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# Applicability of Trademark Laws to Cyberspace: An Analysis

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## ABSTRACT

*E-commerce and online trading are now a component of the modern economy. In addition to the value of trademarks and their function in contemporary business, it's essential to keep in mind that the internet is the dominant force in this millennium. Every human action is governed by the internet, and business is probably one of the areas where it will have the biggest impact. When the internet first entered the scene, nobody was aware of the commercial prospects it offered. However, economic prospects emerged as a result of the slow growth of numerous internet tools including the World Wide Web (www), e-mails, etc. Companies are now using domain names to help others find them online as they trade and advertise their products there. The need of the hour for every commercial firm is to have a presence on the internet through a website in order to be successful. Websites need an address to be found, hence domain names were created for this purpose. Thus, domain names, a new idea in connection to trademarks in cyberspace, have emerged. In the same way that trademarks function in physical space, domain names function in cyberspace. The courts throughout the globe have given no less protection to Domain name than trademarks, however, the trademark law that was evolved and established to suit the needs of physical environment, having geographical boundaries, is ill suited for disputes involving domain names in a borderless cyberspace. The trademarks law allows one trademark to be used by two different traders on the same goods provided channels of market are separated by physical boundaries. Since political boundaries have vanished in cyber space, the trademark law finds it difficult to accommodate, "one mark two owners" possibility. Not only this alone many new issues related to trademark law have cropped up which await judicial resolutions. This research is conducted with the objective of analyzing the interplay of trademarks and domain names. For achieving the objective the study is divided in three parts. Firstly domain name, its role in cyberspace and its various categories have been discussed. In the second part of the article the impact of trademark law on cyberspace has been highlighted and finally in the third part an endeavor is made to analyse the applicability of trademark law to cyber space and role of judiciary.*

**Keywords:** Domain names, cyberspace, passing off, infringement .

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## I. INTRODUCTION

Domain names have drawn a great deal of attention on a global scale. The Domain Name System (DNS) makes it possible to access information from host computers and to send and receive messages anywhere on the Internet. It is a virtual address of some resource, device or service<sup>2</sup>. Businesses all around the globe have begun to see the enormous potential of websites as a key tool for enabling electronic trade. The business entities have now started new trade operations and online product marketing campaigns, and they have begun utilising domain names to help people find them quickly online. Concerns over intellectual property have increased as a result of the internet's amazing expansion as a commercial medium.<sup>3</sup>The conflict between domain names and trademarks has grown over the period of time and has given rise to a number of problems that pose important regulatory concerns. These issues result from the internet's structure, which disregards all boundaries and is incompatible with the system intended for the physical, territorial world.<sup>4</sup>. Therefore, the confluence of the domain name system (DNS) and the intellectual property system is just one illustration of a bigger phenomenon: the intersection of the global media, where traffic circulates without consideration of boundaries, and territorially-based systems that originate from sovereign power of the area.<sup>5</sup>

## II. DOMAIN NAMES

The Internet, as we know, is made up of thousands of separate, self-contained networks, each of which has millions of host machines. When two computers need to communicate, they must be able to recognise one another. Internet users who want to connect to another computer need a fixed address to do so in order to connect to that machine and utilise the service it offers. Every machine linked to the internet has an IP (internet protocol) address, which is a number used for identification on a worldwide scale. Generally, users prefer names over numbers even if using numerical addresses is a suitable method of communication through computers.

The communications protocol named Internet Protocol (IP) underlying the Internet allows large and geographically diverse networks of computers to communicate with each other instantly and economically over a variety of physical links. An Internet Protocol Computers on the Internet use IP addresses to route traffic and establish connections among themselves. e.g. when

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<sup>2</sup>M.Tariq Bandy&Farooq. A.Mir, Techno-Legal Interplay of Domain Names: A Study with Reference to India, World Academy of Science, Engineering and Technology International Journal of Computer and Information Engineering Vol:8, No:1, 2014

<sup>3</sup> P.S. Sangal, Trademarks and Domain Names: Some Recent Developments, Journal of Indian Law Institute (JILI) 1999. p. 36

<sup>4</sup> V.K. Unni, Trademark Law and Emerging Concept of Cyber Property Rights, 1st Ed., 2002 Eastern Book House.

<sup>5</sup> See report of WIPO entitled "The Management of Internet Names and Addresses: Intellectual Property Issue". Final Report of the WIPO Internet Domain Name Process, 30 April 1999.

a request for a Webpage is sent from a client computer system to a Webserver, the client computer includes the IP address of the Webserver. In order to make the identification of destination computer system simple and mnemonic, a Domain Name System (DNS) has been developed which enables to use globally unique easy-to-remember names called domain names for Webpages and mailboxes, rather than long numbers or codes.<sup>6</sup>

The names were referred to as domain names and the mechanism is known as the Domain name system (DNS). The domain name system is the distributed database responsible for the domain name-to-IP address conversion, while the domain name service, as the name implies, is the service offered by this system<sup>7</sup>. Thus the fundamental function of the domain name on the internet is to identify and find the address of the website.<sup>8</sup>

### **(A) Definition**

Before engaging in any kind of economic action in the current e-economy, a company must be able to be found online, or have a physical address in cyberspace. As a result, machines on the internet are located and identified using their domain names. Every server permanently connected to the internet has an identifiable but distinctive identification number known as an internet protocol address, much like how every office or apartment in the physical world has an address, which is composed of a street, a city name, and a country. I. P addresses are composed of digit sequences separated by periods,<sup>9</sup> which other computers connected to the internet use to send messages or access data stored on computers. For example, 207.46 130.150 (the IP address of Microsoft's website www.microsoft.com) is not user-friendly and is difficult to use and remember. The computer linked to the internet has the ability to convert each numerical address to its matching mnemonic alpha- numeric counterpart, known as a domain name, in order to make the internet more user-friendly. Consequently, a domain name functions as an accessible equivalent of an IP address.<sup>10</sup>

The computer transforms an easy-to-remember mnemonic domain name into a distinct numeric address that corresponds to the relevant computer site when a user types the name into the browser; it then converts that specific numeric address into the mnemonic one and search the

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<sup>6</sup>M.Tariq Bandy&Farooq.A.Mir, *Techno-Legal Interplay of Domain Names: A Study with Reference to India*, World Academy of Science, Engineering and Technology International Journal of Computer and Information Engineering Vol:8, No:1, 2014

<sup>7</sup> Ibid.

<sup>8</sup> Mohammad Hussain, *Trade mark and Domain names, Conflict and Conciliation*, KULR 2001 p. 96.

<sup>9</sup> The IP addresses are comprised of strings of digits delimited by periods. The delimited fields indicate the network sub-networks and local address reading from left to right. A typical Internet address might appear as 207.82. 250. 251 where 207 is network, 82 & 250 refer to sub network and 251 refer to computer itself.

<sup>10</sup> Internet applications have been designed to automatically look the IP addresses corresponding to designations this is done through a facility called domain name system, which operates invisibly to the user.

site. Consequently, mortals like us do not need to know these complicated IP addresses.<sup>11</sup> To put it simply, these domain names serve the same purposes in the digital sphere as a physical address would in the real one; in fact, a cyber address directs the virtual mailman to a specific computer on the internet. Furthermore, even when a person relocates, the domain name remains the same. Anywhere in the world, a person can access a website with the same name.<sup>12</sup>

The browser tries to obtain the IP address of the domain name when a user inputs a domain name into the browser to access a website. The domain name server, which keeps track of the list of domain names and their accompanying numeric IP addresses, provides data to the browser. If the IP address is valid, the domain name server then passes it on to the browser otherwise, it delivers an error notice or refers the user to another page. The user can interface with the web server to access specific websites after identifying an IP address. Therefore, from a technical perspective, the domain name is a mnemonic device an internet user uses to instruct a computer to obtain the internet protocol number of the desired website, with the IP address being the numerical address code required to locate and communicate with the computer hosting a website anywhere in the world. The use of a site name helps the computer find the IP address of the site so that it can communicate with it and allow users to access web pages.<sup>13</sup>

A hierarchy is used to assign each domain name, and it starts at the right end of the name. The domain name is divided into a number of tiers, or domain levels, that are separated by full stops. Its maximum length is 255 characters, with 63 characters allowed for each string.<sup>14</sup>

## **(B) Categories of Domain Names**

Domain name consists of two levels of use from right to left.

### **1. Top level domain TLD**

### **2. Second level domain SLD**

1. **Top level Domain TLD:** - Top Level domain is that part of the domain name which identify the company or the nation where the address was registered. It is present on the right most side of the domain name (URL). For example .com is recognised as the top-level domain in the instance of www.hotmail.com (TLD). There were typically three sorts of TLDs.

- a. Generic top level domains (g-TCD)

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<sup>11</sup> V. K. Unni, *Trademark and Emerging Concept of Cyber Property Rights* 2002, Eastern Book House, p- 16.

<sup>12</sup>Farooq Ahmad, *Domain Name Dispute and Trademark Law: Cyber Law in India* 2000, Pioneer books, p- 134.

<sup>13</sup>PG, *Medic Me. V. Network Solutions Inc*, Supp. 2d 389, 390.

<sup>14</sup> David W. Quinto, *Law of Internet Disputes*, 1<sup>st</sup> Ed, 2002 supp, Aspan Law and Business.

- b. Sponsored Top Level Domains (s-TLD)
- c. Country code top level domain (Cc-TLD)

As of 2015, there are thousands of top level domains in the following categories

- Generic Top Level domains (gTLD)
- Infrastructure Top Level Domains (ARPA)
- Restricted Top Level Domains (grTLD)
- Sponsored Top Level Domain (sTLD)
- Country code Top Level Domain (cc TLD)
- Test Top Level Domain (t TLD)

Root Zone Database maintains the whole list of top level domains by IANA. The list contained 1589 TLD's on March 2021 out of which 68 were not assigned (revoked), 8 retired and 11 were test domains so on April 2021 there are 1502 TLD's registered<sup>15</sup>

**a) Generic TLD's:** - Specifies the sort of company that owns the domain name. Currently, there are seven TLDs; of these, .com, .org, and .net are the three that are freely available. The remaining four g-TLDs, however, are not as widely available, meaning that only a limited number of individuals or organisations are permitted to register after meeting specific requirements. Seven g-TLDs are listed, the first of which is free to use and the next four of which require the fulfillment of additional requirements. .com – used for commercial and personal sites

- i. .org – Recommended for nonprofit organization
- ii. .net – Recommended for companies involved in internet infrastructure ie., internet providers.
- iii. .edu- Recommended for educational Institutions.
- iv. .mil – used by military agencies
- v. .gov. – used by government organizations.
- vi. .int – used by international organizations.

