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**COMPARATIVE STUDY ON THE PROTECTION OF DOMAIN NAMES
UNDER TRADEMARK LAWS: INDIA AND USA**

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INTRODUCTION

Electronic computers were invented in the 1950s, which is considered to be the beginning of the period of the Internet. Packet networking was initially conceived in several computer science research facilities in the United States, Great Britain, and France. Since then, and especially since the birth of the accessible World Wide Web in 1989, the Internet has experienced a radical transformation, becoming a communication and commerce centre whose applications are as varied as the people who use it. This is because many individuals use the Internet for various purposes. Since the invention of the internet, commercial transactions have been more efficient and more accessible, and more and more transactions are taking place online. Individuals started developing websites they could use for regular businesses, advertising, information exchange, and contact with people worldwide.³

The development of the Internet has made it feasible for businesses to do business over the Internet by registering a domain name that includes the company's trademark. Customers in today's market prefer to purchase online at retailers such as Amazon, Myntra, and Jabong, amongst others, rather than go to traditional shopping malls. Tickets for flights, trains, and buses may all be reserved through a single booking process with the assistance of online travel providers such as Yatra.com and makemytrip.com. Notable educational institutions such as Sikkim University, Delhi University, and the National Law School of India University in Bangalore, amongst others, all maintain their websites. The URLs present the sites in a format that is universally accepted. The addresses of resources can be found in the form of Uniform

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³ J. Abbate, *Inventing the internet*. (MIT press, 2000).

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Resource Locators (URLs), and those addresses are domain names. To put it another way, "a domain name is a computer address that allows any other user who has access to the Internet to locate a company or an individual."⁴

Every single website that is accessible online is provided with a one-of-a-kind 'Internet Protocol' (IP) address. Because they are both numerical and long, Internet Protocol (IP) addresses are notoriously difficult to remember. When discussing the method by which numerical addresses are converted into addresses consisting of letters or words, the term "domain name system" (DNS) is the one that is most frequently used. The identification and localisation of specific nodes on the Internet, such as computers, users, files, and resources, is accomplished through domain names. Without a domain name, an organisation would be unable to attract customers who conduct business online since those customers would be unable to find them. Internet users need to be able to recognise and track down every machine and user on the network.⁵

There have been an infinite number of instances of abusive usage of domain names. Some people, for example, would use widely recognised brand names to register domain addresses in their names before the domain owner has a chance to do so legally. These strategies eventually develop into unethical business practices as more time passes. Examples of unfair trade practices include business practices that are either dishonest or unethical, as well as practices that are deceptive. It is considered unethical business practices to engage in activities such as misrepresentation, misleading advertising, link sales, and other practices of a similar kind, which are all prohibited by various regulations. This is also sometimes referred to as using deceptive business practices. According to Merriam-Webster's definition, the term "unfair trade practices" refers to "any of various deceptive, fraudulent, or otherwise injurious (as to a consumer) practises or acts that are declared unlawful by statute (as a consumer protection act) or recognised as actionable at common law" (emphasis added). "Cybersquatting" refers to registering a domain name online to drive traffic to another website; this practice is becoming increasingly common. The act of registering or using a domain name without the owner's authorisation is known as cybersquatting. Squatting on domain names happens when advertisers register domain names that are visually or phonetically identical to those of popular websites that receive a lot of traffic. It's a sort of cybercrime, but there are plenty of others. Another word for

⁴*Ibid.*

⁵*Ibid.*

cybersquatting is "domain squatting." According to the Anticybersquatting Consumer Protection Act passed in the United States, cybersquatting is defined as registering, trafficking in or using a domain name to gain from the goodwill of a brand that belongs to someone else. This can be done with or without good faith. The term "squat" comes from the phrase "Practise of occupying another person's property without that person's permission", which is where the phrase "squatting" comes from. In contrast to the United States, which has specific laws to deal with domain name-trademark conflicts, the Indian Court in Yahoo Inc, Rediff Communications, and the Satyam Info way grouped the concerns under two areas: infringement and passing off. This contrasts with the United States, which has specific legislation for domain name trademark disputes. The United Kingdom and India do not have domain name-specific laws; instead, they handle such cases using the Trademarks Act of 1994. This means that the method used by the Indian government in this matter was analogous to that of the United Kingdom's. In the case of unregistered trademarks, passing off is the legal remedy that can be utilised, whereas registered trademarks can have infringement proceedings pursued against them.

