

# Indian Trademark Law & Cyberspace

This document is an extract from the book *IPR & Cyberspace – Indian Perspective* authored by Rohas Nagpal. This book is available as courseware for the **Diploma in Cyber Law** and **PG Program in Cyber Law** conducted by Asian School of Cyber Laws



[www.asianlaws.org](http://www.asianlaws.org)



## Part 3

# Trademark Law & Cyberspace

## 1. Domain Names

### What is a domain name?

Every computer on the Internet is assigned a unique address called an Internet Protocol Address (IP Address). A typical IP address looks like this:

67.19.217.53

The above IP address belongs to a web server on which the official website of Asian School of Cyber Laws (ASCL) is hosted. If you use an Internet browser and type in <http://67.19.217.53> in the address bar, you will reach the ASCL website.

However, it is very inconvenient to remember such numbers. It is much easier for humans to remember names ([asianlaws.org](http://asianlaws.org) is a domain name). This is why the **domain name system** (DNS) was developed.

Simply put, DNS is like a very large telephone directory that maps domain names with IP addresses. It is the DNS that enables you to type in <http://www.asianlaws.org> instead of <http://67.19.217.53> and still reach the ASCL website. Let us examine a simple domain name:

data64.com

This domain can be split into two parts – “data64” and “com”. The two parts are separated by a “.” or dot. The “com” is referred to as the top level domain. Thus we can say that “data64” is a sub-domain on the top level domain “com”.

The following generic top-level domains were first implemented in January 1985:

.com	for commercial organizations
.edu	for post-secondary educational establishments
.gov	for governments and their agencies in USA
.mil	for the US military
.net	originally for network infrastructures
.org	for others

Subsequently many other top level domains were added. These include:

.aero	for the air transport industry
.asia	for companies, organisations and individuals in

	the Asia Pacific region
.biz	for business use
.cat	for Catalan language/culture
.coop	for cooperatives
.info	for informational sites, but unrestricted
.int	for international organizations established by treaty
.jobs	for employment related sites
.mobi	for sites catering to mobile devices
.museum	for museums
.name	for families and individuals
.pro	for certain professions
.tel	for services involving connections between the telephone network and the Internet
.travel	for travel agents, airlines, hoteliers, tourism bureaus, etc.

In addition there are country top level domains such as “.in” for India and “.us” for USA.

### **Important facts about domain names**

1. Domain names are **not case sensitive** i.e. DATA64.COM is the same as data64.com or dAtA64.CoM
2. Domain names can only contain **alphabets, numbers** and **hyphens**.
3. You cannot legally own a domain name. Domain names are licensed to you by the relevant registries in return for a fee.
4. You can find out information about a domain name holder using a “whois search”. However, the results of a whois search are not of much evidentiary value as anyone can register a domain using a fake name and address.

### **Are domain names trademarks?**

A domain name is not itself a trademark. A trademark is a right, granted under law, to use a mark in commerce to represent a product (or a business, in the case of a trade name). A domain name is a word or phrase registered in the domain name registration system.

A domain name may be a company's expression of its trademark. The use of a trademark in a domain name, for instance, is the equivalent of using the trademark on a billboard, or in advertising.

For example, the trademark “data64” can be used in magazine advertising, or in the domain name, data64.com. The use of the domain name may be the way in which a company initially establishes its rights to a trademark.





### **Illustration**

The use by Data64 LLC of the domain name data64.com was one way in which Data64 LLC established its right to the “data64” trademark.

Whether a word or phrase used in a domain name qualifies for trademark protection is determined under regular trademark law. Trademark law does not protect the use of generic words, such as “computer”.

Similarly, if a domain name is the same name by which the product or service is typically described, the law will consider it ‘generic’ and will not treat it as a trademark.

For instance, the domain name computers.com uses a word that is the generic term for a class of products and will most likely never receive protection as a trademark because the law does not allow monopolies over generic terms.