For the first three TLD's i.e. .com, .net. and .org. the information concerning each match is maintained in the registry owned by network solutions Inc. As per of May 2001 more than 35.6 million domain names had been registered worldwide including approximately 22.4 million in

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<sup>15</sup> Root Zone Database IANA.org.

the .com registry<sup>16</sup>. Recently Board of ICANN has approved on Nov. 7, 2000 seven new domain name extensions. They are .info- for information, .biz for business, .name for individuals, .pro for professionals, .museum for museum, .corp for corporations, .aero for aviation Industry.

It is clear that in 2001 there was a limited expansion of the top level domains. Twenty one new top level domains were added in 2008 out of which as per government policy only 14 TLD's were opened for registration .this was done in order to increase the choice in domain names and to give boost to competition.

On June, 2011, the board of ICANN voted to end restrictions on Top level domains. Companies and organizations were allowed to choose any top level domain even use of non Latin characters was recognized. The new generic TLDs (or gTLDs) will enable addresses to end in almost any word in any language, thereby enabling stronger and more creative brand. At that time Peter Thrussh the then chairperson of ICANN's board said

Today's decision will usher in a new internet age. We have provided a platform for the next generation of creativity and inspiration. Unless there is a good reason to restrain it, innovation should be allowed to run free<sup>17</sup>.

Currently there are thousands of generic top level domains registered.

This may lead to a new round of domain name and trademark disputes, historically a source of considerable legal and may be even more heated, as a custom TLD is more difficult to replace than a regular domain name with a generic TLD. Existing TLDs will still see much contention for domain names—many companies will want to be available at a more “traditional” address, at least for a long while, so Google may be reachable with main.google and google.com simultaneously. This may eventually also result in ICANN being forced to judge content even more than before to determine how to handle TLD management<sup>18</sup>.

### **b) Sponsored Top Level Domains (s-TLD)**

A Sponsored top level domain is a category of TLD's maintained by Internet Assigned Number Authority (IANA) for the use in Domain name system. It is a specialized TLD which has a sponsor which represents a particular community based on professional, ethical, geographical or technical makeup. It represents a narrower community most affected by TLD. For example .asia is sponsored by Dot Asia Organisations , .aero is sponsored by SITA,.edu by Educause

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<sup>16</sup> Current Statistics can be found at <<http://www.domainstats.com>.

<sup>17</sup><https://www.voanews.com/a/new-internet-name-rule-opens-door-to-huge-changes-124180874/141045.html>

<sup>18</sup>The Domain Name System: Past, Present, and Future. Available from: <https://www.researchgate.net/publication/268521730>

The Domain Name System Past Present and Future [accessed Dec 15 2022].

and so on

**c) Country Code top level domain (CCTLD):** There are several TLDs in addition to the standard TLDs that are referred to as CCTLDs (country code top level domains) based on where they are located. Each top-level domain with a country code has a two-letter country code that identifies the nation where the domain name was registered. e.g., .in for India, .de for Germany, .fr for France, .ca for Canada, .au for Australia, .us for USA etc. the CC TLCD's are administered by the respective governments or private organization<sup>19</sup>. The CCTLD's are listed in the International Standards Organization Documents ISO Norm 3166<sup>20</sup>. This list is periodically reviewed by the maintenance agency secretariat to include new born states. There are between 240-250 CCTLD's and the number changes from time to time as new countries gain independence. Since all the countries are not concerned with internet so some domain names are not yet available for use.

**d) Infrastructure Top Level Domain(.arpa)**

.arpa is mainly the technical network infrastructure. The top level domain .arpa is the acronym for Advanced Research Projects Agency the funding agency of U.S that developed APRANET. It was originally registered to facilitate systematic running of APRENET computers, but later it became practically difficult to remove the domain after the sanctioning of infrastructural use thus consequently the name was used as backronym Address and Routing Parameter Area (arpa). For example , as.arpa provides sinking of Domain name system traffic for reverse IP address Resolution The domain .arpa provides a lookup function that retrieves information associated with telephone numbers through the ENUM service.

2. **Second Level Domain: - (SLD)** SLD exists before TLD's in URL they are allotted to the parties for making a brand specific or to differentiate a body from similar entitles or competitions and they are chosen by registrant himself. These second level domains have given rise to dispute. The main difficulty with SLD's is the allotment of one specific name, which could not be used if needed by any other entity or body unlike TLD's e.g., in the URL *abc.co.in*, the word *abc* becomes SLD we find here that no other entity can have same SLD with that of same TLD's<sup>21</sup>.

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<sup>19</sup> See NTIA, Improvement of Technical Management of Internet Names and Address, the Deptt. of Commerce 63 Fed Reg. 8826, 8828 (1998).

<sup>20</sup> ISO is the high powered authority for the promotion of international internet development. It has over 6000 members throughout the world including 130 companies, a no. of internet access providers universities, software procedures and Int. Organizations like World Bank and IMF. For current codes see <http://www.din.de/germein/nas/nabd/ISO3166ma/>.

<sup>21</sup>Pankaj Jain and Pandey SangeetRai, Copyright and Trademark Laws Relating to Computers, Ist Ed. 2005, Eastern Book Co, p- 93.



Under the registered domain, there may be further hierarchies of sub domains. For instance, a commercial business named ABC may register the domain name abc.org.co.in. The organisation then creates domains like publicity by subdividing them depending on the names of divisions. Division of publicity for ABC.org.co. The financial section of ABC is supported by ABC's support division.<sup>22</sup>

Thus, the domain names are read from right to left, from top level domain names to sub level domain names from general to more specific areas of the internet. For instance, the URL <http://www.philips.india.co.in> suggests that the domain name has been registered in India, (.in CCTLD), it is a commercial entity (.co.GTLD), known by the entity's preferred name Philips India (SLD) and it is found on the World Wide Web (www). The page uses hyper text<sup>23</sup>.

A group of computers known as domain name servers translate a domain name into an IP address when it is input into a Uniform Resource Locator (URL) in order to find a website. For instance, in Philips India.co.in, the server first locates the system carrying information about SLD, i.e., Philips India, and then it locates the system carrying information about commercial organisation in India, i.e., org.com, allowing a link to be made to the appropriate site.<sup>24</sup>

Additionally, locating an Internet site requires more than just typing in the domain name; the computer also needs to know the structure and location of the data file.

Thus the Domain name serves two purposes

1. They are much easier to remember than IP addresses and
2. They allow internet to operate efficiently because the various levels in the domain name are hierarchical<sup>25</sup>.

### **III. INTERNET AND ITS IMPACT ON TRADEMARK LAW**

The basic premise of the legal protection of trademark rests on the fact that the trademark being the source identifier of goods and services, anyone, other than its true owner, using it will create consumer confusion as to its source<sup>26</sup>. Another logical basis of this protection is that no one should be allowed to reap benefits of the goodwill created by hard labor and investment of other. The trademark law gives right to prohibit, the use of the word or words, so far as, to protect the

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<sup>22</sup>NandanKamth, and AnkitMajumdar, Name Calling in Cyberspace: Domain Names and Law; Law Relating to Computer, Internet and E-Commerce 2<sup>nd</sup> Ed. 2002, Universal Law Pub. p.-218.

<sup>23</sup>Farooq Ahmad, Domain Name Disputes and Trademark Law: Cyberlaw in India, 2000,Pioneer Books p. 136.

<sup>24</sup>Ibid.

<sup>25</sup>David W. Quinto, Law of Internet Disputes, 2<sup>nd</sup> Ed. 2002 Supp., Aspen Law and Business p. 2 (3)

<sup>26</sup>WCVBTV v. Boston Athletic Association, 17 US PQ 2d (BNA) 168 - 169.

owner's good-will against the sale of another product as his<sup>27</sup>. The real protection of trademark does not go beyond the prevention of consumer confusion or protection of goodwill. Thus the use of the same mark on two different goods, or services in one place or the use of same mark in similar goods place or the use of same mark in similar goods or services in two different places, where market overlap is not possible, have been generally allowed because of the lack of consumer confusion<sup>28</sup>. Thus the trademark laws across the globe recognize one mark many owner possibility. But these well known principles of trademark jurisprudence do not fit in cyber space. Cyberspace knows no boundaries. It is a global market place that can serve millions of customers across the world<sup>29</sup> and websites acts as a "Shopwindow". The restrictions that apply throughout the globe for the registration of trademark do not apply for domain name registration. So any name whether generic or invented can be registered as the domain name. Since businesses are free to register any name as their domain name, they generally prefer their trademark or famous marks or any other name, that is easy to remember or guess<sup>30</sup> and, as more and more commercial enterprises trade or advertise their presence on the web, DNS have become more and more valuable and potential for disputes is high.

Thus these domain names have affected trademark law in many respects which may be enumerated as under:

1. Trademark law permits concurrent use of the same mark on related or unrelated products or services, as long as users are geographically apart and there is no risk of customer misunderstanding. Under the present domain name registration system, this is not feasible. Due to the domain name's exclusivity, its concurrent usage is not allowed. There cannot be two users of the same mark registering it in the same top-level domain and sub domain, for example, there can only be one whirlpool.com. Due to the fact that the Internet is only one big geographic region, no matter how different two people or firms' products or markets are, only one domain name may be granted to them.<sup>31</sup>
2. The domain name registration is based on "first come first serve" principle. Any person who may not be associated, in any way, with a well known name can register it, as his domain

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<sup>27</sup>PrestonetsInc v. Coty, 264 us 359, 368 (1924)

<sup>28</sup>Mead Data Central Inc v. Toyota Motor Sales USA Inc 875 f. 2nd 1026, 1031. Mead's lexus mark and Toyota lexus mark could exist in two different places because of lack of market overlap.

<sup>29</sup>See Yahoo Inc. V. AkashArora 1999 IPLR 196, noting that an internet site could be reached by anyone anywhere in the world who proposes to visit to said internet site (pg. 208) also see Rediff Communication v. Cyberbooth AIR 2000 Bom. at 27. Internet is one of important features of information revolution

<sup>30</sup>Gayle Weiswasser, Domain Names, the Internet and Trademarks: Infringement in Cyber space, Computer and High Technology Law Journal vol. (13) 1997 at p. 140.

