

Domain Name Dispute Resolution: A Model for the future ?

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Geneva

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OVERVIEW

- **INDIAN INFORMATION TECHNOLOGY INDUSTRY**
- **DOMAIN NAME DISPUTE RESOLUTION THROUGH INDIAN COURTS**
- **EXPERIENCE OF ICANN'S UDRP**
- **PRESENT AND FUTURE ISSUES**

INDIAN IT INDUSTRY

- **ANNUAL GROWTH RATE CONSISTENTLY OVER 50% SINCE 1991**
- **1999-2000 MORE THAN ONE-THIRD FORTUNE 500 CO'S SOURCED MISSION CRITICAL SOFTWARE**
- **NASSCOM - MCKINSEY : 2008 US\$ 87 BILLION**
- **4 MILLION TECHNICAL WORKERS; 1632 EDUCATIONAL INSTITUTIONS; 68000 COMPUTER PROFESSIONALS EVERY YEAR**

DOMAIN NAME DISPUTES - INDIAN EXPERIENCE

- **YAHOO & REDIFF :**
 - **INJUNCTIONS GRANTED**
 - **TM LAW APPLIES ON THE NET**
 - **ANONYMITY, ACCESS AND POTENTIAL HARM - GREATER STANDARD OF VIGILANCE AND CARE**
- **MUTUALFUNDS: NAME GENERIC INJUNCTION DECLINED**
- **OVER 30 CASES, MOSTLY EXPARTE**

The Yahoo! Case



Other Cases



NASSCOM

National Association of Software and Service Companies

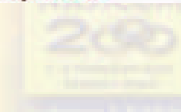


NASSCOM

India's National Association of Software and Service Companies

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- 1. 2000 award
- 2. 1999 award
- 3. 1998 award
- 4. 1997 award



Revenue of the IT industry in India. At the end of 2000, the revenue of the IT industry in India was estimated to be around \$10 billion. This is a significant increase from the \$5 billion in 1999. The IT industry in India is expected to continue its growth in the coming years.



UDRP PROCEEDINGS

- **SLOWING DOWN OF DOMESTIC CASES AFTER UDRP CAME INTO FORCE**
- **COST LESS BUT NOT DRAMATIC - LITIGATION INEXPENSIVE**
- **TIME: DRAMATIC SAVING 2-3 MONTHS VS MINIMUM 3-5 YEARS; NO INTERIM TRANSFER**
- **FOREIGN DEFENDANTS: LOCATING THEM, SERVING AND EFFECTIVELY ENFORCING NIGHTMARE**

LITIGATION PREFERRED :

- NEED FOR IMMEDIATE INJUNCTION
- RELIEFS SOUGHT BEYOND TRANSFER
- ccTLD's & SOME OTHERS
- INFRINGEMENT OTHER THAN DOMAIN NAMES : COPYRIGHT CONTENT, TM USE ON HOMEPAGE, METATAGGING HYPERLINKING TYPE CASES
- WHERE BAD FAITH NOT EVIDENT

TREMENDOUS AWARENESS

WWW.TATA.com



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Revenue to the tune of Rs. 10,000 crore. At the end of the year, the industry is projected to grow by 15%.

New
New Members
New Additions



Hero Honda emerges a hero in the domain name dispute

By Anna Kelly
BIRMINGHAM

Are you an ardent fan of a car, a motorcycle or a television? Well, you may get carried away. Do not register a domain name using the trademark of a well-known star, or you may be in for a

The company argued that the trademarks Hero and Honda, both of which make up the hybrid trademark HeroHonda, represent the company's reputation for excellence which was further enhanced by extensive advertising. The company pointed out that the respondent had registered the domain name hero-honda.com, which was identical to its trademark. Such registration was

In mid 1998, he tried to the domain name hero-honda.com which was not available. He tried to register hero-honda.com but this domain was already taken. Hence, he registered hero-honda.com. The respondent argued that he had a valid right to use the domain name hero-honda.com and he had no obligation to register it.

The name game: No longer cybersquatter domain?

By Anandaram Srinivasan

Why does cybersquatter registration of domain names matter? It is not just the fact that the domain name is being used by someone other than the owner of the trademark. It is the fact that the domain name is being used in a way that is likely to cause confusion among consumers.



Government intervention is required to prevent the loss of a domain name to a cybersquatter. The government should take steps to ensure that domain names are used in a way that is consistent with the trademark. This can be done by requiring the registration of domain names to be subject to a review by a government agency. This would ensure that domain names are not used in a way that is likely to cause confusion among consumers.

Julia Roberts wins control of www.juliaroberts.com

New York Times

Actress Julia Roberts has secured control of an Internet domain name that bears her name, in a decision said to have broader implications for domain name registration. The actress, an international star, sued the domain name registrar, who registered the domain name www.juliaroberts.com, and won a court order to transfer the domain name to her.



The registration was challenged by the US in a lawsuit. Roberts argued that the registrar had no authority to register the domain name. She argued that the registrar had no authority to register the domain name because she was the only person who had a right to use the name. The court agreed with her and ordered the registrar to transfer the domain name to her.

Julia Roberts. Source: address on

DELHI

Oberoi group gets rid of cybersquatter

By Anandaram Srinivasan

The Oberoi group has successfully removed a cybersquatter from its domain name. The group had filed a lawsuit with the court to force the cybersquatter to transfer the domain name to them. The court granted their request and the cybersquatter was removed from the domain name.

