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“शिक्षा मानव को बन्धनों से मुक्त करती है और आज के युग में तो यह लोकतंत्र की भावना का आधार भी है। जन्म तथा अन्य कारणों से उत्पन्न जाति एवं वर्गगत विषमताओं को दूर करते हुए मनुष्य को इन सबसे ऊपर उठाती है।”

— इन्दिरा गांधी

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***“Education is a liberating force, and in our age it is also a democratising force, cutting across the barriers of caste and class, smoothing out inequalities imposed by birth and other circumstances.”***

**- Indira Gandhi**

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Indira Gandhi  
National Open University  
School of Law

**MIP-104**  
**Trademarks, Domain**  
**Names and Geographical**  
**Indications**

Block

**3**

**DOMAIN NAMES**

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**UNIT 9**

**Internet and Domain Names** **5**

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**UNIT 10**

**Registration of Domain Names and Disputes** **18**

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**UNIT 11**

**Domain Name Dispute Resolution-I** **30**

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**UNIT 12**

**Domain Name Dispute Resolution-II** **47**

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## **BLOCK 3 DOMAIN NAMES**

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This Block consists of four units.

**Unit 9** of this course deals with the concept of domain names, domain name system, origin and evolution of domain names, management of domain names, the role of ICANN in the management of Domain names, types of domain names for business, domain names and trademarks etc.

**Unit 10** of this course deals with registration of domain names and disputes, registration of domain name, registration processes that leads to domain name disputes, cyber squatting or domain squatting, and other forms of domain name disputes, nature of domain name dispute, reasons for the disputes and topics related to it.

**Unit 11** of this course deals with domain name resolution through litigation in courts, grounds for proceeding in court, remedies available under the court, Domain name dispute resolution policy under INDRP, filing of complaint under INDRP, appointment of arbitrator and topics related therewith.

**Unit 12** this unit deals with uniform domain name disputes resolution policy, reasons behind adopting UDRP, judicial basis of UDRP, procedure of UDRP, and comparison between UDRP and Court litigation.

# BLOCK 1 - ENVIRONMENTAL

The first block of the document covers the environmental aspects of the project. It includes a detailed description of the project area, the surrounding environment, and the potential impacts of the project on the environment. The text is organized into several paragraphs, each discussing a different aspect of the environmental impact assessment.

The second block of the document discusses the methods used to assess the environmental impacts of the project. It includes a description of the data collection methods, the analysis techniques used, and the results of the assessment. The text is organized into several paragraphs, each discussing a different method or technique used in the assessment.

The third block of the document discusses the results of the environmental impact assessment. It includes a description of the findings of the assessment, the potential impacts of the project on the environment, and the measures that will be taken to mitigate these impacts. The text is organized into several paragraphs, each discussing a different finding or impact.

The fourth block of the document discusses the conclusions of the environmental impact assessment. It includes a summary of the findings of the assessment, the potential impacts of the project on the environment, and the measures that will be taken to mitigate these impacts. The text is organized into several paragraphs, each discussing a different conclusion or recommendation.

The fifth block of the document discusses the recommendations of the environmental impact assessment. It includes a list of the measures that will be taken to mitigate the potential impacts of the project on the environment, and a description of the monitoring and evaluation program that will be implemented to ensure that these measures are effective. The text is organized into several paragraphs, each discussing a different recommendation.

The sixth block of the document discusses the implementation of the environmental impact assessment. It includes a description of the steps that will be taken to implement the assessment, the roles and responsibilities of the various stakeholders involved, and the timeline for the implementation. The text is organized into several paragraphs, each discussing a different step or role.

The seventh block of the document discusses the monitoring and evaluation of the environmental impact assessment. It includes a description of the monitoring and evaluation program that will be implemented, the data that will be collected, and the methods that will be used to analyze this data. The text is organized into several paragraphs, each discussing a different aspect of the monitoring and evaluation program.

The eighth block of the document discusses the reporting of the results of the environmental impact assessment. It includes a description of the reports that will be prepared, the format of these reports, and the methods that will be used to disseminate the results of the assessment to the public and other stakeholders. The text is organized into several paragraphs, each discussing a different aspect of the reporting process.

The ninth block of the document discusses the final conclusions and recommendations of the environmental impact assessment. It includes a summary of the findings of the assessment, the potential impacts of the project on the environment, and the measures that will be taken to mitigate these impacts. The text is organized into several paragraphs, each discussing a different conclusion or recommendation.

The tenth block of the document discusses the final conclusions and recommendations of the environmental impact assessment. It includes a summary of the findings of the assessment, the potential impacts of the project on the environment, and the measures that will be taken to mitigate these impacts. The text is organized into several paragraphs, each discussing a different conclusion or recommendation.

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# UNIT 9 INTERNET AND DOMAIN NAMES

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## Structure

- 9.1 Introduction
- 9.2 Objectives
- 9.3 The Concept of Domain Names
  - 9.3.1 What is the Domain Name System (DNS)?
  - 9.3.2 Origin and Evolution of Domain Names
- 9.4 Management of Domain Names
  - 9.4.1 Role of ICANN in the Management of Domain Names
- 9.5 Types of Domain Names
  - 9.5.1 Top Level Domains
  - 9.5.2 Generic Top Level Domains (gTLD)
  - 9.5.3 Country Code Top Level Domains (ccTLD)
  - 9.5.4 Internationalized Country Code Top-Level Domain (IDN ccTLD or ccIDN)
  - 9.5.5 Second-Level Domain (SLD)
  - 9.5.6 Multilingual Domain Names
- 9.6 Importance of Domain Names for Businesses
- 9.7 Domain Names as Tradable Business Assets
- 9.8 Domain Names and Trademarks
- 9.9 Summary
- 9.10 Terminal Questions
- 9.11 Answers and Hints

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## 9.1 INTRODUCTION

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The domain names are structured in form of top level domains and second level domains. This organization of domain names is called Domain Name System (DNS). The DNS is coordinated by the Internet Corporation for Assigned Names and Numbers (ICANN).

Domain names act as the first link between the physical world and cyberspace; they are a prerequisite for engaging in electronic commerce. Domain names allow users and search engines to locate business and other websites on the Internet. In addition to their function as locators of Internet sites, domain names have a function as identifiers of businesses and their goods or services on the Internet, which gives them an economic value comparable to that of other identifiers. This characteristic of domain names has given rise to a great many ownership disputes with other signs that existed prior to the advent of the Internet and were protected by intellectual property rights such as trademarks.

In this Unit we will discuss the structure of domain name system, its organisation and intellectual property rights related issues together with the various types of domain names.

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## 9.2 OBJECTIVES

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After studying this unit, you should be able to:

- explain what a domain name is;
- describe the importance of domain names;
- explain various kinds of domains names;
- list the organisations responsible for domain name maintenance; and
- know how domain names perform as trademarks in cyber world.

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## 9.3 THE CONCEPT OF DOMAIN NAMES

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Domain names are the human-friendly forms of Internet addresses, and are commonly used to find websites on the Internet. For example, the domain name `www.ignou.ac.in` is the Internet address of the IGNOU's website. The cyber world is created by networking of large number of computers situated at every corner of the world. In order to reach any particular computer on this network, it is necessary to know its precise address, just the way we know a telephone number of a person which is in the form of country code, area code and local telephone number.

In cyber world, the computers are identified by their unique IP (internet protocol) addresses. The IP address is a string of four numbers, separated by periods. Each number can be from zero to 255. For example `201.64.108.132` can be an IP address. These numbers are not easy to remember. Hence these IP addresses are coded in form of familiar strings of letters called domain names. These names map to unique IP numbers that serve as routing address on the Internet, allowing users to access websites on the Internet.

A domain name also forms the basis of other methods or applications on the Internet, such as file transfer (ftp) or email addresses - for example the email address `arbiter.mail@ignou.ac.in` is also based on the domain name `ignou.ac.in`.

Without the domain name, a computer would have no idea where to look for a web page, and e-mail routers would not be able to send e-mail. Of course, domain names are more than just addresses, since they can be selected by the "addressee" and are usually closely associated with a particular service or product. In 2010, the number of active domains reached 196 million.

### 9.3.1 What is the Domain Name System (DNS)?

The domain name system is essentially a global addressing system. It is the way that domain names are located and translated into Internet Protocol (IP) addresses, and vice versa. A domain name such as `wipo.int` is a unique alias for an IP address (a number), which is an actual physical point on the Internet.

### 9.3.2 Origin and Evolution of Domain Names

Prior to December 1999, a company called Network Solutions Inc. ("NSI") was almost solely responsible for the registration of second level domain names for the most popular top-level domains, including `.COM`, `.NET`, and `.ORG`. Since

the vast majority of domain names are under one of these top-level domains (the most common being .COM domain names), Network Solutions had a great deal of control over how domain names were registered, and how disputes would be resolved. To avoid having to be the arbitrator between two parties who both desire the same domain name, NSI decided to simply adopt a first come, first serve arrangement with respect to domain names. Under this scheme, NSI would not question an applicant's right to have a particular domain name. If the domain name was available, the applicant was given the name.

As of December 1999, the ability to register .COM, .NET, and .ORG domain names was spread out among many registrars. These registrars are accredited to the Internet Corporation for Assigned Names and Numbers (or "ICANN"), a non-profit corporation formed specifically to control Internet domain name management and similar functions. NSI continues to assign domain names, but now they are just one of many domain name registrars. Following NSI's precedence, all of these registrars assign names on a first-come, first-serve basis, and do not do any prescreening before assigning a new domain name.

The first commercial Internet domain name, in the TLD *com*, was registered on 15 March 1985 in the name *Symbolics.com* by Symbolics Inc., a computer systems firm in Cambridge, Massachusetts. By 1992 fewer than 15,000 *com* domains had been registered. In December 2009 there were 192 million domain names.

**Self Assessment Question**

**(Spend 3 minutes)**

1) What is domain name?

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**9.4 MANAGEMENT OF DOMAIN NAMES**

From its origins as a United States based research vehicle, the Internet has rapidly become an international medium for communication, commerce and education. In the inception stages of the Internet the Defense Advanced Research Projects Agency of the United States (DARPA) established ARPANET (Advanced Research Projects Agency Network). ARPANET funded the development of consensus-based, informal guidelines called protocols that allowed networks to communicate with each other. This *network of networks* came to be known as the Internet. The protocols became known as Internet Protocols (IPs). Until the 1980s, the Internet, was managed by DARPA.

In 1991 National Science Foundation (NSF) assumed responsibility for coordinating and funding the non-military portion of the Internet infrastructure. It solicited bids to provide a variety of services associated with the infrastructure including DNS registration. Network Solutions, Inc. (NSI) received the NSF contract for DNS registration. It managed registration, coordination, and

maintenance functions of the DNS until a competition was introduced in early November 1998.

The Internet Corporation for Assigned names and Numbers (ICANN) was formed in 1998 to privatize and internationalize the management of domain names. ICANN was formed to take over responsibility for the IP address space allocation, protocol parameter assignment, Domain Name System management, and root server system management functions that were being performed under U.S. government contract by IANA and other entities. ICANN is now a key player in the domain name arena and. It is currently funded by foundation grants and contributions. ICANN is the coordinator for the continued technical development of the Domain Name System. ICANN maintains the directory linking domain names with the IP numbers of domain name servers and the authoritative database of Internet registrations.

Today, ICANN manages the top-level development and architecture of the Internet domain name space. It authorizes domain name registrars, through which domain names may be registered and reassigned.

The right to use a domain name by the registrants (users) is delegated by domain name registrars, which are accredited by the ICANN. In addition to ICANN, each top-level domain (TLD) is maintained and serviced technically by an administrative organization operating a registry. A registry is responsible for maintaining the database of names registered within the TLD it administers. The registry receives registration information from each domain name registrar authorized to assign names in the corresponding TLD and publishes the information using a special service, the who is protocol.

Registries and registrars usually charge an annual fee for the service of delegating a domain name to a user and providing a default set of name servers. Often, this transaction is termed a sale or lease of the domain name, and the registrant may sometimes be called an "owner", but no such legal relationship is actually associated with the transaction, only the exclusive right to use the domain name. More correctly, authorized users are known as "registrants" or as "domain holders".

ICANN publishes the complete list of TLD registries and domain name registrars. Registrant information associated with domain names is maintained in an online database accessible with the WHOIS service. For most of the 250 country code top-level domains (ccTLDs), the domain registries maintain the WHOIS (Registrant, name servers, expiration dates, etc.) information.

Some domain name registries, often called network information centers (NIC), also function as registrars to end-users. The major generic top-level domain registries, such as for the COM, NET, ORG, INFO domains and others, use a registry-registrar model consisting of hundreds of domain name registrars. In this method of management, the registry only manages the domain name database and the relationship with the registrars. The *registrants* (users of a domain name) are customers of the registrar, in some cases through additional layers of resellers.

ccTLDs are not uniform in their management or policies, some are open in the sense that any person or entity may register in them, while others are restricted to persons or entities that satisfy entry criteria (e.g., domicile or business presence

in the country). The administrative authority for each ccTLD, in principle, has autonomy to determine the policies for domain name registration within its domain.

### 9.4.1 Role of ICANN in the Management of Domain Names

The ICANN is a non-profit corporation headquartered in California, United States, that was incorporated in 1998 to oversee a number of Internet-related tasks previously performed directly on behalf of the United States government. The context of ICANN's relationship with the U.S. government was clarified on September 29, 2006 when ICANN signed a new Memorandum of Understanding with the United States Department of Commerce (DOC). At present, ICANN is formally organized as a non-profit corporation "for charitable and public purposes" under the California Nonprofit Public Benefit Corporation Law. In the Memorandum of Understanding that set up the relationship between ICANN and the U.S. government, ICANN was given a mandate requiring that it operate "in a bottom up, consensus driven, democratic manner." ICANN holds periodic public meetings rotated between continents for the purpose of encouraging global participation in its processes.

ICANN is responsible for the coordination of the global Internet's systems of unique identifiers and, in particular, ensuring its stable and secure operation. This work includes coordination of the Internet Protocol address spaces and assignment of address blocks to regional Internet registries, for maintaining registries of Internet protocol identifiers, and for the management of the top-level domain name space. Most visibly, much of its work has concerned the DNS policy development for internationalization of the DNS system and introduction of new generic top-level domains (TLDs).

ICANN's primary principles of operation are helping preserve the operational stability of the Internet; to promote competition; to achieve broad representation of the global Internet community; and to develop policies appropriate to its mission through bottom-up, consensus-based processes. There are currently three Supporting Organizations of the ICANN. The Generic Names Supporting Organization (GNSO) deals with policy making on generic top-level domains (gTLDs). The Country Code Names Supporting Organization (ccNSO) deals with policy making on country-code top-level domains (ccTLDs). The Address Supporting Organization (ASO) deals with policy making on IP addresses.

One task that ICANN was asked to do was to address the issue of domain name ownership resolution for generic top-level domains (gTLDs). ICANN's attempt at such a policy was drafted in close cooperation with the World Intellectual Property Organization (WIPO), and the result has been known as the Uniform Dispute Resolution Policy (UDRP). This policy essentially attempts to provide a mechanism for rapid, cheap and reasonable resolution of domain name conflicts, avoiding the traditional court system for disputes by allowing cases to be brought to one of a set of bodies that arbitrate domain name disputes. According to ICANN policy, a domain registrant must agree to be bound by the UDRP — they cannot get a domain name without agreeing to this.

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## 9.5 TYPES OF DOMAIN NAMES

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Domain names are organized in subordinate levels (subdomains) of the DNS root domain. The first-level set of domain names are the top-level domains (TLDs), including the generic top-level domains (gTLDs), such as the prominent domains com, net and org, and the country code top-level domains (ccTLDs). Below these top-level domains in the DNS hierarchy are the second-level and third-level domain names that are typically open for reservation by end-users that wish to connect local area networks to the Internet, create other publicly accessible Internet resources or run web sites.

### 9.5.1 Top Level Domains

A top-level domain (TLD) is one of the domains at the highest level in the hierarchical Domain Name System of the Internet. The top-level domain names are installed in the root zone of the name space. For all domains in lower levels, it is the last part of the domain name, that is, the last label of a fully qualified domain name. It appears after the last dot (‘.’) in a domain name. In “microsoft.com”, the top level domain name is .com or .COM, as domain names are not case-sensitive. In “www.ignou.ac.in”, the top level domain is .in. The .com name is the most common top-level domain name, and is used to indicate that the domain name is owned by a commercial enterprise. Other common top-level domain names include .ORG (for non-profit organizations), .NET (for network and Internet related organizations), .EDU (for four-year colleges and universities), and .GOV (for government entities).

TLDs are further classified into: gTLD, ccTLD.

### 9.5.2 Generic Top Level Domains (gTLD)

A generic top-level domain (gTLD) is one of the categories of TLDs maintained by the Internet Assigned Numbers Authority (IANA) for use in the Domain Name System. These are top-level domains with three or more characters.

The core group of gTLDs consists of the com, info, net, and org domains. These four gTLDs are unrestricted, that means these domains are available for registration by any person or organization for any use whatsoever. Info was the first that was explicitly chartered as unrestricted the others initially had a specific target audience. However, due to lack of enforcement, they acquired an unrestricted character.

In addition to the above four, the domains biz, name, and pro are also there; however, these are designated as *restricted*, because registrations within them require proof of eligibility within the guidelines set for each. Sponsored gTLDs are those domains which are derived from the fact that these domains are based on theme concepts proposed by private agencies or organizations that establish and enforce rules restricting the eligibility of registrants to use the TLD. For example, the aero TLD is sponsored by the Société Internationale de Télécommunications Aéronautiques, which limits registrations to members of the air-transport industry. A geographic TLD is a gTLD using the name of or invoking an association with a geographical, geopolitical, ethnic, linguistic or cultural community. As of 2009, only two GeoTLDs existed: the sponsored

domains.cat, for the Catalan language and culture, and .asia, but many others have been proposed.

All these domain names did not come into being in the very beginning of the Internet; they have been created gradually. In the growth of the Internet, it became desirable to create additional gTLDs. Some of the initial domains' purposes were also generalized, modified, or assigned for maintenance to special organizations affiliated with the intended purpose. However, the presence of several gTLDs has not stopped the demand for more gTLDs and ICANN has received many proposals for establishment of new top-level domains. Proponents have argued for a variety of models ranging from adoption of policies for unrestricted gTLDs to chartered gTLDs for specialized uses by specialized organizations. The establishment of new gTLDs requires the operation of a domain registry and a demonstration of technical and financial capacity for such operations and the management of registrar relationships.