<sup>31</sup>Farooq Ahmad, Domain Name Disputes and Trademark Law: Cyber Law in India (Law of Internet), 2001, Pioneer Books p. 139.

name, with the result the legitimate owner having goodwill in that name will be prevented from registering it as his domain name. However, a person can register the same sub domain in another top level domain for instance, it is possible to register the trademark “Amazon” as amazon.com or amazon.org. Similarly amazon.com and amazon shopping.com can be registered. The same domain name can be registered with any of the other country top level domain amazonshopping.in,amazonshopping.us, where .in stands for India and .us stands for United states. Furthermore only the same domain names cannot be registered twice, but the names that look alike can be registered. For instance, leberly.com can be registered as a domain name even if liberty has been registered. It has been laid down that the domain names identify internet sites to those who reach it, much like a person’s name identifies particular person or more relevant to trademark disputes, a company’s name identifies a specific company<sup>32</sup>.

3. The current technology does not make possible to differentiate domain names through the use of capitalization stylized format or fonts.<sup>33</sup> Since a website can be accessed from any part of the globe, a famous mark of one actually registered in another country in sub domain, can be accessed in the country of its origins and is likely to result consumer confusion there, especially when the registrant offers the same good or services for which the mark is famous in the country of its origin.
4. The application of current substantive and procedural principles has been altered by the development of the Internet. The national boundaries of each country are the extent of the courts’ jurisdiction. These boundaries recognize the rules controlling jurisdiction that the courts develop and establish, parties better understand the boundaries of their own jurisdiction as well as the locations of the other parties they were engaging in business with. But this nineteenth-century philosophy finds it challenging to address the problems brought about by the arrival of Cyberspace, which has basically a worldwide scope and recognises no political boundaries.<sup>34</sup> Through the internet, participants may carry out transactions without revealing their identities and may even be geographically dispersed. The parties may be located in two distinct continents or nations. A website may be accessed from any place. The question arises that in case of trademark infringement which court has

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<sup>32</sup> Id p. 139.

<sup>33</sup> See Andre Brunel, Billions Registered But No Rules: Scope of Trademark Protection for Internet Domain Names, *Journal of Intellectual Proprietary Rights*, March 1995, p. 4. (Stating that although the words “wire” and “wired” look quite different on paper the technology of internet cannot yet allow this differentiation to translate to domain name address).

<sup>34</sup> See Howard B. Stravitz, Symposium, Personal Jurisdiction in Cyberspace: Something More is Required on the Electronic Stream of Commerce, 49 *S.C.L. Rev.* 925 (1998).

Jurisdiction. The owner of the web site may be residing in one place, web site may be hosted at another place and it can be accessed from any part of the Globe. The Internet, which is completely defiant of any territorial restrictions, and the conceptions of personal jurisdiction, which are fundamentally territorial in nature <sup>35</sup>. This complicates the implementation of ideas with a territorial foundation.

Businesses first paid little attention to domain names since they believed they had no real value beyond having computer addresses that needed to be distinctive like phone digits. They did not object to their registration, though. Furthermore, technical personnel who paid little to no regard to market factors picked these domain names.

The problems with domain names first surfaced when a business seeking to register its trademark as a domain name discovered that another party, not in any way connected to the brand, had already registered it as his own domain name. Two schools of thought evolved as a result of the legal challenges to domain name registrations based on trademark law, which sparked a discussion in academia regarding the status of domain names and the viability of applying trademark law.<sup>36</sup>

According to one theory, domain names and trademarks are not the same thing. One may argue that a domain name is simply a way to access the internet, much like a street address or a building's name. Legal challenges should not be permitted to be successful just because a domain name is similar to someone's registered trademark because these domain names are not fundamentally trademarks and are not being utilised as trademarks. Equating domain names with the postal address, it is stated that there has been never an argument that postal address be seen as synonymous with a trademark. Any name should not be subject to cancellation for likelihood of confusion with a registered trademark, regardless of how similar it is.<sup>37</sup>

The other view is that domain names are, undoubtedly, the unique indicators on the indices for the internet which not only identifies the address of the home page of any given website but it has a secondary role also. Being an alpha-numeric address, easy to remember for people to access any given website, it is not only an address but also specific identifier<sup>38</sup> A domain name based on famous trademark or a trade name conveys all the goodwill and intangible value

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<sup>35</sup> Andrew E. Costa, Comment, Minimum Contacts in Cyberspace: A Taxonomy of the Case law, 35 *House. L. Rev.* 453, 455-56 (1998).

<sup>36</sup> Charlotte Waelde, *Domain Names and Trademark: What is in a name* p. 63. Also see Farooq Ahmad, *Domain Name Disputes, Cyber Law in India (law of Internet)*, 1st Ed. 2000 Pioner Books, p. 140.

<sup>37</sup> Richard L. Baum and Robert C. Combow, *First Use Test in Internet Domain Name Disputes*, 18 *NATL. LJ*, Feb. 12, 1996, p. 18.

<sup>38</sup> Graham J. H. Smith, *Internet Law and Regulation* 2<sup>nd</sup> Ed. 1999, p. 47.

encapsulated in the trademark, even if that domain name is not used for commercial purposes and the company should not lose protection for that mark, simply because it is used in cyberspace. Justification of treating domain names separate from trademarks, would have arisen had domain names been used, only for locating a website. Since domain name has ability to communicate the identity of its source<sup>39</sup>, it is this function which brings them within trademark jurisprudence. The important function of domain name to identify the source of the product or service, demands that they should be treated equivalent to trademarks in terms of legal protection and be recognized as capable of infringing other trademarks<sup>40</sup>

Therefore, corporations are prepared to invest a significant amount of time and money into the acquisition of these names and conflicts over the registration of domain names have resulted from this pursuit. When businesses with similar names or providing same kinds of goods try to use similar or identical domain names, it results in several disagreements. Generally speaking, two situations have led to domain name conflicts.

1. a person or group may register a website with a name they do not already have any other interests . This could be done for a number of reasons, including blackmail, taking advantage of goodwill, diverting online traffic, defamation, etc.
2. Parties have equal rights to a name.

Having said that, the truth of the matter is that a memorable, easy to spell domain name is more valuable than diamond<sup>41</sup> for corporations wishing to establish their presence on Internet. People are losing privilege of using words on the Internet because somebody else has already registered these words as his domain name<sup>42</sup>. Search results reveal that virtually all words describing people's daily lives are registered.<sup>43</sup> The sole person or entity that may own a given domain name, plus the fact that there is no Internet counterpart of a phone book or directory assistance, are the two factors that have caused this rush for domain names. When a customer is unsure of the firm's domain name, they frequently assume it to be the same as the company name. Because it makes it easier to communicate with a customer base, a domain name that is an exact match

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<sup>39</sup>Satyam Infoway Ltd v. Sifynet solutions Pvt. Ltd (2004) 6.In this Case the S/C observed that original role of domain names was no doubt to provide an address for computers on the internet, but the internet has now developed from a mere means of Communications to a mode of carrying an commercial activities therefore Domain Name not only serves as an address but also identifies the specific internets site.

<sup>40</sup> Ibid.

<sup>41</sup>David Yen, Virtual Reality: Can We Ride Trademark Law To Surf Cyberspace? Fordham I.P.M.E.L.J (2000) Vol. 10. 871Domain names are highly valued. Because millions of Internet users may potentially view them. See Jerome Gilson, Trademark Protection & Practice §5.11(1)(1997). Similarly in Cardservice Int'l v. Mc. Gee, 1950 F. Supp. 737, 741 (E.D. va 1997), it was laid down that a domain name mirroring a corporate name may be a valuable corporate asset, as it facilitates communication with a customer base

<sup>42</sup> Id at 872

<sup>43</sup> Id at 872

to a company name may be a significant corporate asset. Customers also often expect businesses to avoid utilising their trade names or trademarks as domain names. These consumers utilise the same information to navigate directly to that page by entering it into a browser. . If this doesn't work, users employ search engines' assistance and enter key terms or phrases they believe will be connected to the desired website. Due to this, the website's owner is compelled to use the same name as the domain name by which it is known outside of the internet.

Domain names have assumed much the same role in virtual space as trademarks in real space. This emerging area of cyber law eventually involves trademark law, with its emphasis on domain names, with a gradual increase of internet uses of trademarks. There is, no doubt, currently a great deal of confusion surrounding issues of trademark as domain names. Trademark law has to grapple with the issues thrown open by the Internet especially in the field of domain names. The principal allegation is usually of Trademark infringement. The primary question which arises is whether the use of domain name amounts to trademark infringement and whether the law of trademark applies to domain names. It will therefore be worth devoting some attention to the principles of infringement of trademark before probing into its effect on domain names.

Faced with a situation like this, the trademark holder has below mentioned options:-

1. The trademark holder could file a lawsuit under trademark law for infringement of trademark.
2. Common law remedy of passing off.

#### **IV. REMEDY UNDER TRADEMARK ACT FOR INFRINGEMENT OF TRADEMARK**

Specifically, the act complained of must meet the following criteria in order to constitute an infringement:

- (a) the mark used by the person must be either identical with or deceptively similar to the registered trade mark;
- (b) the goods or services in respect of which it is used must be specifically covered by the registration;
- (c) the use made of the mark must be in the course of trade in areas covered by the registration;

The use must be done in a way that makes it appear to be the use of a trademark. The following uses, however, also constitute infringement under Section 29 if they are likely to confuse the public or to be associated with the registered mark:

- (a) Identical mark used in relation to similar goods or services.
- (b) Similar mark used in relation to identical or similar goods or services.
- (c) Identical mark used in relation to identical goods or services.

### **(A) Applicability of Principles of Infringement of Trademark to Domain Names**

The principles discussed above have been debated before various courts<sup>44</sup> and carry now a well-defined meaning in the trademark jurisprudence. The courts in America have decided a good number of cases on domain names. These cases can help in interpreting the provisions of TM Act relating to infringement of trademark in cases involving domain names. Objectively, a person is said to have infringed a trademark when he makes

- a. Commercial use of the mark.
- b. That mark is identical with or deceptively similar to a registered mark
- c. Dilutes the distinctive quality or repute of the mark that results into consumer confusion.
- d. Use of mark by other results in likelihood of confusion.

