



## A Descriptive Study on the Intersection of Trademark and Domain Name Disputes in India

*Arshjot Kaur<sup>1</sup>, Arryan Mohanty<sup>2</sup>*

<sup>1</sup>GHG Institute of Law, Ludhiana

<sup>2</sup>Symbiosis Law School, Nagpur, India.

### ABSTRACT:

Since the inception of the dot-com boom, there has been a remarkable increase in internet usage and dependence, establishing it as a fundamental element of contemporary communication, commerce, and information sharing. This notable escalation in online engagement has, in turn, spurred the growth of digital marketing, which has become vital for businesses looking to connect and interact with their intended audiences. Like traditional marketing—where products are often endowed with unique identities and associated goodwill that aid in consumer recognition and differentiation—the digital realm has embraced comparable identifiers, mainly through domain names and websites. These online markers have evolved to function similarly to trademarks, acting as indicators of origin and reliability in the online marketplace. Understanding the crucial importance of trademark law in safeguarding these source identifiers and preventing bad-faith actors from capitalising on the commercial value linked to recognised reputations, this research advocates for formally accepting domain names as trademarks. They argue that the legal justifications supporting the protection of physical products should also apply to their online equivalents, given the similar roles they play in consumer identification and brand integrity. Through a systematic comparative examination of legal systems across different nations, the authors underscore a considerable inconsistency in how various jurisdictions tackle the issue of cyber-squatting—a tactic where individuals pre-emptively secure domain names that correlate with prominent trademarks to sell them at inflated prices. The investigation uncovers a significant lack of uniformity in legal responses. It highlights the deficiencies of the existing domain name registration framework, which predominantly functions on a first-come, first-served basis. This unregulated landscape unintentionally encourages opportunistic behaviour, permitting cyber squatters to exploit legal loopholes. Utilising a doctrinal approach, the authors put forward a series of thoughtful reforms to current legislation and propose alternative dispute resolution methods that could yield more effective and fair outcomes. These suggestions aim to improve the domain name allocation system, promote more significant equity, and serve as a deterrent against exploitative actions. Ultimately, the authors seek to fill the existing gaps in regulatory frameworks and contribute to establishing a more equitable and just digital environment for all parties involved.

### Introduction

In ancient societies like Greece and Rome, people often marked items to indicate ownership or origin. As these civilisations progressed, so did their trade practices, leading to a demand for unique product identifiers, ultimately leading to trademarks. With the growth of e-commerce, companies began establishing their online presence. Yet, an entity must have a unique online identity to function digitally. The Domain Name System (DNS) was created to solve this issue as a more accessible alternative to complicated numerical IP addresses.<sup>3</sup> In 2020, as the world faced the unprecedented challenges of the COVID-19 pandemic, numerous entrepreneurs saw the crisis as a chance to start or grow their businesses—primarily online, which had emerged as the most effective means of sharing information and establishing market presence. One of the significant scientific breakthroughs that supported this transition was the invention of the computer. With its extensive implementation came notable advancements across different sectors, made even more dynamic by the influence of the internet. During the early 1990s, the Internet was mainly utilised for email exchanges and basic information searches. However, as e-commerce rapidly expanded, the Internet became a centre for various commercial activities. Today, it is crucial in almost every element of our lives—from digital banking and e-wallets to e-governance, online dispute resolution systems, and information technology. This technological evolution has turned the Internet into an essential platform for innovation across many industries. Nonetheless, while its benefits are clear, the internet is also susceptible to misuse. Its fundamentally open and borderless nature has rendered it vulnerable to numerous forms of abuse, resulting in intricate legal and ethical issues within the digital space. One of the key challenges arising from this environment is the tension between domain names and trademarks.<sup>4</sup>

<sup>1</sup> Student from GHG Institute of Law, Ludhiana (Affiliated to Panjab University, Chandigarh)

<sup>2</sup> Student from Symbiosis Law School, Nagpur (Affiliated to Symbiosis International University, Pune)

<sup>3</sup> Shraddha Tiwari, Trademark issues related to Internet Domain Names, iPleaders (February 27, 2025, 07:10 PM) <https://blog.ipleaders.in/trademark-issues-related-to-internet-domain-names/>

<sup>4</sup> Arryan Mohanty, Domain Names in India: A Legal Perspective, Law Insider India (February 28, 2025, 06:39 PM) <https://lawinsider.in/columns/domain-names-in-india-a-legal-perspective>

Domain names have become vital for online businesses, functioning as web addresses, commercial identifiers, and branding instruments. Many now consider domain names to be the digital counterparts of conventional brand names. Established within the Domain Name System (DNS), these names are registered and act as unique markers in the online environment. They represent a business's digital identity and are converted into IP addresses through DNS servers to enable internet connectivity. Because domain names are easy to recall and user-friendly, they have emerged as powerful branding tools. Although initially meant to be technical addresses for locating computers on the web, domain names have since transformed into essential business identity and communication elements in the digital marketplace. As online commerce has grown, domain names play a role beyond mere digital addresses; they have become significant indicators of business presence and legitimacy. Consequently, there is increasing pressure on trademark owners to secure domain names that correspond with their brands. Many companies prioritise obtaining ".com" domains due to their perceived credibility and commercial advantage. Given the saturation of popular extensions like ".com," ".org," and ".net"—with millions of names already registered—organisations frequently find themselves willing to pay considerable amounts to acquire their desired domain names from others. In the end, a domain name has developed into more than just a technical designation; it represents a website's identity to users, akin to how a person's name identifies an individual or a company's name denotes a business. Within the framework of trademark law, this relationship prompts significant questions regarding ownership, rights, and resolving disputes when domain names and trademarks collide.<sup>5</sup>

