

Does Cybersquatting amount to Infringement & Passing Off of Domain Names ?

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Basic Concepts:

Firstly, we have to understand a little bit about the *Domain Names* and some of its related aspects. The Domain Name System (“DNS”) serves the primary function of facilitating user’s ability to navigate the Internet. It has 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.¹

Domain names identify one computer from the millions of others connected to the internet enabling users to send e-mail, to access web pages, to transfer files etc. A domain name is thus an internet address identifying a computer site connected to the internet in the same way that a telephone number uniquely identifies a telephone line connected to the global telephone network. No two organizations can have the same domain name as no two people have the same telephone number. The DNS is a distributed database where information about domains and the computers that host them is spread across many Name Server computers connected to the Internet. The name server simply provides the IP address of a specific computer on the Internet in answer to a query made by someone using the alphanumeric string. The searcher’s computer then connects to the right computer.²

The DNS has been administered by IANN (Internet Assigned Names and Numbers), pursuant to principles that were described in Request for Comments (RFC) 1591 of March 1994. The DNS operates on the basis of a hierarchy of names. At the top, are the top-level domains, which are usually divided into two categories: the generic top-level domains (gTLDs) and the country code top-level domains (ccTLDs). There were, at the onset seven gTLDs which were established by ICANN (The Internet Corporation of Assigned Names and Numbers). Three of these are open, as there is no restriction on the persons or entities that may register names in them. These three gTLDs are “.com”, “.net” and “.org”. The other four “restrictive” gTLDs are “.int”, which can only be registered to use by international organization, “.edu”, which is restricted to use by four-year, degree-granting colleges and universities, “.gov”, which is restricted to use by agencies of the federal government of United States of America and “.mil”, which is restricted to use by the military of the United States of America. In addition to gTLDs and ccTLDs, there is one special TLD, “.arpa”, which is used

¹ WIPO, December 23, 1998, “*The Management of Internet Names and Addresses: Intellectual Property Issues*”, Interim Report of the WIPO Internet Domain Process

² Kitchin, Llewelyn, Mellor, Meade, Stuart, Thirteenth Edition, Kerly’s Law of Trade Marks and Trade Names, Sweet & Maxwell.

for technical infrastructure purposes.³

Once registered, a domain name may be used in various ways. Generally, a domain name forms part of a website address (technically known as an URL - Unique Resource Locator). It may also be used as part of an email address, for example info@squiffo.com. Domain names are often used in advertising to point people to information about an organization and they identify a company or organization.⁴

In the case of *American Civil Liberties Union v. Reno*⁵, Judge Mokenna has explained the Internet address system, as follows; each host computer providing Internet services (“site”) has a unique Internet address. Users 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.

The domain name, therefore, not only serves as an address for Internet communication but also identifies the specific Internet site. As a domain name owner provides information/services that are associated with such domain name, a domain name may pertain to provisions of services within the meaning of S. 2(1)(z) of the Trade Marks Act, 1999.⁶ Hence the Domain Name today serves as online trademark, because it is not only a source identifier but also indicates the quality along with the goodwill.

Secondly we must familiarize ourselves with what is *Cybersquatting*?

Cybersquatting – registration, use or trafficking in a domain name with mala fide intent to make profit from the goodwill of the trademark belonging to the owner of such trademark.⁷

‘Squatting’ means occupying an abandoned or unoccupied space or building, usually residential, that the squatter does not own, rent or otherwise have permission to use. So Cyber-squatting refers to the bad faith registration of a domain name containing another person’s brand or trademark in a domain name. It can be defined as registering, trafficking in, or using a domain name with bad-faith i.e. mala fide intent to make profit from the goodwill of a trademark belonging to someone else. The cyber squatter then offers to sell the domain to the person or company who owns a trademark contained within the name at an inflated price. With the domain prices falling and more top level domains (.biz, .cn, .mob and lately .in) getting accredited, cyber squatters are in business fulltime.⁸

As long as a cybersquatter owns the domain name, the trademark owner cannot register his own trademark as a domain name. Thereby, a cybersquatter breaches the right of the trademark owner to utilize his own trademark. It is relevant to note that there is nothing wrong with the practice of reserving a domain name. The problem spawned by cybersquatting is augmented as entrepreneurs try to take advantage of the reputation of others by registering domain names which attract members of the public.