#### **(a) Commercial Use of the Mark**

The plaintiff has to prove in an action for trademark infringement that the defendant has made a “commercial use” of the registered mark. A person is said to be using a registered trademark in the course of business when

- i. they apply it to products or the packaging of those products,
- ii. they offer or expose products for sale, put them on the market, or stock them for those purposes using the registered trademark, or
- iii. imports or exports goods under the mark, or
- iv. uses the registered trademark on business paper or in advertising<sup>45</sup>

The expression “commercial use” is not confined to the above instances only because the provision contains the word “in particular” which suggest that courts may consider any use, of the registered trademark other than the one mentioned in the provision as commercial use. The words ‘commercial use’ have found place in the America Lanham Act and Trademark Dilution

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<sup>44</sup>For cases on the point-see *HaidiramBhujawala V. Anand Kumar Deepak Kumar* 200 (1) Arb. LR 531 se at PP535, *Kamal Trading Co. V. Gillette UK Ltd.* (1988) ILPR 135; *Ham Par Bros International Ltd. v. Tiger Bairn Co. (P) Ltd.* and ors 1996 PTC 311; *Apple computer Inc v. Apple leasing K. Industries* (1993) IJLPR 63; *William Grant K Sons Ltd. v. MC DoweH and Co. Ltd.* I.A. No. 9721 of 1993 in Suite No. 2532 of 1993 Judgement dated 27-05-94.

<sup>45</sup>. Section 27 (b).

Act, 1995. While discussing the scope of this expression in domain name context the US courts have laid down many principles. In *Lackheed Martin Corp v. Network solutions, Inc*<sup>46</sup>, it was laid down that when the registrar of domain names accepts domain name registration, he cannot be said to have used the domain name for commercial use. The plaintiff has filed an action against the registrar of domain names (NSI) on the ground that his federally registered, service mark ‘SKUNK WORKS’ was diluted by NSI by registering ‘SKUNK WORKS “type domain names to entities other than the plaintiff. The court rejected this argument and distinguished between the technical function of a domain name to designate computers on the Internet and the trademark function of a domain name to identify the source of goods and services. The court outlined the fact that NSI does not trade on the value of domain name as trademarks and the fact that NSI makes a profit from the technical function of domain names does not convert NSI’s activity to trademark use.

In *PanavisionInt v. Toeppen*<sup>47</sup>, it was laid down that trying to sell trademark-based domain names to the legitimate trademark owners qualifies for commercial use. It has been observed that a registrant who registers a domain name merely to store it and sell it later on for profit is using the domain name for commercial purposes. In *Intermatic, Inc. v. Toeppen*, the court laid down that the defendants’ desire to re-sell the domain name is sufficient to meet the “commercial use” requirement.<sup>48</sup> However, merely registering a domain name does not qualify it as using a trademark for commercial purposes. Non-commercial use of a domain name that inhibits the use of the same domain name by the owner of a trademark does not constitute trademark infringement.<sup>49</sup>

The Ninth circuit in *Avery Dennison Corp v. Sumption*<sup>50</sup> laid down that

*“the commercial use means capitalizing on trademark status. Where a trademark has not been used as a trademark but for non-trademark purposes, that does not constitute commercial use .But a sham website using domain name based on some one’s trademark does not fall within the exception of non commercial purpose because these web sites are created as a front, a pseudo- legitimate use of the domain name, till the real trademark owner comes forward to purchase it.”*

In *Panavision International v. Toeppen*<sup>51</sup>, the domain name “panavision.com” was registered

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<sup>46</sup>985 F Supp. 949 959-60 (C. D. Cal. 1997).

<sup>47</sup> No. 97-55467 1998 WL 178553 at 1 (9th cir Apr.177598.

<sup>48</sup>. Id at 1239.

<sup>49</sup>. PANAVISION INT. L. V. TOEPPEN, NO. 97-55467, 1998 WL 178553 AT 1.

<sup>50</sup>189 F. 3d 868, 980 (9th Cir. 1999).

<sup>51</sup>945 F. Supp. 1296. 1303 (C.D.Cal. 1996)



by the defendant that was based on the plaintiffs federally registered trademark for its motion pictures and photographic equipments. The defendant used his website for displaying aerial views of Panama and Illinois and contended that he is not making a commercial use of the domain name. The court rejected this argument and held that:-

*“this element is satisfied by the ultimate goal of arbitrage alone, and that satisfaction is not precluded by the absence of goods or services for sale.”*

Commercial use was defined by the court in *Planned Parenthood Federation of America v. Bucci*<sup>52</sup> as the impact on the plaintiff's activities as a result of the defendant's appropriation of the plaintiff's mark.. The defendant registered the domain name *plannedparenthood.com* for a web site promoting anti-abortion book. The domain name was based on plaintiffs federally registered trademark *“Planned Parenthood”* that is meant to provide abortion services.

The court found that the defendant was found to have used *plannedparenthood.com* to hurt the plaintiff commercially, promote his book, and raise money for his anti-abortion causes, all of which the court determined to be commercial use.<sup>53</sup>

This proposition was confirmed in *Jews for Jesus v. Brodesky*.<sup>54</sup> At the time of the lawsuit, the plaintiff, a group called Jews for Jesus, had been operating under this name for more than 24 years and was committed to carrying out Jesus' message. *Jews-for-Jesus.org* was registered by the defendant, a skilled Internet site developer, in 1995. It was decided that the defendant intended to financially hurt the plaintiff by denigrating and restricting them from using their mark in commerce. The court determined that the use of a hyperlink on the defendant's *Jewsforjesus.org* to access the outreach Jewish organisation constituted commercial use.

### **(b) Similarity of Mark with the Registered Mark**

The statutory requirement that the mark in issue should be identical with or deceptively similar to the registered mark so as to call it infringement is a question of first impression. The decision must be made from the perspective of a man with average intelligence and faulty memory. A man of average intelligence is probably going to be confused by the two marks due to their overall phonetic similarity and concept resemblance.<sup>55</sup> The Bombay High Court in *Hiralal Parbhudas v. M/s Ganesh Trading Co.*<sup>56</sup> has laid down nine non exhaustive principles to

<sup>52</sup> 42 U.S.P.Q. 2d at 1446.

<sup>53</sup> 42 U.S.P.Q. 2d at 1446.

<sup>54</sup> 993 F. Supp. 282, 308 (D.N.J.) aff'd, 159 F. 3d 1351 (3d Cir. 1998)

<sup>55</sup> **CORN PRODUCTS REFINING CO. V. SHANGRILA FOOD PRODUCTS LTD. AIR 1960 SC 142.**

<sup>56</sup> **AIR 1984 BOM.218 SEE ALSO SACHDEVA AND SONS V. LOTI RAM MAKHANLAL 2000 PTC 20; OM PRAKASHMAHJAN AND NARINDER KUMAR MAHAJAN V. HERO CYCLES LIMITED 1999 PTC 23; VISNUDASKISHANDES V. VAZIR SULTAN TOBACCO Co. LTD. AIR 1996 SC 2275.**

determine similarity of the two marks. These are (i) main idea or salient features (ii) general impression of the marks on the public as the marks are remembered by general impressions or by some significant detail rather than by a photographic recollection of the whole (iii) overall similarity of the two marks (iv) first impression of a person of average intelligence and imperfect recollection (v) overall structure, phonetic similarity and similarity of idea are important and both visual and phonetic test must be applied (vi) the purchaser must not be placed in a state of wonderment (vii) marks must be compared as a whole, microscopic examination being impermissible (viii) marks should not be placed side by side to find out the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances have to be taken into account. The above principles are elastic enough to cover domain name disputes. Almost similar principles have been invoked by the American courts to decide domain name cases.

In *Comp. Examiner Agency, Inc v. Juris*<sup>57</sup>, the plaintiff is the owner of trademark *JURIS* and the defendant registered *Juris.com* as his domain name. Rejecting the plea of the defendant that his domain name is not identical with the plaintiff's trademark, the court held that although the trademark was registered in all capital letters, it is also entitled to protection for other formats and design variations. The trademark is entitled to protection in all lower case letters including in the domain name "Juris.com". Furthermore, because capital letters and lower case letters do not differ functionally on Internet, an Internet user arrives at the same web site with either *JURIS.com* or *Juris.com*.

In *Hasbro v. Internet Entertainment Group Ltd*<sup>58</sup>, Internet Entertainment Group Ltd. (IEG), a Seattle-based company that utilised the domain name *candyland.com* for an Internet site offering sexually explicit material, nudity, and Cybersex, was sued by the plaintiff, who makes the well-known children's board game "Candy Land." The court decided that a finding of similarity would not be prevented by the difference between the defendant's one-word domain name and the plaintiff's two-word trademark. It was established, with reference to the case mentioned above, that the difference in capitalization had no bearing on the similarity analysis.

In *Prince Pipes and Fittings Limited v. Prince Platinum Pipes and Fittings*,<sup>59</sup>

the plaintiff Prince Pipes uses the word "PRINCE" as a registered trade mark for its PVC pipes. The trademark itself was first used in 1996. By 2014, the Plaintiff has registered the "PRINCE"

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<sup>57</sup> NO.96-0213 WMB, 1996 WL 376600 AT I (C.D.CAL. APR.26, 1996).

<sup>58</sup> No. C96-130 WD, 1996 WL 84853 at I (W. D. Wash. Feb. 9, 1996)

<sup>59</sup>Prince Pipes & Fittings Limited vs Prince Platinum Pipes & Fittings decided by Bombay High Court, on 10 March, 2021.

mark and logo through a number of registrations and plaintiff had classified his goods “Piping Systems”. Defendant the trader of platinum pipes used the trade name “Prince platinum” and also had a website to reach its customers under the domain name *www.princeplatinumplastindia.com*

One of the dealers of plaintiff, was actually misled by the domain name of defendant and thought it as plaintiff's trademark. He wrote a communication asking for their platinum products but was duped by the defendant's marketing strategy. The plaintiff filed a suit and contested that this message constitutes strong prima facie evidence that true error and deceit have already occurred, and that anyone may be led to believe that the PRINCE platinum product originated from the plaintiff's company.

The court issued temporary injunctions prohibiting the defendant from using the trade mark “PRINCE PLATINUM,”, the domain name “www.princeplatinumplastindia.com,” the contested business name “Prince Platinum Pipe & Fittings,” any other contested mark, domain name, company name, trading style that contains the term PRINCE, as well as any other contested trade mark, domain name, business name, or trading style that is confusingly similar to the Plaintiff's well-known trade mark “PRINCE” The receiver was also appointed by the court to take possession of the defendants' goods, stamps, printing supplies, labels, brochures, pamphlets, flyers, advertising materials, papers, stationery, printed matter, things, and other items bearing or containing the disputed trade mark “PRINCE PLATINUM.”

### **(c) Dilution of Trademark**

Where a trademark is used in such away that it dilutes the distinctive quality or repute of the mark that results into consumer confusion it amounts to infringement.