Following is the list of currently available domain names together with the purpose, if any, for which they could be registered:

<b>gTLD</b>	<b>Intended use</b>
aero	the air transport industry.
asia	companies, organizations and individuals in the Asia-Pacific region
biz	business use
cat	Catalan language/culture
com	commercial organizations, but unrestricted
coop	Cooperatives
edu	U.S. post-secondary educational establishments
gov	U.S. government entities at the federal, state, and local levels
info	informational sites, but unrestricted
int	international organizations established by treaty
jobs	employment-related sites
mil	the U.S. military
mobi	sites catering to mobile devices
museum	Museums
name	families and individuals
net	originally for network infrastructures, now unrestricted
org	originally for organizations not clearly falling within the other gTLDs, now unrestricted
pro	certain professions
tel	services involving connections between the telephone network and the Internet
travel	travel agents, airlines, hoteliers, tourism bureaus, etc.
xxx	Pornography

### 9.5.3 Country Code Top Level Domains (ccTLD)

A country code top-level domain (ccTLD) is a top-level domain generally used or reserved for a country, a sovereign state, or a dependent territory. The Internet Assigned Numbers Authority (IANA) is responsible for determining an appropriate trustee for each ccTLD. Administration and control is then delegated to that trustee, which is responsible for the policies and operation of the domain. The IANA does not decide what is and what is not a country. The selection of the ISO 3166 list as a basis for ccTLDs was made with the knowledge that ISO has a procedure for determining which entities should be and should not be on that list. All ccTLDs are two letters long, and all two-letter top-level domains are ccTLDs. The ccTLDs mostly correspond to the ISO 3166 codes, for example, .mx for Mexico, .CA for Canada, .in for India and .za for South Africa.

These ccTLDs are administered independently by nationally designated registration authorities. There are currently 252 ccTLDs reflected in the database of the IANA. Individual ccTLDs may have varying requirements and fees for registering subdomains. For instance there may be a local presence requirement like citizenship or other connection to the ccTLD, as for example the Canadian (ca) and German (de) domains, or registration may be kept open. A number of the world's smallest countries have licensed their TLDs for worldwide commercial use.

### 9.5.4 Internationalized Country Code Top-Level Domain (IDN ccTLD or ccIDN)

An internationalized country code top-level domain (IDN ccTLD or ccIDN) is a top-level domain. IDN ccTLDs are specially encoded domain names that are displayed in an end user application, such as a web browser, in their language-native script or alphabet, such as the Arabic alphabet, or a non-alphabetic writing system, such as Chinese characters. IDN ccTLDs are an application of the internationalized domain name system to top-level Internet domains assigned to countries, or independent geographic regions. Countries with internationalized ccTLDs also retain their traditional ASCII-based ccTLDs.

### 9.5.5 Second-Level Domain (SLD)

Below the top-level domains in the domain name hierarchy are the second-level domain names. These are the names directly to the left of gTLDs like .com, .net., etc. For instance, in the domain *www.shamala.co.in*, *co* is the second-level domain.

Next are third-level domains, which are written immediately to the left of a second-level domain. There can be fourth- and fifth-level domains, and so on, with virtually no limitation. An example of an operational domain name with four levels of domain labels is *www.sos.state.oh.us*. Each label is separated by a full stop (dot). 'sos' is said to be a sub-domain of 'state.oh.us', and 'state' a sub-domain of 'oh.us', etc. In general, subdomains are domains subordinate to their parent domain. Second-level (or lower-level, depending on the established parent hierarchy) domain names are often created based on the name of an organization (e.g., *du.ac.in*), product or service (e.g., *facebook.com*). The disputes that arise over domain names involve "second level" domain names.

### 9.5.6 Multilingual Domain Names

The recent trend towards globalization and the increase in world trade has accelerated the internationalization of the intellectual property system and heightened the importance of identifiers like domain names. The advent of e-commerce in the online environment furthers this trend due to the role such identifiers play in developing consumer awareness and trust towards trademarks that are newly emerging.

Until recently, it was only possible to register domain names in Roman script (those that make up the English alphabet) or ASCII characters. However, there are now efforts to allow the registration of domain names written in other non-ASCII characters such as Arabic, Chinese, Cyrillic, Japanese or Hindi.

In January 2000, the Internet Engineering Task Force (IETF) formed a Working Group on the Internationalization of Domain Names to specify the requirements for internationalized access to domain names and to specify access and a standard track protocol based on the requirements. Since that time, a number of commercial test-beds using various technologies have been established and began to register multilingual domain names.

Numerous issues remain to be addressed, as it is important that the introduction of multilingual domain names to the DNS does not affect its stability. There are technological challenges to the development of internationalized domain names, such as the need to standardize the underlying technologies so that such names may be incorporated in the DNS without difficulty. It is also necessary to determine the authority with respect to such languages.

The internationalization of domain names will have repercussions for intellectual property as well. The conflicts that ensue from the use of the various languages and alphabets in a designation system such as the DNS is well known in the trademark field. However, the internationalization of domain names may be expected to raise a number of new considerations with respect to such disputes, including: the importance of phonetic similarity in what is essentially a visual or textual communication medium, the speed and modest cost at which a domain name registration can be obtained as compared with a trademark registration, and the automatic nature of domain name registrations.

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## 9.6 IMPORTANCE OF DOMAIN NAMES FOR BUSINESSES

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The word 'business' or 'commerce', brings to mind the image of going into a shop with money, selecting a product one wishes to buy, paying up its cost and bringing it home. The advancement in technology has now brought a radical change in this traditional process of selling/purchasing. This is because of the facility of doing trade, right from the place where you are sitting by using electronic commerce or e-commerce. E-commerce is not limited by any geographical borders or time zones. One is able to log on to any website regardless of the country one resides in or the time of the day. One may live in India but still have full access to an e-commerce website of Europe. One may be visiting China and easily trade online on the NASDAQ stock exchange by logging on to a financial website. Similarly, one may reside in Malaysia and purchase books from a Korean website.

All this information exchange in the cyber world is done by using the domain name of the website, which replaces the postal address of the shop in the physical world. Thus domain names as web addresses help one in reaching to the website, where the required information is made available regarding products, their pricing, conditions of sale, etc.

Because of the increasing popularity of the Internet, companies have realized that having a domain name that is the same as their company name or the name of one of their products can be an extremely valuable part of establishing an Internet presence.

The original role of a domain name was to provide an address for computers on the Internet. The Internet has, however, developed from a mere means of communication to a mode of carrying on commercial activity. With the increase of commercial activity on the Internet, a domain name is also used as a business identifier. A domain name is easy to remember and use, and is chosen as an instrument of commercial enterprise not only because it facilitates the ability of consumers to navigate the internet to find websites they are looking for, but also at the same time, serves to identify and distinguish the business itself, or its goods or services, and to specify its corresponding online internet location.

As more and more commercial enterprises trade or advertise their presence on the web, domain names have become more and more valuable and the potential for dispute is high. The fact that many consumers searching for a particular site are likely, in the first place, to try and guess its domain name has further enhanced this value.

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## **9.7 DOMAIN NAMES AS TRADABLE BUSINESS ASSETS**

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Domain names are often seen in analogy to real estate in that they are foundations on which a website can be built and the highest “quality” domain names, like sought-after real estate, tend to carry significant value, usually due to their online brand-building potential, use in advertising, search engine optimization, and many other criteria.

The business of resale of registered domain names is known as the domain aftermarket which is the secondary market for domain names in which a party interested in acquiring a domain that is already registered bids or negotiates a price to effect the transfer of registration from the registered holder of that domain name. The domain aftermarket has grown substantially, as an increasing number of generic domains names that promise ‘marketing appeal’ and ‘desirability’ are registered by domain warehouses, or resellers. The professional pursuit of speculation in the domain aftermarket is known as domaining. The domain aftermarket is facilitated by auction houses which provide communication methods for buyers and sellers to interact, often anonymously, to negotiate and close a transaction. They often provide additional services, such as financial escrow services and domain parking.

Various factors influence the perceived value or market value of a domain name. As of 2011, the most expensive domain name sales on record were: Insure.com 2009 \$16 million, Sex.com for \$14 million in October 2010, Fund.com 2008

£9.99 million, Porn.com 2007 \$9.5 million, Fb.com for \$8.5 million in November 2010, Business.com for \$7.5 million in December 1999, Diamond.com 2006 \$7.5 million, Beer.com 2004 \$7 million, Israel.com 2008 \$5.88 million, Casino.com 2003 \$5.5 million.

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## 9.8 DOMAIN NAMES AND TRADEMARKS

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Though there is no separate intellectual property right related to the Domain Name System, the function of domain name as identifier in a manner similar to the trademark in the physical world gives rise to significant intellectual property related issues. The registrations of domain names result in a global presence, accessible from anywhere in the world via the Internet. Conversely, the intellectual property rights system is publicly administered on a territorial basis and gives rise to rights that are enforceable only within the associated jurisdiction. In this respect, the intersection of the Domain Name System and intellectual property is but one example of a larger phenomenon: the meeting of a new global medium in which traffic circulates without cognizance of borders with the traditional, territoriality based system that emanates from the, sovereign authority of nation states.

In the era of e-commerce domain names have become the identifiers of business. The tension between domain names and other identifiers is largely a result of the incongruous nature of the systems to which each type of identifier belongs: the DNS is, to a large extent, managed by the private sector, and gives rise to registrations that result in a global presence, accessible from anywhere in the world while the intellectual property system is managed by public authorities according to the principle of territoriality, giving rise to rights that can only be exercised in a specific territory. Consequently, a trademark may have multiple 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 that a domain name would require world wide exclusivity. Whereas a large number of trademarks containing the same name can comfortably co-exist because they are associated with different products, belong to business in different jurisdictions etc, the distinctive nature of the domain name providing global exclusivity is much sought after. In other words, the same trademark may be held by two separate entities in different countries still both the trademarks could co-exist peacefully. However, the domain names, due to their transparency to geographical boundaries cannot be repeated.

Sometimes these domain name registrations led to illegal practices and disputes. Any domain name can be owned only by a single entity uniquely, throughout the world. This fact gave rise to a practice of cyber-squatting which means abusive registrations of others' trademarks as domain names. These registration practices result in conflicts between trademarks and domain names which are described in the subsequent unit.

**Self Assessment Question**

**(Spend 3 minutes)**

2) Distinguish between Domain names and Trademarks.

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**9.9 SUMMARY**

- The domain name system is essentially a global addressing system. It is the way that domain names are located and translated into Internet Protocol (IP) addresses, and vice versa.
- Domain names are the human-friendly forms of Internet addresses, and are commonly used to find websites on the Internet.
- Without the domain name, a computer would have no idea where to look for a web page, and e-mail routers would not be able to send e-mail.
- The Internet Corporation for Assigned Names and Numbers (or “ICANN”) is a non-profit corporation formed specifically to control Internet domain name management and similar functions.
- Today, ICANN manages the top-level development and architecture of the Internet domain name space. It authorizes domain name registrars, through which domain names may be registered and reassigned.
- A top-level domain (TLD) like .org, .com, .in, etc. are the domains at the highest level in the hierarchical Domain Name System of the Internet.
- TLDs are further classified into: gTLD, ccTLD.
- Below the top-level domains in the domain name hierarchy are the second-level domain names.
- For instance, in the domain *www.shamala.co.in*, *co* is the second-level domain and *in* is the top level domain.
- With the increase of commercial activity on the Internet, a domain name is also used as a business identifier.
- Domain names are often seen in analogy to real estate.
- The business of resale of registered domain names is known as the domain aftermarket.
- The function of domain name as identifier in a manner similar to the trademark in the physical world gives rise to significant intellectual property related issues.

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## 9.10 TERMINAL QUESTIONS

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- 1) What are domain names and what do you understand by domain name system?
- 2) Write a detailed note on the management of domain names.
- 3) What are the various types of domain names?
- 4) What function do domain names play in modern commerce?
- 5) How domain names are akin to trademarks?

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## 9.11 ANSWERS AND HINTS

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### Self Assessment Questions

- 1) Refer to Section 9.3
- 2) Refer to Section 9.8

### Terminal Questions

- 1) Refer to Section 9.3
- 2) Refer to Section 9.4
- 3) Refer to Section 9.5
- 4) Refer to Section 9.6
- 5) Refer to Section 9.8

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# UNIT 10 REGISTRATION OF DOMAIN NAMES AND DISPUTES

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## Structure

- 10.1 Introduction
- 10.2 Objectives
- 10.3 Registration of Domain Names
  - 10.3.1 Registrar of Domain Names
  - 10.3.2 Process of Domain Name Registration
  - 10.3.3 Cost and Time of Registration
  - 10.3.4 Domain Name (Registrar) Transfer
- 10.4 Registration Practices that could Lead to Domain Name Disputes
  - 10.4.1 Cybersquatting or Domain Squatting
  - 10.4.2 Typosquatting
  - 10.4.3 Reverse Domain Name Hijacking
  - 10.4.4 Domain Tasting
  - 10.4.5 Domain Flipping
  - 10.4.6 Domain Name Front Running
  - 10.4.7 Reverse Domain Tasting
  - 10.4.8 Domains for Gripe Websites
  - 10.4.9 Domains for Personal Names
  - 10.4.10 Culturally Significant Domain Names
  - 10.4.11 Domain Parking
- 10.5 Domain Name Disputes
  - 10.5.1 What is the Nature of a Domain Name Dispute?
  - 10.5.2 The Reason behind Domain Name Disputes
- 10.6 Summary
- 10.7 Terminal Questions
- 10.8 Answers and Hints

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## 10.1 INTRODUCTION

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Domain name registrations are done on a first come first served basis. That means if a domain name has not yet been registered it is available for registration and anyone could register it. This unit highlights the process of registration together with who is the designated authority to register domain names and what is the cost and duration of registration.

Ever since domain names became business identifiers, their market value became proportional to the worth of the business it could be used to identify. This led many persons to pre-emptively register various domain names over which others had a better claim. This in turn led to the emergence of numerous domain name disputes. This unit discusses various such practices and also seeks to explain the reasons for domain name disputes.

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## 10.2 OBJECTIVES

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After studying this unit, you should be able to:

- acquaint yourself with the process of domain name registration;
- know who are registrars of domain names;
- understand various practices of registration that give rise to domain name disputes;
- appreciate the nature of domain name disputes; and
- know why so many domain name disputes arise

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## 10.3 REGISTRATION OF DOMAIN NAMES

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### 10.3.1 Registrar of Domain Names

A domain name registrar is an organization or commercial entity, accredited by both ICANN and gTLD registry to sell gTLDs and/or by a ccTLD registry to sell ccTLDs; to manage the reservation of Internet domain names in accordance with the guidelines of the ICANN.

Until 1999, Network Solutions (NSI) operated the com, net, and org registries. In addition to the function of domain name registry operator, it was also the sole registrar for these domains. In October 1998, following pressure from the growing domain name registration business and other interested parties, NSI's agreement with the United States Department of Commerce was amended. This amendment required the creation of a shared registration system that supported multiple registrars. This system officially commenced service on November 30, 1999 under the supervision of ICANN. Since then, over 500 registrars have entered the market for domain name registration services. Go Daddy is the largest registrar. Other successful registrars include eNom, Tucows and Key-Systems.

Each ICANN-accredited registrar must pay a fixed fee of US\$ 4,000 plus a variable fee. The sum of variable registrar fees is intended to total US\$ 3.8 million. The competition created by the shared registration system enables end users to choose from many registrars offering a range of related services at varying prices.

Domain registration information is maintained by the domain name registries, which contract with domain registrars to provide registration services to the public. Once a user selects a registrar to provide the registration service, that registrar becomes the designated registrar for the domain chosen by the user. Only the designated registrar may modify or delete information about domain names in a central registry database. Many registrars also offer registration through reseller affiliates. A registrant registers either directly with a registrar, or indirectly through one or more layers of resellers. It is common for these registrars to offer a range of website-related services like web-hosting.

**Self Assessment Question**

**(Spend 3 minutes)**

1) What is meant by registrar of domain names?

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**10.3.2 Process of Domain Name Registration**

Registering a domain name is simple, largely automated process' that involves visiting a registrar online, checking to ensure that the desired domain name is available, and providing basic information such as your name and contact data and, normally, paying .a basic registration fee.

Checking the availability means that one's preferred domain name hasn't already been registered by somebody else. A domain name can only be registered to one person at any one time so if someone else has already registered it, you won't be able to register it. However, once you register your own domain name, nobody else can get it. It is important to supply your up to date contact details as the domain name registrars won't register a domain name without providing these details.

Provision of contact information to the registrar will make these details available on the Internet. If one doesn't like the idea of having one's details available on the Internet, one may be interested in a private domain registration. Private domain registration ensures that the details are hidden from public view. Without a private registration, anyone can see the details of a domain registrant by using the (publicly available) "WHOIS" database. The WHOIS database is a searchable list of every single domain name registered in the world. For example, if you were to register a domain name, anyone could look up your details by going to the WHOIS database and entering your domain name. That is, unless you have private domain registration. If you register a domain name as a private registration, your details are replaced with a proxy company. When somebody does a WHOIS search on your domain name, the details of the proxy company appear instead of yours.

Domain names are registered on a first-come, first-served basis. Most registration agreements require registrants to certify that, to the best of their knowledge, their chosen domain name registration does not infringe third party rights. In most cases, the registrar performs no further checks.

Domain name registrants are frequently referred to as "domain owners", although domain name registration with a registrar does not confer any legal ownership of the domain name, only an exclusive right of use.

**10.3.3 Cost and Time of Registration**

Domain registrations were free of charge when the Domain Name System was new. However, it became "paid" eventually. Now, when a registrar registers

a .com domain name for an end-user, it must pay a maximum annual fee of US\$7.34 to VeriSign, the registry operator for com, and a US\$0.18 annual administration fee to ICANN. Most domain registrars price their services and products to address both the annual fees and the administration fees that must be paid to ICANN. As of 2010, the retail cost generally ranges from a low of about \$7.50 per year to about \$35 per year for a simple domain registration.

A few companies have offered low-cost, below-cost or even cost-free domain registrations with a variety of models adopted to recoup the costs to the provider. These usually require that domains be hosted on their website within a framework or portal that includes advertising wrapped around the domain holder's content, revenue from which allows the provider to recoup the costs. A domain holder can give away or sell infinite number of subdomains under their domain name. For example, the owner of "www.answer.org" could provide subdomains such as "www.foo.answer.org" and "foo.bar.answer.org" to interested parties.

It is common for registrants to register a domain name for a year in the beginning. The maximum period of registration for a domain name is 10 years. Some registrars offer longer periods of up to 100 years, but such offers involve the registrar renewing the registration for their customer; the 100-year registration would not be in the official registration database.

After the expiration date, the domain status often passes through several management phases, often for a period of months; usually it does not simply become generally available. However, it is advisable for the registrant to take steps to renew the registration before the expiry of the time for which the domain name had been registered. If a domain registration expires, irrespective of the reason, it can be difficult, expensive, or impossible for the original owner to get it back.

### **10.3.4 Domain Name (Registrar) Transfer**

A domain name transfer is the process of changing the designated registrar of a domain name. It is not unusual for a registrant to switch registrars, invoking a domain transfer process between the registrars involved. ICANN has defined a Policy on Transfer of Registrations between Registrars. The usual process of a domain name transfer is:

The end user verifies that the whois admin contact info is correct, particularly the email address; obtains the authentication code from the old registrar, and removes any domain lock that has been placed on the registration. The end user contacts the new registrar with the wish to transfer the domain name to their service, and supplies the authentication code. The gaining Registrar must obtain express authorization from either the Registered Name Holder or the Administrative Contact. The new registrar starts electronically the transfer of the domain with the help of the authentication code.