While trademarks and domain names may serve similar purposes, they are distinct legal concepts. However, they frequently overlap in practice. In certain instances, individuals intentionally register domain names that closely mimic established trademarks to mislead consumers—this practice is known as "cybersquatting." The United States Patent and Trademark Office (USPTO) allows domain names to be trademarked under specific circumstances to address such abuses. When assessing whether a trademark has been violated, U.S. courts use the Sleekcraft test, a legal criterion that evaluates the likelihood of consumer confusion. In the digital space, trademark infringements can occur in multiple ways, such as unauthorised hyperlinking and framing, improper use of meta tags, or dilution of trademark prominence. A domain name typically consists of two components: the Top-Level Domain (TLD) and the Second-Level Domain (SLD), both of which can be registered with registrars authorised by the Internet Corporation for Assigned Names and Numbers (ICANN), such as organisations like the World Intellectual Property Organization (WIPO). Conflicts regarding domain name ownership or misuse can be settled through various means, including Alternative Dispute Resolution (ADR), mutual agreements, or formal legal actions. To aid in resolving such disputes worldwide, ICANN implemented the Uniform Domain-Name Dispute-Resolution Policy (UDRP). Despite these procedures, jurisdiction poses a significant issue, as the global nature of the internet makes enforcing legal rulings complicated. Identifying which court has the authority to hear the case and whether its decision can be enforced across international borders are crucial challenges in domain name and trademark disputes.<sup>6</sup>

## Trade Mark & Domain Names

Intellectual property rights afford creators exclusive authority over their inventions and creations, particularly concerning intangible assets. Among these, trademarks hold significant importance in the business sector by allowing companies to forge and protect their distinct identity in a competitive and crowded marketplace. Section 2(1)(zb) of the Trade Marks Act, 1999 defines a trademark as any sign that can be represented graphically and distinguishes one entity's goods or services from another's.<sup>8</sup> This definition includes product shapes, packaging designs, and unique colour combinations. Essentially, a trademark serves to:

- Recognize the origin of goods or services;
- Denote a specific quality standard;

Assist in marketing and selling those goods or services.

Under the Trade Marks Act 1999, domain names can also be registered and protected as trademarks, assuming they fulfil the legal criteria for trademark registration. Once these domain names are officially registered, they receive worldwide protection through entities like the Internet Corporation for Assigned Names and Numbers (ICANN). In cases of misuse—such as improper registrations or breaches of intellectual property rights—formal complaints can be lodged through mechanisms like the Uniform Domain Name Dispute Resolution Policy (UDRP) at the international level or through India's domestic IN Domain Name Dispute Resolution Policy (INDRP). These frameworks aim to resolve disputes related to domain names effectively and equitably. In the current digital era, where having an online presence is critical for businesses, e-commerce platforms, and personal branding, domain names play an essential role. They help establish a brand's identity in the online arena. For companies aiming to create a strong digital presence and draw in consumers in physical and virtual markets, securing a domain name that closely resembles their brand or registered trademark is vital. This clarifies users navigating numerous websites, enabling them to locate the authentic brand and avoid confusion easily. This necessity also highlights the dangers of cybersquatting, where individuals deliberately register domain names similar to established brands to take advantage of their reputation.<sup>9</sup> Conflicts emerge when someone uses a domain name that violates existing rights or trademarks. To resolve such conflicts, complainants must satisfy specific criteria outlined in dispute resolution systems. Typically, this involves proving valid trademark rights, demonstrating that the domain was registered in bad faith, and showing that the respondent has no legitimate entitlement to the domain name. Given the global nature of the internet, these infringements can occur across borders, often involving parties from different nations. The UDRP provides a unified procedure for addressing these

<sup>5</sup> Ibid

<sup>6</sup> Shraddha Tiwari, Supra Note 3

<sup>7</sup> The Trade Marks Act, 1999, § 2(1)(zb), No.47, Acts of Parliament, 1999 (India)

<sup>8</sup> Swati Agarwal, Domain Names As Trademarks: Beyond URLs, Mondaq (March 2, 2025, 09:36 PM) <https://www.mondaq.com/india/trademark/1400976/domain-names-as-trademarks-beyond-urls>

<sup>9</sup> Aastha Verma & Deergh Uppal, Navigating the Intersection: A Comparative Analysis of Domain Name Disputes and Trademarks in Intellectual Property – Insights from India and Beyond, Vol.VI Issue III, IJLSI, 337, 337-339 (2024) <https://ijlsi.com/wp-content/uploads/Navigating-the-Intersection-A-Comparative-Analysis-of-Domain-Name-Disputes-and-Trademarks.pdf>

disputes on a global scale, creating a consistent and organised process in contrast to the complex and varied domestic legal systems. The UDRP aims to deliver an accessible, prompt, and equitable solution to domain name disputes, particularly those concerning fraudulent or bad-faith registrations. By complying with this globally recognised policy, parties involved in such disputes can resolve issues, regardless of geographical boundaries, ensuring a fair and balanced resolution for everyone concerned.

With the increase in internet use and the rise of the digital age, the significance of domain names in commercial activities has expanded considerably. They are no longer limited to merely guiding users to websites; domain names have started to represent many essential characteristics associated with trademarks. This shift has led legal systems to acknowledge domain names as a type of trademark for several key reasons:

To begin with, domain names operate like traditional trademarks by serving as markers of origin. They assist in identifying the source of goods or services, playing an essential role in forming a company's digital brand identity. Consequently, businesses must maintain a distinct and exclusive online presence.

Additionally, as the internet has evolved into a vital centre for global commerce and digital communication, a company's online visibility and reputation have become just as critical as its physical market presence. This change has highlighted the necessity of protecting a brand's domain name from misuse or unauthorised use.

Furthermore, when a domain name mirrors the services provided by its owner, it may fall within the parameters of Section 2(1)(z) of the Trade Marks Act 1999.<sup>10</sup> This inclusion confirms that such domain names can qualify for trademark protection in the same manner as physical products or service identifiers.

