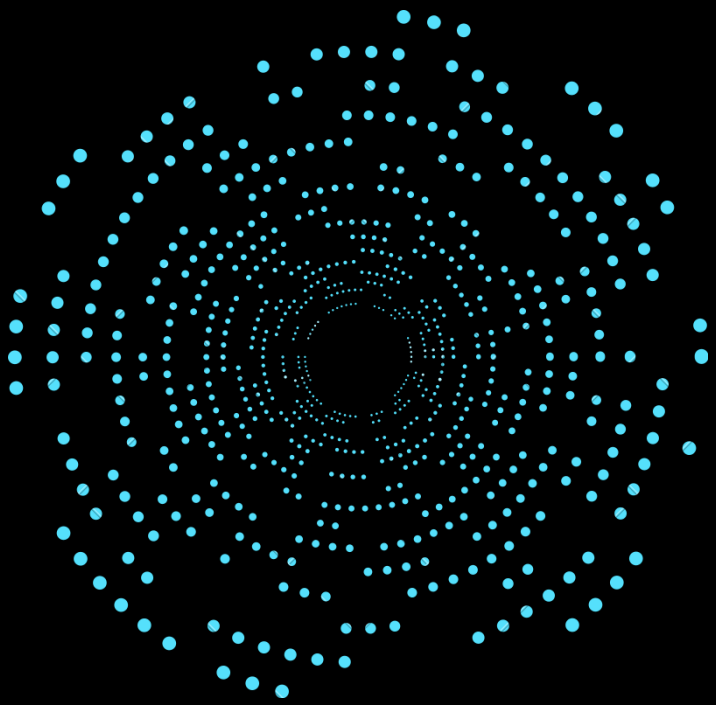
INTERNATIONAL JOURNAL ON CYBERSPACE LAW AND POLICY



VOLUME 1 AND ISSUE 1 OF 2023

INSTITUTE OF LEGAL EDUCATION

International Journal on Cyberspace Law and Policy

(Free Publication and Open Access Journal)

Journal's Home Page – https://ijclp.iledu.in/

Journal's Editorial Page - https://ijclp.iledu.in/editorial-board/

Volume 1 and Issue 1 (Access Full Issue on - https://ijclp.iledu.in/category/p-volume-1-and-issue-1-of-2023/)

Publisher

Prasanna S,

Chairman of Institute of Legal Education (Established by I.L.E. Educational Trust)

No. 08, Arul Nagar, Seera Thoppu,

Maudhanda Kurichi, Srirangam,

Tiruchirappalli – 620102

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INTERNATIONAL JOURNAL ON CYBERSPACE LAW AND POLICY

(P) Volume I and Issue I of 2023

ISBN - 978-81-960702-9-8

Published by

Institute of Legal Education

https://iledu.in

Cybersquatting: Infringement Through Domain Names

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Best Citation - Debapriya Biswas, Cybersquatting: Infringement Through Domain Names, *International Journal on Cyberspace Law and Policy,* 1 (1) of 2023, Pg. 13-17, ISBN (P) - 978-81-960702-9-8.

Abstract

With the advancement of technology, many things have shifted online that could only be once seen in the physical form. One such thing is the market space which gained the most popularity in the past decade due to easy advertising and reach to the public on the net. It, in turn, led to most of the companies shifting a part of their business over the net. Due to such a shift, the concept of Trademark, which helped buyers with the identification of their products, also evolved to adapt to the digital space.

This paper discusses the Trademark in the digital space in the form of 'domain name', while also exploring its different types and the usage of such types. The infringement of Trademark in the digital space is also discussed – most of which is focused on the cybersquatting and its types.

Lastly, the paper also focuses on the possible remedies and prevention through discussing some precedents and how the Judiciary interpreted the law in those precedents to protect the interest of individual trademark owners. Several international legislations and Treaties are also discussed that can be invoked in cases of such infringement.

Keywords: Trademark, Domain Name, Cybersquatting, typosquatting and digital space.

Introduction

With everchanging times, humanity has developed through leaps and bounds, especially when one considers it in the aspect of technology. What started with a computer system and its various pieces of equipment covering one whole room just to run has now developed to the point where a whole world exists on the virtual platform of cyberspace. With such advancements in technology, many things have changed including the very activities humans were used to doing physically but now do through online platforms.