The American Courts have traditionally been granting protection against the dilution of the distinctive qualities of the trademark. The defendant is forbidden from “distorting” or pruning away the mark's distinctive quality and from degrading the mark by creating unfavourable associations through his use. Famous trademarks are protected by the Federal Trademark Dilution Act of 1995. Dilution, according to this Act, is the loss of a well known mark's ability to identify and differentiate products or services. Despite the fact that this Act did not specifically address domain name problems, it was hoped that its “anti-dilution Statute can help stop the use of misleading Internet addresses obtained by individuals who are picking marks that are connected with the products and reputations of others.” The injunctive relief is possible only when a plaintiff proves that the following conditions are in his favour.

- a. He is the proprietor of a well-known mark

- b. The defendant has used that mark in commerce
- c. The plaintiff's mark gained fame before the defendant's use
- d. The distinctiveness of the mark was diluted by the defendant's usage.

The aforementioned dilution argument has broadened the court's jurisdiction even in situations where consumer confusion is unlikely to occur but where the defendant's improper use of the mark has the potential to gradually obscure the source of products or services.<sup>60</sup> Many cases have been decided by the American courts, in the Internet context, on the ground of dilution.

In *Intermatic, Inc v. Toeppen*<sup>61</sup>, one of the defences found out by the court against the defendant is that the well-known mark for electronic devices used by the plaintiff is based on the domain name *intermatic.com*, which he registered to display images of his hometown and is therefore likely to reduce that mark's distinctiveness. In order to avoid consumer confusion about source, the court accepted that it is doubtful that customers will mistake the source of photos of a small town for the source of well-known technological devices in this case. However, the court found that the famous mark's association with a non-affiliated party lessens its power to distinguish one source from another. As against this decision, in *Avery Dennison Corp v. Sumpton*<sup>62</sup>, the plaintiff an owner of the registered trademarks, "Avery" and "Dennison", having domain names, *avery.com* and *averydennison.com*, challenged the defendant's domain names *avery.net* and *dennison.net*. Under his domain names, the defendant ran Mail bank. The court ruled that the plaintiff must prove his marks are distinctive through secondary meaning and further ruled that the plaintiff failed to demonstrate that his marks are well-known. In dilution situations, the burden of evidence is greater, and proving the mark's sheer uniqueness is insufficient to meet this criterion. Both the mark's fame and distinctiveness are required. A distinctive mark is always associated with a renowned mark, while the reverse is not always true. *Jews for Jesus v. Brodesky* did not call for the aforementioned high threshold of proof.<sup>63</sup> The court observed that the defendant's domain name *Jewsforjesus.org* is identical with the plaintiff's trademark "Jews for Jesus" and its web site *Jews - for - Jesus. org*. The plaintiff's trademark has become famous because nearly half million dollars are being spent per year on advertisement and information is disseminated to the millions of people across the globe. This case is hardly different from "Avery Dennison" and perhaps the trademarks "Avery" and "Dennison" would have been more famous than "Jews for Jesus" if advertising alone has been

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<sup>60</sup>15 U.S.C. § 1127 ( Supp.IV 1998) ( defining dilution)

<sup>61</sup> Supra Note 48.

<sup>62</sup> CV 97-0407-JSL

<sup>63</sup> Supra Note 58

considered as a yard stick to measure famousness of the mark.

The standard of proof adopted in *Jews for Jesus* has been endorsed in *Playboy Enterprises, Inc v. Asia focus International, Inc*<sup>64</sup>. The court ruled that the marks “playboy” and “playmate” have become famous after acquiring goodwill and secondary meaning through incessant advertisements and because of the fame, people generally associate play boy and playmate with the plaintiff’s playboy. The distinctiveness of the plaintiffs mark is likely to be diluted by the defendant’s use of domain names *asian.playmates.com* and *playmatesasian.com*.

The dilution of trademark by tarnishment has invited the attention of the courts in the context of the Internet in *Hasbro Inc v. Internet Entertainment Group, Ltd*. The plaintiff had a prima-facie case demonstrating quite clearly that dilution by tarnishment is the most likely outcome because defendant had used plaintiff’s trademark CANDYLAND as his domain name for a website carrying pornographic material, and the court granted preliminary injunction against defendant. The court ruled that the appearance of the obscene content shocked users who went to *candyland.com* with the intention of learning more about the game, which might damage the goodwill attached to Hasbro’s brand. The CANDY LAND brand was well-known for its children’s games, but the defendant utilised this name to advertise pornographic content online.

In *Tata Sons Pvt. Ltd v. Sunil Keshavji Tataria*<sup>65</sup>, the plaintiff, Tata Sons Pvt. Ltd., sought a permanent injunction preventing the defendant, Sunil Keshavji Tataria, from using the plaintiff’s registered trade mark improperly, passing it off as the plaintiff’s product, diluting and tarnishing trademarks, causing harm, and rendering accounts. By producing and offering for sale adult diapers and underpads online under the domain and website *www.tatariahygiene.com*, the Defendant infringed upon the Plaintiff’s registered trademark “Tata”. The subject of the litigation was amicably resolved, according to a Settlement Agreement dated 3.08.2021 published by the Delhi High Court Mediation and Conciliation Centre. The dispute between the parties was resolved before the filing of pleadings, so the court decided that the plaintiff was entitled to a full refund of all court expenses.

#### **(d) Likelihood of Consumer Confusion**

The rational basis of trademark protection is to avoid consumer confusion. The standard to determine consumer confusion is that of a man of ordinary intelligence. The courts generally look from the angle of man of average intelligence and imperfect recollection. The following

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<sup>64</sup> 1998 U.S. Dist. LEXIS 10359 at (E.D. va. Feb. 2, 1998)

<sup>65</sup> *Tata Sons Private Limited v. Sunil Keshavji Tataria & Anr.* Decided by Delhi High Court on 31 August, 2021 visited on 03.09.2021.

factors are typically considered by the courts when determining whether there is a likelihood of consumer confusion<sup>66</sup>:

“ (a) *the nature of the two marks, including the alphabets used, the manner in which they have been used, the device on which they have been used, and the trademark colour combination used;*

*(b) the class of customers;*

*(c) the degree of reputation;*

*(d) the trade channels; and*

*(e) the existence of any connection in the course of trade”.*

The above non exhaustive list can still form the basis for deciding the consumer confusion in the Internet context. Nevertheless, some of these principles may be inapplicable in Cyberspace. For instance, it is not possible, in Cyberspace, to differentiate domain names through the use of capitalization, stylized format or fonts. The courts have followed “average intelligence” test in Cyberspace also. In *Rediff Communication limited v. Cyberbooth*<sup>67</sup>, the claim that Internet users are intelligent and only literate persons who can figure out how to access the actual Internet site that they desire to visit was rejected by the Bombay High Court. It has been held that

“*even 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 defendant’s Internet site.*”

The Delhi High Court in *Yahoo! Inc., v. AkashArora and Anr*<sup>68</sup> has held that

“*due to easy access of Websites, a very alert vigil is necessary and, a strict view is to be taken to prevent defendant from passing off his goods or services as that of the plaintiff*”.

The courts have taken the stand that there is no single factor, which could be called as the only factor necessary to establish likelihood of consumer confusion. The test to determine likelihood of confusion depends upon a number of grounds, it is the overall impression of a mark that has to be taken into account.<sup>69</sup>

The America Court in *PolariodCorp. v. PolariodElecs. Corp*<sup>70</sup>, has propounded eight non

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<sup>66</sup>KedarNath Gupta v JK Organization 1998 PTC 189; HiralaiParbhuda: v. M/S Ganesh Trading Co. AIR 1984 Bom. 218.

<sup>67</sup>AIR 2000 Bom. 27 See; also Jews for Jesus v. Brodsky 993 F. Supp. 282-308.

<sup>68</sup> Yahoo Inc v. AkashArora IPLR 1999 April 96.

<sup>69</sup> Supreme Bedi Factory v. ArdathTahacco Company Ltd. (1999) PTC (19) 150 at151; Punjab Tractors Limited v. PramodGarg 2000 PTC 260 at 276; HeralalPrebudas v. M/S Ganesh Trading Co. AIR 1984 Bom. 218.

<sup>70</sup> 287 F 2d492, 495 (2nd Cir 1961).

exclusive grounds to establish likelihood of confusion. These are:

- “(1) *the strength of the mark*
- (2) *the degree of similarity between the two marks*
- (3) *the proximity of the products*
- (4) *the likelihood that the prior owner will bridge the gap*
- (5) *actual confusion*
- (6) *defendant’s good faith in adopting its own mark*
- (7) *the quality of defendant’s product and*
- (8) *the sophistication of buyers.*”

The American courts have used these tests in Internet-related cases. In *Jews for Jesus v. Brodsky*,<sup>71</sup> the court found defendant’s web site [jewsforjesus.org](http://jewsforjesus.org) based on his trademark “Jews for Jesus”. The court took overall impression of the two Websites into account and laid down that they may differ in minute details but those subtle differences are not strong enough to ward off the possible confusion because Internet users are not sophisticated enough to comprehend the distinguishing features of the two Websites. Similarly in *Public Service Co. of New Mexico v. Nexus Energy Softwar,e*<sup>72</sup> the plaintiff an owner of federally registered service mark, “Energy Place”, sued against the defendant for using energy-place as his mark and the domain name <energyplace.com>. The court held that the possibility of consumer confusion cannot be ruled out because the mark and the domain name in question so nearly resembles with the plaintiff’s federally registered trademark that the consumer confusion is the likely result.

In *SNA, Inc v. Array, SNA*<sup>73</sup>, the plaintiff brought a lawsuit against the defendant for using the word “*Seawind*” as the domain name. The defendant published copies of Seawind builders, newsletters, and other material on his website while the plaintiff produced kits for amphibious aircraft. The defendant is giving the appearance that he is affiliated with the plaintiff by utilising the plaintiff’s trademark as his domain name, according to the court’s ruling. The defendant attempted to capitalise on the plaintiff’s goodwill because he is recognised for his qualities. Due to their familiarity with this trademark, the information’s users would also, most likely, identify the defendant’s website with the plaintiff. Thus the users, without knowing the truth, may access the web site of the defendant with this hope that it has a patronage of the plaintiff. They will be

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<sup>71</sup> Supra note 45.

<sup>72</sup> 36 F. Supp. 2d 436,437 (D. Mass. 1999).