A trademark's primary function is distinguishing one company's offerings from those of another. Similarly, domain names are key in helping consumers recognise and differentiate online businesses. As a result, it has become a standard practice for companies to register their domain names as trademarks to reinforce their digital brand identity. The Trade Marks Act, 1999 offers official legal protection to registered trademarks in India, allowing owners to seek legal remedies in infringement cases. Even if trademarks are not registered, protections may still be available under the doctrines of 'passing off' or 'trademark dilution' governed by common law. Legal remedies in these cases might include injunctions, compensation for damages, and the recovery of profits.<sup>11</sup>

The legal status of domain names as protectable assets was examined in the Supreme Court case *Satyam Infoway Ltd. v. Sify.net Solutions Pvt. Ltd.*<sup>12</sup> In this case, Satyam Infoway had registered domain names such as sify.net, sifymall.com, and sifyrealestate.com in mid-1999. Later, in June 2001, Sify.net began using similar domain names—siffynet.com and sifynet.net—for its online operations. Satyam Infoway initiated legal proceedings, asserting that Sify.net was misrepresenting its services and trying to benefit from Satyam's established online reputation. The trial court granted a temporary injunction favouring Satyam Infoway. Although the Karnataka High Court later upheld an appeal by the respondent, the matter was brought before the Supreme Court, which ultimately decided in favour of the appellant. The Court concluded that the respondent had indeed attempted to exploit the goodwill and reputation that Satyam had already built in the digital arena.

The presiding judge pointed out an essential difference between trademarks and domain names. Trademarks are typically protected within the borders of the countries where they are registered, which permits multiple registrations in various jurisdictions. In contrast, due to the borderless nature of the internet, domain names are globally accessible. This global accessibility requires a unique and exclusive identity on an international level, which existing national legal frameworks alone cannot sufficiently guarantee.

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## Trademark and Domain Name at the International Level

Trademarks generally receive legal recognition and protection exclusively within domestic and international jurisdictions where they are officially registered. They do not inherently possess global protection. In contrast, domain names that serve as trademarks or service marks can achieve worldwide recognition through registration, overseen mainly by the Internet Corporation for Assigned Names and Numbers (ICANN). Along with this global recognition, domain names may also take advantage of national trademark laws and international trademark treaties. However, no singular national or international trademark law provides complete and universal protection for domain names across all countries, often leading to legal conflicts. To tackle these issues and offer a streamlined approach to resolving such disputes, ICANN established the Uniform Domain Name Dispute Resolution Policy (UDRP). This policy enables trademark owners to challenge domain name registrations that violate their rights. The first case under the UDRP involved the domain name *worldwrestlingfederation.com*, filed in December 1999. It was adjudicated by the World Intellectual Property Organization (WIPO) Arbitration and Mediation Center, the first ICANN-approved body for dispute resolution.<sup>13</sup>

After WIPO, ICANN broadened the UDRP framework to include additional authorised dispute resolution organisations such as the Asian Domain Name Dispute Resolution Centre, the National Arbitration Forum, and the Arab Centre for Domain Name Dispute Resolution (ACDR). These accredited entities are authorised to:

- Cancel domain names acquired through cybersquatting,
- Alter domain name registrations, or
- Transfer the disputed domain name to the rightful claimant.

Under the UDRP, domain name disputes are settled through arbitration rather than court proceedings. For a complainant to succeed under this policy, they must establish three essential criteria:

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<sup>10</sup> The Trade Marks Act, 1999, § 2(1)(z), No.47, Acts of Parliament, 1999 (India)

<sup>11</sup> The Trade Marks Act, 1999, § 29, No.47, Acts of Parliament, 1999 (India)

<sup>12</sup> (2004) 6 SCC 145

<sup>13</sup> Abhishek Verma and Sukhwinder Singh, Conflict between Domain Names and Trade Marks in India: An Analysis, Vol VI Issue III, JETIR, 291, 294-295 (2019) <https://www.jetir.org/papers/JETIR1903044.pdf>

- The domain name in question is identical or confusingly similar to a trademark or service mark they own,
- The current registrant of the domain name lacks legitimate rights or interests in it, and
- The domain name was registered and is utilised in bad faith.
- The domain name can be cancelled or transferred to the complainant if all three criteria are met. However, the UDRP does not provide for financial damages as a remedy.
- The WIPO Arbitration and Mediation Center is the leading dispute resolution authority for domain names under the UDRP and is officially recognised by ICANN. WIPO guarantees impartiality, offers a roster of expert arbitrators, and employs effective administrative processes. Cases presented to WIPO are typically resolved within two months through online means, with minimal fees. In-person hearings are uncommon and reserved for exceptional scenarios.
- The National Centre for Software Technology (NCST) was initially entrusted with domain registrations nationally in India. On September 26, 2000, NCST broadened domain name categories under the ".in" extension by introducing "ind.in" for individuals and "gen.in" for general organisations. Unlike previous domain types such as "co. in" and "org. in," these classifications do not necessitate that the applicant be physically present in India," which requires registrants to have a local presence. Subsequently, on October 26, 2004, the Indian government appointed the National Internet Exchange of India (NIXI) as the official authority for overseeing ".in" domain registrations. NIXI was responsible for coordinating with accredited registrars who comply with international standards for domain name registration.<sup>14</sup>

## Settlement of Domain Name Disputes

The increase in disputes over domain names can primarily be linked to the complexities of jurisdiction in the digital realm. Specifically, there was an increase in cybersquatting cases in 2016. The United States pioneered specific legislation addressing online trademark infringements, known as the Anti-Cybersquatting Infringement Act of 1999. Typically, these conflicts can be resolved through various approaches, including:

- Alternative Dispute Resolution (ADR), such as arbitration or mediation,
- Judicial actions in a court setting,
- A mutual agreement between the involved parties, often accompanied by compensation,
- Following the dispute resolution procedures specified in the domain name registration contract between the registrar and the registrant.