The Oberoi group had filed a lawsuit with the court to force the cybersquatter to transfer the domain name to them. The court granted their request and the cybersquatter was removed from the domain name. This case is a landmark decision in the area of domain name registration and trademark law.



Volvo wins cybersquatting case on ocean race

Reuters

GENEVA, Aug. 9

SWEDISH automaker Volvo, sponsor of the world's premier ocean sailing race, has won its case to evict a cybersquatter from the Web site, www.thevolvooceanrace.com, UN arbitrators said.

Volvo, owned by Ford Motor Co, filed a complaint in April at the Commercial World

also ruled that the New Zealand firm had no legitimate interest in the Internet address and that the name was confusingly similar to the trademark Volvo owned.

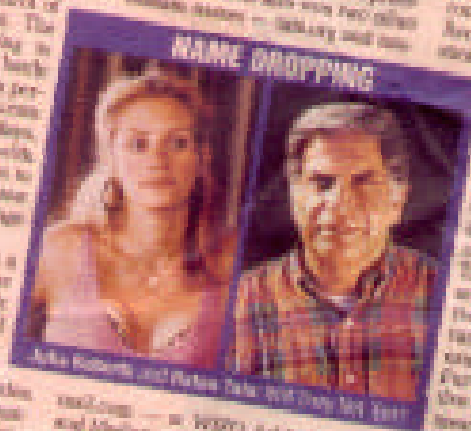
It said it had also registered the domain names www.americascup.com and www.teamnewzealand.com.

As domain names have become more valuable with

WHAT'S

Arbitration

Ratan Tata became Julia Roberts' first step to keep control of her name. The arbitration is expected to help her keep control of her name. The arbitration is expected to help her keep control of her name.



Arbitration is a process where a neutral third party, called an arbitrator, hears the arguments of both sides and makes a decision. It is often used to resolve disputes between businesses or individuals. In this case, it is used to resolve a dispute over a domain name.

is a landmark judgment case from a cybersquatter, and the Tata's are looking at this as a precedent. The Tata also won two other domain names — www.americascup.com and www.teamnewzealand.com.

responsibility placed the domain name up for auction on eBay, a controversial auction website. Recently, Madonna has also filed a similar case, but has to first prove to arbitrators that she is the owner of the domain name.

The WIPO ruling has been a landmark case for cybersquatters. It was a landmark case for cybersquatters. It was a landmark case for cybersquatters. It was a landmark case for cybersquatters.

“TRULLY INTERNATIONAL TM LAW”

- **“The Administrative panels will develop precedent under these rules which will form a new body of trully international trade mark law unique to domain name entitlement” ..Prof J. Thomas McCarthy**

The New Jurisprudence

WIPO

Treaties - TRIPS, Berne, UCC etc25

INTERNET

ICANN - Policy for Domain Name Dispute Resolution

Trademark
Law

USA

Trademark
Law

UK

Trademark
Law

INDIA

BAD FAITH

- OFFER TO SELL AMOUNTS TO 'USE'
 - BROKER SITES
 - COMPLAINANT CONTACTS RESPONDENT
- USE INCLUDES INACTIVE USE, PASSIVE HOLDING
- LINK TO PORNO OR COMPETITOR SITES
- DISRUPTING BUSINESS - CONTACTS WITH A COMPETITOR, LICENSEE IN BREACH
- GENUINE PROTEST SITE - FREEDOM OF EXPRESSION - UNLESS COMMERCIAL

BAD FAITH

- MULTIPLE REGISTRATION OF FAMOUS MARKS
- TYPOGRAPHICAL PIRACY
- CONCEAL IDENTITY, CONTACT DETAILS
- ATTRACT COMMERCIAL GAIN
- DISCLAIMER DOESN'T DISPEL BF

LEGITIMATE INTEREST

- FAILURE TO RESPOND - ADMISSION BY SILENCE
- NOT AWARE - BONAFIDE OFFERING GOODS OR SERVICES OR PREPERATIONS
- AUTHORISED DEALER
- DIFFERENT FIELDS OF BUSINESS
- GENERIC/DESCRIPTIVE NAMES
- THIRD PARTIES USING
- COMMONLY KNOWN
- MERE INTEREST NOT ENOUGH

GENERAL

- NATURE OF CASE - ONLINE ARBITRATION NOT APPROPRIATE
- PROCEDURES NOT MET BY COMPLAINANT
- CHOICE OF LAW DIFFERENT COUNTRIES INVOLVED - BROAD AND COMMON SENSE INTERPRETATION

SOME ISSUES

- Seek Transfer - Not Cancellation
- No Right to Rejoinder - Attempt before panelist appointment else Anticipate defense - put best case forward
- Where Complex facts - fit for court - challenge how much to include

CONCLUSION -THE UDRP EXPERIENCE

- ADMINISTRATIVE PROCEEDINGS IN WHICH PANELISTS CONCERNED WITH MIXED QUESTIONS OF LAW AND FACT
- BOUND TO BE IMPERFECTIONS:
 - GLOBAL - MANY DIVERSE SYSTEMS
 - VISIBLE
 - DEVELOPED IN VACUUM
 - ANY TM BOOK WILL HAVE CONFLICTING VIEWS
- WITH EXPERIENCE - REDUCE INCONSISTENCIES
- POSSIBLE ONLINE APPEALS