<sup>73</sup> **173 F. Supp. 2d 347 (2001)**

confused as to the relationship of the defendant with the plaintiff. In *Brookfield Communications, Inc v. West Coast Entertainment Corp.*<sup>74</sup>, the court developed for the first time “initial interest confusion” doctrine in Cyberspace. The plaintiff challenged the registration of the defendant’s domain name moviebuff.com on the ground that it infringed plaintiff’s trademark “*Movie Buff*”. The court found that the defendant’s domain name is identical with the plaintiff’s trademark.<sup>75</sup> In reaching this conclusion the court laid down that the tests evolved and established in physical environment are not exhaustive and the courts are free to find confusion on the other grounds also. Neither the evidence of actual confusion nor intent to confuse is necessary to establish likelihood of confusion. The court believes that the likeness between the mark and the goods and the overlap of the marketing channels are key indicators of the likelihood of consumer confusion. When a person is initially perplexed about the source of products but quickly finds the source’s true identity and makes no purchase as a result of the confusion, the legal doctrine known as “initial interest confusion” has been recognized by the courts. According to this doctrine’s justification, the parties’ anticipated relationship gives the infringement a chance to obtain the initial commercial contact. Using the same reasoning in the current case, the Brookfield court determined that the defendant would still gain customers by using the goodwill that the plaintiff had built up in its mark “*Movie Buff*” even if users realised upon accessing defendant’s Websites that they did not reach the plaintiff’s website. It was further elaborated by the court that to determine possibility of consumer confusion, the defendant’s domain and the plaintiff’s trademark should be taken into consideration. By applying this principle, the court reached to the conclusion that the defendant’s domain name moviebuff.com is confusingly similar to *MovieBuff*. Moreover the court admitted that in terms of appearance, there are differences in capitalization and the addition of .com in the defendant’s complete domain name, but pointed out that these differences are inconsequential in light of the fact that web addresses are not caps-sensitive.

In situations where the defendant has registered the plaintiff’s trademark in a top-level domain that is distinct from the top-level domain in which the plaintiff has registered his trademark, the courts have expressed conflicting opinions on this issue. In *Avery Dennison Corp. v. Sumpton*<sup>76</sup>, the plaintiff registered his trademark in .com whereas the defendant registered plaintiff’s trademark as his domain name in .net. The court held

*“that Internet users now well know the difference between the two top level domains. The former*

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<sup>74</sup> 174 F.3d at 1061-65.

<sup>75</sup> Id at 1054.

<sup>76</sup> 189 F.3d 868



*is meant for commercial purposes and the latter for networks, The distinction is so well recognized among the Internet users that the defendant's domain name would hardly cause any dilution of the plaintiffs trademark".*

However, in *Playboy Enterprises International Inc. v. Global Site Design, Inc*<sup>77</sup>, the court did not recognize any distinction between .com and .net so far as likelihood of consumer confusion is concerned. The court held:-

*that once trademark of the plaintiff is registered by the defendant as his sub domain, as consumer's will be confused as to source and the difference in the top level domain will not eliminate that confusion.*

Similarly, the court in *Washington Speakers Bureau, Inc. v. Leading Authorities*<sup>78</sup>, Inc did not take into account the effect of functional top level domains in determining consumer confusion. The court fixed the liability on defendant for infringement inspite of the fact that the competing domain names were registered in .com and .net.

## **V. COMMON LAW REMEDY OF PASSING OFF**

In absence of domain name specific legislation and for the marks which are not registered , the Indian courts favoured the common law strategy<sup>79</sup> and used the Passing Off doctrine to settle disputes over domain names.

The passing-off doctrine is founded on the idea that “no man is entitled to represent his goods as being the goods of another man, and no man is permitted to use any mark, sign, symbol, device, or other means whereby, without directly making a false representation to the purchaser who purchases from him, he enables such purchaser to tell a lie or to make a false representation to someone else who is the ultimate customer”<sup>80</sup>.

Passing off is a common law action that hasn't altered in more than a century, albeit evolving in terms of wording. The goal of this doctrine is to prevent dishonest competitors from damaging a company's goodwill and reputation. This idea also holds true for businesses that don't include the sale of any items. To put it briefly, it is an actionable offence for anyone to misrepresent their goods or businesses as being those of others, using any method necessary to do so. The passing-off statute has been expanded to cover professions and non-commercial activity. In

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<sup>77</sup> 1999 WL 311707 at 2J S.D. JFla. Max 15, 1999.

<sup>78</sup> Inc. 33 F. Supp. 2d 488 (E.D. Va., Feb. 2, 1999)

<sup>79</sup> In UK there is no domain name specific legislation the courts are relying on passing off and trademark infringement principles. *Marks and Spencer PLC v One In A Million* (1998) 4 All 6 R476 CA at P. 497 is a leading case and this decision is relied by courts all around the globe and the common wealth countries in particular.

<sup>80</sup> In *Singer v. Nicholson* (1881) 18 Ch 395 at pg 412 also see. Lord Halsbury in *Reddaway v. Banham* {1896} A.C. 199 at 204; 13 RPC 1218 at 224.

actuality, it is used to describe a variety of unfair competition today when one person's actions harm or harm the goodwill connected to the actions of another person or group of people. Passing off may not always require criminal intent<sup>81</sup>.

According to Kerl's law of Trademark and Trade Names, passing off has been defined as follows.

*"It is an actionable wrong for the defendant to represent for trading purposes, his goods are those or his business is that of the plaintiff and it makes no differences whether the representations are affected by direct statement, or by using same of the badges by which the goods of the plaintiffs are known to be his, or any badges colourably resembling these in connection with goods of same kind, not being the goods of plaintiffs, in such a manner as to be calculated to cause the goods to be taken by ordinary purchasers for the goods of the plaintiff"*<sup>82</sup>.

Salmond in his 'Law of Torts' has laid down gist of the conception of passing off as hereunder.

"The gist of conception of passing off is that the goods are in effect telling a false hood about themselves is saying something about themselves which is calculated to mislead. The law on this matter is designed to protect traders from that form of unfair competition which consists in acquiring for oneself, by means of false or misleading devices the benefits of reputation already achieved by rival traders"<sup>83</sup>.

According to Winfield,

*"The law of passing off arose to prevent unfair trading and protects the property right of a trader in his good will"*<sup>84</sup>.

The nature of property protected in passing off is thus the good will which had become attached to plaintiff's business, the name, the mark, the getup, being the badge or vehicle for the goodwill.

### **(A) Essentials of passing off action**

False representations are the basis for passing off lawsuits, so it is necessary to establish this fact in each and every instance. It might have been said in terms that were expressed, which is uncommon. The more frequent scenario is when the use or restriction of a mark, trademark, or

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<sup>81</sup> Narayan P; Law of Intellectual Property 2<sup>nd</sup> Ed. 1999, Eastern Law House, p. 179.

<sup>82</sup> T. A. Balcano White & Robin Jacob, Kerly's Law of Trademark and Trade Names, 12<sup>th</sup> Ed. 1986, Sweet and Maxwell p. 344.

<sup>83</sup>R. .V. F. Hueston, Salmonid on Law of Torts; 16<sup>th</sup> Ed. 1973, Sweet and Maxwell, p. 401.

<sup>84</sup> W. V. H. Rogers, Jolowicz Winfield, Law of Tort 15<sup>th</sup> Ed. 1998 p. 667 also see Sarabhai International Ltd, V. Sara Exports International AIR 1988 Del: 134.

getup creates an implicit association in the minds of the general public or a certain segment of the public with the goods of another. In such cases, the issue is whether, in light of all the relevant facts, the defendant's use of the disputed mark, name, or getup in connection with his goods implicitly represents those goods to be of the plaintiffs', or to be of a particular class or quality, or, as it is sometimes put, whether the defendant's use of such mark, name, or getup is intended to deceive. However, it would be impossible to list or categorise every possible manner a man may make the false representation that was depended upon. The representation does not have to be false. It is sufficient if it has actually been produced, whether dishonestly or not, and damages may most likely result<sup>85</sup>.

The degree to which the use of specific words, signs, or images results in passing off must always be determined by the evidence, and the simpler the phraseology, the more likely it is that it is merely a description of the item sold. However, if the evidence establishes the fact, legal repercussions will follow<sup>86</sup>. These guidelines apply to both misrepresenting a business as well as misrepresenting a product.

According to Lord Diplock in the case of *Erven Warnink v. Townend*<sup>87</sup> (the Advocatt case), the following fundamental elements must be present in order to establish a legal course of action for passing off:

1. *“Misrepresentation;*
2. *Made by a person in the course of trade;*
3. *To prospective customers of his or ultimate customers of goods or services supplied by him;*
4. *Which is calculated to injure the business or good will of the trader;*
5. *Which cause actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so*

Similarly. In *Reckitt and Colman v Borden*,<sup>88</sup> Lord Oliver reformulated the classical formulation of passing off as follows:

No one may pass off his things as those of another, which is a condensed version of the rule of passing off. It can be stated more precisely in terms of the factors that the plaintiff in such a case must establish in order to prevail.

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<sup>85</sup> Supra note 11 p. 181.

<sup>86</sup> Lord Halsbury in *Camel Hair Betting Case* (1896 ) 13 RPC (218 at 224) (HL)

<sup>87</sup> 1980 RPC 31 at 93 (HL) Judgement given by Lord Diplock, commonly known as Advocatt's Case.

<sup>88</sup> 1990 RPC 341 at 406 (HL).

These three are in order:-

1. He must create goodwill, favourable impression of the products or services he offers to the potential customers by associating them with an identifiable appearance;
2. He must show that the defendant misrepresented the goods/services to the public in a way that caused or was likely to cause the public to assume that the goods or services he was offering were those of the plaintiff; and
3. He must demonstrate that he suffers or in a qua timet action that he is likely to suffer damage by reasons of the erroneous belief engendered by the defendant's misrepresentations that the source of the defendants goods or services is the same as the source of those offered by the plaintiff.

These principles are sometimes referred to as the classical trinity<sup>89</sup>

### **(B) Applicability of Principles of Passing off to Domain Name Disputes**

Internet domain names have come into prominence only very recently. The courts have seized the opportunity and many principles have evolved which guide them to resolve domain name disputes under the law of passing off.

#### **(i) Domain Names More Than Simple Address: Protection Justifiable**

High business importance and potential value can be found in internet domain names as company assets. A domain name has the same legal protections as a trademark and is more than just an internet address. The domain name provided by an online resource must also be acknowledged and approved, and it is protected against passing off. As a result of the development of modern technology, especially that pertaining to cyberspace, domain names or Internet addresses are now eligible for trademark protection because they are more than just an address<sup>90</sup>.

With the advancement of Internet communication the domain name attained as much legal sanctity as a trade name. Since the services rendered in the Internet are crucial for any business the domain name needs to be preserved so as to protect such provider of services against anyone else trying to traffic or usurp the domain name.