The Internet Corporation for Assigned Names and Numbers (ICANN) established the Uniform Domain Name Dispute Resolution Policy (UDRP) to facilitate global dispute resolution. This policy allows trademark holders to contest the legitimacy of domain names that could violate their rights. The inaugural case under the UDRP, which dealt with the domain *worldwrestlingfederation.com*, was filed in December 1999 and overseen by the Arbitration and Mediation Center of the World Intellectual Property Organization (WIPO)—the first UDRP dispute resolution provider authorised by ICANN. ICANN broadened the UDRP framework to encompass other recognised organisations, such as the Asian Domain Name Dispute Resolution Centre, the National Arbitration Forum, and the Arab Centre for Domain Name Dispute Resolution. These entities accredited by ICANN possess extensive authority, including:

- Revoking domain names that were registered in bad faith,
- Changing registration details of domains,
- Transferring domain ownership to the legitimate claimant.

The UDRP also provides remedies for domain registrants who, while not formally holding trademark rights, are popularly associated with the disputed domain name. The process initiates when a trademark owner submits a complaint to one of the appointed resolution bodies. The respondent must then reply within 20 days. By default, the UDRP applies to regions where ICANN accredits registrars but does not cover areas where local authorities have not embraced it.

Case Study: Singapore has established its regulatory framework, the Singapore Domain Name Dispute Resolution Policy. Under this framework, conflicts regarding domain names are settled by local courts according to their specific terms. The first case under this policy involved *Viacom International v. Elitist Technologies Co.*, where Viacom, a media giant based in the U.S. operating through subsidiaries such as MTV Networks, had registered the domain *www.mtv.com.sg* in Singapore. However, the respondent utilised a similar domain to provide email and entertainment services. The complainant sought the domain's transfer, which faced initial opposition. Ultimately, the Singapore Court ruled in favour of Viacom, concluding that the respondent's domain utilisation created a misleading impression of connection with the well-known entertainment brand. As a result, the court mandated that the domain be transferred to the complainant.<sup>15</sup>

## Role of Trade Mark in E-Commerce

Trademarks play a vital role in commercial operations by providing distinct identities to products or services. They allow businesses to stand out from their competitors, increasing customer recognition and encouraging brand loyalty. As a type of intellectual property, trademarks guard against unauthorised use or replication, preserving the brand's integrity. They also affect consumer purchasing decisions by indicating consistent quality and dependability. A well-recognized trademark can accumulate substantial value over time, becoming an essential asset for the business. Furthermore, trademarks facilitate unified branding strategies, which is crucial to expanding operations internationally. Legal protections against infringement further

<sup>14</sup> Ibid

<sup>15</sup> Phang, Hsiao Chung, Resolving Domain Name Disputes - a Singapore Perspective. Available at SSRN: <https://ssrn.com/abstract=639403>

strengthen a company's position within the market. In summary, trademarks enhance a company's reputation, build consumer trust, and promote broader market success.<sup>16</sup>

Creating a strong brand identity is essential for businesses seeking to excel in competitive environments. This requires developing a distinct mix of visual components, messaging, and core values that resonate with the target audience. Elements such as logos, colour schemes, typography, and communication style form the basis of this identity. Consistent use of these elements across various platforms reinforces brand recognition and association. An engaging brand identity sets a business apart and cultivates emotional connections, fostering trust and customer loyalty. Enhancing brand recall is crucial for ongoing business growth. This process involves creating a strong link between the brand and its products or services in consumers' minds. Regular exposure to visual and auditory cues—such as brand logos, catchy jingles, and memorable taglines—helps to solidify these connections. Effective marketing, creative content, and storytelling that resonates emotionally can also boost brand memory. Additionally, positive interactions with a brand create lasting impressions, leading to improved recognition and customer retention over time.<sup>17</sup> In the case of *Cardservice Int'l v. McGee*,<sup>18</sup> the court highlighted the significant impact a domain name has on influencing consumer perceptions. It noted that when consumers are unsure about a company's precise name, they frequently believe that the domain name accurately represents the business. This underscores the necessity of maintaining a consistent and easily identifiable brand image, with the domain name being a crucial component of a company's online presence. The court's recognition illustrates domain names' essential role in building consumer trust and brand awareness in the digital sphere. A comparable viewpoint was taken in *MTV Networks Inc. v. Curry*,<sup>19</sup> where the court acknowledged that a domain name resembling a company's name is a valuable corporate asset. This recognition stemmed from the understanding that domain names are practical tools for connecting with a business's target audience. By facilitating smooth and intuitive access, they enhance brand communication and boost visibility online. These judicial comments emphasise the strategic significance of domain names, mainly when they closely reflect the company's brand and identity, reinforcing their importance as vital assets in today's business environment.

Safeguarding a brand's image and market presence necessitates strong protection of its intellectual property. An essential part of this defence is averting unauthorised duplication and the proliferation of counterfeit items. Counterfeits can significantly undermine a brand's perceived worth, erode customer trust, and result in financial setbacks. Securing intellectual property—such as trademarks, copyrights, and patents—provides a legal framework against such infringements. Furthermore, anti-counterfeiting strategies like holograms, distinctive packaging, and product tracking technologies act as effective deterrents. Actively monitoring both the market and online platforms aids in the early detection of violations and allows for prompt responses. These initiatives not only safeguard a brand's authenticity but also enhance consumer confidence in the validity and quality of its products. Organisations must protect their unique offerings and innovations to maintain a strong foothold in the marketplace. This protection helps deter rivals from unlawfully imitating or reproducing proprietary concepts, services, or technologies. Intellectual property instruments—such as patents, copyrights, and trade secrets—are vital to this endeavour. Patents grant inventors exclusive rights to their inventions, while copyrights safeguard original artistic or literary creations. Trade secrets protect confidential information, such as formulas or methods, from being revealed or exploited. These legal safeguards ensure that a company's unique assets remain proprietary, preserving their worth and preventing competitors from undermining the brand's originality. By securing what distinguishes them, companies can maintain their advantage in a competitive market.<sup>20</sup>