³ Country Code Top Level Domains. Available from: <<http://www.icann.org/en/resources/cctlds>>. [30 April 2014].

⁴ P. Narayanan, Sixth Edition, *Trade Marks and Passing Off*, Eastern Law House.

⁵ *American Civil Liberties Union v. Reno* (1996) 929 F Supp 824.

⁶ Rodney D Ryder, 2002, *Intellectual Property and the Internet*, Lexis Nexis.

⁷ Lecture on ‘Domain Name & Cybersquatting’ by Mr. James M.

⁸ Mr. Sanchit Mehta, “*Cybersquatting and its Legal Position*”, Manupatra Articles. Available from: <<http://www.manupatrafast.com/pers/Personalized7.aspx>>. [30 April 2014].

Particular concern is regarding the growing practice of registering the names of celebrities, particularly where domain name is used for a pornography site. The evolution of the domain name registration system is causing growing concern for trademark owners, in particular some of the effects of the use of computer software to automatically register expired domain names and the free-of-charge for a five-day 'testing' period, the proliferation of new registrars, and the establishment of new generic Top Level Domains (gTLDs). The combined result of these developments is to create greater opportunities for the mass, often anonymous, registration of domain names without specific consideration of third-party intellectual property rights. While electronic commerce is flourishing along with the expansion of the Internet, recent developments in the domain name registration system have fostered practices which threaten the interests of trademark owners and cause consumer confusion. Practices such as 'domain name testing' risk turning the domain name system into a mostly speculative market.⁹

The US legislature has already dealt with this issue by enacting the Anticybersquatting Consumer Protection Act, 1999 (ACPA). The Act creates civil liability for bad-faith registration with the intent to profit of domain names that are identical or confusingly similar to distinctive trademark. Personal names are also protected. Remedies under the Act include injunction, forfeiture or cancellation of domain name, actual damages or profits, or elective statutory damages of between \$ 1,000 and \$ 100,000 per domain name.

Thus Cybersquatting is the act of registering a domain name that is same as, or deceptively similar to, the trademark of another with the intention of selling (at a profit) the domain name to the trademark owner or passing off his own goods or services as that of the registered owner of the trademark.

The nuisance of cybersquatting is evident from the fact that cybersquatting disputes filed with the World Intellectual Property Organization (WIPO) in 2016 increased by 25% as compared to 2015.¹⁰

Lastly with respect current market practices we must also know what is a *Famous Mark*?

Well-known trade mark (or a Famous Mark) means a mark which has become so familiar to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first mentioned goods or services.¹¹

The very concept of 'well-known trade mark' has been incorporated in the Trade Marks Act, 1999 for the purpose of protecting not only a trade mark which has come to be identified with a particular type goods or services, but also for protection of the same mark from being used in relation to other goods and services, if a substantial segment of the public which uses the first mentioned goods or services is likely to be misled to believe that there is a connection in the course of trade between the second

⁹ Mr. Shine Joy, "Domain Name, Cyber Squatting And Domain Name Dispute Resolution", Manupatra Articles, Available from: <<http://www.manupatrafast.com/pers/Personalized2.aspx>>. [30 April 2014].

¹⁰ See "Cybersquatting Remains on the Rise with further Risk to Trademarks from New Registration Practices", Available from: <http://www.wipo.int/pressroom/en/articles/2007/article_0014.html>. [30 April 2014].

¹¹ The Trade Marks Act, 1999, Section 2(1)(zg).

mentioned goods and the proprietor of the trade mark in relation to the first mentioned goods and services. The Trade and Merchandise Marks Act, 1958 did not deal with a well-known trademark specifically. It is important to note that in India the term famous mark is synonymous with the term well-known mark.