While trademark law may not protect the use of domain names, such as medicines.com, exclusive use of a domain name is guaranteed by the domain name registration system.

However, while no other website can use the domain medicines.com, there may be nothing to prevent them from using derivatives or copycats such as medicines123.com or medicinesindia.com

## 2. Domain Name Disputes

Domain name disputes often arise when “**cyber-squatters**” intentionally register domain names that include a trademarked word, company name, name brand of a product, or even names of film stars.

However, these disputes are not always between a person with a purely speculative reason for registering the domain name and a person with a legitimate reason to want the domain name. Sometimes both parties have a legitimate use and right to the domain name.

### Illustration

In 1994 a journalist preparing an article on domain name policy realized that McDonalds.com was available. He registered the domain name.

The fast food chain McDonalds pressured Networks Solutions Inc (NSI) into taking action against the journalist. At that time, there was no formal dispute policy in place. A week after revoking the registration, NSI realized it had made a mistake and reversed its decision.

Finally McDonalds paid US \$3,500 for retaining the domain name.

**Cyber squatting** is the registration of a domain name by someone who lacks a legitimate claim with the intent to

1. sell the name,
2. prevent the trademark holder from gaining access to the name, or
3. to divert traffic

In **typo-squatting** the squatter registers a variant of a famous trademark.

### Illustration

While typing in google.com many people accidentally type googlw.com as the “e” and “w” keys on the keyboard are next to each other.

Registering the domain googlw.com to intercept traffic meant for google.com would be typo-squatting.





### 3. Domain Name Disputes in India

India's top level domain is ".in". The sunrise period for the ".in" domains was from 1<sup>st</sup> January, 2005 to 21<sup>st</sup> January, 2005. During this period owners of registered Indian trademarks or service marks were given an opportunity to apply for ".in" domains. The booking was opened to the public from 16<sup>th</sup> February, 2005.

**INRegistry** is the official ".in" registry. INRegistry is operated under the authority of **NIXI** (National Internet eXchange of India)

NIXI is a not-for-profit company registered under section 25 of the Indian Companies Act. NIXI has been set up to facilitate improved Internet services in India.

INRegistry has the following responsibilities:

1. maintaining the "in" top level domain
2. ensuring the operational stability, reliability, and security of ".in"
3. implementing Government of India policies

INRegistry took over its role from National Centre for Software Technology (NCST) and Centre for Development of Advanced Computing (C-DAC). End users cannot register ".in" domains from INRegistry. Registrations are handled by INRegistry accredited registrars. The following are the registrars for specific domains:

1. National Informatics Centre is the registrar for **gov.in** domains
2. ERNET is the registrar for **res.in** and **ac.in** domains
3. Ministry of Defence is the registrar for **mil.in** domains

".in" domain name disputes are resolved in accordance with the **.IN Dispute Resolution Policy** (INDRP) and the **INDRP Rules of Procedure**.

The INDRP outlines:

1. the types of disputes that can be brought and
2. the criteria that will be considered by the arbitrators.

The INDRP Rules of Procedure describe:

1. how to file a complaint,
2. how to respond to a complaint,
3. the fees,
4. communications, and
5. other procedures.

### 3.1 The .in Domain Name Dispute Resolution Policy

The “.in Domain Name Dispute Resolution Policy” (INDRP) sets out the terms and conditions to resolve a dispute between the **Registrant** and the **Complainant**, arising out of the registration and use of a “.in” Internet Domain Name.

**Registrant** is a holder of the .in Internet domain name.

**Complainant** is the person who has complaint against the Registrant.

#### Illustration

Sameer has booked the domain name “noodle.in”. Noodle Ltd files a complaint against Sameer to get the “noodle.in” domain transferred to its own name.

In this case, Sameer is the registrant while Noodle Ltd is the complainant.

