Along with TLDs, there are more than 250 Country code TLDs. They are '.in' – India, '.br'- Brazil, '.au' – Australia, '.us' – USA, etc.
- II. **Second level domain (SLD)** – SLDs exist before TLDs in URL. They are allotted to the parties for making a brand specific or to differentiate a body from other similar entities or competitors. The 'hotmail' becomes the SLD in the URL <http://www.hotmail.com>. The 'vidyodayalawcollege' becomes the SLD in the URL <http://www.vidyodayalawcollege.in>

3. Registration of Domain Names:

The Internet Network Information Centre ('InterNIC') maintains and administers the central database of all Internet domain names. In 1993, the InterNIC was established under the sponsorship of the National Science Foundation as a joint project of AT&T, General Atomics and Network Solutions Inc. (NSI). AT&T was to manage the InterNIC Directory and Database Services Project; NSI was to manage the Registration services Project and General Atomics was to manage the Information services project. Thus InterNIC granted Network Solutions Inc. (NSI) the exclusive authority to register domain names in the .com, net, and org TLDs on behalf of the U.S. Department of Commerce.¹³

¹¹See Supra note 10

¹² 2016 SCC Online Bom 7351

¹³ See Supra note 9, p-93

In November 1998, Internet Corporation for Assigned Names and Numbers (ICANN's) was formed to assume responsibility for the IP address space allocation, protocol parameter assignment, domain name system management, and root server system management functions which were previously performed under U.S. Government contract by IANA and other entities.¹⁴

India's top-level domain names on the Internet are .IN and .CO.IN. just like .COM, .IN and .CO.IN can be used for e-mail, Web sites, and other applications. .IN and .CO.IN are unique symbols and are able to inform the public at large that the website or domain name is INDIA specific.

The top domains so registered in India are '.IN' and '.CO.IN' and these domains were made available to the general public only after January 01, 2005. In consonance to the UDRP, India has enacted the Indian Domain Name Dispute Resolution Policy & Domain Name Disputes (INDRP). The activities in the pertaining situation are monitored by the National Internet Exchange of India (NIXI). INDRP has been successful in eliminating the issue of the cybersquatting.

Domain name registration of .IN and .CO.IN has been made hassle-free and the procedure for domain name registration in India is quite simple and everyone has access to it. .IN domain has thus become a relatively simple process. Registration is available for organizations and individuals in India and outside India. The domain registration is done by registrars appointed by .IN registry and would happen through a transparent non-biased process. To register a domain name in India, the registrant has to place a request online and the .IN domain name is usually registered in his name within 24 hours as per the guidelines established by the Government of India.

4. Domain Name and the Trademark:

A trademark is used to distinguish goods or services of one trader from those of others. Trademark is visual symbol in the form of a word, a device, or a label applied to articles of commerce with a view to indicate the purchaser as to the manufacturer of quality of goods. It is a general practice where companies desire to obtain such domain name which can be easily identified with their established trademarks. This helps the public to identify the company as there is no physical contact between the two of them. It helps the purchaser satisfactory assurance of the make and quality of the article he is buying. It also guarantees its unchanged quality. It is an ancient concept of identifying the source of manufacture. Strictly speaking, this concept of trademark is the product of a competitive economy where more than one manufacturer is producing similar goods and a particular product is required to be distinguished in respect of quality of the other similar products.

Domain names and trademarks are connected with each other. According to Section 2 (1)(zb) of the Trademarks Act, 1999, 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 colors; and

¹⁴ Ibid

- a registered trade mark or a mark used in relation to goods or services for the purpose of indicating 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 proposed to use the mark; and
- 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.”¹⁵

In *Cadbury India Limited And Ors. v. Neeraj Food Products*,¹⁶ the court laid down the purpose of “trademark” that Trademark is a mark used to protect traders and the consumers against malafide use/adoption of another’s well-known trademark to deceive the general public to avail unfruitful benefits in the market.

Few Examples of Domain name of Trademark registered Company/Institutions.