From drawing to shopping to conducting business to even ordering food, everything that was once done in physical mode can now also be done through online mediums, making cyberspace a world with infinite possibilities. These possibilities attracted people to its virtual platforms, making many businesses aim to make their own online presence to garner the attention of a wider range of potential customers.

This change made the digital space an ideal place for businesses to operate and expand, which was especially highlighted during the pandemic when activities in the physical world ceased for a brief period due to lockdowns. It is when many people noticed how convenient yet secure online transactions and thus, online businesses can be for tuition, shopping, delivering food and many more.

Since the prospect of online business was wide and very promising, many small companies and organisations started conducting their business online while the already existing physical businesses also started conducting through their online websites and platforms to cater to a wider customer pool. This is where the role of websites and domains became vital in online business for any company or business.

Internet Domain as a Trademark

As mentioned earlier, websites are a vital part of conducting any online business since that from where most of the customers come in contact with the main business. In a manner, one can compare an (official) website to a physical shop or showroom of the company through

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which it conducts its business; in cases of online shopping websites, one can compare them to supermarkets, if they so wish.

It helps make it clear how much websites can affect one's business and its conduct since that is the place where a customer may visit first to make their purchases or even contact customer care with their queries and complaints.

This makes official websites and their domain name play a chief role in the business of any company. Any foul tactics with a company's domain name can lead to heavy losses and unfair usage of its goodwill. However, before exploring that possibility, let us see what exactly is a domain name.

An Internet domain name, as the term suggests, is a string of unique terms that acts as an identifier of a particular website or web page on the internet.[1] In a nutshell, it is a part of the web address that helps access particular pages and their ancillary links on the internet. Some common examples of it would be www.facebook.com and www.youtube.com.

The domain name in the aforementioned examples would be 'Facebook' and 'youtube' respectively. And while the whole of the web address can be refreshments to as a domain name, it is divided into three parts — sub-domain, domain names and top-level domains.

Taking the example of 'www.youtube.com', the sub-domain, in this case, is the 'www' part, which stands for 'World Wide Web.' It usually depicts as a part of another domain in this case the 'www' entails that the web address is a part of the internet servers.

Meanwhile, 'youtube' is the domain name in the above-given example, which represents the online streaming platform YouTube. Thus, the web address may direct anyone using it to the official home page of YouTube.

And lastly, the 'com' stands for the top-level domain (TLD) which usually follows the domain names after a dot (.). And can help one trace the nature of the web address. In simpler terms, TLDs can define the domain class of a web address as well as the country of origin if it is country coded.[2] Based on this, there are three types of TLDs:

- Generic Top-Level Domain (gTLDs)[3]

As the name suggests, these are the generic and usually seen TLDs which can help identify the domain class a web address is associated with. Some common instances of it would be '.org' which represents a non-profit or charity organisation, '.net' which represents a network-related business or '.com' which represents the commercial intent of a website at a global range.

- Country Code Top-Level Domain (ccTLD)[4]

It is a type of TLD which usually consists of only a two-letter domain extension that represents the country or region of origin of the web address. Each nation has its own assigned ccTLD such as '.in' for India and '.jp' for Japan. Any website using these TLDs usually does so to limit their business to the given region to access the local or regional market.

- Sponsored Top-Level Domains (sTLDs)[5]

These are the new TLD names which are based on brands and organisations providing the said services online. They are customised to respect the brand itself, making it more relevant and unique amongst the generic TLDs. The most common of their examples will be '.post' used by the Universal Postal Union and '.xxx' by adult websites or pornographic sites.

Within these parts of the web address, the domain name and the TLD is usually what is used as an identifier for any business, company or platform. These two together are also known

[1] Internet Corporation for Assigned Names and Numbers (ICANN), 2010, *Beginner's Guide to Domain Names*, available at: https://www.icann.org/en/system/files/files/domain-names-beginners-guide-06dec10-en.pdf.