A **complaint** can be filed with the .IN Registry on the **following grounds**:

1. the Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights,
2. the Registrant has no **rights or legitimate interests** in respect of the domain name,

Simply put, the following circumstances demonstrate the Registrant's rights to or legitimate interests in the domain name:

1. Before any notice to the Registrant of the dispute, the Registrant uses or prepares to use the domain in connection with a bona fide offering of goods or services.
2. The Registrant (as an individual or organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights.
3. The Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for





commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

3. The Registrant's domain name has been registered or is being used in **bad faith**.

Simply put, the following circumstances are evidence of the registration and use of a domain name in bad faith:

1. circumstances indicating that the Registrant has registered / acquired the domain name primarily for
  - a. selling,
  - b. renting, or
  - c. otherwise transferring it to the Complainant or its competitor for a profit.
2. the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name [provided that the Registrant has engaged in a pattern of such conduct]
3. by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location.

**The basic procedure for the dispute resolution is:**

1. The Complainant files the **complaint** with the .IN Registry and pays the relevant **fees**.

The Complainant can ask for

- a. **cancellation** of the Registrant's domain name or
  - b. **transfer** of the domain name registration to the Complainant
2. The .IN Registry **appoints an Arbitrator** out of the list of arbitrators maintained by it.

The List of the Arbitrators is published online at [www.registry.in](http://www.registry.in)



3. The Arbitrator conducts the **arbitration proceedings** in accordance with the Arbitration & Conciliation Act 1996 and the IDR Policy and Rules.

The Registrant is required to submit to the mandatory arbitration proceeding.

The Registrant cannot **transfer** a domain name registration to another holder:

- b. for **15 working days** after conclusion of the proceeding
- c. during a **pending case** unless the transferee agrees to be bound by the decision.

The Registry reserves the right to cancel any transfer of a domain name registration to another holder that is made in violation of this paragraph.

4. The Arbitrator **decides** on the complaint.

All decisions under this Policy are published in full over the Internet. **Note:** An Arbitration Panel can decide in exceptional cases to edit portions of its decision.





## 3.2 The INDRP Rules

The “.in Domain Name Dispute Resolution Policy Rules” (INDRP Rules) describe the following:

1. how to file a complaint,
2. how to respond to a complaint,
3. the fees,
4. communications,
5. other procedures.

### **The complaint**

An arbitration proceeding in respect of a domain name dispute can be initiated by submitting a complaint (in hard copy and electronic version) to:

.IN Registry  
c/o NIXI (National Internet eXchange of India)  
Corp. Office: 121-123, Ansal Tower, 38  
Nehru Place, New Delhi 110019

The complaint must contain the following:

1. Name, postal addresses, e-mail addresses, telephone numbers and facsimile numbers of the **complainant**.
2. Contact information of the **respondent**.
3. The **domain name** which is the subject of the complaint.
4. The **trademark(s)** or service mark(s) on which the complaint is based.
5. The **grounds** on which the complaint is made.

#### The following must be specified:

- a. The manner in which the domain name is **identical** (or confusingly similar) to the complainant's trademark or service mark.
  - b. reasons why the respondent should be considered to have no **rights** or legitimate **interests** in the domain name,
  - c. reasons why the domain name should be considered to have been registered and as being used in **bad faith**.
6. The **remedies** sought.
  7. Any other relevant legal **proceedings**.



8. Relevant **documents**.
9. Cheque / draft (in favour of 'NATIONAL INTERNET EXCHANGE OF INDIA') for the **relevant fees**. The fees for adjudication is payable as per the following schedule:

.IN Registry's Administration Fee	Rs.5000
Arbitrator's Fee	Rs.25000
Personal hearing	Rs.5000 per hearing

**Note:** In case the Arbitrator calls for personal hearings, the fees for the same are to be shared by the parties equally.

If any party requests for personal hearing and that request is allowed by the Arbitrator, the fees for it is payable by the requesting party.

### **Notification of complaint**

The procedure followed by the .IN Registry on receipt of the complaint is as under:

1. If the complaint is in accordance with the policy and rules, it will be **forwarded to the respondent** within 3 working days.

