

Domain Names and Disputes

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What is a Domain Name

- ❑ A Domain Name is a word or a combination of words which help identify a website.
- ❑ Domain names are used to locate a website and are popularly known as Uniform Resource Locator (URL).
- ❑ Domain Name is very important for every business that wants to establish their name on the Internet globally .

Continued.....

- ❑ Domain Names consist of two parts, top-level and second-level domain names.
- ❑ www.irctc.co.in, here '.in' is the top-level domain and 'co' is the second-level domain. irctc is third level.
- ❑ One can purchase a Domain Name from a certified Registrar for a limited period which needs renewal after its expiry.

Domain Names and Trade Marks

- ❑ Domain Names can be registered and protected as trademarks as long as it meets the requirements of a trademark under the Trade Marks Act 1999.
- ❑ Domain Names with registered trademarks are universally protected.
- ❑ Abusive or Infringement of domains has an option to file a Domain Name Dispute

What is a Domain Name Dispute ?

- ❑ A Dispute to Domain Name arises, when more than one individual claims the right to a specific Domain Name.
- ❑ It occurs when a person registers a Domain Name very similar to a registered trademark and *ipso facto* is liable under INDRP & UDRP policies on domain registration *per se*.
- ❑ INDRP is applicable to .in and co.in domain names for Indian domain names, while UDRP is applicable to global ones like .com, .net, .org and so on.

Internationalized Domain Names

- ❑ Domain names represented in local language characters. Such domain names could contain letters or characters from non-ASCII scripts.
- ❑ .भारत, .ভারত, .ਭਾਰਤ, .ભારત, بهارت, இந்தியா
- ❑ .भारत, .ਭਾਰਤ, ଭାରତ, .ভাৰত, .भारतम्, भारोत
- ❑ .بھارت, .پارت, .ഭാരതം

New gTLDs

- ❑ ICANN launched New generic top level domains in 2012.
- ❑ .hotel,.teacher,.doctor,.game,.book
- ❑ .Berlin,.London
- ❑ .bank, .bar,.college,.CEO,.club,.earth,.cloud
- ❑ There is big business out there.
- ❑ 1200 such names already launched.

New gTLDs

- ❑ Risk of attracting cyber squatters, that is, people or entities who buy up these gTLDs and then profit from them by licensing them to companies.
- ❑ Especially problematic when the gTLD is identical or similar to a trademark or if it is likely to harm the public interest.

UDRP/INDRP Policy Conditions

In order to succeed in a Domain Dispute matter, it is quite necessary to prove all the three clauses of the Policy:

A. The Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

B. Domain Name owner has no rights or legitimate interests in respect of the domain name.

C. The domain name has been registered and is being used in bad faith.

UDRP Policy Conditions-A

- ❑ In order to succeed in a Domain Dispute matter, it is quite necessary that a complainant should prove all the three clauses in terms of the UDRP Policy.
- ❑ Domain Name is identical or confusingly similar to a trademark or service mark.

Confusingly Similar Domain Name

- ❑ Case of ***Britannia Industries Ltd. Vs Amit Singh*** (Decided on 14th Nov, 2022) the respondent's domain name www.britanniacare.in was confusingly similar to the complainant's domain name www.britannia.in.

UDRP Policy Conditions-B

- ❑ Domain Owner prove: a) demonstrable preparation to use Domain Name in connection with bona fide offering of goods or services; or b) has been commonly known by the Domain Name, even though no Trademark has ever acquired; or c) is making legitimate or fair use of the domain name, without any intent for commercial

UDRP Policy Conditions-C

- ❑ Circumstances that may indicate bad faith:
 - a) Domain acquired for the purpose of selling or transferring to the Complainant or even his competitor;
 - ❑ or b) Pattern of conduct indicating that registrant has prevented Complainant from reflecting Mark in corresponding Domain Name;

UDRP Policy Conditions

- ☐ or c) Domain registered primarily for disrupting the business of a competitor;
- ☐ or d) Intentionally attempted to attract online users for commercial gain by creating confusion with Complainant's mark.

Example Britannia Industries

- ❑ it was contended that the
- ❑ domain name of the respondent is identical and confusingly similar to the complainant's domain name.
- ❑ respondent has no legitimate interest in the domain name. Further it was contended that the mark was used by the respondent in bad faith.

Britannia example

- ❑ The learned arbitrator held that the disputed domain name was confusing, similar and identical to the complainant and that they had right in the trademark. The respondent had registered the domain name in bad faith and so the domain name should be transferred to the complainant.