EXISTING LEGAL FRAMEWORK: INDIA AND U.S.A

There is a school of thought that contends that trademark law can be utilised to mediate disputes over domain names that are connected to trademarks. In this part of the discussion, we are going to contrast and compare the legal systems that are now in place in the United States and India. As India does not have a law known as the "Anti-Cyber-Squatting Consumer Protection Act," the research will include an examination of the legal situation in the United States. The Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) both contributed to the development of the fundamental principles that serve as the basis for both pieces of law. The phrase "well-known trademark" first appeared in legal writing in the year 1883. Convention in Paris for the Protection of Industrial Property, which specifies the standards for providing extra safeguards for renowned trademarks. Agreement for the protection of intellectual property in Paris. The treaty leaves the choice of how to preserve well-known trademarks and the processes for obtaining their recognition up to the individual countries

that are parties to the accord. The "Paris Convention" is the most significant multilateral agreement ever created in terms of trademark protection on a worldwide scale.⁶

- **Paris Convention**

The Paris Convention seems to have been designed to protect inventors from losing patent protection prematurely due to the publication of patent applications and participation in international exhibitions before filing national patent applications. It also seems to have been designed to try and achieve some degree of harmonisation among the various patent laws of the different nations. Before the Convention, individuals wishing to make sure their inventions qualified for patent protection in multiple nations had to simultaneously file patent applications in each of those nations, as well as do so before the invention was published or displayed at a trade show. This ensured that the inventions would qualify for patent protection in each of those nations.

After the Congress of Vienna the year before, the International Congress on Industrial Property was next held in Paris in 1878. The legislative body has approved the international diplomatic conference's organisation, which aims to establish the framework for a unified body of rules about intellectual property. The French government invited foreign dignitaries to a conference in Paris in 1880 as part of its advocacy for a global "union" to protect intellectual property. This meeting was held in Paris. The current agreement in Paris might have originated from a draft that was agreed at the Conference of 1880. In 1883, in Paris, a second Diplomatic Conference was convened to finalise the treaty's language. Belgium, Brazil, El Salvador, France, Guatemala, Italy, the Netherlands, Portugal, Spain, and Switzerland were among the nations who put their names on the Paris Convention back in 1883. Other signatories were the countries of Italy and the Netherlands. The Convention included Britain, Tunisia, and Ecuador as signatories when it went into force on July 7, 1884—this day also marked the beginning of the Convention.⁷ The Paris Convention was amended several times, starting in Rome in 1886 and continuing there until 1979. These amendments took place in 1890 in

⁶Honouring International Obligations in the U.S. Trademark Law: How Available at:https://digitalcommons.law.lsu.edu/cgi/viewcontent.cgi?article=1301&context=faculty_scholarship (Last Visited on January 31, 2024).

⁷Honouring International Obligations in the U.S. Trademark Law: How the Available at:https://digitalcommons.law.lsu.edu/cgi/viewcontent.cgi?article=1301&context=faculty_scholarship (Last Visited on January 31, 2024).

