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ABOUT US

WHITE BLACK LEGAL is an open access, peer-reviewed and refereed journal provided dedicated to express views on topical legal issues, thereby generating a cross current of ideas on emerging matters. This platform shall also ignite the initiative and desire of young law students to contribute in the field of law. The erudite response of legal luminaries shall be solicited to enable readers to explore challenges that lie before law makers, lawyers and the society at large, in the event of the ever changing social, economic and technological scenario.

With this thought, we hereby present to you

DEVELOPMENT IN TECHNOLOGY LEADS TO CYBERSQUATTING AND INFRINGEMENT OF TRADEMARK- THE NAME GAME

AUTHORED BY - MANJARI SUGIRTHA A¹

ABSTRACT

Over the past decades, people have wished to lead more sophisticated lives. This leads to the tremendous growth of the internet and increases people's access. They rely on the Internet for their day-to-day work. Especially during the pandemic people used to work from home, purchase essential commodities to luxury items, instantaneous communication across the globe, play games, communicate about safety with their close ones, pay bills through e-service, etc. Where there is good, there is bad. In such aspects, the concept of cybersquatting has increased, which is directly connected to the infringement of a trademark.

The domain names are registered by the person who is not the actual owner of such undertakings, with the intent of making wrongful gain by selling the domain in the future for high profits. Such practices are coupled with the infringement of trademarks.

Unlike many developed countries, India has no domain name protection legislation specifically. The main objective of this study focuses on, the position of India in cybersquatting and comparison with other developed nations and their laws regulating this cybersquatting as an offence.

Several cybersquatting and infringement cases are referred to determine the role of technology development leading to cybersquatting and trademark infringement. Also, we recommend certain suggestions for making laws, to protect the domain users. There is a need for a tribunal to look into the most serious issues of cybersquatting offences.

Keywords: Domain Users, Cyber Squatting, Trademark Infringement, Legislation, Student

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INTRODUCTION:

In the 21st century, the usage of the internet has increased tremendously. The people rely on information technology for their daily activities. Especially the business magnates who have created goodwill among the people, to create a unique profile for the social networking and marketing of their products directly with the help of the internet. They create a domain name completely based on their trademark, which helps the people to identify them and distinguish them from the others. Such development in technology leads to an unauthorized person who individually hijacks the domain name with maliciousness to earn profit by causing damage to the brand name of the person or by selling the same domain to the person on high profits. This is popularly called cyber squatting.

CYBERSQUATTING:

A United States civil law, the Anti-Cybersquatting Consumer Protection Act, of 1999,² defined the term cybersquatting as the "enrollment, trafficking in, or using of a domain name that is identical or confusingly analogous to a mark of another that is famous at the time of the registration of the domain name, without being a proprietor of the mark, with the bad faith intent to profit from the goodwill of someone's mark, which:

- a) results in confusion in the minds of people and may lead to consumer fraud
- b) impairs e-commerce, which is essential for interstate commerce and the United States economy;
- c) Deprives the revenue of the actual owner and reduces the goodwill among consumer
- d) places unreasonable, intolerable, and overwhelming burdens on trademark owners in protecting their valuable trademarks³.”

In simple terms, cybersquatting is defined as registering, trafficking, or using a domain name in bad faith to profit from the trademark holder's goodwill. This is also known as domain squatting.⁴ I.e., the squatter with a grudge, registering a domain with bad faith, which obstructs

² Congress finding the following, The registration, trafficking in, or use of a domain name that is identical to, confusingly similar to, or dilutive of a trademark or service mark of another that is distinctive at the time of registration of the domain name, without regard to the goods or services of the parties, with the bad-faith intent to profit from the goodwill of another's mark (commonly referred to as "cyberpiracy" and "cybersquatting")--

³ Anticybersquatting Consumer Protection Act

<https://www.govinfo.gov/content/pkg/CRPT-106s rpt140/html/CRPT-106s rpt140.htm>[Last Visited Mar. 03,2023]