UDRP Vs INDRP

- ❑ UDRP deals with major TLDs like .com, .net, .org, .biz and so on. Proceedings are governed by the UDRP Policy and rules thereunder.
- ❑ INDRP deals Indian ccTLDs, which includes .in, .co.in, .net.in and so on. Proceedings governed by The Arbitration Act, 1996 in terms of INDRP Rules.

UDRP Vs INDRP

- ❑ UDRP: Remedy - No Penalty can be imposed on the Domain Name owner but only transfer or cancellation of Domain Name
- ❑ Injunction can be brought against the UDRP decision within 10 days time either at the location of Registrar's principal office or at Registrant's location.

UDRP Vs INDRP

- ❑ INDRP: Remedy - Penalty in the form of documented costs can additionally be ordered by the Arbitrator.
- ❑ Injunction - There are no specific provisions under INDRP but an action can be brought against the decision as per the provisions of Arbitration Law.

Cybersquatted Domain Names

There are some common Domain names, which Indian Public will relate to Presidium School only. Due to the brand value and the registered Trademark 'PRESIDIUM'.

PRESIDIUMSCHOOL.com - registered

PRESIDIUM.in - registered

THEPRESIDIUM.in - registered

PRESIDUM.co.in - not registered

Presidium Domain Names - Risks

- A. Unregistered Domain Names should be claimed now !
- A. While the squatted Domain Names by third parties, has the following risks:
 - Huge loss to your organization in terms of revenue, traffic, etc.
 - Student/parent/employee may inadvertently send confidential email to offending domain name.
 - Phishing risks, wherein the sensitive/confidential information may be demanded by culprits.

Remedy - How to claim .IN Domain

.INDRP is administered by the .IN Registry/ NIXI, a not for profit organization based in India. Official website is www.registry.in.

It takes approx 6-8 months to get the Domain Name transferred, while the cost is usually about Rs 30,000 in arbitration fees plus legal fees.

Remedy - How to claim .Com Domain

UDRP is administered by WIPO a not for profit organization based in Geneva - www.wipo.int. All the three primary conditions need to be satisfied.

It takes approx 5-6 months for the complete UDRP procedure. The cost is usually about \$1000-1500 in UDRP fees plus the legal fees.

Alternative Remedy

To start a UDRP / INDRP process, it is sometimes helpful to communicate with the Domain Registrant and try to pressurize them to surrender / settle the matter, which may save your organization - costs & time.

In any case, it is worth to reserve the relevant domains, not registered yet and first try to use the alternative remedy for the registered ones !!!

Case of Khadi Domain Name

- ❑ Domain under dispute

Justkhadi.zepo.in

- ❑ Parties: Khadi and Village Industries
Commission-Complainant

- ❑ Zepo Technologies Pvt. Ltd-Respondent

Dispute over.AMAZON

- ❑ Dispute over the ownership of a name - Amazon. It's one of the world's largest companies.
- ❑ Amazon is also the name of the giant rainforest in South America. So who gets to use the Internet domain **.amazon**?

.Amazon Dispute.....Cont...

- ❑ It all started in 2012, when Amazon company applied for .amazon instead of .com.
- ❑ Brazil and other countries in the Amazon basin didn't like the idea that .amazon would belong to Amazon Company.

.Amazon dispute...Contd

- ❑ South American countries see a chance of confusion. If a guy searches the Internet and sees Amazon, is he finding this Amazon or that Amazon?
- ❑ This dispute took 7 years to resolve.
- ❑ It was a political settlement and ICANN favored Amazon.

.RAM vs .RAMTRUCKS

- ❑ Ram Trucks, stylized as RAM and formerly known as the Ram Truck Division, is an American brand of light to mid-weight commercial vehicles.
- ❑ Dispute came when they claimed .RAM as their brand.
- ❑ Indian Government through GAC took the matter and resolved.

Mumbaiindians Vs Indians

- ❑ In June 2012, Reliance had applied for the gTLD ‘.indians’ (presumably to build upon the IPL Team ‘Mumbai Indians’ brand).
- ❑ India opposed this application on the grounds that a private party offering the ‘.indians’ gTLD as an alternative to ‘.in’ which is managed by the Government, would lead to deception and confusion.

Mumbaiindians Vs Indians

- ❑ It was cited that the similarity between '.in' and '.indians' would have the potential to be used nefariously.
- ❑ Later Reliance had [withdrawn](#) its application for the gTLD.

Thank You !