After this process, the new registrar is the domain name's designated registrar. After transfer, the domain cannot be transferred again for 60 days, except back to the previous registrar.

## 10.4 REGISTRATION PRACTICES THAT COULD LEAD TO DOMAIN NAME DISPUTES

Ever since domain names became business identifiers, their market value grew in proportion to the business that a domain name could identify. Therefore, various registration practices soon developed which would permit the first registrant to exploit the situation and win an unfair advantage over the other who came late. These registration practices, which could potentially lead to domain name disputes are discussed below.

### 10.4.1 Cybersquatting or Domain Squatting

Cybersquatting is registering, trafficking in, or using a domain name with bad faith intent to profit from the goodwill of a trademark belonging to someone else. The term is derived from “squatting”, which is the act of occupying an abandoned or unoccupied space or building that the squatter does not own, rent or otherwise have permission to use. Cybersquatting, however, is a bit different in that the domain names that are being “squatted” are (sometimes but not always) being paid for through the registration process by the cybersquatters.

The cybersquatters do not have any direct interest or connection with the mark in question. Since the domain names are unique, when the mark owner tries to register a domain name in form of his trademark, he discovers that it is already registered by some other person and hence refused that domain name. Since the registration of domain names can be done at very low cost, the cyber squatter usually registers many domain names exactly same or deceptively similar to the well-known marks. These domain names are then offered by the cyber-squatter to the genuine trademark owner at exorbitant costs. It is usual for cybersquatters to ask for prices far greater than that at which they purchased it. Or sometimes web pages related to these domain names contain material, which may be infuriating to the reputation of the well-known mark. Some cybersquatters put up derogatory remarks about the person or company the domain is meant to represent in an effort to encourage the subject to buy the domain from them. These kinds of registrations are treated as bad-faith registrations.

Another strategy is as follows: Internet domain name registrations are for a fixed period of time. If the owner of a domain name doesn't re-register the name with an internet registrar prior to the domain's expiration date, then the domain name can be purchased by anybody else after it expires. At this point the registration is considered *lapsed*. A cybersquatter may use automated software tools to register the lapsed name the instant it is lapsed. This strategy is one of a family of identity theft schemes including renewal snatching, extension exaggeration and alert angling.

**Self Assessment Question**

**(Spend 3 minutes)**

1) What is cybersquatting?

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## 10.4.2 Typosquatting

Typosquatting, also called URL hijacking, is a form of cybersquatting which relies on mistakes such as typographical errors made by Internet users when inputting a website address into a web browser. Should a user accidentally enter an incorrect website address, they may be led to an alternative website owned by a cybersquatter. Sometimes this practice is referred to as brandjacking because by this the typosquatter wishes to hijack or take undue advantage of the brand name of others.

Adopting this practice, the typosquatter chooses a URL which is similar to the victim's website address. If the victim's website address is [www.answer.com](http://www.answer.com) the typosquatter could adopt the following ways:

- The typosquatter could adopt “[www.answar.com](http://www.answar.com)” which is a common misspelling of the word “answer”, thinking that a few people who wanted to reach the victim's website would commit a mistake and mistype the address. Once the user has reached the wrong website the typosquatter either fools him to believe that he has reached the right website through the use of copied or similar logos, website layouts or content or his website contains enough material to capture the user's interest. For example, the user was looking for solutions to a math problem on “[www.answer.com](http://www.answer.com)” may be induced to spend some time on a gambling website.
- The typosquatter could adopt “[www.swer.com](http://www.swer.com)” or “[www.answre.com](http://www.answre.com)” or “[www.ansqer.com](http://www.ansqer.com)”. Thereby he is banking on normal tyographical errors of the users.
- The typosquatter could adopt “[www.answers.com](http://www.answers.com)” which is an addition to the victim's domain name. Here the intention of the typosquatter is to confuse the user and lead him to his website rather than that of the victim.
- The typosquatter could adopt “[www.answer.org](http://www.answer.org)” or “[www.answer.in](http://www.answer.in)” hereby choosing a different top-level domain. The user could be made to think that “[www.answer.in](http://www.answer.in)” is an Indian version of the main website “[www.answer.com](http://www.answer.com)”.

Many prominent companies such as Verizon and Lego and many celebrities have been victims of typosquatting. Some other examples could be [yuube.com](http://yuube.com) for [youtube.com](http://youtube.com), [luftahnsa.com](http://luftahnsa.com) for [lufthansa.com](http://lufthansa.com) and [arifrance.com](http://arifrance.com) for [airfrance.com](http://airfrance.com).

## 10.4.3 Reverse Domain Name Hijacking

Reverse domain name hijacking occurs where a trademark owner attempts to secure a domain name by making false cybersquatting claims against a domain name's rightful owner. This often intimidates domain name owners into transferring ownership of their domain names to trademark owners to avoid legal action, particularly when the domain names belong to smaller organizations or individuals. Reverse domain name hijacking is most commonly perpetrated by larger corporations. This practice is also known as reverse cybersquatting.

Reverse domain name hijacking is an analogue to the practice of domain hijacking, wherein domain name registrants registered domain names containing famous

third party trademarks with the intent of profiting by selling the domain names back to trademark owners. Trade mark owners initially responded by filing cybersquatting lawsuits against registrants to enforce their trademark rights. However, as the number of cybersquatting incidents grew, trademark owners noticed that registrants would often settle their cases rather than litigate. Consequently, although the filing of cybersquatting lawsuits began as a defensive strategy to combat cybersquatting, such lawsuits can also be used as a way of to deter innocent domain name registrants into giving up domain names that the trademark owner is not comfortable with.

#### 10.4.4 Domain Tasting

During the five-day period starting from the registration of a domain name the registrar has to refund full fee to the registrant if the registrant wants to give back the domain name. Domain tasting is the practice of a domain name registrant using this five-day "grace period" at the beginning of the registration of an ICANN-regulated second-level domain to test the marketability of the domain. During this period the registrant attempts a cost-benefit analysis in order to test the viability of deriving income from advertisements being placed on the domain's website.

Domains that are deemed "profitable" or "successes" and retained in a registrant's portfolio often represent domains that were previously used and have since expired, misspellings of other popular sites, or generic terms that may receive traffic upon being typed. The reason is that these domains are usually still active in search engines and other hyperlinks and therefore receive enough traffic such that advertising revenue exceeds the cost of the registration. The registrant may also derive revenue from eventual sale of the domain, at a premium, to a third party or the previous owner.

The practice is controversial as practitioners typically register and delete many hundreds of thousands of domain names under this practice, with these temporary registrations far exceeding the number of domain names actually purchased.

In order to dissuade registrants from adopting such practice ICANN in 2008 proposed several possible solutions, including that the exemption on transaction costs (US\$ 0.20) during the five-day grace period be abandoned. This would effectively make the practice of domain tasting not viable or profitable. The transaction fee of US\$ 0.20 will be applied to domains deleted in the Add Grace Period where the number of such domains exceeds 10% of the net new registrations or 50 domains, whichever is greater. The "net new registrations" is defined as the number of new registrations less the number of domains deleted in the Add Grace Period.

The decision of ICANN has proved to be successful as prior to implementing the excess domain deletion charges, the peak in a month for domain tastings was over 15 million domain names. After the \$0.20 fee was implemented, this dropped to around 2 million domain names per month.

**Self Assessment Question**

**(Spend 4 minutes)**

2) What is domain tasting?

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**10.4.5 Domain Kiting**

Through domain kiting one is able to use a domain name without paying for it. It is the process of deleting a domain name during the five-day grace period and immediately re-registering it for another five-day period. This process is repeated any number of times with the end result of having the domain registered without ever actually paying for it.

**10.4.6 Domain Name Front Running**

Domain name front running is the practice whereby a domain name registrar uses insider information to register domains for the purpose of re-selling them or earning revenue via advertisements placed on the domain's landing page. By registering the domains, the registrar locks out other potential registrars from selling the domain to a customer. The registrar typically takes advantage of the 5-day "domain tasting" trial period, where the domain can be locked without payment. The term is similar to the practice of front running in the stock market when a stockbroker illegally puts their own financial interests above that of their clients.

In January 2008, Network Solutions was accused of this practice of domain name front running when the company began reserving all domain names searched on their website for five days. The company used data collected from their web-based "whois" search to register every domain that users check for availability. However, Network Solutions defends the practice, claiming that it provided their customers the opportunity to register domains they have previously searched.

**10.4.7 Reverse Domain Tasting**

A number of registrars routinely change a domain's name servers to those of their own, or a parking service when a domain has gone past its expiration or renewal date. Often, domains will still resolve for up to 30 days or more after they have technically expired. The advantage of this 'reverse tasting' is that the registrars or parking services can determine which domains have traffic before they are deleted, and hence maintain a list of domains that they might re-register (or even transfer) after the deletion date.

**10.4.8 Domains for Gripe Websites**

A gripe site is a type of website devoted to the critique and or mockery of a person, place, institution or government. They are also known as "complaint" or

“sucks” sites. The Internet provides a low cost public platform for anyone, even of modest means, to reach a global audience via a “gripe” website. The web gives ordinary individuals the opportunity to publicly criticize anyone. Time and money is invested in the hope of gaining satisfaction by airing a perceived grievance and embarrassing the party which is the target of the “gripe”.

The owners of gripe websites usually want to use a domain name which is similar to the target person or institution because that will direct some of the target’s traffic towards them. For example, the one who wants to criticize Air France may choose [www.airfrancesucks.com](http://www.airfrancesucks.com). Which is a build-up on the domain name of Air France.

Not surprisingly, powerful institutions often do not take kindly to being criticized, and they have invented a variety of ways to try to suppress the speech of their adversaries. In an attempt to shut down a gripe site, companies have sued the gripe site owner alleging defamation, trademark infringement, libel and copyright infringement.

#### **10.4.9 Domains for Personal Names**

It is perfectly possible for an individual to register a domain name that matches with his name. For example, Mr. Lalit Kumar is free to choose [www.lalitkumar.com](http://www.lalitkumar.com). But there are multiple persons with same name. In this situation, who has the best rights to domain names corresponding with personal names where different people have similar names? The problem becomes acute with the names of celebrities and politicians.

Personal names may not operate like trademarks. So, in such cases resort is usually made to trademark together with privacy laws.

#### **10.4.10 Culturally Significant Domain Names**

There are so many names that are culturally significant. For example, Buddha, Delhi, Freemason, Madonna, America and the list is endless; who has the right to register [www.buddha.com](http://www.buddha.com) or [www.islam.com](http://www.islam.com). Could we do justice by allowing the first registrant to own it forever? It is difficult to establish which people, groups, or government entities should have the strongest claim to such legal right. At stakes would also be genetic resources, traditional expressions and folklore.

#### **10.4.11 Domain Parking**

Domain parking is the registration of a domain name without using it for building a website or for e-mail, i.e. without placing any content on the domain. This is usually done to reserve the domain name for future development, to protect against the possibility of cybersquatting, or to engage in cybersquatting. Domain names can be parked before a web site is ready for launching.

Domain parking can be used as a placeholder for an existing website. The domain holder might also choose to redirect a domain to another website it has registered, either through URL redirection, domain cloaking or by pointing it as an alias of the main domain, although if this is done by the ultimate registrant, the domain is then in use, rather than parked.

Domain parking can be classified as monetized and non-monetized. In the former, advertisements are shown to visitors and the registrant gains revenue. The domain name will usually resolve to a webpage containing advertising listings and links. These links will be targeted to the predicted interests of the visitor and may change dynamically based on the results that visitors click on. In the latter, an "Under Construction" or a "Coming Soon" message may or may not be put up on the domain by the registrar or reseller. This is a single-page website that people see when they type the domain name or follow a link in a web browser.

**Self Assessment Question**

**(Spend 3 minutes)**

3) What is domain parking?

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## **10.5 DOMAIN NAME DISPUTES**

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A domain name dispute could arise from any of the above stated registration practices where the person feels that he has a better right to an already registered domain name than the one who has registered it. The aggrieved person could then fight out the matter through various dispute resolution methods.

### **10.5.1 What is the Nature of a Domain Name Dispute?**

The nature of domain name dispute lies in the architecture of the Internet where two identical second level domain names cannot coexist under the same top level domain. While designed to serve the function of enabling users to locate computers and people in an easy manner, domain names have acquired a further significance as business identifiers and, as such, have come into conflict with the system of business identifiers that existed before the arrival of the Internet and that are protected by intellectual property rights.

Domain name disputes arise largely from the practice of cybersquatting, which involves the pre-emptive registration of trademarks by third parties as domain names. Cybersquatters exploit the first-come, first-served nature of the domain name registration system to register names of trademarks, famous people or businesses with which they have no connection. Since registration of domain names is relatively simple, cybersquatters can register numerous examples of such names as domain names. As the holders of these registrations, cybersquatters often then put the domain names up for auction, or offer them for sale directly to the company or person involved, at prices far beyond the cost of registration. Alternatively, they can keep the registration and use the name of the person or business associated with that domain name to attract business for their own sites.

### **10.5.2 The Reason behind Domain Name Disputes**

There is no agreement within the Internet community that would allow organizations that register domain names to pre-screen the filing of potentially

problematic names. The reasons vary, ranging from allowing easy registrations to stimulate business, to the practical difficulties involved in determining who holds the rights to a name, to the principle of freedom of expression. Furthermore, the increasing business value of domain names on the Internet has led to more cybersquatting, which results in more disputes and litigation between the cybersquatters and the businesses or individuals whose names have been registered in bad faith.

**Self Assessment Question**

**(Spend 3 minutes)**

4) Explain domain name disputes.

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## 10.6 SUMMARY

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- A domain name registrar is an organization or commercial entity, accredited by both ICANN and gTLD registry to sell gTLDs and/or by a ccTLD registry to sell ccTLDs; to manage the reservation of Internet domain names in accordance with the guidelines of the ICANN.
- Domain registration information is maintained by the domain name registries, which contract with domain registrars to provide registration services to the public.
- Once a user selects a registrar to provide the registration service, that registrar becomes the designated registrar for the domain chosen by the user.
- Registering a domain name is simple, largely automated process' that involves visiting a registrar online, checking to ensure that the desired domain name is available, and providing basic information such as your name and contact data and, normally, paying .a basic registration fee.
- Domain names are registered on a first-come, first-served basis.
- Most registration agreements require registrants to certify that, to the best of their knowledge, their chosen domain name registration does not infringe third party rights.
- As of 2010, the retail cost generally ranges from a low of about \$7.50 per year to about \$35 per year for a simple domain registration.
- The maximum period of registration for a domain name is 10 years.
- A domain name transfer is the process of changing the designated registrar of a domain name.
- Cybersquatting is registering, trafficking in, or using a domain name with bad faith intent to profit from the goodwill of a trademark belonging to someone else.

- Typosquatting is a form of cybersquatting which relies on mistakes such as typographical errors made by Internet users when inputting a website address into a web browser.
- Through domain kiting one is able to use a domain name without paying for it.
- A gripe site is a type of website devoted to the critique and or mockery of a person, place, institution or government.
- Domain parking is the registration of a domain name without using it for building a website or for e-mail, i.e. without placing any content on the domain.
- The nature of domain name dispute lies in the architecture of the Internet where two identical second level domain names cannot coexist under the same top level domain.
- There is no agreement within the Internet community that would allow organizations that register domain names to pre-screen the filing of potentially problematic names.
- Cybersquatters exploit the first-come, first-served nature of the domain name registration system to register names of trademarks, famous people or businesses with which they have no connection.

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## 10.7 TERMINAL QUESTIONS

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- 1) Explain the process of domain name registration?
- 2) Who are domain name registrars? What functions do they perform?
- 3) What do you understand by cybersquatting? Explain the reasons behind this practice.
- 4) What are various domain name registration practices that could potentially lead to domain name disputes?
- 5) What is a domain name dispute? What are the reasons for so many disputes?

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## 10.8 ANSWERS AND HINTS

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### Self Assessment Questions

- 1) Refer to Sub-section 10.3.1
- 2) Refer to Sub-section 10.4.1
- 3) Refer to Sub-section 10.4.4
- 4) Refer to Section 10.5

### Terminal Questions

- 1) Refer to Section 10.3
- 2) Refer to Sub-section 10.3.1
- 3) Refer to Sub-section 10.4.1
- 4) Refer to Section 10.4
- 5) Refer to Section 10.5

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# UNIT 11 DOMAIN NAME DISPUTE RESOLUTION-I

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## Structure

- 11.1 Introduction
- 11.2 Objectives
- 11.3 Domain Name Dispute Resolution through Litigation in Courts
  - 11.3.1 Grounds of Proceeding in Court
  - 11.3.2 Remedies Available under the Court System
  - 11.3.3 Jurisdiction of Courts
  - 11.3.4 Shortcomings of the Court System
- 11.4 ccTLDs and their Registration
- 11.5 The .in Domain Name Dispute Resolution Policy
  - 11.5.1 Juridical Basis for INDRP
  - 11.5.2 Types of Disputes that could be Brought within INDRP
  - 11.5.3 Remedies Available under INDRP Proceedings
  - 11.5.4 Cost of Proceedings
- 11.6 Procedure of Dispute Resolution under INDRP
  - 11.6.1 How to File a Complaint under INDRP?
  - 11.6.2 Appointment of Arbitrator
  - 11.6.3 How the Registrant could Defend Himself?
  - 11.6.4 Dispute Resolution by Arbitrator
- 11.7 Summary
- 11.8 Terminal Questions
- 11.9 Answers and Hints

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## 11.1 INTRODUCTION

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Online business transactions have become important for every business. However, in order to carry out such transactions companies need to register a domain name and operate a website. As a result the domain names become the business identifiers of companies and hence perform the role of trademarks on the Internet. Most of the businesses prefer to identify themselves by the domain name that is similar to their already existing trademarks just to have a continuity with their offline businesses. In such case they can also be searched by their customers by typing their trademark in a search engine. However, the registrants of trademarks and domain names are different and their registration is based on different principles. So, it happens that a trademark belonging to one enterprise gets registered by a third party either inadvertently or deliberately.

Most of the domain name disputes arise because of the practice of cybersquatting whereby a third party registers the trademark of a business enterprise with the hope to sell the domain name to that enterprise or in the open market at a premium. The previous unit describes in detail which registration practices lead to domain name disputes.

This unit focuses on the methods and manners of domain name dispute resolution which primarily include litigation in courts and arbitration. Like any other dispute, a domain name dispute could also be brought before the courts for adjudication. This unit explains in detail the procedure for such dispute resolution in courts, the remedies available to the plaintiff, the costs and the advantages.

For disputes concerning ccTLDs in the .in category there is an alternate option to approach the arbitration through the .in Dispute Resolution Policy (INDRP). The following passages describe the procedure and the requirements of INDRP. The unit also highlights various important cases decided by courts and arbitrators so that the readers could appreciate the practical angle of dispute resolution.

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## 11.2 OBJECTIVES

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After studying this unit you, will be able to:

- explain the ways of resolution of domain name disputes;
- describe how to file a domain name case in a court;
- explain the grounds for filing a case;
- explain the remedies available through the court system; and
- discuss the arbitration procedure is available for domain name dispute resolution in in .in category of ccTLDs.