In India, the first important case regarding the domain names is that of *Yahoo v. AkashArora and Anr*<sup>91</sup>; the Delhi High court was called to restrain the defendant from using the domain

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<sup>89</sup> Cornish W.L, Law Intellectual Property 2<sup>nd</sup> Ed. 1995, Sweet and Maxwell p. 405.

<sup>90</sup> Rediff Communications Ltd. v. Cyberbooth, AIR 2000 Bom.27; Tata Sons Limited v. Manu Kosuri 2001 PTC 432.

<sup>91</sup> Yahoo Inc v. AkashArora IPLR 1999 April 96; Acqua Minerals Ltd. v. PramodBorse AIR 2001 Delhi 463.

name yahooindia.com for Internet related services. The plaintiff is a well known Internet Service Provider of America having yahoo and yahoo.com its trade mark and domain name respectively and other domains names which are country specific, for instance, yahoo.co.in for India yahoo.in. ca forCanada. The argument raised by the plaintiff was that the defendant's domain name yahooindia.co is deceptively identical and confusingly similar to its domain name yahoo.co.in or yahoo.co. The defendant has deliberately copied the colour scheme, layout, design, contents and source code of the plaintiff's Indian specific website with a sole purpose to cause consumer confusion, as to source and affiliation of the Website. The consumers are likely to believe that either defendant's Website is an affiliate of the plaintiffs Website or the defendant's Website is a regional section of the plaintiff's Website. The defendant opposed the contentions of the plaintiff on the ground that the trade and Merchandise Marks Act, applies only to goods and not to services. Yahoo! is an Internet Service Provider so its case cannot be decided under the Trade and Merchandise Marks. Act. Furthermore, the defendant has posted disclaimer in its site stating that the defendant is not an associate of yahoo.com. The defendant also objected the use of word "yahoo" on the ground that it is a dictionary word and has no special significance for the plaintiff.

The judge rejected the defendant's arguments. The court brought it under a passing off action rather than deciding it under the Trade Mark Act. The court acknowledged that although service marks are not recognised in India, rendered services must be acknowledged to prevent passing off. It was decided that the plaintiff is entitled to injunctive action as a result of the defendant's appropriation of the word "Yahoo" The defendant's website's disclaimer was deemed insufficient by the court to completely rule out potential consumer confusion. While agreeing with the defendant that "Yahoo" is a dictionary word, the court maintained that it has acquired distinctiveness, gained widespread reputation, and is closely linked with the plaintiff. No one is permitted to profit from such fame by arguing that it is just a dictionary word. The defendant was given an injunction by the court.

The defendant's claim that internet users are sophisticated users and only literate people are able to determine and approach the actual website that they intend to visit was also rejected by the learned judge Dr. M.K. Sharma (J). He noted 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

In *TATA sons limited v. Manu Kosuri*<sup>92</sup>, the defendant had registered a series of domain names based on well known registered and famous trademark TATA. The domain name involved include: *tatatelservices.com*, *tatassl.com*, *tatapowerco.com*, *tatahydro.com*, *tatawestiae.com*, *jrdata.com*, *ratantata.com*, *tatahoneywell.com*, *tatayodogawa.com*, *tatatde.com*, *tatatimeken.com*. The plaintiff claimed that the defendant is a cybersquatter whose only goal is to monetize the plaintiff's identity and renown by selling these domain names. TATA has been the trademark of the plaintiff since 1917 in connection with a variety of items, and it is registered in 9 additional nations. The domain name is as good as any other trademark, according to the court, which upheld Yahoo Inc.'s ruling in this matter. The domain name needs the same protection as the trademark since it is more than just an address.

Similarly, *In case of Info Edge India Pvt. Ltd*<sup>93</sup>. Court held that domain name is more than an internet address and is entitled to equal protection as that of trademark.

In the case of *Satyam Info way ltd. V. Sifinet Solutions Pvt. Ltd*<sup>94</sup>.

According to the Supreme Court, domain names were undoubtedly first used to provide Internet computers a physical address. However, the Internet has evolved from being just a tool for communication to a platform for conducting business. A domain name is also utilised as a means of identifying a business due to the growth of online commerce. As a result, the domain name not only acts as an Internet address but also identifies particular Internet site.

### **(ii) Nature of Domain Name Results in Consumer Confusion**

The foundation of trademark law is the assumption that consumers will likely become confused by similar marks on products or services but the question arises whose intelligence should be used as a benchmark to assess consumer confusion? Should the benchmark be normal, above average, or just ordinary intelligence? The general perception is that Internet users are sophisticated, intelligent, and possibly not so readily duped. Recently, the Bombay High Court *in Rediff Communications Ltd. v. Cyberbooth*<sup>95</sup> held that a domain name is entitled to protection under the Trade and Merchandise Marks Act, 1958 as a Trade mark. The plaintiffs were doing their business of communication and providing service through the Internet. By creating web pages, the plaintiffs published advertisements for their clients. The plaintiffs also offered services including booking hotels, selling books and other items, and selling movie tickets for specific Bombay movie theatres. The plaintiff's services were highly publicised under the Trade

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<sup>92</sup>2001 PTC 432.

<sup>93</sup> 2002 (24) PTC 355 (Del.)

<sup>94</sup>(2004) 6 SCC 145.

<sup>95</sup>*Rediff Communications Ltd. v. Cyberbooth*, AIR 2000 Bom. 27.

Mark/Domain Name “rediff,” and the group of businesses had an annual turnover of more than 250 corers. The complainant and the defendant both worked in related fields. On the websites, the defendant operates and offers comparable material.

The relevant issue of whether there was a case of misrepresentation, probability of confusion, or deceit of the public, and resultant harm to the domain names, was taken into consideration by the Bombay High Court. The defendant argued that the term “rediff.com” was created by combining the first three letters of the words “radical,” “information,” “feature,” and “free,” and that there was no chance of confusion or misdirection between the websites www.redif.com of the plaintiff and www.rediff.com of the defendant. He added that the defendant’s website primarily provides hypertext connections to its advertisers’ websites, whereas the plaintiff’s website is more akin to an online newspaper and offers a variety of services, from news to shopping. It has an entirely distinct feel and appearance. Its appearance and feel are completely different from the website of the defendant. He continued by saying that Internet users are knowledgeable and educated, thus there can be no room for confusion between the two Domain names in their thoughts. In this instance, the Bombay H/C rendered a significant decision. On the newly emerging idea of domain names on the internet and their protection in a global village, the court held a thread-bare discussion. The court determined that “rediff” was a made-up name and found the defendants’ argument to be absurd. The judge was convinced that there was a clear intent to deceive and that the dependents’ primary motivation for registering was to capitalise on the plaintiff’s goodwill.

The court acknowledged that:-

*Internet users are sophisticated and literate people. But held that even if an individual is a sophisticated user of the Internet, it is quite possible that he may be unsophisticated consumer of information and such person may find his/her way to the defendant’s Internet site.”*

However, in *Invest Smart India Ltd. v. ICICI*,<sup>96</sup> despite the fact that the lawsuit included a misspelt domain name that had previously been registered, the court did not offer the plaintiff any interim relief. The defendant registered the domain name investmartindia.com, which is identical to the plaintiff’s domain name “investsmartindia.com,” with a bad faith interest, according to the plaintiff, who claimed that they were the ones who originally came up with the name “investsmartindia.” The aforementioned Rediff case was frequently cited by the plaintiff. However, the Court compared the two cases and determined that the Rediff case was very dissimilar from the current one. The contested word Rediff in the Rediff case was not a general

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<sup>96</sup> Mumbai High Court Suit No. 1040 of 2000, Notice of Motion No. 860 of 2000.

descriptive word; rather, it was a name that was coined. But in this instance, the phrases in question—Invest, Smart, and India—are widely used. However, in this case, the challenged words Invest, Smart, and India are generic concepts that are widely used in the English language. The Court further determined that the website “investsmart.com” had been registered before the Plaintiff’s domain.

In *Info Edge (India) Pvt. Ltd v. Shailesh Gupta*<sup>97</sup>, the plaintiff claimed that the defendant was impersonating the plaintiff’s domain name, “naukri.com,” which is identical to or confusingly similar to the defendant’s domain name, “naukari.com,” in order to sell goods and services under that name. The Plaintiff also claimed that the Defendant was plagiarising the format and name of the Plaintiff’s website on its website, “naukari.com,” and that because the Defendant in question was operating in the same industry as the Plaintiff, there was a serious and significant risk of confusion and deception. On the other hand, the Defendant had argued that the Plaintiff’s trademark “naukri.com” is generic and cannot, thus, achieve the trademark significance as secondary meaning. The Court did rule, however, that the domain name is likewise entitled to the same level of trademark protection. Therefore, the Court determined that the Defendant had used a slight misspelling of the Plaintiff’s domain name and showed the Defendant’s dishonest intent. As a result, the Court prohibited the Defendant from using “naukari.com” or any other name . As a result, the Court prohibited the Defendant from using “naukari.com” or any other similar name

*Titan Industries Ltd. v. Prashant Kooapati*<sup>98</sup>, the Court granted the Plaintiff broad passing-off remedies and restrained the Defendant from registering a name, running a business, producing, offering for sale, marketing, or otherwise dealing in any items bearing the name or the aforementioned mark on the Internet or in any other manner. The domain name tanishq.com, which was a well-known brand name used by the Plaintiff company in connection with the manufacture of watches, had been registered by the Defendant. According to the plaintiff, the defendant’s actions met all the requirements for passing off. The defendant’s use of the domain name would cause consumer confusion and deception, harm the plaintiff’s reputation, and harm its goodwill. Consequently, the Delhi High court correctly issued a temporary injunction prohibiting the defendant from using the domain name tanish.com.

*Dr. Reddy’s Laboratories Limited v. Manu Kosuri & Anr*,<sup>99</sup>

the plaintiff company, which had registered the domain name “drreddys.com,” was founded in

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<sup>97</sup>2002 (24) PTC 335 (Del).

<sup>98</sup>Delhi High Court Interlocutory Interim Application No. 787 of 1998 in Suit No. 179 of 1998.