Acquiring exclusive rights to original works, innovations, and brand identifiers is a significant benefit provided by enforcing intellectual property (IP). Companies obtain legal ownership through tools like patents, trademarks, and copyrights, which prevent unauthorised usage or replication. This exclusivity aids in differentiating products or services in the marketplace and builds consumer confidence. Enforcing IP rights entails legal actions to inhibit infringement, discourage imitation, and protect investments. Cases of infringement may result in compensation, court-ordered injunctions, and enhanced legal stature. Such enforcement encourages innovation and equips businesses with a competitive edge by safeguarding their distinct assets.

**Legal Remedies for Infringement** – In cases where intellectual property rights are infringed upon, businesses are entitled to initiate legal proceedings as a remedy. This involves filing lawsuits against individuals or entities that misappropriate or unlawfully replicate protected content. Legal actions can lead to court-ordered damages, cease-and-desist orders, or other forms of relief. Regardless of whether the breach concerns patents, copyrights, trademarks, or trade secrets, the effectiveness of these measures relies on solid documentation of ownership and evidence of misuse. Alternative dispute resolution methods, like mediation or negotiation, may also prove beneficial. Pursuing legal action aids in preserving the value of IP, discouraging future infringements, and ensuring that businesses maintain their competitive advantage and brand integrity. Safeguarding intellectual property is also critical for business development and international growth. Trademarks, copyrights, and patents establish trust and credibility, empowering companies to enter new markets confidently. These rights protect original concepts and products from duplication, enhancing brand loyalty and attractiveness. Strong IP protection also draws in investors and promotes global collaborations, simplifying the navigation of unfamiliar regulatory landscapes. By reinforcing authenticity and quality, IP rights serve as a gateway to broader market access, assisting companies in forming a secure and recognisable presence both at home and abroad.

**Cross-Border IP Protection** – Expanding IP rights across countries is vital for international operations. Treaties like the Paris Convention and the TRIPS Agreement (managed by the World Trade Organization) offer a framework for securing IP protection across various jurisdictions. These global agreements simplify gaining protection across borders and foster respect for IP internationally. To enforce these rights, businesses often must

<sup>16</sup> Sonalika Gupta & Malobika Bose, *The Intersection of Trade Mark Law and E-Commerce in India: A Study of Online Brand Protection*, Vol X Issue I, IJARIE, 4599, 4600 (2024)

[https://ijarie.com/AdminUploadPdf/THE\\_INTERSECTION\\_OF\\_TRADEMARK\\_LAW\\_AND\\_E\\_COMMERCE\\_IN\\_INDIA\\_A\\_STUDY\\_OF\\_ONLINE\\_BRAND\\_PROTECTION\\_ijarie23392.pdf?srltid=AfmBOorsG9HZMZTL0BatWf7ehLP6Dxq9MbB\\_rluKWuTuEFpy\\_EKsXluK](https://ijarie.com/AdminUploadPdf/THE_INTERSECTION_OF_TRADEMARK_LAW_AND_E_COMMERCE_IN_INDIA_A_STUDY_OF_ONLINE_BRAND_PROTECTION_ijarie23392.pdf?srltid=AfmBOorsG9HZMZTL0BatWf7ehLP6Dxq9MbB_rluKWuTuEFpy_EKsXluK)

<sup>17</sup> Suman U, *Trade Mark Violations in E-Commerce*, Vol V Issue I, IJLLR, 1-7 (2023) <https://www.ijllr.com/post/trademark-violations-in-e-commerce>

<sup>18</sup> 950 F. Supp. 737

<sup>19</sup> 867 F. Supp. 202

<sup>20</sup> Deesha Vyas & Mehel Chablani, *E-Commerce Market in India: Enigmatic Difficulties Necessitating Reforms*, Vol III Issue I, IJLLR [https://heinonline.org/hol-cgi-bin/get\\_pdf.cgi?handle=hein.journals/injllolw3&section=35](https://heinonline.org/hol-cgi-bin/get_pdf.cgi?handle=hein.journals/injllolw3&section=35)

collaborate with local authorities, IP agencies, and customs in different nations. Effective cross-border enforcement guarantees that a company's IP remains shielded from unauthorised usage in foreign markets, facilitating secure global expansion and the provision of consistent, high-quality products worldwide.<sup>21</sup>

Understanding intellectual property (IP) as an important intangible asset is essential for improving a brand's image and boosting investor trust. Components like patents, trademarks, and copyrights represent a company's innovation and distinctiveness, enhancing its overall market worth. Firms with strong IP protections are frequently viewed as dependable and forward-thinking, attracting investors and promoting long-term partnerships. Moreover, intellectual property can generate income through licensing, franchising, or strategic collaborations. Effective management of IP reflects a company's dedication to protecting its innovations, positively impacting investors' decisions. By safeguarding intellectual property, organisations bolster their brand value and heighten their chances of attracting financial support and strategic alliances. Legal safeguards for inventions and creative works reassure investors of a company's capability to stand out in the marketplace and maintain long-term growth. A well-structured IP portfolio minimises potential legal and competitive challenges, providing additional security for investors and stakeholders. Additionally, intellectual property can be utilised as an asset when pursuing financing, as it can serve as collateral. Presenting a comprehensive strategy for managing and capitalising on IP rights can create investment opportunities, strengthen alliances, and develop a network of stakeholders aligned with the company's vision for success.