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## 11.3 DOMAIN NAME DISPUTE RESOLUTION THROUGH LITIGATION IN COURTS

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When a dispute over a domain name occurs the parties can always approach the courts. Courts have the authority to award control and ownership over any other property; similarly they have the authority to award control and ownership over domain names. In the early days of domain names, one had no option but to litigate domain name disputes before a court of law. The cause of action would be primarily one in passing off or trademark infringement, depending on whether the trademark was registered or not. If one is successful in the court, then he could furnish a copy of such order to the registrar of the domain name and the registrar would then transfer the domain name in his favour or cancel the registration of the defendant.

In an action for passing off it is usual, rather essential, to seek an injunction temporary or ad-interim. The principles for the grant of such injunction are the same as in the case of any other action against injury complained of. The plaintiff must prove a prima facie case, availability of balance of convenience in his favour and his suffering an irreparable injury in the absence of grant of injunction.

The concept of 'use' occupies a significant place in litigating trademarks. The trademarks law restricts use of someone's trademark by others. Section 29(1), Trade Marks Act, 1999 states that a registered trademark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, *uses* in the course of trade, a mark which is identical with, or deceptively similar to the trademark in relation to goods or services in respect of which the trademark is registered and in such manner as to render the use of the mark likely to be

taken as being used as a trademark. Further, the common law remedy of passing off also required that the plaintiff show that the defendant had *used* the plaintiff's trademark in some way. So the issue "Has the domain name holder made use (prior to the dispute) of the domain name in connection with a bona fide sale of goods or services?" holds the key to the resolution of domain name dispute.

To be able to resolve the issue of use, the greatest difficulty was the fact that the most cyber-squatters never activated their website; or their webpage would just open only to tell the viewer that the site is under construction. The registration of the domain name was kept alive with the hope that some day the trademark owner would pay a large sum to acquire it or they would be able to sell it in open market at a premium. In such instances, could it be said that the said trademark had been used in some way?

In *Marks & Spencer Plc v. One in a Million* [1999 FSR 1], creative legal interpretation was resorted to in order to bring even such obvious 'non-use' cases within the ambit of 'use'. The English High Court held and the Court of Appeal affirmed that the mere act of registration of the domain name and an offer to sell the same constituted 'use'. Most other common law jurisdictions followed suit and soon, the Marks and Spencer ruling was adopted in India as well in various cases.

The first case in India with regard to cybersquatting was *Yahoo! Inc. v. Akash Arora & Anr.* [1999 PTC 201]. In this case the Internet search engine Yahoo! Inc. sued the defendant who had not only copied the domain name Yahooindia.com but had used Yahooindia as a trademark in a similar script on its website by offering directory services with information specific to India, and was passing itself off as an extension of Yahoo. The defendant had done this before Yahoo Inc. decided to come to India. The defendant had further copied the contents of the plaintiff's web page and consequently the HTML code associated with the said page. The Delhi High Court granted an injunction restraining him from using Yahoo either as a part of his domain name or as a trademark or from copying any of the contents of the plaintiff's website and thereby infringing Yahoo's copyrights. Specifically, the court held that trademark law applies with equal force on the Internet as it does in the physical world. Moreover, on account of the ease of copying, anonymity, easiness of access from any part of the globe, the Internet was a medium in which the courts should take a strict view of copying because the potentiality of the harm was far greater because the effect of a wrong would be propagated to every corner of the world. The court observed, "it was an effort to trade on the fame of yahoo's trademark. A domain name registrant does not obtain any legal right to use that particular domain name simply because he has registered the domain name, he could still be liable for trademark infringement."

### 11.3.1 Grounds of Proceeding in Court

Anyone who chooses to bring a court action must present legal arguments on why a domain name registered to someone else should be cancelled or transferred to him while admitting that he wasn't fast enough to register the name first. As stated earlier these arguments are based on trademark or passing off law.

Under law the following factors can be considered by a court as elements to determine whether the domain name was registered in bad faith:

- Does the domain name holder have trademark rights in the domain name?
- Is the domain name the legal name of the domain name holder, or some other name that is otherwise commonly used to identify that person?
- Is the domain name holder using the mark in a bona fide non-commercial or fair use way at a website accessible at the domain name?
- Is the domain name holder attempting to divert consumers from the trademark owner's website in a confusing way, either for commercial gain or in an attempt to tarnish or disparage the trademark?
- Has the domain name holder registered multiple domain names which are the trademarks of others?
- Has the domain name holder behaved in a pattern of registering and selling domain names without intending to use them in connection with the sale of goods or services?
- Has the domain name holder offered to sell the domain name to the trademark owner (or anyone else) for financial gain without having any intent to use the mark with the sale of goods or services?
- Has the domain name holder deliberately provided false contact details at the time of registration of the domain name?

The Bombay High Court in *Rediff Communication v. Cyberbooth & Anr* [2000 PTC 209] observed that the value and importance of a domain name is like a corporate asset of a company. In this case the defendant had registered a domain name *radiff.com* which was similar to plaintiff's trademark and domain name *rediff.com*. Deciding in favour of the plaintiff the court stated, "a domain name is more than an Internet address and is entitled to equal protection as a trademark". The court held that the only reason the defendant had adopted the domain name *radiff.com* was to trade upon the plaintiff's position. Further, the court stated that a first time user would be confused and furthermore as both the sites offered similar features the confusion would be compounded.

In *Titan Industries Limited v. Prashanth Koorapati & Others*, the plaintiff who was the owner of the trademark TANISHQ, which had become well-known for jewelry and watches, filed a suit for passing-off and sought a permanent injunction restraining the respondent from using their registered domain name "tanishq.com" on the Internet. Titan commenced the production and marketing of jewelry and watches in 1994 under the trademark TANISHQ, obtaining registrations in 23 countries. Prashanth Koorapati registered the domain name "tanishq.com" with Network Solutions Inc. (NSI). Titan disputed Prashanth Koorapati's domain name registration on the grounds that the registration would cause confusion and deceive the public and thus divert Titan's business to Prashanth Koorapati. Titan argued that Prashanth Koorapati would thus be able to earn profits based on the goodwill and well-established reputation of Titan's TANISHQ mark, thereby causing financial loss to Titan and damage to the goodwill and established world-wide reputation of Titan's TANISHQ mark.

The Delhi High Court issued an ex parte ad interim injunction restraining Prashanth Koorapati from registering a name, or operating any business, manufacturing, selling or offering for sale, or advertising any goods under the name TANISHQ or any other name deceptively similar thereto; or including the word TANISHQ as an essential feature of a domain name on the Internet; and from conducting any activities with the name TANISHQ that may lead to passing off the business and goods of Prashanth Koorapati as those of Titan. During the pendency of the dispute NSI placed Prashanth Koorapati's domain name registration "on hold" and the web page was never activated.

In *Dr. Reddy's Laboratories Ltd. v. Manu Kosuri* [2001 PTC 859] the plaintiff had a registered domain name *www.drreddys.com*. The defendant was in the business of operating websites adopted the domain name *drreddyslab.com*. The court observed that the defendant was liable to be prosecuted for an action of passing off since the domain name serves same function as a trademark and thus the court was pleased to restrain the defendant. In *Info Edge India Pvt. Ltd. & Anr. v. Shailesh Gupta & Anr.* [2002 PTC 355] the plaintiff's domain name "naukri.com" was adopted by the defendants as *naukari.com* as their domain name. Interim injunction was granted in favour of the plaintiff. In *Tata Sons Ltd. v. Manu Kosuri* [2001 PTC 432], an interim injunction was granted against the defendants who had registered series of domain names, incorporating the well known and famous trademark TATA.

In *British Telecom Plc. v. One in a Million* [1999 FSR 1] the court held that in the case of a registration of domain names of third party trademarks, there was jurisdiction to grant injunctive relief when the defendant was equipped with or was intending to equip another with an instrument of fraud. It was also held that a name which would by reason of similarity to the name of another, inherently lead to passing off, was such an instrument. It was held that in case it would not inherently lead to passing off but the court concluded on the facts without regard to the defendant's intention that the name was produced to enable passing off, was adapted to be used for passing off and, if used, was likely to be used fraudulently, an injunction would be appropriate.

In the United States, one Dennis Toeppen registered a host of well-known trademarks as domain names. He was generally unsuccessful in defending his rights to them when sued by the trademark proprietors. In *Intermatic v. Toeppen* [947 F. Supp. 1227 N.D. Ill. 1996] the plaintiff owned a federal trademark registration for 'Intermatic' which was registered as domain name by the respondent. The court observed that the respondent, Mr. Toeppen's conduct caused trademark dilution since the registration of the domain name *intermatic.com* lessened the capacity of Intermatic to identify and distinguish its goods and services on the Internet. In *Panavision v. Toeppen* 141 F.3d 1316 (1998), it was Panavision which had filed a case against Toeppen for registering their trademark as his domain name *panavision.com*. Again the court ruled in favour of the plaintiff.

In *Satyam Infoway Ltd. v. Sifynet Solutions* [2004 (6) SCC 145], the respondent had registered domain names *www.sifynet.com* and *www.sifynet.net* which were similar to the plaintiff's domain name *www.sifynet.com*. Satyam (plaintiff) had an image in the market. The word Sify was first coined by the plaintiff using elements from its corporate name Satyam Infoway and enjoyed reputation and goodwill in the market. The Supreme Court held that "domain names are business

identifiers, serving to identify and distinguish the business itself or its goods and services and to specify its corresponding online location." The court also observed, "The use of the same or similar domain name may lead to a diversion of users which could result from such user mistakenly accessing one domain name instead of another. This may occur in e-commerce with its rapid progress and instant (and theoretically limitless) accessibility to users and potential customers and particularly so in areas of specific overlap. Ordinary consumers/users seeking to locate the functions available less than one domain name may be confused if they accidentally arrived at a different but similar website which offers no such services. Such users could well conclude that the first domain name owner had misrepresented its goods and services through its promotional activities and the first domain owner would thereby lose their custom. It is apparent therefore that a domain name may have all the characteristics of a trademark and could found an action for passing off." The court also recognised the prior use by Satyam of the domain name and rejected the respondent's contention that the parties carried on different business activities. Therefore, the Supreme Court allowed the plaintiff's appeal and confirmed the grant of an injunction against the respondent.

Highlighting the significance of domain names for modern day commerce the Apex court stated: "As more and more commercial enterprises trade or advertise their presence on the web, domain names have become more and more valuable and the potential for dispute is high. Whereas a large number of trademarks containing the same name can comfortably co-exist because they are associated with different products, belong to business in different jurisdictions etc, the distinctive nature of the domain name providing global exclusivity is much sought after. The fact that many consumers searching for a particular site are likely, in the first place, to try to guess its domain name has further enhanced this value."

Where the domain name involved a descriptive term such as *mutualfundsindia.com*, the Delhi High Court (*Online India Capital Co. Pvt. Ltd. v. Dimensions Corporate*, 2000 PTC 396) refused to grant an injunction holding that in the absence of secondary meaning, the term "mutualfundsindia" is descriptive and the plaintiff cannot be said to have any trademark rights over it. This decision is a clear signal that if the plaintiff is unable to bring his case within the four corners of trademark law then the dispute may not be resolved in his favour.

In *Manish Vij v. Indra Chugh* [AIR 2002 Del 243] the plaintiff was the proprietor of the trademark and domain name "*www.kabadibazaar.com*", dealing with second hand goods on the Internet. Since "kabadi" means a person who buys second hand products and "bazaar" means a market where trading takes place the words suit the domain name indicating the nature of business on the website. The defendants had been operating the website "*www.kabaribazaar.com*" a month after the plaintiff and claimed wider reputation amongst the public, than that of the plaintiff's site. The plaintiff argued that the defendant's registration and use of the domain name "*www.kabaribazaar.com*" was in bad faith. The Court found that both parties had operated their websites within a month and while the plaintiff was unable to show the quantum of business carried out, it could not be said that the defendant had not incurred advertisement costs. It was held that it was not possible to prove that the registration of the domain name was in bad faith. "Kabadi- bazaar" is a common term in the Hindi language and so the plaintiff's domain name had not acquired secondary meaning. Thus the plaintiff's application was dismissed and the interim injunction order against the defendant was vacated.

### 11.3.2 Remedies Available under the Court System

Courts have tried to address the domain name disputes with injunctions, domain name transfers and damages under the laws of trademarks and passing off. Other than these civil remedies, the Trademarks Act, 1999 provides criminal remedies for non-bailable cognizable offences, being imprisonment up to 3 years and fine up to Rs. Two Lakh, however the use of this provision for trademarks involved in domain name disputes is virtually nonexistent. In fact this provision is barely used even in other trademark cases due to the requirement under the Act for an approval of the criminal complaint by the Trademarks Registrar.

### 11.3.3 Jurisdiction of Courts

Domain name disputes where the plaintiff relies on trademark law can be filed only in a court having appropriate jurisdiction. According to Section 134, Trade Marks Act, 1999: "No suit (a) for the infringement of a registered trademark, or (b) relating to any right in a registered trademark, or (c) for passing off arising out of the use by the defendant of any trademark which is identical with or deceptively similar to the plaintiff's trademark, whether registered or unregistered shall be instituted in any court inferior to a District Court having jurisdiction to try the suit." Further "a district court having jurisdiction shall notwithstanding anything contained in the Code of Civil Procedure, 1908 or any other law for the time being in force, include a district Court within the local limits of whose jurisdiction, at the time of the institution of the suit or other proceeding the person instituting the suit or proceeding or where are more than one such persons any of them, actually and voluntarily resides or carries on business or personally works for gain."

In *Banyan Tree Holding (P) Ltd. v. A Murali Krishna Reddy* [MANU/DE/3072/2009], the court not only examined the applicability of the principles of passing off in domain name cases, but also determined questions of jurisdiction on the basis of whether a website is passive or interactive in nature, among other considerations. In a case the Delhi High Court held that the mere presence of a website and accessibility by an audience in a particular jurisdiction does not automatically give the courts of that country jurisdiction. Jurisdiction of the forum court is not based merely on the interactivity of the website accessible in the forum state. In addition to the degree of interactivity, the nature of the activity permissible and whether it results in a commercial transaction must be examined.

### 11.3.4 Shortcomings of the Court System

Although domain name disputes have given rise to a strong line of precedents, approaching a court of law has many disadvantages. The first difficulty is of detecting the wrong or of serving the defendants. The defendants would try to avoid the service and to complicate the matters in many cases the defendants are foreign entities where the service of the process of Indian courts becomes rather difficult. Second, there is always the risk of the domain name being transferred if the plaintiff gives a cease and desist notice to the domain name holder; and this could go on endlessly. Third, even if one gets an injunction from the court on a specific domain name, there is always a possibility that the defendant would obtain registration of other variations of the plaintiff's trademarks. Fourth, the judicial process is notoriously slow. Fifth, it is sometimes difficult to present a

strong case under the traditional principals of trademark law, especially when the party seeking to obtain a domain name either could not prove a likelihood of confusion (which is required under trademark law) or is a famous individual who never technically established trademark rights in his or her name. Sixth, a trademark is protected by the laws of a country where such trademark may be registered or used; consequently, a trademark may have multiple 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. Therefore, in court litigation, we are trying to control something which is international through national laws. The result is, national laws, in such international cases, might be inadequate to effectively protect a domain name. Consequently, many parties have avoided the courts and turned to arbitration under the domain name dispute policies offered by of the domain name registrars.

<b>Self Assessment Question</b>	<b>(Spend 3 minutes)</b>
1) Explain the remedies available under the court system.	
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## 11.4 CCTLDS AND THEIR REGISTRATION

Most corporations apart from registering their trade names and some of their core brands as gTLD's, also register them as ccTLD's in certain select countries where they foresee business potential. For example, *Yahoo.com* is a gTLD. However, *yahoo.cn* would be a ccTLD of China. Similarly, *yahoo.fr* would be a ccTLD registered in France. The administration of a ccTLD is left to the specific country concerned and thus ccTLD policies are distinct from each other.

India's country code top level domain is ".in" and IN Registry is the official ".in" registry. IN Registry was appointed by the government of India. The policies for the .in domain allow unlimited second-level registrations under .in. Unlimited registrations under the previously structured existing zones are also allowed:

- .in (available to anyone; used by companies, individuals, and organizations in India)
- .co.in (originally for banks, registered companies, and trademarks)
- .firm.in (originally for shops, partnerships, liaison offices, sole proprietorships)
- .net.in (originally for Internet service providers)
- .org.in (originally for non-profit organizations)
- .gen.in (originally for general/miscellaneous use)
- .ind.in (originally for individuals)

Six zones are reserved for use by qualified organizations in India:

- .ac.in (Academic institutions)
- .edu.in (Educational institutions)
- .res.in (Indian research institutes)
- .ernet.in (Older, for both educational and research institutes)
- .gov.in (Indian government)
- .mil.in (Indian military)

The IN Registry is an autonomous body under the National Internet Exchange of India (NIXI). NIXI is a not-for-profit company registered under Section 25 of the Indian Companies Act, 1956. It was established in 2003 to provide neutral Internet Exchange Point services in the country. It was established with the Internet Service Providers Association of India (ISPAI) to become the operational meeting point of Internet service providers (ISPs) in India. The IN Registry has the responsibilities to maintaining the “.in” top level domain, ensure the operational stability, reliability, and security of “.in”, and implementing Government of India policies with regard to domain names.

The administration of domain names within the .in category was initially overseen by National Center for Software Technology (NCST), a scientific R&D institution under the Ministry of Information Technology. IN Registry took over its role from NCST and Centre for Development of Advanced Computing (C-DAC). IN Registry accredits registrars through an open selection process. End users cannot register “.in” domains from IN Registry. Registrations are handled by IN Registry accredited registrars.

With every domain names being opened, the first concerns are those of trademark owners who fear that they may soon be at the receiving end of cybersquatters. Therefore, in 2005 NIXI implemented a narrow “sunrise” period giving priority to trademark owners 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 16th February, 2005.

When a registrant applies for a domain name registration, or when he asks a Registrar to maintain or renew a domain name registration, the registrant has to represent and warrants:

- a) the statements that the registrant made in the registrant’s application form for registration of domain name are complete and accurate;
- b) to the registrant’s knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;
- c) the registrant is not registering the domain name for an unlawful purpose; and
- d) the registrant will not knowingly use the domain name in violation of any applicable laws or regulations.

Further, it is the registrant’s responsibility to determine whether the registrant’s domain name registration infringes or violates someone else’s rights.

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## 11.5 THE .IN DOMAIN NAME DISPUTE RESOLUTION POLICY

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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.

### 11.5.1 Juridical Basis for INDRP

NIXI enters into standard form contracts with registrars setting out standard terms to be entered into with end users of their services (registrants of domain names). To obtain accreditation, registrars are required to enter into a registrar accreditation agreement, which is largely similar in substance to the Internet Corporation for Assigned Names and Numbers (ICANN) global generic top level domain registrar accreditation agreement. The agreement contains an arbitration clause making it compulsory for a registrar and NIXI to submit disputes to arbitration in India.