SL. NO.	TRADEMARKS OF THE COMPANY	DOMAIN NAME OF THE COMPANY
01.	Eastern Law House	https://www.elh.co.in
02.	Parle	https://www.parleproducts.com
03.	MARUTI SUZUKI	https://www.mautisuzuki.com
04.	GoDaddy	https://www.godaddy.com
05.	Mercedes-Benz Group	https://www.group.mercedes-benz.com
06.	Nike	https://www.nike.com
07.	Google	https://www.google.com
08.	ITC LIMITED	https://www.itcportal.com
09.	KARNATAKA STATE LAW UNIVERSITY	https://www.kslu.karnataka.gov.in
10.	NATIONAL LAW SCHOOL OF INDIA UNIVERSITY	https://www.nls.ac.in
11.	Godrej	https://www.godrej.com
12.	The Hindu	https://www.thehindu.com
13.	Sony IN	https://www.sony.co.in
14.	Raymond	https://www.raymond.in
15.	Microsoft	https://www.microsoft.com

In *Satyam Infoway ltd. v. Sifynet Solutions Pvt. Ltd.*,¹⁷ the respondent had registered domain names as www.sifynet.com and www.siffynet .net which were similar to the plaintiff’s domain name of www.sifynet.com Satyam¹⁸ (plaintiff) had goodwill in the market and had registered the name sifynet and various other names with internet Corporation for Assigned Names and Numbers (ICANN) and WIPO. The word Sify was first coined by the plaintiff using elements from its corporate name Satyam Infaway, The Supreme Court held that “domain

¹⁵A collective trade mark or collective mark is a [trademark](#) owned by an organisation (such as an association), who’s members use them to identify themselves with a level of quality or accuracy, geographical origin, or other characteristics set by the organization. Collective trademarks are exceptions to the underlying principle of trademarks in that most trademarks serve as "badges of origin" - they indicate the individual source of the goods or services. A collective trade mark, however, can be used by a variety of traders, rather than just one individual concern, provided that the trader belongs to the association. Collective trademarks differ from [certificationmarks](#). The main difference is that collective trademarks may be used by particular members of the organization.

¹⁶142 (2007) Dlt 724, MIPR 2007 (2) 269, 2007 (35) PTC 95 Del

¹⁷ (2004) 6 SCC 145

¹⁸ Satyam Infoway (P) Ltd., part of the Satyam Group of Companies, is at the forefront of providing electronic commerce solutions to Indian businesses. We provide end-to-end solutions that span the entire gamut of the electronic commerce value-chain - from network solutions to sophisticated Internet-commerce solutions.

names are business identifiers, serving to identify and distinguish the business itself of its goods and services and to specify its corresponding on-line location.” The Court also observed that domain name has all the characteristics of a trademark and an action of passing off can be can where domain names are involved. The decision was in favor of the plaintiff.

The Indian Courts are of the opinion that internet domain name can be a valuable asset for the company and is therefore entitled to equal protection as a trademark where molafide intent to cause deception is established any further enquiry on likelihood of confusion would be unnecessary The attainment of secondary meaning by the generic domain name is a precondition for granting protection to if as no one can claim monopoly over a generic word otherwise.

The Bombay High Court in *Rediff Communication Ltd v. Cybersbooth & Anr*, observed that the value and importance of a domain name is like a corporate asset of a company in this case the defendant had registered a domain name radiff.com which was similar to rediff.com. The Court gave a decision in favor of the plaintiff.¹⁹

In another case, the defendant registered a number of domain names bearing the name That it was held by the Court that domain name are not only addresses but trademarks of companies and that they are equally important.

5. Domain Name Disputes:

When the awareness about the domain names of the trademark registered companies are more popular in the public domain with the help of internet facilities in the information technology world, it will be a great opportunities for the business people to increase their electronic commercial transitions. The corporate entities commenced with new trading activities and marketing their products on the web and have started using domain names to make others locate them easily on cyberspace. With this drastic change and more scope for domain names, the disputes over the right to use of domain names have also considerably increased.

There are four types of domain name disputes, they are Cybersquatting,²⁰ Profit grabbing, Misspelling and identical domain name and Concurrent claims.

One of the earlier cases pertaining to cybersquatting was *Cardservice International Inc. v. McGee*,²¹ the American Court held that the domain name serves the same function as a trademark and is not merely to be construed as an address, as it identifies an Internet site to those who reach it, much like a person’s name identifies a particular person.

¹⁹ AIR 2000 Bom27

²⁰The term Cybersquatting is coined by two words – Cyber and Squatting. Squatting literally refers to an act of a person who takes unauthorized possession of unoccupied premises. Thus Cybersquatting is an act of occupying domain name of which he is not authorized to.