.IN Registry sends the complaint to all postal, facsimile and email addresses shown in the domain name's **registration data** through .IN Registry's WHOIS database at [www.registry.in](http://www.registry.in) [see next page for an illustration of registration data]

2. If the complaint is not in accordance with the policy and rules, the **deficiencies** will be notified to the complainant within 3 working days. The complainant must **correct the deficiencies** in 5 working days.
3. The .IN Registry then **appoints an arbitrator** from the list of arbitrators.
4. The complaint and documents are **forwarded to the respondent and the arbitrator** for adjudicating (in accordance with the Arbitration and Conciliation Act 1996, rules thereunder, and the Dispute Resolution Policy & rules).
5. Within 3 days from the receipt of the complaint the Arbitrator issues a **notice** to the Respondent. The date of commencement of the arbitration proceeding is the date on which the Arbitrator issues this notice to the respondent.



6. The Arbitrator must pass a **reasoned award** (within 60 days) and put forward a copy of it immediately to the complainant, respondent and the .IN Registry.

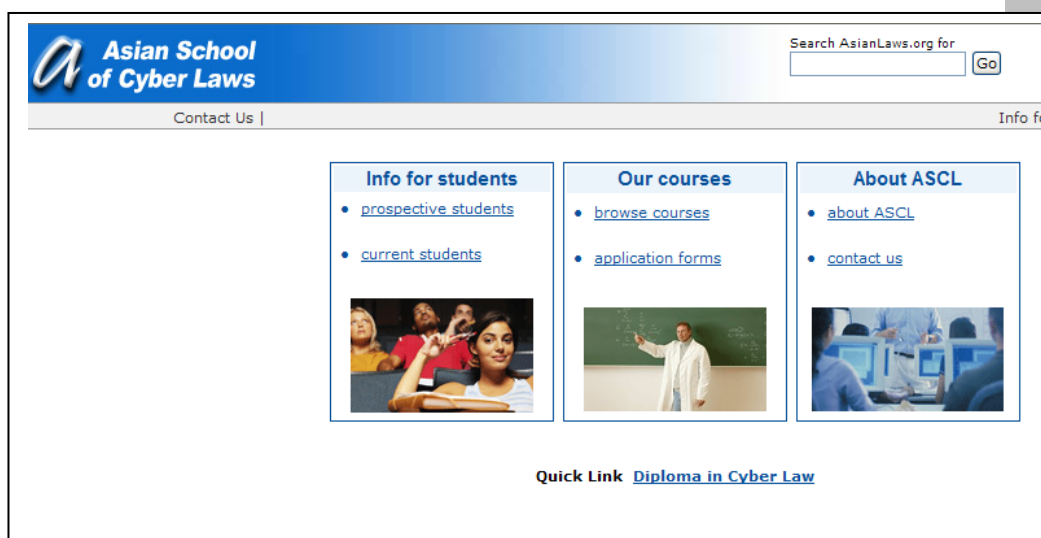
**Registration data for the domain data64.in through  
.IN Registry's WHOIS database at [www.registry.in](http://www.registry.in)**