The IN Registry has introduced terms and conditions binding all registrants. Registrars are required to attach these terms and conditions to all contracts between registrars and potential registrants. The terms and conditions impose an obligation on registrants to comply with all Indian legislation. The IN Registry also reserves the right to suspend or cancel operation of a domain name if a registrant violates the terms and conditions. The terms and conditions require registrants to submit to a mandatory arbitration proceeding under the “.in” Dispute Resolution Policy and its Procedure (INDRP).

The registrant is required to submit to a mandatory arbitration proceeding in the event that a complainant files a complaint to the IN Registry, in compliance with this Policy and Rules thereunder.

Proceedings initiated under the INDRP are of a quasi-judicial nature. Therefore, a judgment is enforceable in the same manner as a civil court decree. The contractual provisions that allow cancellation of the domain in the event of an arbitral decision enable the IN Registry to enforce an arbitral award effectively, even in the absence of enforcement of the award in accordance with civil procedure. It should be noted that the INDRP is neither a statute nor an act, and an arbitrator’s status under the INDRP is that of neither a judge nor a judicial officer; he or she has only a limited mandate to adjudicate on the three questions referred to in the policy.

### 11.5.2 Types of Disputes that could be Brought within INDRP

Any person who considers that a registered domain name conflicts with his legitimate rights or interests may file a complaint to the .IN Registry. The premises which a complaint could be filed are:

- i) the registrant’s domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights;
- ii) the registrant has no rights or legitimate interests in respect of the domain name; and
- iii) the registrant’s domain name has been registered or is being used in bad faith.

A domain name shall be considered to have been registered or used in bad faith in the following circumstances:

- i) circumstances indicating that the registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or
- ii) 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; or
- iii) by using the domain name, the registrant has intentionally attempted to attract Internet users to the registrant's website or other on-line location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location.

It is to be noted that the above stated circumstances are only inclusive in nature and not exhaustive. That means the arbitrator could take into account other relevant circumstances as well.

### **11.5.3 Remedies Available under INDRP Proceedings**

The remedies available to a complainant pursuant to any proceeding before an arbitrator are limited to requiring the cancellation of the registrant's domain name or the transfer of the registrant's domain name registration to the complainant. The arbitrator is also entitled to award costs as may be deemed fit by him. This is contract with the proceedings under UDRP where no monetary damages or costs could be awarded.

The registrant cannot transfer a domain name registration to another holder:

- i) In case an arbitration proceeding is initiated pursuant to this policy, for a period of fifteen working days after such proceeding is concluded; or
- ii) During a pending court proceeding or arbitration commenced regarding the domain name, unless the party to whom the domain name registration is being transferred agrees, in writing, to be bound by the decision of the court or arbitrator.

The Registry has the right to cancel any transfer of a domain name registration to another holder that is made in violation of the above stated principle. This provides the losing party to the proceedings to approach another forum of arbitration or to go to a court of law.

Interim Relief is also available under Section 17(1) of the Arbitration and Conciliation Act, 1996, at the request of either party to be ordered by the Arbitral Tribunal if considered necessary in respect of the subject matter of the dispute. This is in contract to the proceedings under UDRP where no interim relief is possible.

**Self Assessment Question**

**(Spend 3 minutes)**

2) What are the remedies available under INDRP proceedings?

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**11.5.4 Cost of Proceedings**

Except as otherwise stated in this policy or the Rules hereunder, all fees charged by the .IN Registry in connection with any dispute pursuant to this Policy shall be paid by the Complainant. The current fees are as follows:

- .IN Registry's Administration Fee Rs. 1,000/-
- Arbitrator's Fee Rs. 9,000/-
- For personal hearing Rs. 2,000/- per hearing. Maximum two hearings

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**11.6 PROCEDURE OF DISPUTE RESOLUTION UNDER INDRP**

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**11.6.1 How to File a Complaint under INDRP?**

A separate complaint is required to be filed for dispute relating to each domain name. The complaint and the annexures attached to it have to be submitted in hard copy and as far as possible in electronic form also. This is in contrast with the UDRP where a complaint has to be made in electronic form only. The complaint must incorporate the following:

- i) A request that the complaint be submitted to arbitration in accordance with the INDRP and the Rules framed thereunder.
- ii) state the name, postal and e-mail addresses, and the telephone and facsimile numbers of the complainant and of any representative authorised to act for the complainant in the arbitration proceeding and also specify a preferred method of communication to it i.e. by email, postal mail or facsimile.
- iii) provide the name of the respondent and all information (including any postal and e-mail addresses and telephone and facsimile numbers) known to the complainant regarding how to contact the respondent including contact information based on any pre-complaint dealings, to allow the .IN Registry to send the complaint to the respondent.
- iv) specify the domain name which is the subject of the complaint;
- v) specify the trademark(s) or service mark(s) on which the complaint is based and, for each mark, describe the goods or services, if any, with which the mark is used. The complainant may also separately describe other goods and services with which it intends, at the time the complaint is submitted, to use the mark in the future;

- vi) describe, in accordance with the INDRP, the grounds on which the complaint is made including, in particular: the manner in which the domain name in question is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and why the respondent should be considered as having no rights or legitimate interests in respect of the domain name that is the subject of the complaint; and why the domain name in question should be considered as having been registered and being used in bad faith.
- vii) Specify, in accordance with the INDRP, the remedies sought;
- viii) Identify any other legal proceedings that have been commenced or terminated in connection with or relating to the domain name that is the subject of the complaint;
- ix) Conclude with the following statement followed by the signature of the complainant or its authorized representative:

“The complainant, by submitting the complaint agrees to the settlement of the dispute, regarding the domain name which is the object of the complaint by final and binding arbitration in India in accordance with the Arbitration and Conciliation Act, 1996, the .IN Domain Name Dispute Resolution Policy of .IN Registry; Rules of Procedure and any bye-laws, rules or guidelines framed there under.”

“Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute’s resolution shall be solely against the domain-name holder and waives all such claims and remedies against the .IN REGISTRY, as well as their directors, officers, employees, and agents and the arbitrator who will hear the dispute.

“The complainant by submitting this complaint agrees that the decision of the Arbitrator to be appointed in this matter may be made public and may be published on the website including without limitation other forms of publication of the .IN REGISTRY.”

“Complainant certifies that the information contained in this complaint is to the best of complainant’s knowledge complete and accurate, that this complaint is not being presented for any improper purpose, such as to harass the respondent etc.”

- x) Annex any documentary or other evidence, including a copy of the policy applicable to the domain name in dispute and any trademark or service mark registration upon which the complaint relies, together with a schedule indexing such evidence.

The INDRP does not specifically impose the burden of proof on the complainant. However, in *Monster.com (India) Pvt Ltd v. Domain Leasing Company* an arbitral tribunal held that this omission does not mean that the onus to disprove the complainant’s assertions is on the respondent. Relying on the Evidence Act, 1872, the arbitral tribunal held that the complainant would still have to prove these matters in accordance with the act. It was held in *Jagdish Purohit v. Stephen Koeing* [INDRP/006, 5th July 2006] that the Evidence Act requires a party to prove the facts on which it wishes to rely to obtain a judgment. There also appears

to be no restriction on obtaining *ex parte* orders in cases where the domain name registrant resides outside India and fails to respond to notices sent to the address maintained by the registry.

### 11.6.2 Appointment of Arbitrator

Once a complaint is received by the .IN Registry it appoints an arbitrator out of the list of arbitrators maintained by the registry. Arbitrators are experts who have expertise on computer and/or laws, possess a high sense of professional ethics and are capable of rendering independent and unbiased decisions in domain name disputes. The list of the arbitrators is published online by the .IN Registry on its website: [www.registry.in](http://www.registry.in).

The Arbitrator shall conduct the Arbitration Proceedings in accordance with the Arbitration & Conciliation Act, 1996 as amended from time to time and also in accordance with .IN Dispute Resolution Policy (INDRP) and the INDRP Rules of Procedure.

In order to ensure impartiality and independence of proceedings the INDRP states that the .IN Registry and the registrars shall not participate in the domain name dispute resolution proceedings in any capacity or manner other than providing the information relevant to the registration and use of the domain name upon the request of the arbitrator. Further, neither the Registry nor the registrar shall be liable for any decisions rendered by an arbitrator. All decisions under INDRP are published in full on the Internet, except when an arbitration panel decides in an exceptional case to edit portions of its decision.

<b>Self Assessment Question</b>	<b>(Spend 3 minutes)</b>
3) How is an arbitrator appointed?	
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### 11.6.3 How the Registrant could Defend Himself?

The following factors could be proved by the registrant which will go to establish his legitimate interest or right in the domain name:

- i) before any notice to the registrant of the dispute, the registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;
- ii) the registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the registrant has acquired no trademark or service mark rights; or

- iii) 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.

In other words, if the registrant is able to prove the presence of above circumstances then he has the right to retain the domain name. It is to be noted that the above stated circumstances are only inclusive in nature and not exhaustive. That means the arbitrator could take into account other relevant circumstances as well.

#### 11.6.4 Dispute Resolution by Arbitrator

The .IN Registry on receipt of the prescribed fees, forward the complaint to the respondent, within three working days if it is found in accordance with the INDRP and its Rules of Procedure. If the .IN Registry finds the complaint to be not in accordance with the INDRP and the Rules of Procedure, it will within three working days notify the complainant of the deficiencies identified. The complainant will then have five working days within which to correct any such deficiencies, failing which the arbitration proceeding will be deemed withdrawn without prejudice to submission of another complaint by the complainant in respect of the same domain name.

The .IN Registry on receipt of the complaint after correction of the deficiencies shall appoint an arbitrator from the list of arbitrators and forward the complaint and documents to the respondent and to the arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, Rules framed there under, Dispute Resolution Policy & rules framed thereunder. The date of commencement of the arbitration proceeding will be the date on which the arbitrator issues notice to the respondent.

Once the arbitrator is appointed the .IN Registry notifies the parties of the arbitrator appointed. Within three days from the receipt of the complaint the arbitrator has to issue a notice to the respondent. Once the arbitrator has reached a reasoned award he must forward a copy of it immediately to the complainant, respondent and the .IN Registry. The award is passed within sixty days from the date of commencement of arbitration proceeding. In exceptional circumstances this period may be extended by the arbitrator maximum for thirty days. However, the arbitrator must give the reasons in writing for such extension. Within five working days after receiving the decision from the arbitrator, the .IN Registry will communicate the full text of the decision to each party and also communicates to each party, the date for the implementation of the decision.

In *Bloomberg Finance L.P., (BF) v. Kanhan Vijay* [Case No.INDRP/110, 08.09.2009], the domain name in question was *www.bloomberg.net.in* which was registered by the respondent. The complainant Bloomberg Finance L.P. was the registered proprietor of the services mark BLOOMBERG in India and abroad, with rights from 1986 as a trademark, trade name and corporate identity establishing widespread reputation and goodwill. The complainant had registered various domain names under .in ccTLDs incorporating "Bloomberg" as the name and is therefore was the prior adopter, user and registrant. The respondent represented a firm "Bloomberg Computers" which had no association with the complainant Bloomberg Finance and had no reason to adopt or register *www.bloomberg.net.in* as domain name subsequent in time to the complainants

various domain registrations with the name "Bloomberg". The arbitrator held that the respondent's had registered the said domain name in bad faith intent stating that there was a lack of due diligence or evidence on the part of the respondent towards their claims and that the domain was to be transferred to the complainant accordingly.

In *Sony Ericsson Mobile Communications AB v. Chen Shenglu* [2006 (33) PTC 597 NIXI] the complainant, Sony Ericsson Mobile Communications AB filed a complaint with NIXI against Chen Shenglu of China, who had registered 'www.sonyericsson.co.in' as a domain name. Sony Ericsson is the business name and trademark of the complainant and it had also registered many combinations of domain names under the name "Sony Ericsson". The complainant argued that it operates retail outlets in India and has an established reputation under the trademark SONY ERICSSON, therefore, registration of the domain name 'www.sonyericsson.co.in' by the respondent would cause confusion among consumers and would be detrimental to its business. It also contended that the respondent had no right or legitimate interest in the domain name and had registered it in bad faith. However, the respondent contended that the service he provides (ie, classified internet content of a navigating and search service providing information about travel, books, business and education) gives him a legitimate interest in the domain name.

The arbitrator found that the respondent had failed to give any explanation of how he conceived of or hit upon the domain name 'www.sonyericsson.co.in'. Neither his name nor the name of any of his companies or organizations contains the words 'Sony' or 'Ericsson'. The panel found that Sony Ericsson had thus discharged its onus in establishing its proprietary rights in the mark and name SONY ERICSSON on account of having priority in adoption, use and registration. It held that the domain name 'www.sonyericsson.co.in' as registered by the respondent was identical and confusingly similar to the trademark, trade name, service mark and domain names of the complainant.

The arbitrator stated that: "There is sufficient evidence to conclude that the respondent registered the domain name in bad faith and has made active use of the domain name on account of bad-faith registration and under the circumstances of this case." The arbitrator, thus, directed that the domain name 'www.sonyericsson.co.in' be transferred to the complainant.

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## 11.7 SUMMARY

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- When a dispute over a domain name occurs the parties can always approach the courts.
- The cause of action for dispute resolution would be primarily one in passing off or trademark infringement, depending on whether the trademark was registered or not.
- Courts have tried to address the domain name disputes with injunctions, domain name transfers and damages under the laws of trademarks and passing off.
- The first difficulty is of detecting the wrong or of serving the defendants.

- 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.
- The terms and conditions require registrants to submit to a mandatory arbitration proceeding under the “.in” Dispute Resolution Policy and its Procedure (INDRP).
- Proceedings initiated under the INDRP are of a quasi-judicial nature.
- The remedies available to a complainant pursuant to any proceeding before an arbitrator are limited to requiring the cancellation of the registrant’s domain name or the transfer of the registrant’s domain name registration to the complainant.
- All fees charged by the .IN Registry in connection with any dispute pursuant to this Policy are to be paid by the Complainant.

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## 11.8 TERMINAL QUESTIONS

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- 1) How domain name disputes could be resolved by the courts?
- 2) Which laws are applicable for domain name dispute resolution through courts?
- 3) What remedies are available through courts in domain name cases?
- 4) How could domain name disputes concerning .in ccTLD be resolved through arbitration?
- 5) What are the salient features of INDRP?
- 6) What is the procedure of filing a complaint under INDRP?

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## 11.9 ANSWERS AND HINTS

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### Self Assessment Questions

- 1) Refer to Sub-section 11.3.2
- 2) Refer to Sub-section 11.5.3
- 3) Refer to Sub-section 11.6.2

### Terminal Questions

- 1) Refer to Sub-section 11.3.2
- 2) Refer to Sub-section 11.3.1
- 3) Refer to Sub-section 11.3.2
- 4) Refer to Sub-section 11.6.4
- 5) Refer to Section 11.5
- 6) Refer to Section 11.6

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# UNIT 12 DOMAIN NAME DISPUTE RESOLUTION-II

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## Structure

- 12.1 Introduction to ICANN'S UDRP
- 12.2 Objectives
- 12.3 Uniform Domain Name Dispute Resolution Policy
  - 12.3.1 What is UDRP
  - 12.3.2 Reasons behind Adopting UDRP
  - 12.3.3 Juridical Basis of UDRP
  - 12.3.4 Types of Disputes that may be brought within UDRP
- 12.4 Procedure under UDRP
  - 12.4.1 Criteria for Demonstration of Bad Faith Registration
  - 12.4.2 Dispute Resolution Providers
  - 12.4.3 Filing a Complaint
  - 12.4.4 Response to the Complaint by the Domain Name Registrant
  - 12.4.5 The Role of the Administrative Panel in Deciding the Dispute
  - 12.4.6 Cost of UDRP Proceedings
  - 12.4.7 Language of Proceedings under UDRP
- 12.5 Comparison between UDRP and Court Litigation
  - 12.5.1 Scope of Proceedings
  - 12.5.2 Nationality of Proceedings
  - 12.5.3 Time taken in Proceedings
  - 12.5.4 Cost of Proceedings
  - 12.5.5 Outcome of Proceedings
  - 12.5.6 Finality and Enforcement
  - 12.5.7 Procedure of Proceedings
- 12.6 Judicial Review of UDRP Decisions
- 12.7 Summary
- 12.8 Terminal Questions
- 12.9 Answers and Hints
- Appendix

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## 12.1 INTRODUCTION

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The Internet Corporation for Assigned Names and Numbers (ICANN) was formed as a non-profit entity in 1998 and is charged with administering the Internet's addressing systems, including the domain name system. Because of various difficulties in resolving domain name disputes through the traditional litigation route, ICANN adopted the Uniform Domain Name Dispute Resolution Policy (UDRP) on 24<sup>th</sup> of October, 1999. The policy offers an expedited administrative proceeding for rights holders to contest "abusive registrations of domain names", and may result in the cancellation, suspension or transfer of a domain name by the registrar. The UDRP by design is a streamlined method of resolving disputes quickly and inexpensively.

The UDRP explains what trademark owners have to prove in order to take a domain name away from the holder, as well as what domain name holders can use to show that they should be allowed to keep the domain registration. The UDRP Rules outline the actual process for filing a complaint and for responding to a complaint. The Policy and the Rules also explain some of the basics of the proceedings, such as how to choose a dispute resolution provider, how panels make their decisions, how the parties are notified of the outcome, what language will be used in the proceeding, the availability and effect of court proceedings, and the types of remedies available. Apart from discussing these issues, this unit also highlights various important cases decided under the UDRP.

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## **12.2 OBJECTIVES**

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After studying this unit, you should be able to:

- explain the system of dispute resolution through arbitration;
- explain the objectives of UDRP;
- know which disputes are covered by UDRP;
- discuss the procedure of filing complaints and responses under UDRP;
- appreciate the process of dispute resolution under UDRP; and
- appreciate some of the actual cases decided under the UDRP.

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## **12.3 UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY**

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### **12.3.1 What is UDRP?**

UDRP is an online procedure for resolving complaints made by trademark owners about domain names. It sets out the legal framework for the resolution of disputes between a domain name registrant and a third party over abusive registration or use of an internet domain name. UDRP proceedings are not court proceedings; they are similar to arbitration. For a trademark owner the UDRP could provide a faster, cheaper, and easier alternative to filling the complaint before a court of law. UDRP is applicable for resolving generic top level domain (gTLD) disputes. In addition to that many ccTLDs have also subscribed to the UDRP.

### **12.3.2 Reasons behind Adopting UDRP**

The Internet grew rapidly over the last fifteen years as a place to do business. Websites and business identifiers, i.e. 'domain names' became extremely important in doing business on the Internet which came to be known as e-commerce which gained momentum without the existence of any international legal standards to resolve domain name disputes. The increase in domain name disputes was proportional to the growth of e-commerce. The situation was marked by national laws which were diverse from an international point of view. Further, the issue of domain name dispute resolution was by definition international in nature and national laws were considered ill-equipped to handle it. Resort could be had to an international treaty, however, the process of negotiating a new international treaty was considered too slow. ICANN, as overall administrator of domain name system, was in urgent need of a solution to the dispute resolution problem.