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Madrid, 1891 in Brussels, 1900 in Washington, 1925 in The Hague, 1934 in London, 1958 in Lisbon, 1967 in Stockholm, and 1979 in Rome. The landscape of anti-competitive behaviour has undergone significant transformation. The most recent version, known as the Stockholm Act, is supported by almost all members of the Union. In 1967, at the same time as the Stockholm revision was taking place, the World Intellectual Property Organisation (often known as "WIPO") was being founded. The United International Bureau for the Protection of Intellectual Property was succeeded as the Convention's administrator by the World Intellectual Property Organisation (WIPO), which is an international organisation. A country already a member of the World Trade Organisation (often known as the "WTO") must begin adhering to the substantive conditions of the Paris Convention as soon as it applies to join the Paris Union. WTO members are required to comply with the regulations that are outlined in the Paris Convention, as specified in Article 2 of the TRIPS Agreement. These regulations include Articles 1 through 12 and 1.9.”⁸

Primary Register Membership and Private Use;

Section 43(a) of the Lanham Act protects it as a common law trademark if used in the United States without being registered as a trademark. A recent ruling by the Second Circuit Court of Appeals has left the United States partially noncompliant with the Paris Convention. The vast majority of countries who are not party to the Paris pact often provide less protection than those who do. This is especially true of the signatory nations to the pact. When comparing the protection levels provided by nations that are not signatories to the agreement, this is the case. Instead, a lot of countries use extensive legislation to protect unregistered trademarks from unfair competition. That's the situation in the US. Despite this, trademark protection has traditionally been granted in the US, even in the case of non-registration. If the United States is honest in fulfilling its

⁸“Commentary on Paris Convention for - Lex-ip.com Available at:<http://www.lex-ip.com/Paris.pdf>.”

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obligations under article 6bis, it is reasonable to assume that it will act quickly to fulfil its commitments.⁹

- **TRIPS Agreement**

Commonly referred to as "TRIPS" or "the TRIPS Agreement," this is the World Trade Organization's (WTO) treaty on "Trade-Related Aspects of Intellectual Property Rights." The Trade in Services Agreement (TRIPS) is a fundamental part of the WTO Agreement. Known as the Uruguay Round at times, the eighth round of multilateral trade negotiations under the General Agreement on Tariffs and Trade (GATT) took place from 1986 to 1994. This agreement was negotiated during that time.

The Uruguay Round was the occasion of the first official establishment of intellectual property rights regulations as a part of the global trade system. As a result of the Uruguay Round, a "single undertaking" was reached, which includes the TRIPS Agreement. This directly means that every WTO member is required to apply the TRIPS Agreement. For this reason, any disputes arising from the application of this agreement will be settled by the WTO's Dispute Settlement Understanding (often referred to as the "Understanding of Rules and Procedures Governing the Settlement of Disputes"). The Trade-Related Intellectual Property Rights Agreement (TRIPS) is an essential World Trade Organisation treaty.¹⁰

"The considerable duties imposed on parties by the Paris Convention about trademarks are included and expanded upon in the Agreement on TRIPS. This is the intellectual property treaty that was completed as one of the fundamental accords of the World Trade Organisation (WTO). Suppose the use of the trademark would indicate a link with the foreign owner and would likely cause damage to the interests of that owner. In that case, TRIPS protects the unlawful use or registration of the trademark with items or services that are different from those associated with the well-known mark. Both the TRIPS Agreement and the Paris Convention failed to define the term "well-known mark," as was indicated before, and the TRIPS Agreement does not include a definition for "well-

⁹"How the Lanham Act Protects Well-Known Foreign Marks - LSU Law Available at:http://digitalcommons.law.lsu.edu/cgi/viewcontent.cgi?article=1301&context=faculty_scholarship (Last Visited on January 31, 2024)."

¹⁰ *Ibid.*

known." To be more specific, the TRIPS Agreement mandates that participating nations "shall take into account the knowledge of the trademark in the relevant sector of the public," where "knowledge" refers to information that has been collected in the Member concerned as a direct result of the trademark's advertising.

- **Post TRIPS Development**

The most recent multilateral attempt to strengthen protection for well-known marks in overseas markets is the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks ("Joint Recommendation on Well-Known Marks" or "Joint Recommendation"). It was negotiated through the World Intellectual Property Organisation. This is the most current international attempt to strengthen protection for well-known marks in overseas markets, even though it is nonbinding. The Joint Guidance on Well-Known Marks is essentially only a consensus-based guideline that is not required by law in most countries. As part of at least one bilateral agreement, namely a free trade agreement with Singapore, the United States of America is legally required to abide by the Joint Recommendation. In addition, as a result of the most-favoured-nation treatment clause included in the TRIPS Agreement, the United States is now obligated to offer the same benefits to citizens of all WTO Member states as it did to Singaporean citizens under the terms of the legally binding bilateral agreement.