<sup>99</sup> 2001 (58) DRJ 24



1984 with the intention of doing research and development in the field of medicine. Plaintiff learned that the Defendants were engaged in the business of registering domain names in India when they registered the domain name “drreddyslab” in the month of January 1999. The plaintiff filed a lawsuit seeking a permanent injunction against the defendants for passing off, as well as the relief of prohibiting the defendants from using the domain name “drreddyslab.com” or any other trademark that is the same as or confusingly similar to the plaintiff’s trade mark DR. REDDY’S for any purpose. The court held that:-

the general public is likely to be misled into thinking the defendant’s business is the plaintiff’s business or is a branch or department of the plaintiff when the defendant operates under a name that is sufficiently similar to the name under which the plaintiff is doing business and that name has developed a reputation. In such cases, the defendant may be held liable for passing off. Competition would occur when the Plaintiffs and Defendants were active in similar or converging sectors of endeavour. This created a serious and enormous potential for confusion and deception, which increased the likelihood of suffering injury. Because the domain name performs the same purpose as the brand and is not just an address or an Internet directory number, Plaintiff is entitled to the same protection as a trade mark.

Given that two names are almost same or similar in nature, it is obvious that there is a good chance that an Internet user could be misled into thinking that both domain names belong to the plaintiff even when they actually do not. A permanent injunction was issued in the plaintiff’s favour.

In *Celador Productions Ltd. v. Gaurav Mehrotra*,<sup>100</sup> also, in order to prevent the defendant from offering online games based on the format of the programme and its distinctive features, which are confusingly similar to the plaintiff’s programme, the Delhi High Court issued an order prohibiting the defendant from directly or indirectly operating any website using the name “CrorepatiKaun” or “KaunBanegaCrorepati” as their second level domain name or using the name in any manner whatsoever.

The Supreme Court of India gave a Landmark Judgement in case of *Satyam Infoway Ltd. v. Sifynet Solutions*.<sup>101</sup> In the current case, the appellant registered a number of domain names with the internationally renowned registrars, including www.sifynet, www.sifyrealestate.com, and www.sifymail.com. The appellant claims to have created the word “Sify” by combining pieces of its company name, Satyam Infoway, with other words. The appellant asserts that the name

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<sup>100</sup>(2003) 26 PTC 140 (Del).

<sup>101</sup>(2004) 6 SCC 145.

“Sify” has a strong reputation and goodwill Under the domain names [www.siffynet.net](http://www.siffynet.net) and [www.siffynet.com](http://www.siffynet.com), the respondent began operating an online marketing firm. The respondent asserted that ICANN had approved the registration of its two domain names.

The appellant gave notice on the respondent to stop and desist from conducting business under the names Siffynet Solutions (P) Ltd or Siffynet Corporation and to transfer the domain name to the appellant after learning that the word “Siffy” was a part of the Respondent’s corporate and domain name. Respondent refused. The respondent was sued by the appellant in the City Civil Court on the grounds that it was impersonating the appellant’s business and services by using its domain name and business name. Additionally, a request for a provisional injunction was made. The appellant had previously used the trade name “Sify,” had established a solid reputation in connection with Internet and computer services under the name “Sify,” and the respondent’s domain names were confusingly similar to the appellant’s domain name, according to the City Civil Court judge, who granted the application for a temporary injunction. A High Court appeal was chosen by the respondent. The City Civil Judge’s ruling was given a temporary reprieve. The High Court finally decided to accept the appeal. The order was subsequently contested before the Supreme Court. The Supreme Court reversed the High Court’s decision and noted that the appellant had successfully met all three requirements for passing off.

It was noted that the appellant had successfully demonstrated the goodwill and reputation it claimed to have in relation to the trade name “Sify.” It was further maintained that the two names share certain linguistic similarities in addition to their striking visual similarity. This likeness is not diminished by the addition of the word “net” to the word “Siffy.” An inexperienced Internet user of average intelligence and poor memory might conclude that there is a business relationship between the two due to the names’ similarities. Such a user might enter an extra “f” when attempting to access the information or services offered by the appellant and be disappointed by the outcome. The usage of a similar domain name could cause users to access another domain name by mistake, which could result in a loss of users and potential clients. This is especially true in cases where there is a specific overlap. The Supreme Court determined that the respondent was attempting to profit off of the appellant’s online reputation as a service provider. Finally, it supported the City Civil Court’s judgement.

The Supreme Court ruled that giving computers connected to the Internet an address was without a doubt the domain name’s initial purpose. However, the Internet has evolved from being just a tool for communication to a platform for conducting business. A domain name is also utilised as a means of identifying a business due to the growth of online commerce. As a

result, the domain name not only acts as an Internet address but also as a moniker for a particular Internet site.

The Court further declared that the primary goal of the registrant's domain name registration was to increase traffic to its website to get benefit, which was similar to a well-known trademark. When a respondent registers a domain name that is identical to or confusingly similar to a service mark or trademark in which the complainant has rights and the domain name has been registered and used in bad faith, the complainant is entitled to transfer the respondent's domain name to them.

### **(C) Developments after Satyam Case**

The developments in the Indian domain name jurisprudence can be identified in cases of *Times Internet Ltd. v. Just Flowers and another*<sup>102</sup> and *Super Cassette Industries v. MR. Wang Zhi Zhu Ce Yong Hu*<sup>103</sup>

In Times Internet Ltd case, the plaintiff registered and used "Indian Times" mark and domain name india times.com, which were hijacked by the defendants. Despite the fact that the plaintiff did not present proof on the scope of the harm caused by the defendants' use, the court still decided to grant the punitive damages in the amount of Rs. 3 lakhs in favour of plaintiff.

In Super cassette case the plaintiff was running his business with the name "Super cassette" since 1983. In the year 2003 defendants registered "Super Cassettes" as their domain name for running the same business as that of plaintiffs which resulted in the financial loss of 25 lakh to the plaintiff along with loss of goodwill in the name. It was held that practice of registering a domain names based on trademark of a successful business enterprise insufficient to hold defendants guilty and a perpetual injunction was passed against them along with the compensation of 5 lakh rupees.

The next significant case is *Rolex Sav. Alex Jewellery and othes*,<sup>104</sup>

the plaintiff a Swiss company had registered a trademark "Rolex" in 1908 in Switzerland and subsequently in 140 jurisdictions of the world including India and were successfully doing the business of dealing with premium quality watches since then. Defendants a Bombay and Delhi based enterprise used the word Rolex and subsequently registered the domain name "Rolexjewelleryhouse.com" for doing the business of selling Jewellery. Plaintiff being

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<sup>102</sup>Manu/De/2909/2007. 37 Cs(Os) No. 769/2004,

<sup>103</sup> Del H/C 2008.

<https://www.the-laws.com/encyclopedia/browse/case?caseId=108002196200&title=super-cassettes-industries-ltd-vs-wang-zhi-zhu-ce-yong-hu>.

<sup>104</sup> Manu/De/0796/2009

aggrieved brought an action against defendants and they have acquired reputation in trademark with an annual turnover of about 2 crore rupees. The defendants resisted the suit on the ground of doctrine of estoppel and laches and silence by plaintiff<sup>105</sup>. It was also argued by the defendant that their business was different from business of plaintiff, thus no possibility of consumer confusion. It was also contested that the word Rolex is a common name and lacks distinctive character.

The Court also observed a close connection between the watches and jewellery, especially in the light of changing trends. The modern day use of watch is not confined to know the time, but extends as an ornament. Thus, the expensive brands of watches are also sold at the retail outlets of jewellers. Hence, there is every possibility of consumer confusion by the defendants' use of the mark "Rolex". The Court further went on to hold that the use of the mark "Rolex" by many others is completely immaterial in the present case. Such use cannot be the basis for holding the loss of distinctiveness of the mark in this case. Merely the fact that the plaintiff did not take any action against others is not a ground to deny relief to it in the present case. Finally, the Court rejected the contention of ignorance by the defendants. The facts clearly indicated a more than 90 years of prior use of the mark by the plaintiff, which should have been known to the defendants. Even if at the time of commencing the use of the mark, the defendants did not know the inherent risk in using the mark, at least, immediately after the opposition by the plaintiff for the defendants' registration of trademark, they must have become aware of the risk. Had the intention been bona fide, the defendants would have immediately changed their name. In the absence of such bona fide act, the defendants have taken the unfair advantage of reputation and the goodwill of the plaintiff's mark, and they cannot contend any reputation or goodwill earned out of their mala fide act. Therefore, the Court held that the defendants are neither entitled to use the mark "Rolex" nor the domain name "rolexjewelleryhouse.com". The passing off actions outlined in the above cases is advantageous to the plaintiff, since it is maintainable against even the registered owner of the trademark.

Thus the trademark owner has legal recourse against the registrant, regardless of whether the domain name was registered in good faith or without malice. As a result, the Trade Mark Act's protection is more robust than that provided by other means. The Trade Mark Act's geographical restrictions, meanwhile, raise questions because domain name protection demands

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<sup>105</sup>The suit was argued to be barred by limitation, since the plaintiff was aware of the use of "Rolex" by the defendants at least from 2001. This was evident from the fact that the defendants application for the trademark registration of "Rolex" was opposed by the plaintiff long back. Second, the inaction of the plaintiff for such a long period has allowed the defendants to develop in India their business in "Rolex" as trademark.

worldwide ownership.

## **VI. CONCLUSION**

The study demonstrates that trademark law eventually plays a role in the developing field of cyber law, with a focus on domain names. Regarding the interrelationship between trademark and domain name issues, there is now a lot of uncertainty. When a business wants to register a trademark as a domain name and discovers that another party who is not connected to the trademark has already registered it as a domain name, domain name difficulties arise. Any goodwill and intangible value contained in a trademark are conveyed in a domain name based on that trademark. If domain names were just used to locate websites, there would be a case for treating them separately from trademarks; but, because domain names are considered as source identifiers, this role brings them inside the purview of trademark law.

Organizations are now willing to invest a significant amount of time and money into acquiring domain names due to the realisation of their significance. Conflicts over the registration of domain names have resulted from this pursuit, as was to be expected. The adoption of similar or identical domain names by businesses with similar names or that produce the same kinds of goods have given rise to several disputes. When businesses with similar names or that provides the same kinds of goods tried to use similar or identical domain names, several disagreements resulted. Generally speaking, types of situations have led to domain name conflicts. In the first, a person or group may register a website with a name they do not already have any other rights to. This could be done for a number of reasons, including extortion, taking advantage of goodwill, diverting online traffic, defamation, etc. Due of the global reach of the Internet, disputes of the second kind frequently occur between parties who have equal rights to a name. Thus due to the unauthorised use of internet domain names, trademark law grapple with a number of problems for which there is no clear solution. The protection that domain names have received from courts around the world is equal to that of trademarks. However, the widely accepted concepts that apply to trademarks don't fit in cyberspace.

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