Domain ID:D2243738-AFIN  
Domain Name:DATA64.IN  
Created On:26-May-2006 18:46:53 UTC  
Last Updated On:07-Sep-2007 06:36:27 UTC  
Expiration Date:26-May-2010 18:46:53 UTC  
Sponsoring Registrar:Silicon House (R38-AFIN)  
Status:OK  
Registrant ID:DI\_5590479  
Registrant Name:Data 64  
Registrant Organization:Data64 Techno Solutions Pvt Ltd  
Registrant Street1:6th Floor  
Registrant Street2:Senapati Bapat Road  
Registrant City:Pune  
Registrant State/Province:MH  
Registrant Postal Code:411016  
Registrant Country:IN  
Registrant Phone:+91.2064006464  
Registrant FAX:+91.2025884192  
Registrant Email:rn@asianlaws.org  
Admin ID:DI\_5590479  
Admin Name:Data 64  
Admin Organization:Data64 Techno Solutions Pvt Ltd  
Admin Street1:6th Floor  
Admin Street2:Senapati Bapat Road  
Admin City:Pune  
Admin State/Province:MH  
Admin Postal Code:411016  
Admin Country:IN  
Admin Phone:+91.2064006464  
Admin FAX:+91.2025884192  
Admin Email:rn@asianlaws.org  
Tech ID:DI\_5590479  
Tech Name:Data 64  
Tech Organization:Data64 Techno Solutions Pvt Ltd  
Tech Street1:6th Floor  
Tech Street2:Senapati Bapat Road  
Tech City:Pune  
Tech State/Province:MH  
Tech Postal Code:411016  
Tech Country:IN  
Tech Phone:+91.2064006464  
Tech FAX:+91.2025884192  
Tech Email:rn@asianlaws.org  
Name Server:NS1.DREAMHOST.COM  
Name Server:NS2.DREAMHOST.COM  
Name Server:NS3.DREAMHOST.COM

## 4. Web related issues

### 4.1 Meta tags

Meta tags are codes contained within websites that provide a description of the website. Let us take the illustration of the **Asian School of Cyber Laws (ASCL)** website. When a student visits [www.asianlaws.org](http://www.asianlaws.org), he sees the website illustrated below:



What the user does not see are the description and keywords meta tags as illustrated below:

```
<META content="Education, training, consultancy and research in Cyberlaws, cybercrime investigation and cyber forensics" name=description>
```

```
<META content="education, training, consultancy, research, cyberlaws, cyber laws, cyberlaw, cyber law, cybercrime investigation, cyber crime investigation, cyber forensics" name=keywords>
```

These tags are embedded in the source code of the website. They are put so that search engines (e.g. [google.com](http://google.com), [yahoo.com](http://yahoo.com) etc) can accurately identify what the website relates to.

As can be seen in the illustrations above:

1. The **description tag** contains a description of the web page.
2. The **keywords tag** contains relevant associated keywords.

When a user searches for “Asian School of Cyber Laws” in [google.com](http://google.com), the first search result clearly contains the description of the ASCL website as per the description tag. This is illustrated below:





Web [Images](#) [Maps](#) [News](#) [Products](#) [Gmail](#) [more](#) ▼

**Google**™   [Advanced Search](#)  
[Preferences](#)

Web Results 1 - 10

**[Asian School of Cyber Laws](#)**  
Education, training, consultancy and research in **Cyberlaws**, cybercrime investigation and **cyber** forensics.  
[www.asianlaws.org/](http://www.asianlaws.org/) - 6k - [Cached](#) - [Similar pages](#)

[Diploma in Cyber Law](#)   [Contact Us](#)  
[Current students](#)   [Our Courses](#)  
[Prospective students](#)   [About Us](#)

[More results from asianlaws.org »](#)

