



Search **.edu**



Search **.in**



Search **.com**



Search **.org**



# PROTECTION OF DIGITAL IDENTITY ON PRIORITY!



The internet's explosive growth has made online presence crucial for businesses. An individual or enterprise's digital identity in today's online world is marked by its website which is denoted through its web address or the domain name.

Internet users may not remember the entire web address and generally use key words to reach the website. Thus, protecting one's domain name is the need of today's hour. In the recent past an engineering student from Kochi, made Mark Zuckerberg pay \$700 to buy a domain that he badly wanted. Facebook approached the student for the domain name registered by him "maxchanzuckerberg.com" as it was the short form of Maxime Chan Zuckerberg, Zuckerberg's daughter.[1]

Similar incidents have been faced by many enterprises and celebrities, wherein their names or identities are misused to register web address. Like "www.amitabhbachchan.com" and "www.amitabhbachchan.in [2]

Manipulating these domain names with a malicious intent is known as cybersquatting. The term has emerged from "squatting" which refers to occupying space by cybersquatter in the digital world which ideally should belong to someone else. Individuals known as cybersquatters create or buy domain names reflecting the names of existing companies, brands or upcoming celebrities to gain an unfair advantage. Cybersquatters exploit third-party trademarks, trade names by misleading consumers or by attempting to sell the domain name back to the rightful owner at an exorbitant price.

Due to this unethical practise, companies and trademark holders are prevented from monetizing their brand/trademark on digital platform as there is no possibility of using two domain names that are identically same.

Taking into consideration the grave impacts like brand dilution, consumer confusion, it may be required to take legal action to prevent such misuse.

**Let us understand the legal mechanism available to counter this mischief.**

[1] <https://economictimes.indiatimes.com/tech-life/this-kochi-boy-made-mark-zuckerberg-pay-him-700/slideshow/51851978.cms>

[2] CS(COMM) 819/2022



## IN Dispute Resolution Policy (INDRP)

In India, the .IN Dispute Resolution Policy (“INDRP”) introduced by the National Internet Exchange of India (NIXI) addresses disputes involving .in domain names which is a country code top level Domain (ccTLD) for India and is administered by the .INRegistry.

.INDRP is governed by Indian laws, including the Trade Marks Act, 1999 and IT Act, 2000.

## Grounds for Filing Complaint under. INDRP[3]

Rule 4 of INDRP provides for the below grounds to any cybersquatting victim who considers that a registered domain name conflicts with its legitimate rights or interests:

- The Registrant's domain name is identical and/or confusingly similar to a Name, Trademark or Service Mark or domain name <https://www.tatacliq.com/> in which the Complainant has rights. For example [tatacliqfashion.in](https://www.tatacliqfashion.in) (“disputed domain”) was unauthorizedly used by a company named Lazy SK SK and the same was successfully contested and removed by the TATA Group through .INDRP Policy by way of an arbitration proceedings.[4]
- The Registrant has no rights or legitimate interests in respect of the domain name; (For example In the case of Mattel INC.(Complainant) vs Huxxe India (Respondent), the Complainant registered its domain name as [barbiegirl.in](https://www.barbiegirl.in) (“disputed domain”). It was held that the Complainant has the exclusive right to make use of the word "[barbie](https://www.barbie.com)" and since the Complainant had not authorised, licensed or permitted the Respondent to register or use it's trademark/trade word "BARBIE" or any of Complainants other intellectual property, the Respondent didn't have any legitimate interest in the disputed domain.[5]

[3] <https://www.registry.in/domaindisputeresolution>

[4] INDRP Case No. 1895 of 2024

[5] INDRP Arbitration Case No. 1828



- The Registrant's domain name has been registered or is being used either in bad faith or for illegal/unlawful purpose. (For example in Starbucks Corporation (“Complainant”) vs Tomto Creative Private Limited (“Respondent”) wherein Respondent had unethically registered [www.star-buck.in](http://www.star-buck.in) (“disputed domain”) which is very closely resembling to original domain [www.starbucks.in](http://www.starbucks.in) , it was held that Respondent had registered the domain name to wrongfully give impression that the domain name is affiliated to Complainant and to unfairly profit from the popularity of the Complainant’s mark Star Buck. This was held to be a bad faith registration use.[6]