Discussion on Merits:

Now as we have discussed the basic subjects related to the topic we may proceed to probable redressal options, in case a person is a victim of cyber squatting :

- a) The Complainant can file regular law suit in the Court of suitable Jurisdiction (Suppose any of the parties reside in Mumbai or the cause of action has arisen i.e. location of registration is in Mumbai then the Court will be Bombay High Court and so on)
- b) The Complainant can file Arbitration proceedings in the Uniform Domain Name Dispute Resolution Policy (UDRP) as the domain name disputes regarding a generic top level domain (gTLD) name are governed by the UDRP.
- c) The Complainant can file an arbitration proceeding with the .in registry handled by National Internet Exchange of India (NIXI) which brings the matter to fast track dispute resolution process whereby decisions are transferred within 30 days of filing a complaint (this option is only available to the Complainant if he uses a Domain Name “.in”).

The Complainant can pick any one of them based on his needs and resources, but for the sake of argument lets presume that he has filed a case in the Court demanding permanent injunctions under Order 39 Rule 1 & 2 of the Code of Civil Procedure, 1908 in order to desist the Respondent from using the disputed domain name along with damages. In order to establish his claim the Complainant has to show that his trademark and/or domain name are registered and that they are reputed marks, secondly the disputed domain name registered by the Respondent is either similar or deceptively similar with that of the Complainant and lastly that the Respondent has registered his domain name in bad faith.

Before we move ahead with the arguments we must see whether the law related to the Trade Marks is applicable on the domain names in equal force?

The unanimous view is that the internet domain name is of great importance and is a valuable corporate asset. A domain name is more than an internet address and is entitled to the equal protection as trade mark. With the advancement and progress in the technology, the services rendered in the internet sites have also come to be recognized and accepted and are being given protection so as to protect such providers from passing off the services rendered by others as his services.¹²

In the case of *Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.*¹³ the Hon'ble Supreme Court has held that “The original role of a domain name was no doubt to provide an address for computers on the internet. But the internet has developed from a mere means of communication to a mode of carrying on commercial activity. With the increase of commercial activity on the internet, a domain name is also used as a business identifier. Therefore, the domain name not only serves as an address for internet communication but also identifies the specific internet site. In the commercial

¹² *Acqua Minerals Ltd. v. Mr. Pramod Borse & Anr* 2001 A.I.R. DEL 463.

¹³ *Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd* 2004 A.I.R. SC 3540.

field, each domain name owner provides information/services, which are associated with such domain name. Thus a domain name may pertain to provision of services within the meaning of Section 2(z). A domain name is easy to remember and use, and is chosen as an instrument of commercial enterprise not only because it facilitates the ability of consumers to navigate the Internet to find websites they are looking for, but also at the same time, serves to identify and distinguish the business itself, or its goods or services, and to specify its corresponding online Internet location. Consequently a domain name as an address must be peculiar and unique and where a domain name is used in connection with a business, the value of maintaining an exclusive identity becomes critical. 'As more and more commercial enterprises trade or advertise their presence on the web, domain names have become more and more valuable and the potential for dispute is high. Whereas a large number of trademarks containing the same name can comfortably co-exist because they are associated with different products, belong to business in different jurisdictions etc, the distinctive nature of the domain name providing global exclusivity is much sought after. The fact that many consumers searching for a particular site are likely, in the first place, to try and guess its domain name has further enhanced this value'. Hence, the question whether a domain name can be said to be a word or name which is capable of distinguishing the subject of trade or service made available to potential users of the internet was decided in affirmative."

In the case of *Tata Sons Ltd. v. Manu Kasuri & Others*¹⁴ the Learned Single Judge of the Hon'ble Delhi High Court held that "I am satisfied that it is now settled law that with the advent of modern technology particularly that relating to cyberspace, domain names or Internet sites are entitled to protection as a trade mark because they are more than a mere address. The rendering of Internet services is also entitled to protection in the same way as goods and services are, and trademark law applies to activities on Internet."

