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## Protection of Domain Name under Existing Legal Framework

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*Domain names are essentially virtual counterparts of trademarks, even though both of them have fundamentally the same characteristics, there are several technical aspects in which they heavily differ. Trademarks being traditional business identifiers operate in physical mode, whereas the domain names, which serve as an IP address identifier operates virtually and directs the consumers to those traditional businesses on which trademarks operate. The primary objective of this study is to look into the technicalities by analysing the legal protection available to the domain names and exploring further possibilities for improvement in the existing legal framework. Further shedding light on the current regulations and legal protection given to domain names and related disputes in India, European Union, the United States, and the United Kingdom.*

**Keywords:** *domain name, trademark, legal protection, business identifiers.*

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### INTRODUCTION

The current evolving digital era, especially after the COVID-19 outbreak, has seen a surge in online businesses. The rapid growth of technology has also enabled traders to grow their businesses using domain names. Domain name and trademark are both treated as business identifiers. Similar to a trademark, a domain name protects and promotes the brand name in the digital market space. Registering a domain name makes it easier for traders to connect to a wider consumer base and to operate in a larger marketplace. Operating online offers traders ease of

doing business at a lower cost. Domain names are user-friendly which helps internet surfers to locate a particular website, thus helping online traders reap the benefits of it. It increases the visibility and accessibility of traders even from remote sources of the world.

Domain names are easier, cheaper, and faster to register as compared to trademarks. The vast reach of the Internet has also made it more accessible. However, in practicality, everyone cannot avail of such a facility, as when it comes to domain name protections, the laws don't seem to be that efficient. The registrations of domain names are done on a first-come-first-served basis and the conflict arises when someone else registers the domain name using another's trademark, or when there exists more than one company with the same trade name in different jurisdictions. This gives rise to domain name disputes. As a result, the speedy rise in registration and use of domain names in the business has also increased its need for legal protection and a dispute resolution mechanism.

### **CAN TRADEMARKS AND DOMAIN NAMES BE REGARDED AS THE SAME?**

Generally, a domain name performs the same functions as that of a trademark, such as representing a product or service, however, they differ in many aspects as well. Whereas the trademarks represent a product or a service and have traditionally been dealt with in the offline market, the domain name acts as a navigator of a website of a company and operates only in cyberspace. There have been two clashing yet very interesting points of view in this regard.

One view negates the question at hand and supports the distinction between the two, and states that domain names are more of a way of "accessing the cyberspace" which is way different from the concept of trademarks. It further suggests that an IP address should not be questioned on the ground of it being similar to a trademark. However, the contradictory view states that domain names serve other functions than that of representing the IP address alone. It further affirms that a company should not lose its trademark becomes the same name has already been taken by someone else in cyberspace. It conclusively suggests that since domain names also act as a source identification of a product, they should be treated equally as that a trademark.

## CAN DOMAIN NAMES BE PROTECTED UNDER THE TRADE MARKS ACT, 1999?

Even though empirical thoughts mentioned above may differ, they guide us in the same direction; domain names being an invaluable asset to the companies and the prominence of trademarks on domain names. However, can they be rendered equal protection? Technically, yes. They can be registered and protected as trademarks at national and international levels, only if they fulfill all the criteria of the trademark mentioned under Section 2 (ZB) of the Trade Marks Act 1999,<sup>1</sup> which states that *“trademark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include the shape of goods, their packaging, and combination of colours.”*<sup>2</sup>

To secure protection under trademark laws, a domain name has to qualify as a trademark. However, this is not always possible. For a domain name to be successfully registered and protected under the Trade Marks Act 1999,<sup>3</sup> it has to be unambiguously distinctive from all the other domain names. Moreover, the trademark laws also incorporate the relative and absolute grounds of refusal of registration, where if the registrar does not find the trademark to be fit as per the provisions of the Act,<sup>4</sup> the trademark is not allowed to be registered, whereas the registration of domain names does not hold any criteria as such.

Operating in cyberspace, which has no geographical boundaries, makes it difficult for the domain name to fulfill the pre-requisite for it to be protected as a trademark.<sup>5</sup> Also, it is pertinent to note that usage of the same or similar mark on different products and services can be allowed under the trademark law, however, the same cannot be permissible for registration of a domain name. Cyberspace is a large geographical area and no matter how distinct the products are, they cannot be represented by the same domain name which would result in huge confusion amongst the consumers, therefore, concurrent usage of the domain name cannot be acceptable.