Amongst other factors, Rule 7 provides that the .IN Registry considers the following aspects to conclude whether the disputed domain name is registered by the registrant in bad faith:

- a) Purpose of registration or acquiring the domain name was to sell, rent, or transfer the domain name registration to the Complainant who bears the name or is the owner of the Trademark or to a competitor of the Complainant at an exorbitant price.
- b) Intent of registration is to prevent the Complainant who is owner of the Trademark to register a corresponding domain name reflecting the Trademark.
- c) By using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website to create confusion or to indicate any affiliation or sponsorship between Complainant and Registrant.

[6] INDRP Arbitration Case No 1821

**Mode of Dispute Resolution:**

The dispute complaints lodged with the .IN Registry are resolved by means on Arbitration Proceedings in accordance with the Arbitration & Conciliation Act, 1996. Arbitrator is appointed from the list of empanelled Arbitrators maintained by the Registry.

**Quick Timelines:**

**Appointment of Arbitrator takes place within 5 days from the empanelled arbitrator list.**

**Arbitrator shall issue a notice to the Respondent within 3 working days from the receipt of the complaint.**

**Award is issued within 60 days of commencement of arbitration. In exceptional circumstances, the timeline may be extended by a maximum period of 30 days by the Arbitrator subject to a reasonable justification in writing.[7]**

The .INRegistry maintains a formal website and provides comprehensive records of all the arbitral awards passed by it date wise and also updates the list of domain names cancelled after the proceedings on it's website from time to time.

[7] <https://www.registry.in/indrprulesprocedure>



## Case Study:

In a very recent case, Mahindra and Mahindra Limited (Complainant) vs Hansa Customer Equity Private Limited (Respondent), [8] Respondent had illegally registered and was unauthorisedly using the domain name mahindratractors.in. It is well known that Complainant is a multinational conglomerate and has registered mark "MAHINDRA" since 1st November, 1975. Complainant owns and operates website under the domain name www.mahindratractor.com.

The arbitrator appointed reviewed the pleadings and documents presented and concluded that the Complainant successfully proved its case under the INDRP Policy. The Complainant demonstrated its ownership and exclusive rights to the "MAHINDRA TRACTOR" trademark, which is recognized as a well-known mark in India and other countries. The evidence showed that the Respondent's registration of the disputed domain name mahindratractors.in was intended to create confusion and was done in bad faith, without any legitimate interest in the domain name. The disputed domain name mahindratractors.in was ordered to be transferred to the Complainant. The Respondent was also barred from using the domain name in any manner and the costs of the proceedings were also awarded in favour of the Complainant and against the Respondent.

## Things to Remember:

.INDRP Policy has jurisdiction to only adjudicate domain related disputes containing the .IN or .Bharat code at the end. Indian victims of cybersquatting having domain name extension other than .in such as .com, .org, .net etc. have to seek redressal from WIPO at the international level through UDRP Policy formulated by the Internet Corporation for Assigned Names and Numbers (ICANN) in close coordination with WIPO.

Remedy is limited to requiring the cancellation of the Registrant's domain name or the transfer of the Registrant's domain name registration to the Complainant. In case if INDRP deems fit, cost may also be awarded by the Arbitrator. However execution of the same is not the responsibility of the Registry.

[8] INDRP Case No. 1894 of 2024



Each complaint must be filed against a single disputed domain name. If your trademark is being used on multiple domain names, you must submit separate complaints for each one. For example, if you own the trademark "LUXE WATCHES" and someone registers the domain names LUXEWATCH.CO.UK, LUXWATCHES.COM, LUXWATCHSTORE.COM, and LUXWATCHSHOP.CO, you would need to file four separate complaints each of which might be handled by a different arbitrator. This in turn can be a costly process.

### **Raising Trademark Disputes:**

Apart from the aforesaid remedies, one can also resort to Indian Courts especially in circumstances where the unethical registration of a domain name leads to misuse/abuse/infringement of the entity's Trademark/brand name. Courts in India extend the purview of Trademark Act 1999 to handle with these issues.