The need was internationally uniform and mandatory procedures to deal with disputes which were frequently cross-border. With the support of its member States, WIPO (World Intellectual Property Organisation) which is an international organisation mandated to promote the protection of intellectual property worldwide - conducted extensive consultations with members of the Internet community around the world, after which it prepared and published a report containing recommendations dealing with domain name issues. The UDRP is based on recommendations made by WIPO in the Report on the First WIPO Internet Domain Name Process, focusing on the problems caused by the conflict between trademarks and domain names. A number of further issues identified in that Report that were considered to be outside the scope of the First WIPO Process have been addressed in the subsequent Report of the Second WIPO Internet Domain Name Process. The UDRP was made applicable for all ICANN-accredited registrars of Internet domain names.

### 12.3.3 Juridical Basis of UDRP

As the de facto accrediting agency for domain name registrars, ICANN also has the power to set forth the terms under which registrars may operate. In particular, ICANN directs accredited registrars to require domain name registrants to submit to the UDRP. Under the standard dispute clause of the Terms and Conditions for the registration of a gTLD domain name, the registrant also must submit to such proceedings. By virtue of the incorporation of the UDRP into the registration agreement, the registrant submits itself to the jurisdiction of the approved dispute resolution providers and binds itself to the UDRP. For example, Clause 8 of NSI's registration agreement states that "if you reserved or registered a domain name through us, you agree to be bound by our current domain name dispute policy that is incorporated herein and made a part of this Agreement by reference. Further Clause 10 provides that "your use of our domain name registration services is challenged by a third party, you will be subject to the provisions specified in our dispute policy in effect at the time of the dispute".

As registrant of a domain name one becomes bound by ICANN's UDRP when one registers the domain name. The Registration Agreement incorporates the UDRP. Therefore, if the registrant's domain name is later challenged, he must submit to a "mandatory administrative proceeding" to determine rights to the domain name. It does not matter whether the trademark owner and domain name holder live in different countries. The domain registrar (from whom the registrant obtained the domain name) has the power and obligation to enforce the decision take under UDRP. If the registrant refuses to participate, the proceeding may continue without him and his domain could be cancelled or transferred without his input.

The panel decisions are mandatory in the sense that accredited registrars are bound to take the necessary steps to enforce a decision, such as transferring the name concerned. However, under the UDRP, either party retains the option to take the dispute to a court of competent jurisdiction for independent resolution. In practice, this is a relatively rare occurrence. In this sense, participation in UDRP proceedings is mandatory for domain name registrants, but optional for trademark owners (as they are not bound by contracts with domain name registrars), who may choose to take their trademark or related claims directly to court.

### 12.3.4 Types of Disputes that may be brought within UDRP

The UDRP currently applies to all top-level domains, i.e. aero, .asia, .biz, .cat, .com, .coop, .info, .jobs, .mobi, .museum, .name, .net, .org, .pro, .tel and .travel and some country code top-level domains. When a registrant chooses a domain name, the registrant must “represent and warrant,” among other things, that registering the name “will not infringe upon or otherwise violate the rights of any third party,” and agree to participate in an arbitration-like proceeding should any third party assert such a claim.

The UDRP is primarily intended to deter abusive domain name registration practices, not punish ordinary domain name holders who register, for example, a family name for the purpose of putting family news and pictures online or to prevent people with a legitimate business from registering a name they are commonly known by and then offering bona fide goods and services online.

**Self Assessment Question**

**(Spend 3 minutes)**

1) What is UDRP; define.

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## 12.4 PROCEDURE UNDER UDRP

In the event that a trademark holder considers that a domain name registration infringes on its trademark, it may initiate a proceeding under the UDRP.

Under the UDRP, a complainant is required to file a “complaint” with a “Dispute Resolution Service Provider” approved by ICANN. Each of these providers in turn have their own set of supplemental rules which have to be adhered to by a complainant who opts for that particular provider. Further, each provider has its own list of panelists from which either one or three are chosen to decide a particular dispute.

The UDRP permits complainants to file a case with any one of the resolution service provider. The complainant has to specify, mainly:

- the domain name in question,
- the respondent or holder of the domain name,
- the registrar with whom the domain name was registered, and
- the grounds for the complaint.

Such grounds include, as their central criteria,

- the way in which the domain name is identical or similar to a trademark to which the complainant has rights;

- why the respondent should be considered as having no rights or legitimate interests in respect of the domain name that is the subject of the complaint; and
- why the domain name should be considered as having been registered and used in bad faith.

The panel decides the case on the base of these criteria, which are cumulative.

According to UDRP, by applying to register or renew a domain name, the registrant has to declare that:

- a) the statements that the registrant made in the Registration Agreement are complete and accurate;
- b) to the registrant's knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;
- c) the registrant is not registering the domain name for an unlawful purpose; and
- d) the registrant will not knowingly use the domain name in violation of any applicable laws or regulations.

However, the registrant cannot be expected to look up trademark registrations around the world or research legal issues like common law trademark rights. That's why the UDRP requires the trademark owner (the complainant) to prove bad faith and why the UDRP offers domain name holders the opportunity to demonstrate that they have rights or legitimate interests in the domain name.

It is true that as long as the registrant has registered and used the domain name in good faith or have legitimate interests in the domain name, he should not be disturbed. However, the registrant has no right to violate trademark law, or ignore the Registration Agreement, or engage in cybersquatting just because he registered the domain name first.

#### **12.4.1 Criteria for Demonstration of Bad Faith Registration**

A trademark owner can show that a domain name was registered and used in bad faith in a variety of ways, including by showing that the domain name owner:

- registered the name primarily for the purpose of selling or transferring the domain name to the trademark owner or a competitor of the trademark owner for a price greater than out of pocket costs;
- engaged in a pattern of registering trademarks of others to prevent the use of the domain name by the trademark owner;
- registered the domain name primarily to disrupt the business of a competitor; or
- is attempting to attract users to a web site for commercial gain by creating a likelihood of confusion with the trademark owner's trademark.

The factors stated above are, however, merely inclusive and the dispute resolution panel has the discretion to rely upon other factors to determine 'bad faith', such as the fact that the registrant of the domain name has provided false contact details to the registrar with a view to ensuring that no legal notice could be served on him. In *Zwack Unicum Rt. v. Erica J. Duna* [Case No. D2000 0037],

wherein it was held that hyperlinking from the respondent's disputed domain name address to the complainant's competitor's home page was held to indicate bad faith.

In *Tata Sons Ltd. v. The Advanced Information Technology Association* [Case No. D2000-0049], the WIPO Administrative Panel instructed Network Solutions Inc. (NSI) to transfer the impugned domain name tata.org to the complainant, namely Tata Sons Ltd. The panelist relied on, *inter alia*, the decisions that had been earlier given in favour of the complainant by the Indian courts providing protection to the trademark TATA from abusive registration. The panel held that the fact that the respondent had not even activated its Web site was indicative of bad faith.

In *Oberoi Hotels Pvt. Ltd. v. Arun Jose* [Case No. D 2000-0263], the complainant was Oberoi Hotels, which owned the trademarks "TRIDENT" and "TRIDENT HOTELS" in India. The complainant proved that it had common law rights in many other jurisdictions. The respondent argued that the complainant had no rights in respect of the said trademark and contended that it intended to acquire hotels in future. The panel held that the use of the word "TRIDENT" in combination with the word "hotels" has a certain distinctive character as it is indicative in the ordinary language of a chain of hotels such as the complainant's group. Thus, it was inconceivable that the respondent may have planned to establish a hotel known as TRIDENT or THE TRIDENT HOTEL. Further, the use of the plural in the domain name 'tridenthotels.com' signifies that the domain name was intended to be used for a chain of hotels. This, in the view of the panel was indicative of bad faith. Further, the respondent had not given any explanation as to how he came to decide on the domain name.

In *Steinway, Inc. v. Carey Simon Steinway, Inc.* [Claim Number: FA1004001318229, 2010], the acclaimed manufacturer of pianos, lost a cybersquatting action to recover the domain name www.american-steinway.com. While the cybersquatting panel found that Steinway had a trademark registration for the STEINWAY, the panel also found that the registrant of the domain name had been in the business of buying, restoring, and selling Steinway pianos for several years, and had used the domain name in its nominative sense. Therefore, the panel found that the registrant had rights in the STEINWAY mark and did not use the domain name in bad faith. Thus, the panel denied Steinway's claim.

#### 12.4.2 Dispute Resolution Providers

Complaints under the UDRP may be submitted to any approved dispute-resolution service provider listed below:

- 1) Asian Domain Name Dispute Resolution Centre
- 2) National Arbitration Forum
- 3) World Intellectual Property Organisation (WIPO)
- 4) The Czech Arbitration Court Arbitration Center for Internet Disputes

Each provider follows the Rules for UDRP as well as its own supplemental rules. WIPO is the leading dispute resolution service provider. About 60 percent of all the cases filed under the UDRP have been filed with WIPO. Additionally, a growing number of registrars of country code top-level domains have designated WIPO as a dispute resolution service provider.

**Self Assessment Question**

**(Spend 3 minutes)**

2) What is a dispute resolution service provider?

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**12.4.3 Filing a Complaint**

A UDRP complaint may be submitted to any of the accredited dispute resolution providers. A single complaint may be filed in respect of single or multiple domain names so long as the person or entity that has registered the domain names in question is the same. The complaint including any annexes shall be submitted in electronic form and shall:

- Provide the name, postal and e-mail addresses, and the telephone and telefax numbers of the complainant and of any representative authorized to act for the complainant in the administrative proceeding;
- Specify a preferred method for communications directed to the complainant in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy (where applicable);
- Designate whether complainant elects to have the dispute decided by a single-member or a three-member panel and, in the event complainant elects a three-member panel, provide the names and contact details of three candidates to serve as one of the panellists (these candidates may be drawn from any ICANN-approved provider's list of panellists);
- Provide the name of the respondent (domain-name holder) and all information (including any postal and e-mail addresses and telephone and telefax numbers) known to complainant regarding how to contact respondent or any representative of respondent, including contact information based on pre-complaint dealings, in sufficient detail;
- Specify the domain name(s) that is/are the subject of the complaint;
- Identify the registrar(s) with whom the domain name(s) is/are registered at the time the complaint is filed;
- Specify the trademark(s) or service mark(s) on which the complaint is based and, for each mark, describe the goods or services, if any, with which the mark is used. Complainant may also separately describe other goods and services with which it intends, at the time the complaint is submitted, to use the mark in the future.;
- Describe, in accordance with UDRP, the grounds on which the complaint is made

- Specify the remedies sought;
- Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint;
- State that complainant will submit, with respect to any challenges to a decision in the administrative proceeding cancelling or transferring the domain name, to the jurisdiction of the courts in at least one specified mutual jurisdiction;
- Conclude with the following statement followed by the signature (in any electronic format) of the complainant or its authorized representative:

“Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute’s resolution shall be solely against the domain-name holder and waives all such claims and remedies against (a) the dispute-resolution provider and panelists, except in the case of deliberate wrongdoing, (b) the registrar, (c) the registry administrator, and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.”

“Complainant certifies that the information contained in this Complaint is to the best of Complainant’s knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.”;

- Annex any documentary or other evidence, including a copy of the policy applicable to the domain name(s) in dispute and any trademark or service mark registration upon which the complaint relies, together with a schedule indexing such evidence.

#### **12.4.4 Response to the Complaint by the Domain Name Registrant**

It is mandatory for the domain name registrant to file a response within twenty days of receiving a copy of complaint. If the respondent fails to file his response, he shall be considered in default and the proceedings shall continue *ex parte*, i.e. the panelist will decide the case with the material that would be available with him. The response, including any annexes, shall be submitted in electronic form and shall:

- Respond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain-name holder) to retain registration and use of the disputed domain name;
- Provide the name, postal and e-mail addresses, and the telephone and telefax numbers of the respondent (domain-name holder) and of any representative authorized to act for the respondent in the administrative proceeding;
- Specify a preferred method for communications directed to the respondent in the administrative proceeding (including person to be contacted, medium,

and address information) for each of (A) electronic-only material and (B) material including hard copy (where applicable);

- If complainant has elected a single-member panel in the complaint, state whether respondent elects instead to have the dispute decided by a three-member panel;
- If either complainant or respondent elects a three-member panel, provide the names and contact details of three candidates to serve as one of the panelists (these candidates may be drawn from any ICANN-approved Provider's list of panelists);
- Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint;
- State that a copy of the response including any annexes has been sent or transmitted to the complainant; and
- Conclude with the following statement followed by the signature (in any electronic format) of the respondent or its authorized representative:

“Respondent certifies that the information contained in this Response is to the best of Respondent's knowledge complete and accurate, that this Response is not being presented for any improper purpose, such as to harass, and that the assertions in this Response are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.”;

- Annex any documentary or other evidence upon which the Respondent relies, together with a schedule indexing such documents.

Through the response the respondent is offered the opportunity to defend itself against the allegations made by the complainant. Among the ways that a domain name owner can prove a legitimate right or interest in a domain name is by showing:

- use or preparations to use the domain name in connection with a bona fide offering of goods or services prior to any notice of the dispute;
- that the domain name owner has been commonly known by the second level domain name; or
- that the domain name owner is making legitimate noncommercial or fair use of the domain name, without intent of (i) commercial gain, (ii) misleadingly diverting consumers, or (iii) tarnishing the trademark at issue

Apart from the above stated four factors, the UDRP allows the panelists to determine other circumstances of rights or legitimate interests on a case-by-case basis.

The complainant and the respondent may take help by referring to decided cases which are available online. Decisions of all the dispute resolution providers are posted online as soon as the parties to the dispute have been notified of the

decision. Under the UDRP it is not mandatory to engage a lawyer for preparing or submitting complaint or response. However, assistance of a lawyer may be helpful in certain cases.

#### 12.4.5 The Role of the Administrative Panel in Deciding the Dispute

A resolution provider's role in the dispute process is administrative. It assists the communications between the parties and, taking into account the specific circumstances of each dispute such as the nationality of the parties and the language of the proceedings. It appoints an expert panelist to review the dispute and issue a decision. These panelists are selected from a roster of independent individuals qualified for deciding such cases. Either party to the dispute may opt to have one or three panelists assigned to the case.

UDRP disputes are decided by a panel comprised of one or three members; unless one of the parties elects a three-member panel, a single panelist is appointed. Each provider maintains a list of qualified panelists, and the sole or lead panelist is selected from the provider's list of panelists. Panelists must confirm to the dispute resolution provider the absence of any potential conflict of interest before taking a case, as well as disclose in a written statement any and all facts that should be considered prior to appointment. The dispute resolution providers make an effort to ensure impartiality and credibility.

Where a three-member panel is to be appointed, each party may nominate prospective panelists drawn from any provider's list, and the provider administering the proceeding will attempt to appoint a panelist nominated by each party. The panelists generally are experienced intellectual property attorneys, academics, or retired judges. The panel is instructed to decide the dispute on the basis of the statements and documents submitted, applying any rules of law that it deems applicable.

UDRP panelists are expected to write reasoned opinions describing their decisions. The panel's decision is communicated to the parties and subsequently published on the provider's Web site. If the panel orders that a domain name be transferred or cancelled, the domain name registrar ordinarily will implement that order after ten business days have passed.

If the trademark owner successfully proves his case in the administrative proceeding, then the domain name can either be cancelled or transferred to the prevailing trademark owner. If the trademark owner fails to prove one of these points, the administrative panel will not cancel nor transfer the domain name.

A perusal of the cases decided under UDRP shows that these cases relate to the practices of cyber squatting. These cases are mostly straightforward and relatively easy to decide. Some of the well known domain name cases are discussed below:

***World Wrestling Federation, Inc. v. Bosman*** [Case No. D99-0001, WIPO] was the first case to have been decided by WIPO. The domain name registrant offered to sell the domain name in question – i.e. [www.worldwrestlingfederation.com](http://www.worldwrestlingfederation.com) to the complainant i.e. the World Wrestling Federation. The panel inferred 'bad faith' and thus ordered the transfer of the domain name to the World Wrestling Federation. In this case, the Panel resolved that an offer to sell amounts to "use"

of the domain name, even if that offer constitutes the respondent's only use of the name. In short, an offer alone may constitute "use" sufficient to merit a finding of bad faith—a finding cited as authority in numerous subsequent cases.

In *Bennett Coleman & Co Ltd. v. Long Distance Telephone Company* [Case No 2000-0015, WIPO], the complainant was the publisher of the famous The Times of India newspaper. The dispute was regarding the domain name "thetimesofindia.com" which had been registered by the respondent and the complainant held the domain name "timesofindia.com". The contention centred on the point of incorporation of the article "THE" at the beginning, the panelist held that their registration and use of the domain names were in bad faith. Hence the said domain names were transferred to the complainant. Another important fact was that the respondent's websites using the domain names in contention redirect the users to a different website [www.indiaheadlines.com](http://www.indiaheadlines.com) which provided India related news.

In January 2003, *Maruti Udyog* had filed an arbitral complaint with WIPO alleging that Mr Tella's domain name infringed Maruti's trademark, 'MARUTI' and, hence, had the right to the domain name. The complainant, Mr Tella said that his use of the domain name was lawful as the domain was at one point primarily used to post photos of a nephew named Maruti though later he converted the website to an engine portal. Mr Tella earned revenues from the site through an affiliated website that paid him every time someone clicked on [www.maruti.com](http://www.maruti.com) to reach the affiliated Web site. However, Mr Tella is known to be a cyber squatter with a history of registering websites having the names of trademarked companies. The panel decided the case in favour of the complainant.

In May 2001 Osho Dhyam Mandir, an Osho Meditation centre based in New Delhi, India won the right to use the name of Osho for its portal [www.oshoworld.com](http://www.oshoworld.com). The complainant alleged that the respondents domain name 'OSHOWORLD.com' is confusingly similar/identical to the complainants domain names 'OSHO.com', 'OSHO.net' and 'OSHO.org'. Further, by using the domain name 'OSHOWORLD.com' that is in confusion with complainant's trademarks, the complainants have intentionally and in bad faith attempted to acquire financial gain by attracting Internet users to its website and other on-line locations. The Arbitrator M. Kellery Tillery, appointed by the National Arbitration Forum in his decision observed that: "As this Arbitrator imagines Osho himself might observe, one cannot possess trademark rights in a name/mark of such universal significance which cannot and clearly does not serve as a source indicator or distinguishing moniker for complainant or complainant's goods or services. To grant complainant's request for relief would be to permit virtual monopolization on the Internet by complainant of any domain name which includes the name of a great spiritual teacher and leader." The Arbitrator found that permitting the complainant to do so would be as improper as doing the same with Christianity, Judaism, Islam, Zoroastrianism, Hinduism, Buddhism, Taoism, Confucianism, Shintoism or any of the several hundred other of the world's religions and/or spiritual movements. [Case No. FA0094990, NAF].