Cybersquatting (also known as domain squatting), according to the United States federal law known as the Anticybersquatting Consumer Protection Act, is registering, trafficking in, or using a domain name with bad faith intent to profit from the goodwill of a trademark belonging to someone else. The Cybersquatter then offers to sell the domain to the person or company who owns a trademark contained within the name at an inflated price.

²¹ 950 F. Supp. 737 (E.D. Va. Jan. 16, 1997)

In *Marks & Spencer v. One-in-a Million*,²² the UK Court observed that when a person deliberately registers a domain name on account of its similarity to the name, brand name or trademark of an unconnected commercial organization, he must expect to find himself at the receiving end of an injunction to restrain the threat of passing-off.

The first case in India with regard to cybersquatting was *Yahoo inc v. Aakash Arara & Anr*,²³ Where the defendant launched a website providing services nearly identical to the plaintiff's renowned website. Here, the Court ruled in favor of trademark right of US based Yahoo inc. (the plaintiff) and against the defendant that had registered itself as Yahooindia.com. The Court observed, "it was an affront to trade on the fame of Yahoo's trademark A domain name registrant does not obtain any legal right to use that particular domain name simply because he has registered the domain name he could still be liable for trademark infringement".

In a case taken up by the WIPO administrative panel, SBI Card and Payment Services Private Limited (a joint venture between GE Capital Services the largest issuer of private label credit cards in the world and the State Bank of India (SBI), the largest Indian bank) filed a case against an Australian entity on cybersquatting Domain Active Pty Limited, which was incorporated in Australia, had registered a domain name. www.sbicards.com the administrative panel held that domain name registered by the Australian entity was in bad faith and it could have attracted attention from the public because of its affiliation to SBI Cards products and services the domain name www.sbicards.com was transferred to the plaintiff (SBI card and Payment Services Private Limited).

In *Acqua Minerals Ltd. V. Promod Borse*,²⁴ case popularly known as 'Bisleri case', the Delhi high court restrained an it company from using <bisleri.com>²⁵ as a domain name for their website a suit filed by aqua minerals ltd the makers of the bisleri brand of mineral water the plaintiffs had filed a suit and pleaded for an injunction on use or transfer of the domain name by the defendants and also for an order from the court transferring the domain name to the plaintiffs the plaintiffs had already registered <bislerimineralwater.com> but argued that bisleri is a well-established brand name and that the defendants were resorting to cybersquatting "and that their registration of <bisleri.com> was a " bad faith registration "passing the injunction in favor of the plaintiffs the court observed bisleri is a very rare name defendants do not intend to do any business they have asked for money for the transfer of domain name they have got the domain name registered only to obtain monetary settlement with the increase of e commerce, the disputes of this nature are bound to increase once again the court seems to have taken the approach of protecting bisleri as famous marks are in the US .

²²[1997] EWHC PATENTS 357

²³ 1999 (19) PTC 210 (Del)

²⁴ 2001 PTC 619 (Del)

²⁵ Bisleri is a brand of bottled water in India. Bisleri has 60% market share in packaged drinking water in India. It is available in 8 pack sizes: 250ml cups, 250ml bottles, 500ml, 1 litre, 1.5 litre, 2 litre, 5 litre, and 20 litre. Its operations run throughout the subcontinent of India and is one of the leading bottled water supplying companies in India. As of 2007, Bisleri has 8 plants & 11 franchisees all over India.

6. Conclusion:

In conclusion, it may be said that protection of domain name as a trademark gets its focus from International to National level. As domain names are popularized, there was a number of disputed cases emerged and resolution by the authority/courts. Dispute resolution is still in its infancy in India however, one does foresee many more disputes as e-commerce becomes bigger and bigger in the country.

The concept of a domain name is an extended version of Trademark and has all the similar things of being seen as a Trademark. The case of *Arun Jaitley, v. Network Solutions Private Ltd.*,²⁶ laid out a few important points regarding domain names as Trademark by the following points –

1. That the domain name is not just an address but is used for a known person or the prospective customer to visit the webpage and immediately connect with that particular individual's services.
2. Domain names are the personality goodwill of the company in the virtual world which is similar to goodwill in the physical world.
3. It is important to have protection for domain names to protect them from cybersquatting or trafficking like Trademark law.

Finally we may say that, domain names are having their own reputation in a virtual world, there is a more chance of it being misrepresented by somebody else to harm the reputation and goodwill. Therefore, it should be seen as a Trademark and should be protected as a Trademark.

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