### Protection of Trademarks vis-a-vis Domain Names

Trademark infringement occurs when one company utilises another company's trademark—or a mark that closely resembles it—in the marketplace for goods or services, with the aim of misleading consumers and reaping the benefits of the established reputation of the original brand. The growth of the internet has facilitated such violations, as competitors might construct websites or register domain names that closely mimic well-known brands to create confusion among consumers. Concerns regarding trademark infringement have existed since common law, and courts have developed various methods to assess these cases. A widely recognised framework is the Sleekcraft Test, which specifies factors to evaluate whether infringement has taken place. These factors include:

- The Strength of the Plaintiff's Mark: The more well-known or established the mark, the more likely it is to be infringed.
- The Similarity of Use: If the defendant employs a similar mark for similar goods or services in the same market, it heightens the likelihood of consumer confusion.
- The Intent of the Defendant: Unauthorized use of a mark, primarily when intended to benefit from the goodwill of the original brand, usually qualifies as trademark infringement.
- The Marketing Channels Used: For example, if the defendant markets products using the plaintiff's mark in the same retail environment or promotes them online with a domain name that resembles or refers to the original trademark, it bolsters an infringement case.
- The Jurisdictional Context: It is crucial to consider the geographical or market area where the plaintiff's trademark operates to determine whether infringement has occurred.

Using domain names that are either identical or misleading, like prominent trademarks, renders e-businesses susceptible to conflicts of trademark infringement, trademark dilution, or passing off claims. Such conflicts may emerge concerning cybersquatting or its reverse counterpart. Additionally, disputes may arise among domain name holders themselves, exemplified by the phenomenon of typo-squatting. Beyond the option of invoking ICANN's Uniform Domain Name Dispute Resolution Policy (UDRP), the available remedy within the Indian jurisdiction entails either pursuing recourse through the judicial system or resolving the disputes via the IN-Domain Name Dispute Resolution Policy (INDRP).

The lack of regulation of international domain names established a comprehensive framework governing the domain name system, which fell under the jurisdiction of the World Intellectual Property Organization (WIPO) and the Internet Corporation for Assigned Names and Numbers (ICANN). The collaborative efforts between WIPO and ICANN culminated in formulating a systematic approach to domain name registration and establishing the Uniform Domain Name Resolution Policy (UDRP) in 1999. The registration process operates on a principle of first come, first served. However, such registration does not inherently confer protection under Indian Trademark Law. According to the UDRP policy, a complaint may be lodged because the domain name is either identical to or confusingly like a trademark or service mark in which the complainant possesses rights. The determination of similarity is predicated upon the potential for consumer deception. In the context of a passing-off action, similarity is equally grounded in the deception experienced by consumers due to the identity or resemblance of the marks. The defences available to a complainant are analogous to those invoked in an action for passing off under Indian Trademark Law.

Traditionally, trademark disputes were resolved by courts applying established legal principles. However, as commerce has evolved—particularly with the rise of digital commerce—the standards and enforcement methods have also been modified to tackle contemporary forms of infringement. When users click on a highlighted link within a webpage—on purpose or by mistake—they are taken to a different website elsewhere. This process of redirection is called "linking." Unfortunately, this system can be misused for trademark infringement. In some instances, fraudulent parties imitate the trademarks of well-known brands and place them within hyperlinks across various sites. This misleading practice tricks users into believing they are visiting a legitimate site connected to the original brand. Another method employed is "framing," where a web developer designs a page that enables users to browse multiple other sites through embedded links, occasionally misrepresenting the origin or relationship of the content.

Moreover, websites commonly use a keyword field, and the alteration of this field is referred to as "meta tagging." This entails incorporating specific keywords into a website's metadata to affect search engine algorithms. By doing this, manipulators can guide users to irrelevant websites while pretending to be pertinent, even if the content has no authentic connection to the user's search query. Meta-tags serve as hidden indicators to the search engine, shaping results without being seen by the user, thus distorting the reliability and intent of search results.

<sup>21</sup> Ankit Singh, Regulation E-Commerce in India A Work in Progress, Vol II Issue IV, IJLMH (2019) <https://www.ijlmh.com/wp-content/uploads/2019/10/Regulating-E-Commerce-in-India-A-Work-in-Progress.pdf>

Cybersquatting can be characterised as registering, trafficking in, or utilising a domain name with a malicious intention to profit from the goodwill associated with a trademark owned by another entity. Subsequently, the cybersquatters propose to sell the domain to the individual or entity that holds the trademark embedded within the domain name at an exorbitant price. Numerous legal precedents in India indicate that cybersquatters have been prohibited based on the doctrine of passing off. In the Bisleri case,<sup>22</sup> Upon receiving a complaint from the trademark Bisleri and the domain name Bislerimineralwater.com proprietors, the Delhi High Court issued an injunction against an IT company from utilising the domain name Bisleri.com. In another ruling rendered by the Delhi High Court in the Yahoo! Inc case,<sup>23</sup> The Court enjoined the defendant from employing the domain name Yahooindia.com because it infringed upon the rights of the plaintiff, the owner of the earlier registered domain name Yahoo.com, which had been registered in various jurisdictions, excluding India. The court cited the case of Monetary Overseas v. Montari Industries to address the issue of passing off. The court ruled that if a defendant uses a name like the plaintiff's and has a reputation, the public may be misled into thinking it is the plaintiff's business or a branch of it.<sup>24</sup>