In *Tata Sons Ltd v. The Advanced Information Technology Association* [Case No. D2000-0049, WIPO], the dispute was regarding the registration of the domain name "tata.org" by the respondent. The panelist of the WIPO Arbitration and Mediation Center held that the registration of the domain name was a "bad faith

registration” and ordered that the said domain name be transferred to the complainant. In *Tata Sons Ltd v. Ramadasoft* [Case No. D2000-1713, WIPO] the domain names at issue were: tatapowerco.com; tatahyro.com; tatawestside.com; tatahoneywell.com; taatyodogawa.com; tatateleservices.com; tatassl.com; tatatimken.com; jrdata.com; ratantata.com. These domain names were registered with Network Solutions Inc. and the respondents did not submit any response and the panelist noted that the domain names were the names of former chairman and the present chairman who were world-renowned industrialists. Thus the ground of bad faith registration and use was established beyond doubt and all the above said names were transferred to the complainant.

With thousands of cases decided, indeed, the UDRP has in effect given rise to a new system of international common law, with panelists increasingly citing to, and relying upon, previous UDRP decisions. However, UDRP has also attracted criticism and much of it includes claims of bias on the part of panelists or dispute resolution service providers. Courts obviously should disregard findings made by biased decision makers, but the extent of bias in UDRP process may well be exaggerated. Another criticism is that in the overall proceedings, the trademark owner selects the timing and the provider, and has a much greater influence than the domain name registrant over the selection of the panel as well.

<b>Self Assessment Question</b>	<b>(Spend 3 minutes)</b>
3) What is the role of the administrative panel in deciding a dispute?	
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.....	
.....	
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### 12.4.6 Cost of UDRP Proceedings

The costs depend on two criteria, i.e. the number of domain names included in the dispute, and the number of panelists (one or three). The fee consists of an amount to be retained by the dispute resolution provider as an administration fee and an amount to be paid to the panelist(s). In the case of a single member panel the fee, in full, is to be paid by the complainant. If it is a three member panel, requested by the complainant, the fee, in full, is to be paid only by the complainant. In cases of a three member panel requested by the respondent, the fee is split equally between the complainant and the respondent. So, there is no charge to the domain holder, unless he requests a 3-person panel.

For resolution of a case involving one to five domain names, with a single panelist, the current cost is US\$ 1,500; for three panelists, the total cost is US\$ 4,000. For six to ten domain names, the current cost is US\$ 2,000 for a case involving a sole panelist and US\$ 5,000 for a case involving three panelists. These fees do not include any payments that might have to be made to a lawyer or agent representing a party in the arbitration proceedings.

In exceptional circumstances, either the dispute resolution provider or the panel may ask the parties to make additional payments to defray the costs of the administrative proceedings. For example, an exceptional matter could be the requirement of in-person hearing.

#### 12.4.7 Language of Proceedings under UDRP

Unless otherwise agreed by the parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding under UDRP shall be the language of the Registration Agreement, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The dispute resolution panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.

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## 12.5 COMPARISON BETWEEN UDRP AND COURT LITIGATION

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### 12.5.1 Scope of Proceedings

All domain name disputes that could arise are not within the scope of UDRP; in fact the UDRP is intended to cover only a narrow range of domain name disputes. It is restricted to claims of “abusive registration” of a domain name made with the intent to profit from another’s trademark. The UDRP itself contemplates that most domain name disputes, including all “legitimate” disputes, are beyond its scope. UDRP leaves the resolution of disputes to the courts or other arbitrators and calls for registrars not to disturb a registration until those fora decide.

A legal action in a court that challenges a UDRP decision therefore does so only incidentally to the legal claims that the action involves, claims potentially involving trademark and unfair competition law, contract law, fraud, conversion, privacy and personality rights, free speech, defamation, due process, public policy, and other matters related to the parties’ overarching dispute. The scope of UDRP proceedings is extremely narrow, encompassing only the three elements set forth in the policy:

- identity/similarity to a trademark;
- lack of legitimate interests; and
- bad faith registration/use

While a UDRP panel also has discretion to consider other matters, it is unusual for panels to go far beyond the general principles of trademark law. For example, UDRP panels faced with disputes involving personal or geographic names generally have considered only the trademark rights that may attach to such names. In *Port of Helsinki v. Paragon Int’l Projects Ltd.* [Case No. D2001-0002, WIPO] the domain name in issue was “portofhelsinki.com”. The respondent had also registered over 50 ‘portof’ prefixed domain names. The respondent’s case was that the domain name in issue was part of its ‘portof.com’ network containing about twenty three sites on-line with more than two hundred additional ones to follow as part of the respondent’s global plan to launch a comprehensive search engine for the shipping industry. The panel rejected the complaint on the basis

that the complainant Helsinki Port Authority had no trademark rights in the denomination PORT OF HELSINKI. The Panel stated: "The Policy consequently does not presently apply to, for instance, conflicts between domain names and geographical indications of signs or symbols that are not supported by trademarks/service marks. The Panel cannot agree with the contention that a unique geographical name should be considered as belonging to the legal authority of the geographical area in question under the Policy." In *Jeanette Winterson v. Mark Hogarth* [Case No. D2000-0235, WIPO], the panel granted relief to the complainant for enforcing her "right of publicity".

Even the application of trademark law is quite narrow in case of UDRP. In other words, the trademark law related questions that arise in UDRP proceedings are very limited in comparison with trademark questions that could arise had the matter been brought before a court. Under the UDRP, for example, a panel is to consider whether the disputed domain name is "identical or confusingly similar" to the complainant's trademark. Trade mark law, on the other hand, imposes liability for the commercial use of a copy or imitation of a registered trademark if the use "is likely to cause confusion." While both standards depend upon the likelihood of confusion, the UDRP makes this determination merely by comparing the domain name with the trademark, whereas the Trademarks Act considers the strength of the mark, the manner in which the mark and the domain name are used, and many other contextual facts. Courts could consider a number of factors in assessing likelihood of confusion, which may include the strength of the mark, similarity of marks, similarity of the goods/services, evidence of actual or potential confusion, marketing channels used, type of goods and the degree of care likely to be exercised by the purchaser, defendant's intent in selecting the mark, and likelihood of expansion of the product/service lines.

### **12.5.2 Nationality of Proceedings**

UDRP is inherently international, or perhaps "anational"—UDRP panels base their decisions on the policy itself, occasionally exercising their discretion to consider legal rules of one or more jurisdictions that seem relevant — while courts apply national or local laws, using formalized choice of law rules to determine what law to apply.

### **12.5.3 Time taken in Proceedings**

Compared to litigation, UDRP is a fast and efficient means of resolving disputes. Unless the domain holder fails to appear in court, a domain name case filed under UDRP is normally concluded within two months, using on-line procedures, whereas litigation can take much longer.

### **12.5.4 Cost of Proceedings**

UDRP proceedings generally cost about \$1500 or \$4000 depending on the number of panelists. Since the dispute resolution providers charge a flat fee and since the costs of hiring a lawyer (if one chooses to use one) will generally be less because the types of documents used in UDRP proceedings require less time to prepare. These fees are much lower than normal litigation when considered from the dollar point of view. However, comparing the UDRP fee with Indian standard it cannot be stated that they are less than expenses incurred under court litigation as many lawyers would be ready to conduct the case in a lesser amount.

### 12.5.5 Outcome of Proceedings

Under UDRP, the relief could be either transfer or cancellation of the domain name in question. However, there are no monetary damages applied in UDRP domain name disputes, and no injunctive relief is available. If one wants injunctive relief and monetary damages, one has to approach the court of law.

### 12.5.6 Finality and Enforcement

Since there is no provision of any appeal from the decision of a panelist under UDRP, it could be said that UDRP procedure provides a greater degree of finality than court proceedings. However, UDRP decisions are not binding in the sense that a losing domain name registrant can block implementation of a cancellation or transfer order by filing a lawsuit following the decision, and a losing trademark owner can resurrect its claim by filing suit or (depending on the panel) merely by filing a second UDRP complaint. In this sense the court proceedings are more final than UDRP.

An important advantage of the UDRP over courts is that courts can only enforce their orders within their own territories. The UDRP can be enforced against all domain holders in gTLDs regardless of where they live.

### 12.5.7 Procedure of Proceedings

UDRP proceedings are conducted almost exclusively via documents and that too online; live hearings being rare or non-existent. In-person hearings (including teleconferences) are permitted only if a panel deems a hearing necessary as an "exceptional matter". However, in person hearings are a hallmark of our court system.

Default proceedings are common under UDRP. In one third to one half of all UDRP cases domain name registrants do not even file a response. In such instances complainants usually prevail. The UDRP procedures are supposed to be simple enough that an average person would not need legal assistance.

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## 12.6 JUDICIAL REVIEW OF UDRP DECISIONS

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Courts normally apply an extremely deferential standard of review to arbitration decisions. However, it is not uncommon for those who lose in arbitration to seek recourse in the courts. Courts can reverse arbitration awards that are arbitrary or capricious, in manifest disregard of the law, or contrary to public policy. However, for the sake of finality, sometimes limitations are placed on judicial review of arbitration awards. Absent such a limitation, a losing party could always appeal to a court.

There is nothing in the UDRP that prevents either the trademark owner or the domain name holder from choosing to go to court before, during, or after the UDRP proceeding. In fact, the UDRP itself clearly contemplates that parties may initiate parallel legal proceedings. Unlike conventional arbitration, the UDRP is not meant to replace litigation, but merely to provide an additional forum for dispute resolution, with an explicit right of appeal to the courts. The only requirement is that the parties have to let the UDRP Panel know if they have begun court action so the Panel can decide whether to postpone the proceeding

or so that the Registrar won't implement the Panel's decision until the court reaches its own decision.

Domain name registrars implement a decision after a period of ten days, unless the decision is appealed in court in that time. So, under UDRP a losing trademark owner can seek a legal remedy at leisure, as an adverse award merely maintains the status quo. A losing domain name registrant, on the other hand, has only ten business days after the decision (and quite possibly less than two months after receiving the initial notice of the dispute) to prepare and file a lawsuit in order to prevent the immediate loss of its domain name.

Relatively few UDRP decisions have been brought to the courts, perhaps because of the high expense of litigation relative to the value of a domain name, or perhaps because trademark owners and domain name registrants believe it would be difficult to convince a court to overturn a UDRP decision.

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## 12.7 SUMMARY

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- UDRP is an online procedure for resolving complaints made by trademark owners about domain names.
- UDRP by design is a streamlined method of resolving disputes quickly and inexpensively.
- Participation in UDRP proceedings is mandatory for domain name registrants, but optional for trademark owners.
- UDRP decisions are not binding; a losing domain name registrant can block implementation of a cancellation or transfer order by filing a lawsuit following the decision, and a losing trademark owner can resurrect its claim by filing suit or (depending on the panel) merely by filing a second UDRP complaint.
- UDRP proceedings are conducted almost exclusively via documents, with live hearings being rare or nonexistent. In-person hearings (including teleconferences) are permitted only if a panel deems a hearing necessary "as an exceptional matter."
- Default proceedings are commonplace; domain name registrants do not even file a response in one third to one half of all UDRP cases.
- UDRP panelists are expected to write reasoned opinions describing their decisions.
- Indeed, the UDRP has in effect given rise to a new system of international common law, with panelists increasingly citing to, and relying upon, previous UDRP decisions.
- Relatively few UDRP decisions have been brought to the courts, perhaps because of the high expense of litigation relative to the value of a domain name, or perhaps because trademark owners and domain name registrants believe it would be difficult to convince a court to overturn a UDRP decision.
- UDRP is intended to cover only a narrow range of domain name disputes: claims of "abusive registration" of a domain name made with the intent to profit from another's trademark; only cases of abusive registrations are intended to be subject to the streamlined administrative dispute-resolution procedure.

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## 12.8 TERMINAL QUESTIONS

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- 1) What is meant by UDRP? What is the procedure for filing a complaint under UDRP?
- 2) Who are dispute resolution providers under UDRP and how do they decide the complaints filed?
- 3) Compare the remedies of arbitration under UDRP and court litigation for domain name dispute resolution. Outline the advantages and disadvantages of each one.
- 4) Is it possible to appeal the decisions of UDRP in courts? If yes, what is the procedure for the same?
- 5) Explain the juridical basis of UDRP. On what basis can we say that UDRP provides for compulsory adjudication of domain name disputes?

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## 12.9 ANSWERS AND HINTS

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### Self Assessment Questions

- 1) Refer to Section 12.3
- 2) Refer to Sub-section 12.4.2
- 3) Refer to Sub-section 12.4.5

### Terminal Questions

- 1) Refer to Section 12.4
- 2) Refer to Section 12.4
- 3) Refer to Section 12.5
- 4) Refer to Section 12.6
- 5) Refer to Section 12.6

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# APPENDIX-I UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

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(As Approved by ICANN on October 24, 1999)

- 1) **Purpose:** This Uniform Domain Name Dispute Resolution Policy (the "Policy") has been adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN"), is incorporated by reference into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you. Proceedings under Paragraph 4 of this Policy will be conducted according to the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules of Procedure"), which are available at [www.icann.org/udrp/udrp-rules-24oct99.htm](http://www.icann.org/udrp/udrp-rules-24oct99.htm), and the selected administrative-dispute-resolution service provider's supplemental rules.
- 2) **Your Representations:** By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights.
- 3) **Cancellations, Transfers, and Changes:** We will cancel, transfer or otherwise make changes to domain name registrations under the following circumstances:
  - a) subject to the provisions of Paragraph 8, our receipt of written or appropriate electronic instructions from you or your authorized agent to take such action;
  - b) our receipt of an order from a court or arbitral tribunal, in each case of competent jurisdiction, requiring such action; and/or
  - c) our receipt of a decision of an Administrative Panel requiring such action in any administrative proceeding to which you were a party and which was conducted under this Policy or a later version of this Policy adopted by ICANN. (See Paragraph 4(i) and (k) below.)

We may also cancel, transfer or otherwise make changes to a domain name registration in accordance with the terms of your Registration Agreement or other legal requirements.

- 4) **Mandatory Administrative Proceeding:** This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one

of the administrative-dispute-resolution service providers listed at [www.icann.org/en/dndr/udrp/approved-providers.htm](http://www.icann.org/en/dndr/udrp/approved-providers.htm) (each, a "Provider").

**a) Applicable Disputes:** You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that

- i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- ii) you have no rights or legitimate interests in respect of the domain name; and
- iii) your domain name has been registered and is being used in bad faith.

In the administrative proceeding, the complainant must prove that each of these three elements are present.

**b) Evidence of Registration and Use in Bad Faith:** For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- ii) you have 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 you have engaged in a pattern of such conduct; or
- iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

**c) How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint:** When you receive a complaint, you should refer to Paragraph 5 of the Rules of Procedure in determining how your response should be prepared. Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
  - ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
  - iii) you are making a legitimate noncommercial 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.
- d) Selection of Provider:** The complainant shall select the Provider from among those approved by ICANN by submitting the complaint to that Provider. The selected Provider will administer the proceeding, except in cases of consolidation as described in Paragraph 4(f).
- e) Initiation of Proceeding and Process and Appointment of Administrative Panel:** The Rules of Procedure state the process for initiating and conducting a proceeding and for appointing the panel that will decide the dispute (the "Administrative Panel").
- f) Consolidation:** In the event of multiple disputes between you and a complainant, either you or the complainant may petition to consolidate the disputes before a single Administrative Panel. This petition shall be made to the first Administrative Panel appointed to hear a pending dispute between the parties. This Administrative Panel may consolidate before it any or all such disputes in its sole discretion, provided that the disputes being consolidated are governed by this Policy or a later version of this Policy adopted by ICANN.
- g) Fees:** All fees charged by a Provider in connection with any dispute before an Administrative Panel pursuant to this Policy shall be paid by the complainant, except in cases where you elect to expand the Administrative Panel from one to three panelists as provided in Paragraph 5(b)(iv) of the Rules of Procedure, in which case all fees will be split evenly by you and the complainant.
- h) Our Involvement in Administrative Proceedings:** We do not, and will not, participate in the administration or conduct of any proceeding before an Administrative Panel. In addition, we will not be liable as a result of any decisions rendered by the Administrative Panel.
- i) Remedies:** The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant.
- j) Notification and Publication:** The Provider shall notify us of any decision made by an Administrative Panel with respect to a domain name you have registered with us. All decisions under this Policy will be published in full over the Internet, except when an Administrative Panel determines in an exceptional case to redact portions of its decision.

- k) **Availability of Court Proceedings:** The mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Panel decides that your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the Administrative Panel's decision before implementing that decision. We will then implement the decision unless we have received from you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted under Paragraph 3(b)(xiii) of the Rules of Procedure. (In general, that jurisdiction is either the location of our principal office or of your address as shown in our Whois database. See Paragraphs 1 and 3(b)(xiii) of the Rules of Procedure for details.) If we receive such documentation within the ten (10) business day period, we will not implement the Administrative Panel's decision, and we will take no further action, until we receive (i) evidence satisfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing your lawsuit or ordering that you do not have the right to continue to use your domain name.
- 5) **All Other Disputes and Litigation:** All other disputes between you and any party other than us regarding your domain name registration that are not brought pursuant to the mandatory administrative proceeding provisions of Paragraph 4 shall be resolved between you and such other party through any court, arbitration or other proceeding that may be available.
- 6) **Our Involvement in Disputes:** We will not participate in any way in any dispute between you and any party other than us regarding the registration and use of your domain name. You shall not name us as a party or otherwise include us in any such proceeding. In the event that we are named as a party in any such proceeding, we reserve the right to raise any and all defenses deemed appropriate, and to take any other action necessary to defend ourselves.
- 7) **Maintaining the Status Quo:** We will not cancel, transfer, activate, deactivate, or otherwise change the status of any domain name registration under this Policy except as provided in Paragraph 3 above.
- 8) **Transfers During a Dispute**
- a) **Transfers of a Domain Name to a New Holder.** You may not transfer your domain name registration to another holder (i) during a pending administrative proceeding brought pursuant to Paragraph 4 or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded; or (ii) during a pending court proceeding or arbitration commenced regarding your

domain name unless the party to whom the domain name registration is being transferred agrees, in writing, to be bound by the decision of the court or arbitrator. We reserve the right to cancel any transfer of a domain name registration to another holder that is made in violation of this subparagraph.

**b) Changing Registrars:** You may not transfer your domain name registration to another registrar during a pending administrative proceeding brought pursuant to Paragraph 4 or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded. You may transfer administration of your domain name registration to another registrar during a pending court action or arbitration, provided that the domain name you have registered with us shall continue to be subject to the proceedings commenced against you in accordance with the terms of this Policy. In the event that you transfer a domain name registration to us during the pendency of a court action or arbitration, such dispute shall remain subject to the domain name dispute policy of the registrar from which the domain name registration was transferred.

**9) Policy Modifications:** We reserve the right to modify this Policy at any time with the permission of ICANN. We will post our revised Policy at least thirty (30) calendar days before it becomes effective. Unless this Policy has already been invoked by the submission of a complaint to a Provider, in which event the version of the Policy in effect at the time it was invoked will apply to you until the dispute is over, all such changes will be binding upon you with respect to any domain name registration dispute, whether the dispute arose before, on or after the effective date of our change. In the event that you object to a change in this Policy, your sole remedy is to cancel your domain name registration with us, provided that you will not be entitled to a refund of any fees you paid to us. The revised Policy will apply to you until you cancel your domain name registration.