The following elements are listed in the Joint Recommendation for the examination of a well-known mark:

1. The Degree Of Knowledge Or Recognition Of The Mark In The Relevant Sector Of The Public;
2. The Duration, Extent, And Geographical Area Of Any Use Of The Mark;
3. The Duration, Extent And Geographical Area Of Any Promotion Of The Mark, Including Advertising Or Publicity And The Presentation, At Fairs Or Exhibitions, Of The Goods and Services To Which The Mark Applies;
4. The Duration And Geographical Area Of Any Registrations, and Any Applications For Registration, Of The Mark, To The Extent That They Reflect Use Or Recognition Of The Mark;

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5. The Record Of Successful Enforcement Of Rights In The Mark, In Particular, The Extent To Which The Mark Was Recognized As Well Known By Competent Authorities;
6. The Value associated with the mark.

Nations subject to the Joint Recommendation on Widely-known Marks shall examine if the foreign mark is commonly acknowledged by at least one pertinent subset of the national populace. The following groups of individuals must be taken into consideration:

- a. Consumers, real or future, of the kind of goods and services covered by the mark;
- b. Those who work in the distribution channels for the kind of goods and services covered by the mark;
- c. Spheres of commerce about the goods and services covered by the mark. The following clause, however, may be the most significant for the objectives of this research as it lists specific criteria that "shall not" be applied in evaluating whether a foreign mark is well-known:

(a) To determine whether a mark is well-known, a Member State may not demand:¹¹

1. "The trademark is in use inside the Member State; it is registered; or an application for registration has been filed there, in connection with that location;"
2. "That the mark should be well-known in any jurisdiction other than the Member State, that it has been registered, or that a request for registration of the mark has been made about any such country; or."

- d. That the general public widely recognises the mark in the Member State.

The US has joined a group of nations that publicly state their intention to protect well-known international trademarks that are not being used within their borders and advocate for maintaining such protection by joining the Joint Recommendation. As previously

¹¹"How the Lanham Act Protects Well-Known Foreign Marks - LSU Law Available at:http://digitalcommons.law.lsu.edu/cgi/viewcontent.cgi?article=1301&context=faculty_scholarship (Last Visited on January 31, 2024)."

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stated, the United States' obligations to every WTO member nation have lately increased because these articles are specifically enforceable in at least one bilateral agreement.

Due to the existence of two fundamental principles of trademark law, the judicial systems in the United States have had a difficult time resolving issues using domain names in the context of trademark law:

1. "To prevent confusion in the public and"
2. "To protect the trademark owner's investment in its mark."¹²

- **USA**

"The United States and its commercial citizenry have significant and financially valuable interests when it comes to foreign protection for popular U.S. brand names".¹³

"Commercial actors pay close attention to the availability of trademark protection abroad, especially protection available in advance of the establishment of local sales or business units. For example, McDonald's Corporation fought hard in the 1990s to protect its trademarks from a local infringer in South Africa before beginning to operate in that country."¹⁴ "It succeeded. Starbucks Corporation successfully defended its rights in Russia against a trademark "pirate" who registered the STARBUCKS mark in 2005 and then tried to extort \$600,000 from the company when it contemplated opening local units. Successes like these depend on foreign enforcement of internationally agreed protection for well-known marks. The USA is a signatory to the following international Intellectual Property agreements and the same principles in protecting trademarks and resolving disputes."¹⁵

- Trademark Law's Historical Development: A Worldwide Scenario

"Often, a business's sales emanate from a physical brick-and-mortar location. Any resulting intellectual property rights in the trademark used to make those sales are

¹²*Avery Dennison Corp. v. Jerry Sumpton* 189 F. 3d 868, 873 (9th Cir. 1999).