In the case of Panavision International, L.P. v. Toeppen,<sup>25</sup> the defendant applied for and successfully obtained registration of the domain name panavision.com, which resembles the name of the plaintiff company. The plaintiff, Panavision International, is a renowned manufacturer of filming equipment and cameras. The plaintiff sought to register panavision.com but was made aware of the defendant's domain registration. Consequently, the plaintiff informed the defendant of its intent to utilise the domain name panavision.com. However, the defendant demanded USD 13,000 to relinquish the domain name. The plaintiff declined the offer and initiated legal proceedings against the defendant based on a federal trademark dilution claim. The Court subsequently restrained Toeppen from further utilising the website and ordered him to transfer the domain name's registration to the plaintiff. Cybersquatting continues to be a pervasive concern in disputes concerning domain names. This phenomenon arises when individuals reserve domain names that incorporate trademarks with the intent to derive profit from them, frequently by proposing to sell the domain back to the legitimate trademark owner. This misconduct may also encompass the registration of domain names that consist of typographical errors of trademarks or names that include geographical identifiers. In India, domain name registration regulation falls under the purview of the Internet Corporation for Assigned Names and Numbers (ICANN), wherein the initial domain name registrant typically retains ownership, even when the name bears deceptive similarity to a trademark. Trademark proprietors must proactively register their domain names to safeguard against cybersquatting. Although prior use may apply to domain names, trademark owners must adopt proactive strategies to avert cybersquatting and the unauthorised appropriation of their domain names. A potential recourse for combating cybersquatting is the doctrine of passing off, which entails the unauthorised employment of a trademark on competing or related goods and services. While passing off constitutes a common law remedy and is not explicitly enshrined in statutory law, trademark proprietors have the right to seek damages and injunctions to curtail the unauthorised utilisation of their trademarks. The court cited the decision of In Card Service International Inc. vs. McGee, which determined that domain names fulfil the same role as trademarks and are not just addresses or numbers on the internet. As such, they are entitled to the same protection as trademarks. It was also determined that a domain name is more than just an Internet address since it identifies the Internet site to individuals who visit it, in the same way, that a person's name identifies a specific person or, more pertinent to trademark issues, a company's name identifies a particular firm.<sup>26</sup>

The case of Tata Sons Ltd. and Anr. vs. Fashion Id Ltd.<sup>27</sup> Critically examined the doctrine of passing off within the context of domain name disputes. In this instance, a company identified as Fashion Id Ltd. engaged in cyber-squatting registered a website under the domain name www.tatainfotecheducation.com. Nevertheless, this domain name bore a misleading resemblance to the trademark of an established entity, Tata Infotech. The Delhi High Court, in this matter, revoked the registration of the domain from the cyber-squatter and transferred it to the rightful owner, Tata Infotech, while asserting that *"It is thus obvious that principles of passing off would fully apply to an infringement of a domain name. Action would be available to the owner of a distinctive domain name."* However, courts have also articulated in numerous judicial precedents that a specific domain name may not be afforded the same level of protection as a trademark.

In a contention involving the domain names shaadi.com and secondshaadi.com, as illustrated in the case of People Interactive v. Vivek Pahwa,<sup>28</sup> The court remarked, *"The real difficulty is that shaadi.com is an address. It is the internet equivalent of a physical or terrestrial address. It directs a user to a particular part of the Web where a domain name registrant stores and displays his information and offers services. A physical mailing address can never be a 'trademark,' properly so-called. '10 Downing Street' or '1600 Pennsylvania Avenue' are not trademarks. A web address is, technically, a mnemonic, an easy-to-recall replacement for a complex string of numbers representing the actual internet protocol address (or addresses) where the website is to be found."*

Consequently, in denying the request for an injunction, the judge articulated, *"I believe, prima facie, that the plaintiff's mark is generic and commonly descriptive, and it is an address of an internet destination. There is no question of it 'now' referring exclusively to the plaintiff's website; it never pointed to anything else. But that does not make it a trademark."* In a recent case, GoDaddy.com LLC v. Bundl Technologies (P) Ltd.,<sup>29</sup> the Bombay High Court noted that *"...the Court cannot restrict a domain name registrar from registering certain marks which may lead to trademark infringement in futuro..... The Court held that a suit for trademark infringement is a suit in personam; therefore, in such a suit, directions cannot be issued to restrict third parties, and in each instance of infringement, the proprietor of the mark has to rush to the Court for seeking relief."*

The swift growth of e-commerce has resulted in a concerning rise in the prevalence of counterfeit products in global markets. Recent statistics from the Organization for Economic Cooperation and Development (OECD) indicate that fake goods constitute around 3.3% of international trade. This increase

<sup>22</sup> Acqua Minerals Limited vs. Pramod Bose and Ors, 2001 PTC 619

<sup>23</sup> Yahoo vs. Akash Arora 1999 PTC 201

<sup>24</sup> 1996 PTC 142

<sup>25</sup> 141 F 3d 1316

<sup>26</sup> 42 USPQ 2d 1850

<sup>27</sup> 2005 SCC OnLine Del 72

<sup>28</sup> 2016 SCC OnLine Bom 7351

<sup>29</sup> 2023 SCC OnLine Bom 227

poses significant challenges for consumers, brand owners, and regulatory authorities. Online marketplaces are especially susceptible, as the absence of physical inspections allows counterfeit items to be rapidly listed and sold. This misleads consumers and damages brand reputations, leading to financial losses and diminished goodwill.

Counterfeit products range from luxury items to necessities like clothing, cosmetics, pharmaceuticals, electronics, and household appliances. The growth of digital platforms has facilitated counterfeiters to reach broader audiences while operating under the radar. A notable example is Nike, which opted to withdraw its products from Amazon in 2017 due to an overwhelming number of fake items sold by unauthorised third-party sellers. Counterfeiters frequently utilise deceptive tactics such as creating counterfeit transactions through networks of accounts, employing bots to post positive reviews, and faking high sales figures to establish credibility and evade detection.

In addition to harming businesses and deceiving consumers, counterfeiting represents more significant risks to public health, safety, and the economy. In areas such as pharmaceuticals, counterfeit products can pose life-threatening risks. Moreover, revenues from counterfeit sales have been associated with the financing of illegal and even terrorist activities.