In the case of *Yahoo! Inc. v. Akash Arora*¹⁵, which is probably the first reported Indian Case on this topic the Plaintiff was a global internet media giant and the registered user of the domain name "Yahoo.com" whereas the Respondent had registered the domain name "Yahooindia.com". The learned Single Judge of the Delhi High Court rejected the argument that the provisions of the Indian Trade Mark Act would not be attracted to the use of the domain trade name or domain name on the Internet. The learned Judge held that although the word 'services' may not find place in the expression used in sections 27 and 29 of the Trade and Merchandise Marks Act, services rendered have to be recognised for an action of passing off. The learned Judge held that the two marks/ domain names "Yahoo!" of the plaintiff and "Yahooindia" of the defendant are almost similar excepting for the use of suffix "India" in the latter. The learned Judge also rejected the argument of the defendants that the Internet users are sophisticated users and only literate people who are able to ascertain can approach the actual Internet site that they intend to visit. The learned Judge observed that if an individual is a sophisticated user of the Internet, he may be an unsophisticated consumer of information and such a person may find his/ her way to the different Internet site which provides almost similar type of information as that of the plaintiff and thereby confusion could be created in the mind of the said person who intends to visit the Internet site of the plaintiff, but in fact reaches the Internet site of the defendant.

¹⁴ *Tata Sons Ltd. v. Manu Kasuri & Others* 2001 (90) D.L.T. 659.

¹⁵ *Yahoo! Inc. v. Akash Arora* 1999 (19) P.T.C. 201.

In the case of Dr. Reddy's Laboratories Limited¹⁶ v. Manu Kosuri and Anr.¹⁶ Hon'ble Delhi High Court has held that the domain name serve same function as the trademark and is not a mere address or like finding number of the Internet and, therefore, plaintiff is entitled to equal protection as trade mark. The domain name is more than a mere Internet address for it also identifies the Internet site to those who reach it. 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 rendered through the domain name in the Internet, a very alert vigil is necessary and a strict view needs to be taken for its easy access and reach by anyone from any corner of the world. The trademarks/domain name 'DR. REDDY'S' of the plaintiff and 'drreddyslab.com' of the defendants are almost similar except for use of the suffix 'lab.com' in the defendants domain use. The degree of the similarity of the marks usually is vitally important and significant in an action for passing off as in such a case, there is every possibility and likelihood of confusion and deception being caused. Considering both the domains' name, it is clear that two names being almost identical or similar in nature, there is every possibility of an Internet user being confused and deceived in believing that both the domain names belong to plaintiff although the two domain names belong to two different concerns.

Where the parties are engaged in common or overlapping fields of activity, the competition would take place. If the two contesting parties are involved in the same line or similar line of business, there is immense possibility for confusion and deception and, therefore, there is probability of sufferance of damage. In Card service International Inc. Vs. McGee¹⁷, it was held that the domain name serve same function as the trademark and is not a mere address or like finding number on the Internet and, Therefore, it is entitled to equal protection as trademark. It was further held that a domain name is more than a mere Internet address for it also identifies the Internet site to those who reach it, much like a person's name identifies a particular person or more relevant to trade mark disputes, a company's name identifies a specific company. Accordingly, the Court granted the injunction upon consideration of the relevant law namely, Section 32 of the Lanham Act. In the facts of the said case it was held that Cardservice International's customers who wish to take advantage of its Internet services, but do not know its domain name are likely to assume that "cardservice.com" belongs to Cardservice International. It goes on to hold that these customers would instead reach McGee and see a home page for "Card Service" and thereby many would assume that they have reached Cardservice International.

In the case of Info Edge (India) Pvt. Ltd. v. Shailesh Gupta & Anr.¹⁸ the Hon'ble Delhi High Court has held that the domain names "Naukri.com" of the plaintiff and "Naukari.com" of the defendant, depicting the nature and type of business activity they carry on are identical or confusingly similar trade mark or service marks. It is also a possibility for an internet user while searching for the website of the plaintiff to enter into the website of the defendant through only a small mis-spelling of the domain name and, in fact, such incident has occurred in the case of the plaintiff itself vis-a-vis the defendant in proof of which a documents is also placed on record. Such diversion of traffic with the sole intention of ulterior gain in the similar business activity by a competitor, requires protection. A court discharging equitable justice should come in aid and for protection of the honest user as opposed to a dishonest user acting on bad faith.