¹³*McDonald's Corp. v. Joburgers Drive-Inn Restaurant*, 1997 (1) SA 1 (SCA) (8. Afr.), available at <http://www.saflii.org/za/cases/ZASCA/1996/82.html> (Last Visited on April 8, 2023).

¹⁴David Yan, "Virtual reality: can we ride trademarks law to surf cyberspace?" 10 *Fordham I.P., Media & Ent. L.J.* 773, (2000) at 782.

¹⁵W. Scott Creasman, "Establishing Geographic Rights in Trademarks Based on Internet Use", 95 *TRADEMARK REP.* 1016, 1016-17 (2005)."

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inextricably tied to that physical location.”¹⁶ This is because, under prior common law, ownership rights to a mark were limited to the areas where customers might identify the mark as being connected to a particular business. Goodwill, or the acknowledgement from happy consumers, could only go so far before¹⁷ those goods or services bearing the corresponding trademarks. As early trademark law Since such goodwill was created before the widespread usage of cars, trains, aeroplanes, and the Internet, its initial geographic reach was limited. The courts were unable to foresee the emergence of a cyber market that extended beyond physical limits as the legislation was created within the confines of geography. It is no longer the case that a company's existence is inextricably linked to a specific geographic location because the Internet allows firms to function irrespective of their physical locations.

Due to the Internet's widespread use, business may be promoted, advertised, and conducted globally without being limited by physical location. Nonetheless, trademark law has not developed as fast as technological advancement, and geographically based trademark protection is still widely used today. Ever since their inception, trademarks have been restricted to a specific region.

A. Market Basis for Common Law Trademark Rights Establishment

The basic rule for owning a trademark is that the first one to use a name as a trademark gets the intellectual property rights for it, even without registering it.¹⁸ On the other hand, the unregistered common-law trademark's geographic reach will be limited if a party chooses not to register the mark. "Sales, advertising, reputation, and expansion" refers to the four separate but related geographic areas which comprise the protection provided by common-law trademarks. While the phrase "zone of actual goodwill" is frequently used to refer to factors such as sales, advertising, and reputation, the phrase "zone of natural expansion" is noteworthy for being a very controversial and sometimes unflattering measurement method. The "zone of actual goodwill" and the "zone of natural expansion" are described below concerning their different zones of influence.

¹⁶Julius R. Lunsford, Jr., "Trademarks: Prestige Practice and Protection", 4 GA. L. REV. 322, 323 (1970)."

¹⁷*United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918).

¹⁸Johnson Shontavia, "Trademark Territoriality in Cyberspace: an Internet Framework for Common-Law Trademarks," 29 BerkeleyTech. L.J.

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1. The Zone of “Actual Goodwill”

The domain of genuine kindness is typically divided into the real market penetration zone and the reputation zone, which are distinguished here. A trademark owner can demonstrate the true goodwill zone by providing evidence of one of these two categories alone or in conjunction with the other. The places where goods have genuinely been sold to final customers are called "the zone of actual market penetration". Moreover, sales must always exceed a "de minimis" threshold according to the legal system. Today, most governments consider one or more of the following factors to determine the geographical limitations of a trademark's protection: (1) the number of goods sold under the trademark; (2) both positive and negative regional growth trends; (3) the proportion of customers who make purchases overall potential customers; (4) the volume of regional advertising; and (5) the market share of the trademark owner. The zone of reputation spans places where people recognise the items utilising the trademark but are not direct consumers of those products. The zone of repute might extend well beyond the towns or states that are physically adjacent to one another, even though the distance between two sites is a valuable starting point for measuring it. Consumers who walk around are far more common than they were in the early years of trademark law. These clients have the power to transfer a brand's goodwill thousands of kilometres from a physical location. The question of whether the distinction between “the zone of reputation” and “the zone of true market penetration” should be replaced by a single, unified test has been a topic of discussion among early observers. However, doing away with the current split structure would be a foolish move, particularly in light of the genuine kindness that permeates the Internet. These recommendations, in particular, give the reputational domain relatively minor consideration. The Internet has enabled businesses to create enduring impressions and foster goodwill even when revenue is not a determining factor, in contrast to the late 20th century when a company's reputation was primarily based on its actual sales.¹⁹

2. The Zone of “Natural Expansion”

The zone of natural extension, in contrast to “the zone of real goodwill”, which is determined by the presence of the mark, encompasses a geographical region that has not been affected in any

¹⁹Johnson Shontavia, “Trademark Territoriality in Cyberspace: an Internet Framework for Common-Law Trademarks,” 29 BerkeleyTech. L.J.