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<sup>1</sup> Trade Marks Act 1999, s 2(zb)

<sup>2</sup> *Ibid*

<sup>3</sup> Trade Marks Act 1999

<sup>4</sup> *Ibid*

<sup>5</sup> *Ibid*

## EXISTING PROTECTION OF DOMAIN NAMES

Internationally, all the domain names are registered under “Internet Corporation for Assigned Names and Numbers” famously known as ICANN<sup>6</sup>. WIPO and ICANN together have formulated strict regulations for registering and protecting domain names. However, these registrations are conducted on a first come first serve basis, thus opening gates for the “abusive registration for domain names”,<sup>7</sup> which allows anyone to register a domain name even if that person is not the real owner of the trademark of a particular product or service. When the registered trademark owner tries to obtain a domain name for its business and finds that the domain name under that name is already registered, a dispute arises, such acts are otherwise known as cybersquatting.

The rapid increase in cases as such led to the establishment of the “Uniform Domain Name Dispute Resolution Policy” (UDRP).<sup>8</sup> This is a dispute resolution policy adopted by ICANN to curb cases of “abusive registration for domain names” by offering expedited administrative proceedings for original trademark owners.<sup>9</sup> The domain name registrars are strictly required to follow this policy as UDRP imposes a duty on the registrar to not allow registration of a domain name for unlawful reasons.<sup>10</sup> From the above-mentioned facts and analysis, it is clear how trademarks and domain names are intrinsically related to each other.<sup>11</sup> However, the traditional principles on which the trademark laws are based are not sustainable enough for domain names and do not fit in the digital realm.<sup>12</sup> The Apex Court in the case of *Satyam Infoway Ltd. v Sifynet Solutions (P) Ltd.*, recognizing the distinction between the two observed that “...distinction lies in the manner in which the two operate. A trademark is protected by the laws of a country where such a trademark may be registered. Consequently, a trademark may have multiple

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<sup>6</sup> Franklyn David J, ‘Owning words in cyberspace: The accidental trademark regime’ (2001) 4 Wisconsin Law Review 1251, 1263-1266

<sup>7</sup> *Ibid*

<sup>8</sup> Based on Final Report of the WIPO and the recommendations of DNSO (Domain Name Supporting Organization), ICANN adopted the mandatory, uniform dispute resolution policy, which would be applied only in cases of abusive or bad faith registration of domain names, coming into effect from January 3, 2000

<sup>9</sup> *Ibid*

<sup>10</sup> *Ibid*

<sup>11</sup> Franklyn David (n 6)

<sup>12</sup> *Ibid*

registrations in many countries throughout the world. On the other hand, since the internet allows for access without any geographical limitation, a domain name is potentially accessible irrespective of the geographical location of the consumers. The outcome of this potential for universal connectivity is not only that a domain name would require worldwide exclusivity but also that national laws might be inadequate to effectively protect a domain name"<sup>13</sup>. The Indian Courts do realise the lacuna, however, there is still an absence of proper legislation to govern domain names.<sup>14</sup> The Indian Trademark Act<sup>15</sup> still lacks amending the definition of "mark" for non-conventional marks to include the definition of the domain name under its purview.

## PROTECTION OF DOMAIN NAME IN OTHER JURISDICTIONS

### THE UNITED STATES

Initially, the US courts also faced similar difficulties in incorporating and protecting the domain names under the Lanham Act.<sup>16</sup> The Act suggested that a mark can only be registered in the US Patent and Trademark Office if it has the characteristics of a trademark.<sup>17</sup> Hence a domain name ought to be 'distinctive' and must be able to identify the goods and services provided by it. One of the first cases filed against domain name infringement in the US was *Panavision International v Toeppen*<sup>18</sup> and *Intermatic v Toeppen*<sup>19</sup>. Here,<sup>20</sup> the court decided that mere registration of a domain name does not amount to dilution. However, the intention to resale is considered to be a business activity. The court concluded that "*the significant purpose of a domain name is to identify a business*".<sup>21</sup>

With the increase in trade through internet platforms, the US enacted the Anti-Cybersquatting Consumer Protection Act which prohibits cybersquatting. The Act defined cybersquatting as the registration of an existing trademark as a domain name to earn commercial gain from it. Under

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<sup>13</sup> *Satyam Infoway Ltd v Sifynet Solutions (P) Ltd* (2004) 6 SCC 145

<sup>14</sup> *Ibid*

<sup>15</sup> Trade Marks Act 1999

<sup>16</sup> Trademark Act 1946

<sup>17</sup> *Ibid*

<sup>18</sup> *Panavision v Toeppen* 141 F3d 1316 (9th Cir 4/17/98)

<sup>19</sup> *Intermatic v Toeppen* 947 F Supp 1227, 40 USPQ

<sup>20</sup> *Ibid*

<sup>21</sup> *Ibid*

ACPC, the domain name doesn't have to be used for commerce. Claim for cybersquatting can be filed under this act if a person registers a domain name identical or confusingly similar to a trademark. The Lanham Act's anti-dilution clauses Act<sup>22</sup> can also be triggered by commercial usage of a domain name. Furthermore, the Federal Trademark Dilution Act of 1995<sup>23</sup> provides a way for a firm to defend its well-known trademark from dilution by cyber squatters or other unauthorised internet users.