To tackle this issue, various legal measures have been implemented. The Trademarks Act, 1999 considers counterfeiting a type of trademark infringement, with penalties specified in Section 104.<sup>30</sup> Likewise, the Copyright Act, 1957 allows criminal prosecution against illegally distributing protected works. The Consumer Protection (E-Commerce) Rules, 2020, aim to regulate e-commerce activities and protect consumers from deceptive practices, including counterfeiting. These regulations mandate that platforms must provide truthful product descriptions and images. Additionally, the Information Technology (Intermediaries Guidelines) Rules, 2011, require intermediaries, including e-commerce websites, to exercise due diligence and discourage violations of intellectual property rights.

Despite these legal frameworks, effectively combating counterfeiting in the digital space remains a significant challenge. The anonymity provided by online platforms continues to be leveraged by counterfeiters, making identifying and removing infringing content more difficult. Brand protection managers frequently face challenges like underestimating the extent of counterfeit goods, having limited access to legal resources, and lacking organised strategies for digital brand enforcement. In conclusion, the widespread presence of counterfeit goods online introduces intricate problems for consumers, businesses, and regulatory bodies. While legislative efforts exist, their practical implementation relies on robust enforcement and collaborative action among all parties involved. Brand protection experts must remain vigilant and adopt proactive measures to safeguard brand integrity and consumer safety in the continually changing digital marketplace.

## Conclusion

The convergence of e-commerce and domain name dispute law is rapidly transforming, necessitating ongoing adaptation and a comprehensive understanding of legal frameworks and technological advancements. As online commerce grows unparalleled, a balanced strategy combining legal diligence with technological innovation is crucial for sustaining a secure, reliable, and compliant digital market. One significant pathway for national governments to influence and engage with ICANN's policymaking is through the Governmental Advisory Committee (GAC). Governments' active involvement is essential for formulating policies addressing country-specific concerns while aligning with local and global economic goals. However, the existing model has limitations; for example, India's participation in ICANN's initiatives requires strengthening. Aligning with international standards, especially those established by the World Intellectual Property Organization (WIPO), and increasing engagement in ICANN's activities could bolster the vision of a more digitally resilient India and alleviate pressure on domestic courts by utilising international dispute resolution mechanisms.

There is also a need to clarify how geographic indicators, individual names, and so-called "gripe sites" are treated under the UDRP. The current interpretation that criticism represents legitimate use and that the concept of "tarnishment" is inapplicable under the UDRP needs further refinement. Moreover, UDRP guidelines should clearly state that the complainant must establish demonstrating lousy faith as a separate element. Implementing an appellate mechanism could help avert inconsistent rulings and address interpretative challenges by setting precedents for future panels. Additionally, revising the current practice where providers appoint panellists could enhance fairness. Instead, a "cab-rank" system—where panellists receive cases based on their availability and absence of conflicts—should be adopted. To maintain a balanced caseload, panellists must perform brief reviews of publicly accessible decisions, which would not require extensive oversight from ICANN. This would foster transparency and consistency throughout dispute resolutions.

With the increasing activity in the online world, various thought-provoking concerns are being highlighted regularly. One of the most hotly debated topics is jurisdiction. Domain names and trademarks have become integral to the rapidly expanding e-commerce commercial activity. Domain names identify a company's presence on the internet and are now regarded as critical corporate assets. Domain names are often assigned on a "first come, first served" basis, and registrars such as NSI, which collaborates with the National Science Foundation, have veto authority over domain name assignments. However, these agencies can only do so if the domain name being registered is identical to the other one and registering it will violate the rights of the other. Understanding the origins of trademark laws is crucial, as they were initially designed to serve three key goals. First and foremost, trademarks were developed to act as a source identification for items. Second, they aimed to protect the established goodwill connected with a brand. Finally, the goal was to maintain the quality standards of the items given by a specific brand. Examining these goals emphasises the simultaneous role that domain names provide. At their foundation, trademarks and domain names serve similar objectives. As a result, there is a compelling case for giving domain names the same degree of protection as trademarks, subjecting them to similar scrutiny during allocation. Neglecting this alignment may result in misrepresentation and allow for potential cybersquatting. The complexities of domain name issues highlight the need for amendments to existing legislation. A significant addition would be the inclusion of a local arbitration clause that is both enforceable and consistent with the core principles of arbitration. Furthermore, there is a compelling need to criminalise cybersquatting to control the offence properly rather than relying primarily on common law remedies. By making cybersquatting a criminal offence, the offended party is relieved of the burden of demonstrating ancillary aspects

<sup>30</sup> The Trade Marks Act, 1999, § 104, No.47, Acts of Parliament, 1999 (India)



such as damages, past usage, and resemblance to the challenged mark. As a result, cybersquatting is classified as an offence, expediting judicial proceedings and strengthening the position of people whose actions have been mistreated.

As online engagement continues to expand, many intricate and intellectually stimulating legal dilemmas have arisen—one of the most contentious being the issue of jurisdiction. Trademarks and domain names assume a pivotal role in the flourishing e-commerce environment. A domain name functions as an entity's digital persona and is increasingly acknowledged as a significant commercial asset. Generally, domain names are allocated on a "first come, first served" principle. Entities such as Network Solutions Inc. (NSI), which has amalgamated with the National Science Foundation, possess the regulatory authority to govern domain name allocations. However, this authority can only be exercised when a proposed domain name mirrors an existing one, and its registration would unequivocally infringe upon the rights of another party.

Within the Indian legal framework, the absence of specialised cyber legislation has resulted in adjudicating such disputes under prevailing trademark statutes, mainly through invoking the "passing off" doctrine concerning domain names. Furthermore, the IN-Dispute Resolution Policy (INDRP) offers a structured mechanism for resolving these disputes. Considering the escalating intricacy of these conflicts and the challenges they present to Indian jurisdiction, it is imperative to enact comprehensive legislation that addresses explicitly cybersquatting and domain name disputes within the cyber landscape.