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# APPENDIX-II RULES FOR UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (THE "RULES")

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(As approved by the ICANN Board of Directors on 30 October 2009)

Administrative proceedings for the resolution of disputes under the Uniform Dispute Resolution Policy adopted by ICANN shall be governed by these Rules and also the Supplemental Rules of the Provider administering the proceedings, as posted on its web site. To the extent that the Supplemental Rules of any Provider conflict with these Rules, these Rules supersede.

## 1) Definitions

In these Rules:

**Complainant** means the party initiating a complaint concerning a domain-name registration.

ICANN refers to the Internet Corporation for Assigned Names and Numbers.

**Mutual Jurisdiction** means a court jurisdiction at the location of either (a) the principal office of the Registrar (provided the domain-name holder has submitted in its Registration Agreement to that jurisdiction for court adjudication of disputes concerning or arising from the use of the domain name) or (b) the domain-name holder's address as shown for the registration of the domain name in Registrar's Whois database at the time the complaint is submitted to the Provider.

**Panel** means an administrative panel appointed by a Provider to decide a complaint concerning a domain-name registration.

**Panelist** means an individual appointed by a Provider to be a member of a Panel.

**Party** means a Complainant or a Respondent.

**Policy** means the Uniform Domain Name Dispute Resolution Policy that is incorporated by reference and made a part of the Registration Agreement.

**Provider** means a dispute-resolution service provider approved by ICANN. A list of such Providers appears at <http://www.icann.org/en/dndr/udrp/approved-providers.htm>.

**Registrar** means the entity with which the Respondent has registered a domain name that is the subject of a complaint.

**Registration Agreement** means the agreement between a Registrar and a domain-name holder.

**Respondent** means the holder of a domain-name registration against which a complaint is initiated.

**Reverse Domain Name Hijacking** means using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.

**Supplemental Rules** means the rules adopted by the Provider administering a proceeding to supplement these Rules. Supplemental Rules shall not be inconsistent with the Policy or these Rules and shall cover such topics as fees, word and page limits and guidelines, file size and format modalities, the means for communicating with the Provider and the Panel, and the form of cover sheets.

**Written Notice** means hardcopy notification by the Provider to the Respondent of the commencement of an administrative proceeding under the Policy which shall inform the respondent that a complaint has been filed against it, and which shall state that the Provider has electronically transmitted the complaint including any annexes to the Respondent by the means specified herein. Written notice does not include a hardcopy of the complaint itself or of any annexes.

## 2) Communications

- a) When forwarding a complaint, including any annexes, electronically to the Respondent, it shall be the Provider's responsibility to employ reasonably available means calculated to achieve actual notice to Respondent. Achieving actual notice, or employing the following measures to do so, shall discharge this responsibility:
  - i) sending Written Notice of the complaint to all postal-mail and facsimile addresses (A) shown in the domain name's registration data in Registrar's Whois database for the registered domain-name holder, the technical contact, and the administrative contact and (B) supplied by Registrar to the Provider for the registration's billing contact; and
  - ii) sending the complaint, including any annexes, in electronic form by e-mail to:
    - A) the e-mail addresses for those technical, administrative, and billing contacts;
    - B) postmaster@<the contested domain name>; and
    - C) if the domain name (or "www." followed by the domain name) resolves to an active web page (other than a generic page the Provider concludes is maintained by a registrar or ISP for parking domain-names registered by multiple domain-name holders), any e-mail address shown or e-mail links on that web page; and
  - iii) sending the complaint, including any annexes, to any e-mail address the Respondent has notified the Provider it prefers and, to the extent practicable, to all other e-mail addresses provided to the Provider by Complainant under Paragraph 3(b)(v).
- b) Except as provided in Paragraph 2(a), any written communication to Complainant or Respondent provided for under these Rules shall be made electronically via the Internet (a record of its transmission being

available), or by any reasonably requested preferred means stated by the Complainant or Respondent, respectively (see Paragraphs 3(b)(iii) and 5(b)(iii)).

- c) Any communication to the Provider or the Panel shall be made by the means and in the manner (including, where applicable, the number of copies) stated in the Provider's Supplemental Rules.
- d) Communications shall be made in the language prescribed in Paragraph 11.
- e) Either Party may update its contact details by notifying the Provider and the Registrar.
- f) Except as otherwise provided in these Rules, or decided by a Panel, all communications provided for under these Rules shall be deemed to have been made:
  - i) if via the Internet, on the date that the communication was transmitted, provided that the date of transmission is verifiable; or, where applicable
  - ii) if delivered by telecopy or facsimile transmission, on the date shown on the confirmation of transmission; or:
  - iii) if by postal or courier service, on the date marked on the receipt.
- g) Except as otherwise provided in these Rules, all time periods calculated under these Rules to begin when a communication is made shall begin to run on the earliest date that the communication is deemed to have been made in accordance with Paragraph 2(f).
- h) Any communication by
  - i) a Panel to any Party shall be copied to the Provider and to the other Party;
  - ii) the Provider to any Party shall be copied to the other Party; and
  - iii) a Party shall be copied to the other Party, the Panel and the Provider, as the case may be.
- i) It shall be the responsibility of the sender to retain records of the fact and circumstances of sending, which shall be available for inspection by affected parties and for reporting purposes. This includes the Provider in sending Written Notice to the Respondent by post and/or facsimile under Paragraph 2(a)(i).
- j) In the event a Party sending a communication receives notification of non-delivery of the communication, the Party shall promptly notify the Panel (or, if no Panel is yet appointed, the Provider) of the circumstances of the notification. Further proceedings concerning the communication and any response shall be as directed by the Panel (or the Provider).

### 3) The Complaint

- a) Any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules to any Provider approved by ICANN. (Due to capacity constraints or

for other reasons, a Provider's ability to accept complaints may be suspended at times. In that event, the Provider shall refuse the submission. The person or entity may submit the complaint to another Provider.)

- b) The complaint including any annexes shall be submitted in electronic form and shall:
  - i) Request that the complaint be submitted for decision in accordance with the Policy and these Rules;
  - ii) Provide the name, postal and e-mail addresses, and the telephone and telefax numbers of the Complainant and of any representative authorized to act for the Complainant in the administrative proceeding;
  - iii) Specify a preferred method for communications directed to the Complainant in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy (where applicable);
  - iv) Designate whether Complainant elects to have the dispute decided by a single-member or a three-member Panel and, in the event Complainant elects a three-member Panel, provide the names and contact details of three candidates to serve as one of the Panelists (these candidates may be drawn from any ICANN-approved Provider's list of panelists);
  - v) Provide the name of the Respondent (domain-name holder) and all information (including any postal and e-mail addresses and telephone and telefax numbers) known to Complainant regarding how to contact Respondent or any representative of Respondent, including contact information based on pre-complaint dealings, in sufficient detail to allow the Provider to send the complaint as described in Paragraph 2(a);
  - vi) Specify the domain name(s) that is/are the subject of the complaint;
  - vii) Identify the Registrar(s) with whom the domain name(s) is/are registered at the time the complaint is filed;
  - viii) Specify the trademark(s) or service mark(s) on which the complaint is based and, for each mark, describe the goods or services, if any, with which the mark is used (Complainant may also separately describe other goods and services with which it intends, at the time the complaint is submitted, to use the mark in the future.);
  - ix) Describe, in accordance with the Policy, the grounds on which the complaint is made including, in particular,
    - 1) the manner in which the domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

- 2) why the Respondent (domain-name holder) should be considered as having no rights or legitimate interests in respect of the domain name(s) that is/are the subject of the complaint; and
- 3) why the domain name(s) should be considered as having been registered and being used in bad faith

(The description should, for elements (2) and (3), discuss any aspects of Paragraphs 4(b) and 4(c) of the Policy that are applicable. The description shall comply with any word or page limit set forth in the Provider's Supplemental Rules.);

- x) Specify, in accordance with the Policy, the remedies sought;
  - xi) Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint;
  - xii) State that a copy of the complaint, including any annexes, together with the cover sheet as prescribed by the Provider's Supplemental Rules, has been sent or transmitted to the Respondent (domain-name holder), in accordance with Paragraph 2(b);
  - xiii) State that Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the jurisdiction of the courts in at least one specified Mutual Jurisdiction;
  - xiv) Conclude with the following statement followed by the signature (in any electronic format) of the Complainant or its authorized representative:

“Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain-name holder and waives all such claims and remedies against (a) the dispute-resolution provider and panelists, except in the case of deliberate wrongdoing, (b) the registrar, (c) the registry administrator, and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.”

“Complainant certifies that the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.”; and
  - xv) Annex any documentary or other evidence, including a copy of the Policy applicable to the domain name(s) in dispute and any trademark or service mark registration upon which the complaint relies, together with a schedule indexing such evidence.
- c) The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

**4) Notification of Complaint**

- a) The Provider shall review the complaint for administrative compliance with the Policy and these Rules and, if in compliance, shall forward the complaint, including any annexes, electronically to the Respondent and shall send Written Notice of the complaint (together with the explanatory cover sheet prescribed by the Provider's Supplemental Rules) to the Respondent, in the manner prescribed by Paragraph 2(a), within three (3) calendar days following receipt of the fees to be paid by the Complainant in accordance with Paragraph 19.
- b) If the Provider finds the complaint to be administratively deficient, it shall promptly notify the Complainant and the Respondent of the nature of the deficiencies identified. The Complainant shall have five (5) calendar days within which to correct any such deficiencies, after which the administrative proceeding will be deemed withdrawn without prejudice to submission of a different complaint by Complainant.
- c) The date of commencement of the administrative proceeding shall be the date on which the Provider completes its responsibilities under Paragraph 2(a) in connection with sending the complaint to the Respondent.
- d) The Provider shall immediately notify the Complainant, the Respondent, the concerned Registrar(s), and ICANN of the date of commencement of the administrative proceeding.

**5) The Response**

- a) Within twenty (20) days of the date of commencement of the administrative proceeding the Respondent shall submit a response to the Provider.
- b) The response, including any annexes, shall be submitted in electronic form and shall:
  - i) Respond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain-name holder) to retain registration and use of the disputed domain name (This portion of the response shall comply with any word or page limit set forth in the Provider's Supplemental Rules.);
  - ii) Provide the name, postal and e-mail addresses, and the telephone and telefax numbers of the Respondent (domain-name holder) and of any representative authorized to act for the Respondent in the administrative proceeding;
  - iii) Specify a preferred method for communications directed to the Respondent in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy (where applicable);
  - iv) If Complainant has elected a single-member panel in the complaint (see Paragraph 3(b)(iv)), state whether Respondent elects instead to have the dispute decided by a three-member panel;

- v) If either Complainant or Respondent elects a three-member Panel, provide the names and contact details of three candidates to serve as one of the Panelists (these candidates may be drawn from any ICANN-approved Provider's list of panelists);
  - vi) Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint;
  - vii) State that a copy of the response including any annexes has been sent or transmitted to the Complainant, in accordance with Paragraph 2(b); and
  - viii) Conclude with the following statement followed by the signature (in any electronic format) of the Respondent or its authorized representative:

“Respondent certifies that the information contained in this Response is to the best of Respondent's knowledge complete and accurate, that this Response is not being presented for any improper purpose, such as to harass, and that the assertions in this Response are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.”; and
  - ix) Annex any documentary or other evidence upon which the Respondent relies, together with a schedule indexing such documents.
- c) If Complainant has elected to have the dispute decided by a single-member Panel and Respondent elects a three-member Panel, Respondent shall be required to pay one-half of the applicable fee for a three-member Panel as set forth in the Provider's Supplemental Rules. This payment shall be made together with the submission of the response to the Provider. In the event that the required payment is not made, the dispute shall be decided by a single-member Panel.
  - d) At the request of the Respondent, the Provider may, in exceptional cases, extend the period of time for the filing of the response. The period may also be extended by written stipulation between the Parties, provided the stipulation is approved by the Provider.
  - e) If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint.
- 6) Appointment of the Panel and Timing of Decision**
- a) Each Provider shall maintain and publish a publicly available list of panelists and their qualifications.
  - b) If neither the Complainant nor the Respondent has elected a three-member Panel (Paragraphs 3(b)(iv) and 5(b)(iv)), the Provider shall appoint, within five (5) calendar days following receipt of the response by the Provider, or the lapse of the time period for the submission thereof, a single Panelist from its list of panelists. The fees for a single-member Panel shall be paid entirely by the Complainant.

- c) If either the Complainant or the Respondent elects to have the dispute decided by a three-member Panel, the Provider shall appoint three Panelists in accordance with the procedures identified in Paragraph 6(e). The fees for a three-member Panel shall be paid in their entirety by the Complainant, except where the election for a three-member Panel was made by the Respondent, in which case the applicable fees shall be shared equally between the Parties.
- d) Unless it has already elected a three-member Panel, the Complainant shall submit to the Provider, within five (5) calendar days of communication of a response in which the Respondent elects a three-member Panel, the names and contact details of three candidates to serve as one of the Panelists. These candidates may be drawn from any ICANN-approved Provider's list of panelists.
- e) In the event that either the Complainant or the Respondent elects a three-member Panel, the Provider shall endeavor to appoint one Panelist from the list of candidates provided by each of the Complainant and the Respondent. In the event the Provider is unable within five (5) calendar days to secure the appointment of a Panelist on its customary terms from either Party's list of candidates, the Provider shall make that appointment from its list of panelists. The third Panelist shall be appointed by the Provider from a list of five candidates submitted by the Provider to the Parties, the Provider's selection from among the five being made in a manner that reasonably balances the preferences of both Parties, as they may specify to the Provider within five (5) calendar days of the Provider's submission of the five-candidate list to the Parties.
- f) Once the entire Panel is appointed, the Provider shall notify the Parties of the Panelists appointed and the date by which, absent exceptional circumstances, the Panel shall forward its decision on the complaint to the Provider.

**7) Impartiality and Independence**

A Panelist shall be impartial and independent and shall have, before accepting appointment, disclosed to the Provider any circumstances giving rise to justifiable doubt as to the Panelist's impartiality or independence. If, at any stage during the administrative proceeding, new circumstances arise that could give rise to justifiable doubt as to the impartiality or independence of the Panelist, that Panelist shall promptly disclose such circumstances to the Provider. In such event, the Provider shall have the discretion to appoint a substitute Panelist.

**8) Communication Between Parties and the Panel**

No Party or anyone acting on its behalf may have any unilateral communication with the Panel. All communications between a Party and the Panel or the Provider shall be made to a case administrator appointed by the Provider in the manner prescribed in the Provider's Supplemental Rules.

**9) Transmission of the File to the Panel**

The Provider shall forward the file to the Panel as soon as the Panelist is appointed in the case of a Panel consisting of a single member, or as soon as the last Panelist is appointed in the case of a three-member Panel.

#### 10) General Powers of the Panel

- a) The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.
- b) In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.
- c) The Panel shall ensure that the administrative proceeding takes place with due expedition. It may, at the request of a Party or on its own motion, extend, in exceptional cases, a period of time fixed by these Rules or by the Panel.
- d) The Panel shall determine the admissibility, relevance, materiality and weight of the evidence.
- e) A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.

#### 11) Language of Proceedings

- a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.
- b) The Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.

#### 12) Further Statements

In addition to the complaint and the response, the Panel may request, in its sole discretion, further statements or documents from either of the Parties.

#### 13) In-Person Hearings

There shall be no in-person hearings (including hearings by teleconference, videoconference, and web conference), unless the Panel determines, in its sole discretion and as an exceptional matter, that such a hearing is necessary for deciding the complaint.

#### 14) Default

- a) In the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by these Rules or the Panel, the Panel shall proceed to a decision on the complaint.
- b) If a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, these Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

### 15) Panel Decisions

- a) A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.
- b) In the absence of exceptional circumstances, the Panel shall forward its decision on the complaint to the Provider within fourteen (14) days of its appointment pursuant to Paragraph 6.
- c) In the case of a three-member Panel, the Panel's decision shall be made by a majority.
- d) The Panel's decision shall be in writing, provide the reasons on which it is based, indicate the date on which it was rendered and identify the name(s) of the Panelist(s).
- e) Panel decisions and dissenting opinions shall normally comply with the guidelines as to length set forth in the Provider's Supplemental Rules. Any dissenting opinion shall accompany the majority decision. If the Panel concludes that the dispute is not within the scope of Paragraph 4(a) of the Policy, it shall so state. If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

### 16) Communication of Decision to Parties

- a) Within three (3) calendar days after receiving the decision from the Panel, the Provider shall communicate the full text of the decision to each Party, the concerned Registrar(s), and ICANN. The concerned Registrar(s) shall immediately communicate to each Party, the Provider, and ICANN the date for the implementation of the decision in accordance with the Policy.
- b) Except if the Panel determines otherwise (see Paragraph 4(j) of the Policy), the Provider shall publish the full decision and the date of its implementation on a publicly accessible web site. In any event, the portion of any decision determining a complaint to have been brought in bad faith (see Paragraph 15(e) of these Rules) shall be published.

### 17) Settlement or Other Grounds for Termination

- a) If, before the Panel's decision, the Parties agree on a settlement, the Panel shall terminate the administrative proceeding.
- b) If, before the Panel's decision is made, it becomes unnecessary or impossible to continue the administrative proceeding for any reason, the Panel shall terminate the administrative proceeding, unless a Party raises justifiable grounds for objection within a period of time to be determined by the Panel.

### 18) Effect of Court Proceedings

- a) In the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision.
- b) In the event that a Party initiates any legal proceedings during the pendency of an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, it shall promptly notify the Panel and the Provider. See Paragraph 8 above.

### 19) Fees

- a) The Complainant shall pay to the Provider an initial fixed fee, in accordance with the Provider's Supplemental Rules, within the time and in the amount required. A Respondent electing under Paragraph 5(b)(iv) to have the dispute decided by a three-member Panel, rather than the single-member Panel elected by the Complainant, shall pay the Provider one-half the fixed fee for a three-member Panel. See Paragraph 5(c). In all other cases, the Complainant shall bear all of the Provider's fees, except as prescribed under Paragraph 19(d). Upon appointment of the Panel, the Provider shall refund the appropriate portion, if any, of the initial fee to the Complainant, as specified in the Provider's Supplemental Rules.
- b) No action shall be taken by the Provider on a complaint until it has received from Complainant the initial fee in accordance with Paragraph 19(a).
- c) If the Provider has not received the fee within ten (10) calendar days of receiving the complaint, the complaint shall be deemed withdrawn and the administrative proceeding terminated.
- d) In exceptional circumstances, for example in the event an in-person hearing is held, the Provider shall request the Parties for the payment of additional fees, which shall be established in agreement with the Parties and the Panel.

### 20) Exclusion of Liability

Except in the case of deliberate wrongdoing, neither the Provider nor a Panelist shall be liable to a Party for any act or omission in connection with any administrative proceeding under these Rules.

### 21) Amendments

The version of these Rules in effect at the time of the submission of the complaint to the Provider shall apply to the administrative proceeding commenced thereby. These Rules may not be amended without the express written approval of ICANN.



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