¹⁶ Dr. Reddy's Laboratories Limited¹⁶ v. Manu Kosuri and Anr 2001 (58) D.R.J. 241.

¹⁷ Card service International Inc. Vs. McGee 42 USPQ 2d 1850.

¹⁸ Info Edge (India) Pvt. Ltd. v. Shailesh Gupta & Anr. 2002 (98) D.L.T. 499.

As we have seen that the domain names have similar protection of the law as the Trade Marks and some precedents in this field recognized in the Indian as well as Foreign Jurisdictions, we must move on to show that when does the Respondent's act amounts to passing off of the Complainant's domain name but before that we have to prove that the Respondent has registered his domain name in bad faith.

Firstly, we must understand what is meant by registration in bad faith?

As per the Uniform Domain Name Dispute Resolution Policy framed and adopted by the Internet Corporation for Assigned Name and Numbers (ICANN) RULE 4(a) the following types of disputes can be submitted to the administrative-dispute-resolution service providers ("Providers").

You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that

- (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) you have no rights or legitimate interests in respect of the domain name; and
- (iii) your domain name has been registered and is being used in bad faith.

For the purposes of Paragraph 4(a)(iii), the following circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.¹⁹

The Indian Courts have also recognized this principle in the case of *Info Edge (India) Pvt. Ltd. v. Shailesh Gupta & Anr.*²⁰, where the Hon'ble Delhi High Court held that "The website using the domain name, similar to that of the plaintiff, for commercial purposes, would lead to an inference that the domain name was chosen intentionally to attract internet users of the plaintiff. This is also established in view of the minor spelling variant to a well-known mark, without any Explanation and the same

¹⁹ Uniform Domain Name Dispute Resolution Policy, Rule 4(a), Available from: <http://www.icann.org/en/help/dndr/udrp/policy>. [30 April 2014].

²⁰ *Supra* 18

definitely creates a prima facie inference of bad faith within the meaning of paragraph 4(b)(iv) to the aforesaid Policy, which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN), on August 26, 1999.”

In the case of *Maruti Udyog Ltd. and Suzuki Motor Corporation v. World Information Pages*²¹ the Administrative Panel of the WIPO Arbitration and Mediation Center held that the potential customers would be induced to subscribe to the services of the impugned web site or to deal in some matter with the Respondent/3rd party believing them to be licensed or authorized by the Complainants, potential customers would be induced to believe that the Respondent/3rd party have some connection with the Complainant in terms of a direct nexus or affiliation with the Complainants or either one of its joint venture partners, they would be induced to believe that the Respondent/3rd party is carrying on activities that have been endorsed by the Complainant and services that are sought to be offered by the respondents have the same level of quality and reliability that is synonymous with the goods and services of the Complainants. Therefore, the registration of the domain name “marutisuzuki.com” is a “Bad Faith registration”.

In *Red Bull GmbH v. Bayer Shipping & Trading Ltd.*²² the plaintiff filed a complaint with the WIPO Arbitration and Mediation Center which held that “In the light of the documentary evidence placed on record regarding the sales, marketing and advertisement of the products of the Complainant in approximately 193 countries including United Arab Emirates, the Panel also finds merit in the contention of the Complainant that the Respondent had registered the Domain Name <myredbull.com> being fully aware of the Complainant’s considerable reputation and the fact that they are the proprietors of the famous mark "Red Bull". The record also reveals that the Respondent approached the Complainant for selling the impugned Domain Name for US\$ 100,000 with the stipulation in writing in their communication dated December 22, 2002, that if there would be no response by the Complainant by the end of the year, the name would be sold through an internet auction. The Panel is, therefore, of the opinion that the registration of the disputed Domain Name by the Respondent is in bad faith. The Panel decides that the Respondent’s domain <myredbull.com> should be transferred to the Complainant.”