⁴ Anticybersquatting Consumer Protection Act

the actual owner from registering their domain with their trademark. The squatter then attempts to sell the domain to the actual owner or the individual at an inflated price. The domain name is the name of the website that may be accessed. It is made up of words, letters, and phrases that are easier for people to remember. Mostly, the domain name is created based on their trademarks. This will be in three tiers: World Wide Web, trademark name, and extension. There are various extensions for the domain, such as .mil, .org, .edu, .com, .in, .us, .net, .gov. In *Rediff Communication Ltd v Cyberbooth & Anr*⁵, the defendant registered the domain name as "RADIFF," which creates deceptive similarity to the plaintiff's registered "REDIFF. In this case, it was clearly explained that, the domain name is to be protected as like trademark protection. For a better understanding of this concept, in *Citigroup, Inc. v. Chen Bao Shui*⁶, the defendant created a domain, citybank.org, which was inaptly clicked by many internet users instead of citibank.org. This creates many misleading advertisements and is redirected to the competitor's website, which causes frustration in the minds of the user, and this will be directed towards the goodwill of Citibank. The access of internet users makes a profit for the defendant. This process is known as cybersquatting coupled with the infringement of a trademark.

TYPES OF CYBERSQUATTING:⁷

- Typosquatting: The term typo is commonly used by people in today's world, which means typing mistakes made by the internet user when typing a web address or URL in the web browser. The squatter will register the domain of the registered brand with misspellings and the same logo, color, contents, and layout, which confuses the internet user and redirects to malicious websites.
- Identity theft: the domains are registered for a fixed period, and then they expire if not renewed. The squatters may access that domain illegally and make a profit.
- Domain name squatting: the squatter creates a domain similar to the original website of a well-known company to make a profit from the owner of the trademark. In *Sathyam Infoway Ltd v. Siffynet Solutions Pvt Ltd*⁸, the respondent created a domain as www.siffynet, www.sifjynet, which was deceptively similar to the appellant domain,

<https://www.govinfo.gov/content/pkg/CRPT-106srpt140/html/CRPT-106srpt140.htm> [Last Visited Mar. 03, 2023]

⁵ Rediff Communication Limited v. Cyberbooth & Anr AIR 2000 Bombay 27

⁶ Citigroup, Inc. v. Chen Bao Shui, 611 F. Supp. 2d 507 (E.D. Va. 2009)

⁷ What is Cybersquatting? types and legal frameworks,

<https://lawcorner.in/what-is-cybersquatting-types-and-legal-frameworks/> [Last Visited Mar, 03,2023].

⁸ Satyam Infoway Ltd vs Siffynet Solutions Pvt. Ltd on 6 May, [2004 Supp(2) SCR 465]

www.sifynet. The court of appeal held that the domain names are commercial identifiers, which helps the user to identify and distinguish the goods and services from the others.

- Namejacking: the squatters target the name of the familiar personality with the intent for trafficking with the name of the personality.

LAWS RELATING TO CYBERSQUATTING:

- The Anti-Cybersquatting Consumer Protection Act, 1999 [ACPA] is the first legislation relating to cybersquatting passed by Congress that permits trademark owners to file a civil suit against the squatters, and the Lanham Act, of 1946 was also a federal statute deals with trademarks then.
- Uniform Domain Name Dispute Resolution Policy, 1999 [UDRP]: This policy was adopted and implemented by the Internet Corporation of Assigned Names and Numbers [ICANN] with the object of providing solutions to name disputes by making an arbitration based on the complaint that the domain name was registered with malafide intention by the person who's not having any rights over it, which is deceptively similar to the complainant's domain name that may confuse the users.⁹
- Cybercrime prevention act, 2012 of Philippines defined the term of cybersquat and also imposed certain penalties under section 5(1) of the act, as the use of domain name with bad intent to make a profit by damaging the reputation of making similar trademarks without any rights, and the offence is punishable with a penalty of two hundred thousand pesos may extend to five hundred thousand pesos¹⁰

CYBERSQUAT ISSUES DEALT IN INDIA

In India, there is no specific legislation to deal with cybersquatting coupled with infringement of trademarks. The Trademark Act, of 1999 was used to deal with the issue related to this.