## THE UNITED KINGDOM

English courts have faced difficulties in incorporating the concept of domain names into the traditional meaning of trademark. As far as cybersquatting is concerned there does not exist any exclusive law for it in the UK. Cases relating to cybersquatting are dealt with using the existing trademark act of 1994<sup>24</sup> and precedents. The first case relating to cybersquatting in the UK was *British Telecommunications Plc. v One in a Million Ltd*<sup>25</sup>. The defendants had registered several domain names that were very similar to already existing trade names without the consent of the owner of the trade names.<sup>26</sup> The intention behind the registration of these domain names was to sell them to their respective trademark owners and to gain profit from them. The defendant had not used the domain name to transact goods or services under the name of the trademark of the plaintiff. However, the court provided the plaintiff with injunctive relief on the basis that the defendant's motive was to exploit the goodwill of the plaintiff.<sup>27</sup>

It can be concluded that in the UK<sup>28</sup> when a person is being deprived of registering a domain name that he can rightfully register, due to cyber squatters, the remedy of passing off is available to him. Registration of domain names for selling and buying purposes does not come under

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<sup>22</sup> Trademark Act 1946

<sup>23</sup> Federal Trademark Dilution Act 1995

<sup>24</sup> Trademark Act 1994

<sup>25</sup> *British Telecommunications Plc v One in a Million Ltd* [1999] 1 WLR 913

<sup>26</sup> *Ibid*

<sup>27</sup> *Ibid*

<sup>28</sup> *Ibid*

‘being used in the course of trade’. As a result, cybersquatting would be dealt with through the existing trademark laws.

## **THE EUROPEAN UNION**

The trademarks of all the 28 member states of the European Union are protected through the European Union Trade Mark (EUTM). The European Union Intellectual Property Office (EUIPO) in collaboration with the EURid domain name registry is attempting to protect applicants and owners against trademark and domain name infringement and cybersquatting. The United Kingdom used to be a part of the European Union up till 1st January 2021. The act of Britain leaving the European Union is popularly known as ‘Brexit’ which stands for ‘Britain Exists’. From 1st January 2021 onwards the UK is not eligible to hold a ‘.eu’ domain name. In the EU as well domain names are protected under trademark laws. The domain name must fulfill the requirements of a trademark and then be registered as one. Only after it is registered as a trademark can it benefit from its status. A domain name can be disputed either by alternative dispute resolution at the Czech Arbitration Court (CAC) or WIPO Arbitration Center or one can even approach the court for litigation. The claimant can ask the alleged infringer to either revoke the domain name or transfer the same to the claimant.

## **RECOMMENDATIONS AND CONCLUSION**

It is of utmost importance to note that the prevailing laws of intellectual property are essentially made for the physical world. It is to assist trade and commerce in the physical market and safeguard the interests of those who have invented or created anything using their creativity. The mechanisms adopted by WIPO and ICANN only operate at an international level and with everything switching to online mode, especially after the COVID-19 outbreak, these dispute resolution mechanisms fall short.<sup>29</sup> However, there is still a possibility to combat this situation by the use of artificial intelligence, by the method of directory technology. Using this technology,

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<sup>29</sup> Domain Name System: Hearing Before the Subcomm On Basic Research of the House Science Comm, 105th Cong 1997 WL 14151463 (1997)

the consumers will be directed to the website of their choice and each page would have a recognizable name.<sup>30</sup>

In India, domain names are granted protection under the Trademarks Act, 1999 and Trademark Rules, 2002<sup>31</sup> which leaves a grey area for the domain name. Thus, providing the cyber squatters with the opportunity to harass the trademark owners and earn profits out of it. For a domain name to get protection under the Trade Marks Act, 1999<sup>32</sup> it has to fulfill all the criteria of a trademark and thus protecting it becomes a strenuous task. Moreover, the trademark laws were drafted to predominantly deal with businesses in the physical world. The concept of cyberspace is dynamic and enormous.<sup>33</sup> The internet has enabled worldwide access to data and information. There is no geographical boundary in cyberspace. The territorial division existing in the case of trademark or any other intellectual property law is crucial.

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<sup>30</sup> *Ibid*

<sup>31</sup> Trademark Rules 2002

<sup>32</sup> Trade Marks Act 1999

<sup>33</sup> *Ibid*