

## **IPR UPDATE**

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■ The Concept of  
'Mirror Orders'

### **Your View**

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### **By The Way**

\* If you file it, you'll know where it is, but you will never find it. If you don't file it, you'll need it, but you will never know where it is.

\* If you consult enough experts, you can confirm any opinion and support any position.

## **DOMAIN NAME - POTENTIAL TRADE MARK**

**INTRODUCTION:** Although the internet has been around for over a decade, the concept of '**Domain Name**' is still an enigma to many. From the average person's point of view, it is understood as the internet address belonging to any specific person or entity. Though this may seem easy to understand, conceptually, Domain Names are quite technical in nature. Domain name is a name given to the "**Internet Protocol address**" or in short '**IP address**' of every computer having internet accessibility and is identified through a combination of numbers and for ease of identification, are allotted names.

A trade mark as defined under The Trade Marks Act, 1999 should be capable of distinguishing the goods or service of one from another and should be able to establish a connection or indication in the course of trade between the goods or services and the person claiming to have some right as proprietor for using the mark. Similarly, a domain name is required to be different and distinguished from other names present on the domain of the web and should be corresponding with a bona fide offering of goods or services.

**'CYBER SQUATTING':** The advent of domain name registration has initiated a new set of problems for the registered trade mark users/owners. Time is an important factor in the registration of a domain name and a policy of **first come first serve basis** is used for registering a name as a domain name. Keeping this in mind, many people registered well known domain names which resembled well-known trade mark/ names. Accordingly, they were granted/allotted a particular domain name.

Due to this policy a trend for '**Cyber Squatting**' evolved in which an unlicensed user registered a trademark as a domain name in order to pressure the bona fide trade mark owner/user and extort money or other benefits from such lawful trade mark owner/user. Since there was no connection between trade mark registration and domain name registration, such domain names did not come under objection at the time of registration. This loophole in the procedure further encouraged cyber squatters to demand exorbitant prices for selling these domain names to the registered trade mark owners/users who were desperate to protect their goodwill. Initially, the Courts too were not well equipped with knowledge in dealing with matters of cyber squatting in the absence of any law or regulation to that effect.

**AUTHORITIES, POLICIES & PRECEDENTS:** Realising a need for change and in

light of the aforesaid circumstances, a strong recommendation was made to formulate laws for regulating the domain names in cyber space. Accordingly, ICANN (International Community for Assigned Names and Numbers), Uniform Domain-Name Dispute-Resolution Policy ("UDRP"), came into existence with an object to streamline the process of acquiring domain names. Consequently a similar policy was adopted/introduced in India known as **.IN DISPUTE RESOLUTION POLICY ("INDRP")** with a similar object. The courts across the country and authorities world over started reacting in seriousness to instances or cases of cyber squatting or misuse of registered trade mark by registered domain name holders, who were not the registered trade mark owner/user. Some of the land mark international and domestic cases on this issue are:

**Ms. Barkha Dutt Vs. Easyticket, Kapavarapu, Vas<sup>1</sup>** : The complainant, Ms. Dutt, in the present case filed with World Intellectual Property Organisation's (WIPO's) Arbitration and Mediation Centre and was heard and decided in accordance to UDRP, its rules and supplementary rules. In this case the complainant succeeded in proving all the three elements as required under the said UDRP which are:

- Respondents registered domain name was identical or confusingly similar to trademark or service mark of the complainant in which she holds right.
- Respondent failed to prove any right or legitimate interests in respect of his registered domain name.
- Registration and use of the registered domain name was in bad faith by the Respondent.

In light of this criteria being satisfied the competent authority transferred the disputed domain name back to the complainant.

**Yahoo Inc. Vs. Akash Arora<sup>2</sup>**: The Plaintiff was the owner of the Trade mark "Yahoo!" and domain name "yahoo.com", which are very well known. The Defendant adopted the domain name "Yahooindia.com" and got the same registered in his name. The Plaintiffs filed a suit contending that the action of the Defendant was that of 'passing off' and that he should be permanently restrained from continuing the same.

Accordingly, the Hon'ble Court held that the said word "Yahoo" had acquired distinctiveness and is associated with the business of the Plaintiff. The use of domain name "yahooindia.com" by the Defendant leads to passing off of the business of the Plaintiff as his own and hence the same shall be permanently discontinued. Therefore, an injunction restraining the Defendant from using the impugned mark was granted.

**Rediff Communication Ltd Vs. Cyberbooth and Anr.<sup>3</sup>** : The plaintiff was using the trade mark/domain name "Rediff.com" and the Defendant started business by using the mark/domain name "Radiff.com". Plaintiff filed a suit for passing off against the defendant company.

It was held that the two names were almost similar and there is every possibility that the Internet user may be deceived and confused. Therefore the court accepted the prayer of the plaintiff and restrained the defendant from using the disputed domain name.

**CONCLUSION:** : Domain Names are, per se, not registered as a Trade Mark as they have to be examined for the evidence of distinctiveness. Domain names are neither automatically eligible nor ineligible for registration as trade marks. The test for a domain name to be registered as a trade mark is whether the domain name has the ability to function, not simply as a domain name, but also as a

trade mark for goods or services of the kind specified by the applicant.

**By - Pooja Sharma, Associate**

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1. Ms. Barkha Dutt Vs. Easyticket, Kapavarapu, Vas (Case No. D2009 - 1247)
2. Yahoo Inc. Vs. Akash Arora (1999 PTC (19) 201 Delhi)
3. Rediff Communication Ltd Vs. Cyberbooth and Anr (AIR 2000 AIR Bom. 27)

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