[2] Archives of Internet Corporation for Assigned Names and Numbers (ICANN), *Top-Level Domains (gTLDs)*, available at: http://archive.icann.org/en/tlds/.

[3] *Id.*

[4] *Id.*

[5] *Id.*

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as the 'root domain',[6] which one can get registered as a Trademark since it serves almost the same purpose as the logo or name of a company in the online scenario.

The root domain of any web address acts as an identifier for the costumes to track down the source of the website they are using as well as the products and goods that are provided by that website. Legitimate root domains can lead to good quality materials; thus, the establishment of goodwill and credibility, which is similar to the workings of a trademark in physical businesses.

In addition to that, since official websites have become a vital part of building the online presence of businesses, many companies also promote their domain names and web addresses as a way to advertise and easy access to potential customers and clients.

Thus, it makes the registration of internet domain names vital since they carry the goodwill of businesses in cyberspace. If not done so, then similar websites or websites with the same domain name can operate online and gain an unfair advantage at the goodwill of another trademarked business. It is how the act of domain squatting or 'Cybersquatting' came to be.

Cybersquatting and its legality

As mentioned earlier, since domain names act similarly to a trademark during online transactions, their misuse and copying can lead to the act commonly known as 'Cybersquatting'. Before discussing its legality, let us discuss exactly what cybersquatting means and its different types.

Cybersquatting, as its name suggests, is the act of using a domain name in bad faith.[7] That is, it is the usage of the trademark of another to gain profits through an unfair means. It can also be called domain squatting, which was started in the early days of the internet when the concept of online business was still considered new and unusual.

In cybersquatting, the perpetrator registers domain names the same as or similar to the name of popular companies who are yet to make their official websites and use these registered domain names as a medium to gain profits by either using them to dupe customers or selling the domain name to the owner of the said company at a higher price, like in the case of ***British Telecommunications Plc v One in a Million Ltd***,[8] where the defendant had registered several domain names based on the names of well-known companies and businesses at the time.

The act of domain squatting was previously not illegal since registration of such sites was given based on the 'first come, first serve' approach. It led to many people creating websites with the name of well-known trademarks and registering them only to sell them back to the legal owners of the said trademark at a higher price.

However, once domain names were recognised as or equivalent to trademarks, remember for the act of cybersquatting led to either trademark infringement or passing off, depending on whether the domain name is registered or not. But not all cybersquatting is done only to sell it at a higher price — some are also made to gain an unfair advantage by misusing the goodwill of another company or business.

Many websites registered with a similar yet slightly different variant of the domain name of a well-known trademark can also amount to trademark infringement, albeit under 'Typosquatting' rather than cybersquatting.

Typosquatting, as its name may suggest, is the act of creating domain names with similar yet slightly different names to a popular trademark.

[6] Editors of Alibaba Cloud, *What Is A Root Domain*, Alibaba Cloud, available at: https://www.alibabacloud.com/topic-center/knowledge/3/4jpu9couvas-what-is-a-root-domain (last read: 24 Sep, 2022)

[7] Internet Corporation for Assigned Names and Numbers (ICANN), *About Cybersquatting*, available at: https://www.icann.org/resources/pages/cybersquatting-2013-05-03-en.

[8] British Telecommunications Plc v One in a Million Ltd, [1999] 1 WLR 103; [1999] FSR 1.

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Many customers can accidentally click back to these websites for a typographical error or typo while typing out the web address of the intended websites.

For an instance, the websites 'google.com' and 'goggle.com' have similar domain names and thus, can cause the confusion in minds of the customers, especially since each is just one letter away which can be accidentally typed at any time. The intent of creating such websites is always malicious and can cause great monetary losses to the Trademark owners by diverting a large number of customers to its typosquatted website.

Another tactic of similar nature is when one registers the name of a particular domain name whose registration has expired. In simpler terms, since registration of domain names is given for a fixed period just like trademarks, many domain names expire after the said fixed period. If not renewed, cybersquatters may attempt to register and own it. This method is commonly known as the 'renewal snatching' which may amount to passing off.

While typosquatting can be said to be a sub-category of cybersquatting, both can lead to the usage of domain names in bad faith and the creation of unfair competition by online impersonation. Thus, the need for proper remedies and injunctions is needed in cases of infringement of the legal right of the trademark owners.