Lastly, in the case of *Acqua Minerals Ltd. v. Mr. Pramod Borse & Anr.*²³ the learned Single Judge opined that “Unless and until a person has a credible Explanation as to why did he choose a particular name for registration as a domain name or for that purpose as a trade name which was already in long and prior existence and had established its goodwill and reputation there is no other inference to be drawn than that the said person wanted to trade in the name of the trade name he had picked up for registration or as a domain name because of its being an established name with widespread reputation and goodwill achieved at huge cost and expenses involved in the advertisement.”

Clark and Lindsell On Mark in 15th Edition defines passing off as an actionable wrong as – “It is an actionable wrong for a trader to conduct his business as to lead to the belief that his goods or business are the goods or business of another. This wrong is known as "passing off". It is immaterial whether the false representation, as to

²¹ *Maruti Udyog Ltd. and Suzuki Motor Corporation v. World Information Pages* Case No. D2000-0881, Available from: <<http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0881.html>>. [30 April 2014].

²² *Red Bull GmbH v. Bayer Shipping & Trading Ltd.* Case No. D2003-0271, Available from: <<http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0271.html>>. [30 April 2014].

²³ *Acqua Minerals Ltd. v. Mr. Pramod Borse & Anr* 2001 A.I.R. DEL 463.

goods or business, involved in passing off, is made expressly in words, or impliedly, by the use or imitation of a mark, trade name or get-up with which the goods of another are associated in the minds of the public.”²⁴

Secondly as stated in the well-known treatise on the *Laws of Trademarks and Passing Off* by P. Narayanan²⁵ “The general principles of the law applicable to cases where a person uses a name or intends to use a name which is likely to deceive and divert the business of the plaintiff to the defendant or cause confusion between the two businesses are analogous to the principles which are applicable to ordinary cases of passing off relating to sale of goods.”

It is a settled legal position that when a defendant does business under a name which is sufficiently close to the name under which the plaintiff is trading and that name has acquired a reputation the public at large is likely to be misled that the defendant's business is the business of the plaintiff or is a branch or department of the plaintiff, the defendant is liable for an action in passing off. When the plaintiffs and defendants are engaged in common or overlapping fields of activity, the competition would take place and there is grave and immense possibility for confusion and deception and, therefore, there is probability of sufferance of damage.²⁶

Reference may be made to the decision of the Hon’ble Delhi High Court in *Monetary Over seas v. Montari Industries Ltd.*²⁷, wherein it was found that the defendant adopted a trade name that was identical to that of the plaintiff and the court while injuncting the defendant held “When a defendant does business under a name which is sufficiently close to the name under which the plaintiff is trading and that name has acquired a reputation and the public at large is likely to be misled that the defendant's business is the business of the plaintiff, or is a branch or department of the plaintiff, the defendant is liable for an action in passing off.”

In deciding the question that will the principles of trade mark law and in particular those relating to passing off apply, the Hon’ble Supreme Court held that²⁸ “The use of the same or similar domain name may lead to a diversion of users which could 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 they accidentally arrived at a different but similar web site which offers no such services. Such users could well conclude that the first domain name owner had mis-represented its goods or services through its promotional activities and the first domain owner would thereby lose their customers. It is apparent therefore that a domain name may have all the characteristics of a trademark and could found an action for passing off.”

In *Marks & Spencer Vs. One-in-a-Million*²⁹, which is a landmark case on this subject it was held that any person who deliberately registers a domain name on account of its similarity to the name, brand name or trademark of an unconnected commercial organisation must expect to find himself on the receiving end of an injunction to restrain the threat of passing off, and the injunction will be in terms which will make

²⁴ *Ibid.*

²⁵ P. Narayanan, Sixth Edition, *Trade Marks and Passing Off*, Eastern Law House, India

²⁶ *Supra* 15

²⁷ *Monetary Over seas v. Montari Industries Ltd* 1996 P.T.C. 142.