**Trademark disputes** can arise when someone's trademark is put by his rival in the meta tags of the rival website.

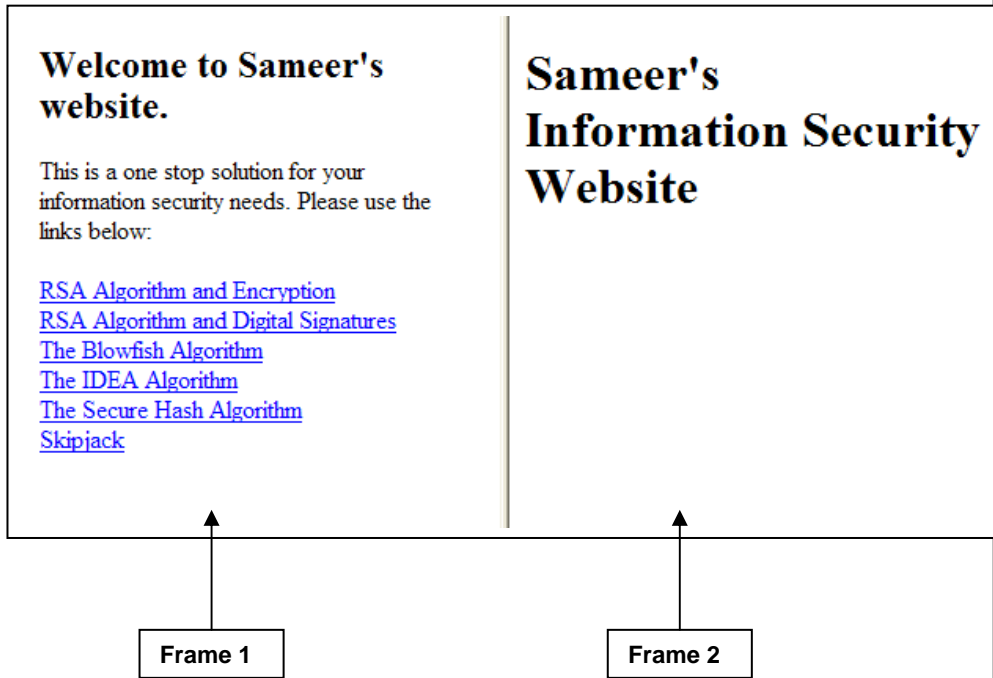
#### **Illustration**

Sameer sells a PDF creator software that rivals the PDF creator sold by Adobe. If Sameer writes the words "Adobe" in the meta tags of his website, then the search engines may mistakenly index Sameer's website as being related to Adobe. Web users looking for Adobe software may get diverted to Sameer's website.

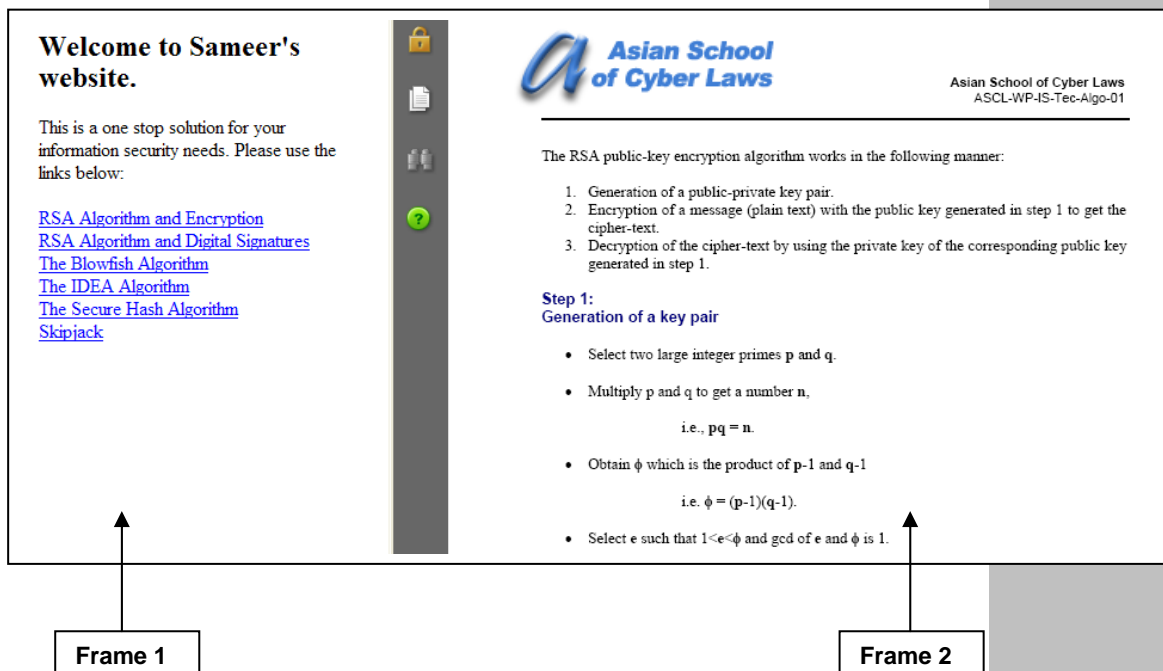
The act of putting meta tags of rival companies and brands in a website is also referred to as **cyberstuffing**.