- In India, a domain name dispute resolution policy was adopted with the object of resolving the dispute between the domain name registrant and the complainant. The

⁹ Cybersquatting: What It Is and What Can Be Done About It:

<https://www.nolo.com/legal-encyclopedia/cybersquatting-what-what-can-be-29778.html> [Last Visited: Mar 05 2023]

¹⁰ Rules and Regulations Implementing Republic Act No. 10175, <https://www.officialgazette.gov.ph/2015/08/12/implementing-rules-and-regulations-of-republic-act-no-10175/#:~:text=Cyber%2Dsquatting%20shall%20be%20punished,or%20a%20fine%20of%20at> [Last Visited: Mar 05 2023]

aggrieved party either gets the registered domain by transfer or cancels usage of such domain.¹¹

- The aggrieved party may send the letter cease and desist to the cyber squatter
- The aggrieved party may seek the help of the arbitration and mediation center based on ICANN rules.

Other than this, various other acts also deal with the concept of infringement with malafide intention.

- Indian Penal Code, 1860, under Section 469, punishes the person who has the intention to forge to harm the reputation.
- Information Technology Act, 2000, under sections 66C and 66D, punishes the Personation electronic resources and for identity theft.

CASES RELATING TO CYBERSQUATTING:

Various cases are decided by the competent courts related to cybersquat and trademark infringements, especially in the past few decades.

- In *Yahoo Inc v Akash Arora*¹² Yahoo, an U.S based firm has a domain of Yahoo.in which deceptively similar domain name yahoo.com was created by the defendant. The court passed the interim injunction in favour of the plaintiff against the defendant as it clearly misguides the customers.
- In *SBI Cards pvt Ltd v. Domain Active Pty. Ltd*¹³ The complainant filed the complaint under WIPO arbitration and mediation center, and the complainant proved all the elements as per para 4 of the policy and Rule 15, and hence the panel has ordered the respondent to transfer the domain name www.sbicards to the complainant.
- *Tata Sons Ltd v Ramadasoft*¹⁴, the defendant owns a domain name as tata which is not only a domain name of plaintiff but also their brand, trademark. The court orders the respondent to transfer the domain name and orders in favour of the plaintiff.

¹¹ .in domain name dispute resolution policy <https://www.registry.in/domaindisputeresolution> [Last Visited Mar 05 2023].

¹² 1999 IIAD Delhi 229, 78 (1999) DLT 285

¹³ <https://www.wipo.int/amc/en/domains/decisions/html/2005/d2005-0271.html> [Last Visited Mar 05 2023].

¹⁴ Tata Sons Ltd. v. Ramadasoft Case No. D2000-1713

CONCLUSION:

As in the 21st century, the concept of the internet has emerged on a ravage which is uncontrollable. If there is a good, there will be bad in such a way many cyber crimes are out in a decade. However many of them are aware of such crimes with the help of newspapers, magazines, but still, there is no specific legislation to punish the squatters for their malafide acts. They are like a disease which spreads and corrupts the function if not cured on time by giving proper dosage. The government must adopt certain laws to prevent certain crimes and the aggrieved party from the act of the infringer.

RECOMMENDATION:

Like the Philippines, USA, India has no specific legislation to punish the offenders. Instead, the TradeMark act, 1999 protects the infringement of trademark but there is no law that uniquely deals with cybersquatting. In India, we have a policy to deal under INDRP but there is no law. We strongly recommend the appropriate Government to enact legislation to deal with cybersquatting. Also, we recommend the Government to establish a tribunal to deal with the dispute related to cybersquatting. As the usages of the internet are severely increased in decades the legislation has to be adopted and the judiciary must interpret the law to control the cybercrimes like this cybersquatting. Thus with the proper legislation everything will be tackled in a more meaningful way by providing a solution to the aggrieved party against the act of the infringer.

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