In **Tata Sons Ltd v. Monu Kasuri & others**[9] it was held "that domain names or Internet sites are entitled to protection as a trademark because they are more than a mere address."

Considering this, all remedies available under the Trademark Act, 1999 would be available to the Complainant like:

Remedies defined under Section 29 of Trademark Act, 1999 for infringement. Section 29 states that using a registered trademark or mark that is similar, deceptively similar or identical to the registered trademark by any third party is likely to cause confusion in the minds of public at large and amounts to infringement. The Act also provides for redressal process to seek legal remedy in such infringement cases. Therefore, if an individual registers a domain identical or deceptively similar to a registered trademark, it could constitute infringement.

[9] 2001 PTC 432 (Del)



The Trademark Act, 1999 under section 27 also takes care of safeguarding and protecting the rights of an unregistered trademark by recognising the common law of passing off. Passing off is a common law tort which occurs when a person sells his products/ services by misrepresenting them to be goods/services of another usually more recognized brand, and thereby mint profit through it.

More information on remedies under the Trademark Act are available here.[10]

Recently, in a lawsuit initiated by ADOBE, INC vs Namase Patel and others[11], the plaintiff accused the defendant of infringing on its "ADOBE" trademark through the domain names [www.addobe.com](http://www.addobe.com) and [www.adobee.com](http://www.adobee.com). The Court determined that these domain names were confusingly similar to the "ADOBE" trademark and thus violated the plaintiff's rights under Section 29 of the Trademarks Act.

In this notable decision, the Court awarded exemplary damages of Rs. 2,00,01,000 (INR Two Crore one thousand) to ADOBE, aimed at deterring similar conduct due to Patel's established reputation as a persistent cybersquatter.

The Court also took into account the fact that Patel was using a "catch-all" e-mail service, which allowed him to access any e-mails that may have misspelt the domain name adobe.com. This raised concerns about the potential for confidential information to be accessed by the defendant.

In light of this, Justice C Hari Shankar issued a permanent injunction prohibiting Patel and his associates from registering domain names incorporating the "ADOBE" trademark. The Court also ordered that the websites [www.addobe.com](http://www.addobe.com) and [www.adobee.com](http://www.adobee.com) be blocked and directed that these domain names be transferred to ADOBE to prevent further misuse by others.

[10] <https://www.ynzgroup.co.in/articles/IP/Trademark%20Same%20or%20Similar.pdf>

[11] CS(COMM) 159/2022





## **Cognizance of Cybersquatting by Social Media Platforms:**

Social Media platforms have taken steps to address this issue to some extent. Facebook, Instagram, and Twitter have implemented measures to protect registered trademarks from infringement, through the use of Meta **verified accounts** option to preserve the identity of the original user. Trademark owners can also report violations by submitting a Trademark infringement form to Facebook or Instagram.

## **Conclusion:**

From the aforesaid presents it is evident that India is progressive in recognizing the cyber threats which are rampant these days and the .INDRP is effectively handling the cybersquatting issues in the country. The recent arrest of Telegram CEO Pavel Durov also underscores worldwide outrage with respect to cyber security and privacy issues and the acceleration of cyber-criminal activity.

Apart from this, there is an urgent need to raise awareness about the harmful practice of cybersquatting so that trademark owners can take further steps to protect their brand identity. There is a need to inculcate the culture of valuing and respecting one's intellectual property on internet to curb the malpractice.

For any feedback or response on this article, the author can be reached on [kedar.gurjar@ynzgroup.co.in](mailto:kedar.gurjar@ynzgroup.co.in) and [ankita.doke@ynzgroup.co.in](mailto:ankita.doke@ynzgroup.co.in)



### **Author: Kedar Gurjar**

Kedar is an Associate at YNZ Legal. By qualification he is Bachelor of Commerce and Bachelor of Law from G.J. Advani Law college, Bandra, Mumbai University.

### **Co-author: Ankita Doke**

Ankita is an Associate at YNZ Legal. By qualification she is Bachelor of Law from Pune University.