Remedies and Preventions

The difference between trademark and domain name is that while there can be same named trademarks in different fields of products and services, domain names do not adhere to such rules. This creates a lot of disputes in regards to the domain name and its unknown similarities which do not always arise from cybersquatting, just as how it happened in the case of ***Prince Plc v. Prince Sportswear Group Inc***,[9] where both the parties had similar brand names in completely different fields with the interest in the domain name 'prince.com' which could represent either of the parties.

To prevent such instances, many businesses and companies register multiple domain names which may spell similarly to their primary domain name. For an instance, if the primary domain name for Google is 'google.com', other similar domain names such as 'googkle.com', 'goggle.com' and more can be registered by the company as well to prevent any cases of cybersquatting. This method of prevention is used by many companies in today's time.

However, the prevention may not always help — thus, legal remedies must be sought out in the cases of cybersquatting, especially when trademark rights are present in the domain name, like the 'Google' in the 'google.com' domain.

The U.S. Anti-cybersquatting Consumer Protection Act or ACPA of 1999 provides legal remedies at an international platform for trademark owners. The victim can either sue the perpetrator directly under provisions of the aforementioned Act or opt for arbitration at the international platform through the Internet Corporation of Assigned Names and Numbers or ICANN.[10]

If the judgement is given in the favour of the plaintiff, the domain name in dispute may either be transferred to them or be cancelled and closed down as an injunction. However, if the case is resolved under arbitration, monetary compensation may be hard to acquire.

In the case of such infringement cases in India, the issue arises that India does not have any particular legislation that provides protection to domain names. While they can be registered nationally under Trademarks Act, 1999 or the

[9] Prince Plc v. Prince Sportswear Group Inc [1998] F.S.R.21.

[10] Internet Corporation for Assigned Names and Numbers (ICANN), 2010, *Beginner's Guide to Domain Names*, available at: https://www.icann.org/en/system/files/files/domain-names-beginners-guide-06dec10-en.pdf.

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Trademarks Rules, 2002 and internationally at ICANN, their protection is equivalent to that of a trademark than its own individual identity. The Judiciary of India, however, has still been providing relief to the victims of cybersquatting despite having no particular legislation.

While ***Manish Vij v. Indra Chugh***[11] was the first case where cybersquatting was defined, it was the landmark judgment of ***Yahoo Inc. v. Aakash Arora***,[12] where cybersquatting was addressed and treated as a Trademark infringement in India for the first time. The issue of registration of similar domain names was almost addressed, where the Court held that just because one has registered a domain name does not mean they may obtain the legal right to use a trademark associated with the domain name — especially if its legal owner is someone else.

Registration and usage of such domain names were held to be an infringement of the legal trademark owner, which was iterated in the case of ***Tata sons Ltd v. Manu Kosuri***,[13] where the defendant had registered domain names with the trademarked term 'Tata.' The Court had held that domain names are similar to trademarks in the online domain and usage of any trademark or brand name in it is an infringement of the legal right of the trademark owner.

The case of ***Satyam Infoway Ltd. v. Siffynet Solutions Pvt. Ltd.***[14] laid down the path for the protection of domain names in India under Jurisprudence, precedents and interpretation of provisions of the Trademarks Act of 1999 by treating it as an online extension of one's Trademark.

Conclusion

With the development of what we know as cyberspace today, the globalisation of businesses and many other services have led to the convenience of the customers and the interconnection of the market at a global level. It has made the internet a vital part of the market and commerce, especially during the pandemic.

However, activities like cybersquatting and typosquatting can lead to the discouragement and loss of many businesses due to the unfair competition they create on online platforms. Thus, to address this issue, it is important to make people aware of such cases — especially since cybersquatting itself is borderless and can be difficult to track or notice at first.

There is a need to establish proper provisions regarding the jurisdiction of such cases of infringement, especially since they are primarily done so in the digital domain. In India, the urgency for legislation as well as the awareness of such cybercrimes is even more due to the current lack of either of them.

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[11] Manish Vij v/s Indra Chugh, 2000, Suit Appeal No. 618 of 2000.
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