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way by the putative owner of the trademark. There is very little "breathing space" provided by the zone of natural expansion. Still, it is enough to ensure that the trademark owner's goodwill is preserved for any future development attempts. These efforts in development need to be articulated and tangible. Some courts include an outline of specific factors that were considered while drawing the borders for the zone of natural growth, such as:²⁰

1. How far away is a point on the edge of the zone of growth from the [trademark owner's] actual location geographically?
2. What sort of company is it? Does it currently have a substantial or negligible reputation or commercial penetration?
3. What is the background of the previous expansion of [trademark owner]? How much time is estimated for the senior user to reach the claimed edge of the expansion zone, considering the time taken for previous expansions?
4. To enter the zone, would the [trademark owner] have to make an extraordinary "great leap forward," or "Is the zone sufficiently near the existing sites such that any extension would be (or is) a reasonable, gradual step of the same length as those already taken?"

Other courts have already adopted an investigation that is broader in scope while being factually precise and concentrating on the senior user's growth initiatives. On the other hand, the zone of natural growth has come under fire from several courts for being inaccurate and unpredictable. First, it could be challenging for the courts, the attorneys, and the²¹ potential trademark owners to determine the zone's boundaries. This is because the junior user cannot know in advance whether or not a specific site fits inside the zone. The natural growth zone could get a fresh lease on life thanks to the Internet, even though it is generally unfavoured in the context of brick-and-mortar businesses. The historical concerns are given less weight, given that the Internet is gradually erasing such regional limits. Most of the time,²² In the United States, the foundation for safeguarding common-law trademarks, and consequently unregistered trademarks, is the bifurcated zone of genuine goodwill and the zone of natural extension. This applies whether the goodwill was established in one zone or both zones. However, the proprietor of that trademark

²⁰Johnson Shontavia, "Trademark Territoriality in Cyberspace: an Internet Framework for Common-Law Trademarks," 29 BerkeleyTech. L.J.

²¹Raxton Corp. v. Anania Assocs., Inc., 635 F.2d 924, 930 (11th Cir. 1980).

²²David S. Barrett, "The Future of the Concurrent Use of Trademarks Doctrine in the Information Age", 23 HASTINGS COMM. & ENT. L.J. 687, 687 (2001).

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does not prioritise using the mark in other locations that are geographically far away. The concurrent use doctrine is an offshoot of the first-to-use concept that was formed by the judiciary. It allows unconnected third parties to use a trademark that is identical to or strikingly similar to another registered brand under specific conditions.²³

“Concurrent use” and “the territorial limits of common law trademarks”

The United States did not have a thorough system for registering trademarks before 1870. Over time, common-law trademarks began to clash with one another because companies frequently catered to customers who lived a specific distance away from their physical locations by offering their products and services. Consider the reputation that the Midwest has gained through its development. At some point, the goodwill of Southern's business expanding westward from South Carolina is bound to conflict with eastward movement from Nebraska. Two distinct approaches were taken to answer this issue: (1) a thorough federal trademark statute passed by Congress that featured a federal registration system, and (2) an Existing concurrent-use doctrine created by judges. Article I, Section 8, "Clause 8" of the U.S. Constitution authorises Congress "to promote the Progress of Science and useful Arts, by securing for limited Times the exclusive Right to their respective Writings and Discoveries to Authors and Inventors," which is how this first federal trademark statute came to be.²⁴ In the Trade-Mark Cases,²⁵ Despite the newly passed law having a good intention, the Supreme Court decided it violated the Constitution and struck it down as invalid. The Supreme Court's decision to strike down the Act was based on its interpretation of Article I, Section 8, Clause 8, which states that the only writings that can be protected under this provision are those that "are the fruits of intellectual labour, embodied in the form of books, prints, engravings, and the like."