²⁸ *Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.* 2004 A.I.R. SC 3540.

²⁹ *Marks & Spencer Vs. One-in-a-Million* 1998 F.S.R. 265.

the name commercially useless to the dealer. It was held in the said decision that the name 'marks and spencer' could not have been chosen for any other reason than that it was associated with the well-known retailing group. The decision further goes on to say that where the value of a name consists solely in its resemblance to the name or trade mark of another enterprise, the Court will normally assume that the public is likely to be deceived, for why else would the defendants choose it? It was also said that someone seeking or coming upon a website called <http://marksandspencer.co.uk> would naturally assume that it was that of the plaintiffs.

An important aspect regarding the use of Internet by first time customers was discussed in the case of *Rediff Communication Ltd. v. Cyberbooth and Another*³⁰ where the Hon'ble Bombay High Court held that there is always a possibility of the first user accessing the defendants' website believing it to be the plaintiffs' website because of the close similarity in the domain names. It is pointed out by the plaintiffs that the potential users, and existing users, talk about such website, products and services, and it is entirely possible and likely that on a potential user being told to access the site "REDIFF" he may get misled on accessing the website "RADIFF" when he is looking for the website "REDIFF". Moreover, a first time visitor to website cannot possibly distinguish one website from another website which also he has not visited. Besides this, as a result of the adoption of the domain name "RADIFF", the public are likely to associate the defendants' domain name with the plaintiffs and/or as part of the Rediffusion group.

In *British Telecom Plc. v. One in a Million*³¹ the Court held that in the case of a registration of domain names of third party trademarks of well-known names, there was jurisdiction to grant injunctive relief when the defendant was equipped with or was intending to equip another with an instrument of fraud. It was also held that a name, which would by reason of similarity to the name of another, inherently lead to passing off, was such an instrument. It was held that in case it would not inherently lead to passing off but the Court concluded on the facts without regard to the defendant's intention that the name was produced to enable passing off, was adapted to be used for passing off and, if used, was likely to be used fraudulently, an injunction would be appropriate.

In *Tata Sons Ltd. v. Fashion ID Ltd.*³², it was reaffirmed that the principles of passing off would fully apply to an infringement of a domain name and that action would be available to the owner of a distinctive domain name. It was observed, "internet is like a market place where people buy and sell. Trade and commerce is carried on through the internet". Defendants in this case were accordingly restrained from conducting any business using the domain name "tatainfotecheducation.com" or the word "Tata".

Lastly, in relation to the distinctiveness of the mark the Hon'ble Kerala High Court in *PenBooks Pvt. Ltd. v. Padmaraj, Emity Estate, Kalpatta*³³ it was held that though the words "Pen" and "Books" were generic in nature, when combined as "PENBOOKS", they get an identity and distinctiveness attached to plaintiff's establishment. Injunction granted by the lower Court was upheld.

³⁰ *Rediff Communication Ltd. v. Cyberbooth and Another* 2000 A.I.R. BOM 27.

³¹ *British Telecom Plc. v. One in a Million* 1999 F.S.R. 1.

³² *Tata Sons Ltd. v. Fashion ID Ltd* 2005 (30) P.T.C. (Del) 182.

³³ *PenBooks Pvt. Ltd. v. Padmaraj, Emity Estate, Kalpatta* 2004 (29) P.T.C. (Ker) 137.

Conclusion:

In light of the authorities cited I am of the opinion that the law related to the Trade Marks is applicable on the domain names in equal force, and as there has been an exponential growth in the sectors of e-commerce and social networking in the recent past *Domain Names* have acquired the status of high potential assets for any organization. It must not only establish and promote them but also protect them with equal skill. Until a specific legislation is made in this regard we must use the provisions of the Trade Marks Act, 1999 and other relevant statutes to safeguard our interests in our Domain Names.

[The views expressed in this paper are personal views of the author on the topics discussed and should not be treated as a solicited legal advice.]

[The author reserves the right to alter/modify/withdraw his opinion expressed in the paper at any stage.]

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