## 4.2 Framing

A webpage can be divided into several frames. Each frame can display different content. Let us take a simple illustration. Sameer provides commercial consultancy in the field of information security. He puts up a website and one of the pages is illustrated below:



When a user clicks on the link “RSA Algorithm and Encryption” in Frame 1 above, a document from the Asian School of Cyber Laws (ASCL) website opens up in Frame 2. See illustration below:





To an ordinary user it may appear that the RSA Algorithm and Encryption document is a part of Sameer's website. In reality this document is being accessed from ASCL's website and being opened up in a frame on Sameer's website.

Clicking on the other links opens up different web pages in Frame 2 while the content in Frame 1 remains the same.

Such framing may give rise to a claim for **passing off** as an ordinary user may infer a business association between Sameer and ASCL. In reality, there is no business association between Sameer and ASCL. ASCL can claim that Sameer has indulged in misleading and deceptive conduct.

It is advisable to put a suitably worded disclaimer or acknowledgment which clearly informs the visitor about the relationship between the two sites (Sameer's and ASCL's in this case). For example Sameer could put the following disclaimer next to the link to ASCL's webpage.

This link leads to content on the website of Asian School of Cyber Laws (ASCL). The homepage of ASCL is at [www.asianlaws.org](http://www.asianlaws.org)

Sameer has no business or other association with ASCL and has provided this link purely for information.



### 4.3 Deep Hyperlinking

Simply, put hyperlink is a reference to a webpage or document on the Internet. Let us consider the **courses page** on the Asian School of Cyber Laws (ASCL) website.

This page is located at <http://www.asianlaws.org/courses/index.htm>



The above webpage consists of several links to other web pages e.g. if a user clicks on the “Diploma in Cyber Law” link, he will be taken to the page containing details of the Diploma in Cyber Law course.

To a user the link appears as

[Diploma in Cyber Law](#)

In the source code of the website, the link appears as:

```
<a href=http://www.asianlaws.org/courses/dcl/index.htm>
Diploma in Cyber Law</a>
```

Normally, no organisation or person objects if someone puts a hyperlink to their homepage. The objection comes when someone puts a link directly to an inner page or document.

For example, ASCL would not object if someone provides a link to the ASCL homepage (<http://www.asianlaws.org/index.htm>). However, if someone provides a link to a document “deep” in the ASCL website, then ASCL may have an objection.

Suppose Sameer puts a hyperlink in his website named “RSA Algorithm”. On clicking this link, the ASCL sponsored whitepaper on the topic opens up from [http://www.asianlaws.org/infosec/library/algo/rsa\\_asym.pdf](http://www.asianlaws.org/infosec/library/algo/rsa_asym.pdf)  
This is called deep hyper-linking.





Deep hyper-linking may give rise to a claim for **passing off** as an ordinary user may infer a business association between Sameer and ASCL. In reality there is no business association between Sameer and ASCL. ASCL can claim that Sameer has indulged in misleading and deceptive conduct

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[www.asianlaws.org](http://www.asianlaws.org)

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Behind Indiabulls Mega Store,  
Senapati Bapat Road,  
Pune - 411016.  
India

**Contact Numbers**

+91-20-25667148  
+91-20-40033365  
+91-20-64000000  
+91-20-64006464

**Email:** [info@asianlaws.org](mailto:info@asianlaws.org)

**URL:** [www.asianlaws.org](http://www.asianlaws.org)