Creation of the “Concurrent-Use Doctrine”

The concurrent-use doctrine sets the boundaries of common-law trademarks. In two decisions from the beginning of the 20th century, the Supreme Court established the theory: “Hanover Star

²³Jane C. Ginsburg, Jessica Litman & Mary L. Kevlin, Trademark And Unfair Competition Law ,13 (4th ed. 2007).

²⁴Available at:<https://www.duo.uio.no/handle/10852/22910> (Last Visited on february 1, 2024).

²⁵In re Trade-Mark Cases, 100 U.S. 82 (1879).

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Milling Co. v. Metcalf”²⁶ and “United Drug Co. v. Theodore Rectanus Co.”. These two cases have been discussed below.

The “Hanover Star Milling Co. v. Metcalf case”. Hanover was involved in a multi-party dispute involving the trademark TEA ROSE regarding flour packing, wrappings, and labels in two different lawsuits. The Steepleville Milling Company and the Hanover Star Milling Company, both headquartered in Illinois, were parties to the first action. The Hanover Star Milling Company has promoted its products in Alabama, Mississippi, Georgia, and Florida since 1904. Along with Tennessee, Indiana, Arkansas, and Mississippi, the Illinois-based Steepleville Milling Company also marketed and sold flour, occasionally shipping it to Alabama. Throughout the four states that make up its region, Hanover developed a solid reputation among flour dealers, and no other TEA ROSE flour products have been sold there since 1905 to rival Hanover's offers. The exclusive distribution agreement between Hanover and its distributor prevented Metcalf, a third-party distributor, from selling Hanover's flour in Alabama. In Alabama, Metcalf desired to market Hanover's flour. As a result, Metcalf switched gears and began distributing Steepleville TEA ROSE flour across that state. After that, Hanover filed a lawsuit against Metcalf for trademark infringement and unfair business practices.

The second lawsuit included Hanover being sued by the Ohio-based Allen & Wheeler Company, which distributed TEA ROSE flour throughout Pennsylvania, Massachusetts, and Ohio. Allen & Wheeler claimed that Hanover's trademark was breached by using the name TEA ROSE throughout the states of Alabama, Florida, and Mississippi. Allen & Wheeler had used the TEA ROSE brand since 1872 but did not provide any evidence of how much they had used this property in the markets above. In addition, in the flour markets of Alabama, Florida, or Mississippi, the Allen & Wheeler TEA ROSE flour had never been promoted, sold, offered for sale, or even heard of before. The Court initially handled the Allen & Wheeler case through the use of trademark common law.

The court cited the fact that the primary goal of trademarks is to protect the reputation that a company has laboriously built over many years in concluding that Allen & Wheeler could not stop Hanover from using the name TEA ROSE in the southeastern states of Alabama, Georgia, Florida, and Mississippi. The Court emphasised that a party that owns a trademark is only entitled to remedies and protection in those markets where the brand has been utilised

²⁶“*Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403 (1916).”

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meaningfully. In this market, a trademark owner's only rights are protection and remedies. A trade mark recognises no national or local borders; instead, it covers any market where the trader's goods have gained recognition for the mark because the trade, not the mark, is what is to be protected.

- **Background and meaning of Domain names.**

The Internet serves as a vital global communication platform for people worldwide. Within this unique medium, domain names play a crucial role. Every computer connected to the Internet networking system is given a unique electronic address.²⁷ The Internet is a network of linked computers, each of which has been given an Internet Protocol (IP) address, a unique electronic address. These are numerical addresses denoted by long strings of binary numbers (0 or 1), such as 0110.11.01.00. It cannot be easy to recall and type these numerical addresses precisely.

The Domain Name System (DNS) was created to improve user convenience and streamline the procedure. The Advanced Research Projects Agency Network (ARPANET) was using an outdated name and address system when computer scientist Paul Mockapetris created the DNS in 1983. The DNS automated tasks and dispersed them over a broader network of servers, in contrast to the earlier versions. This change simplified maintenance and made connecting IP addresses to domain names easier.

Instead of using numerical IP addresses, word-based domain names can be used thanks to the DNS. It is necessary to register these domain names with an authorised registrar, usually one that the International Corporation approves for Assigned Names and Numbers (ICANN). Rather than use complex numerical addresses, this approach enables users to reach specific locations on the internet with easily remembered and understandable domain names.

Essentially, a domain name uses words or alphabets to represent IP addresses instead of numbers. These substitutes are more accessible for people to understand and remember. They are essential for reaching particular online locations. A server is used to log users onto the internet. The server reads the domain name and assigns the IP address that corresponds to it. For example, a domain name like "search.msn.co.in" would be interpreted as the IP address "207.46.176.53" by the server. The domain name system carries out this process.

²⁷Rahul Matthan, "The Law Relating to Computers and the Internet", New Delhi: Butterworths publication.

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A domain name should not be confused with a website or a Universal Resource Locator (URL). Although a domain name takes the place of the IP address, it is simply a portion of the URL and website. But in reality, there is less and less of a difference between domain names and websites—many people use them interchangeably. The website's long path is represented by the URL, which makes it easier to find. For instance, "un.org" is the domain name, "www.un.org" is the website, and "http://www.un.org" is the entire URL in the sample URL.

- **Registration of the domain name**

A unique internet address for websites or online platforms can be secured and claimed by individuals or organisations through the process of domain name registration. Working with a domain name registrar, an accredited organisation authorised to register domain names, is one of the various processes in this registration procedure.

- **Overview of the domain name registration process:**

1. Choose a Domain Name: The first step is to select a suitable domain name that represents your brand, business, or online presence. It should be unique, relevant, and easy to remember.
2. Check Availability: Once you have a domain name in mind, check its availability.
3. Choose a Registrar: Select a reputable domain name registrar to register your chosen domain name.
4. supply Registration Information: You will be required to supply some information, such as your name, contact information, and administrative data, throughout the registration process.
5. Set Registration Period: Decide how long you want to keep your domain name registered.
6. Make Payment: Pay the registration fees to the domain name registrar. Prices can vary depending on the registrar, the chosen domain extension (e.g., .com, .org, .net), and any additional services you opt for.

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7. Complete the Registration: Once you have provided all the required information and made the payment, the registrar will process your registration request. If everything is in order, the registrar will register the domain name in your name and associate it with the chosen IP address or hosting provider.
- **Cases where domain registration and infringement of a trademark is being discussed**

1. **Tata Sons Limited v. Manoj Pitti, (2017)²⁸**

In this instance, the problems were cybersquatting and trademark infringement related to the domain name "tatahr.com." The claim was filed against Manoj Pitti by the well-known Indian corporation Tata Sons Limited, who claimed that his usage of the domain name "tatahr.com" violated their trademark rights.

Following a thorough analysis of the arguments and facts, the court decided in Tata Sons Limited's favour. The court acknowledged the Tata Sons' trademark violation by the domain name 'tatahr.com'. Consequently, the court transferred the domain name to Tata Sons, safeguarding their intellectual property rights.

2. **Rediff Communication Limited v. Cyberbooth and Anr.**

In the case of Rediff Communication Limited v. Cyberbooth and Anr.²⁹ The topic at hand concerned the use of the domain name "rediffmail.com" in violation of the trademark "rediff." Rediff Communication Limited, a well-known Indian internet corporation, filed a lawsuit, claiming that the defendants violated trademark laws and committed passing off by using the domain name "rediffmail.com." "The court determined that the defendant's use of the domain name rediffmail.com' did constitute passing off after reviewing the evidence and arguments put out by both sides.

The defendants' activities caused harm to Rediff Communication Limited's brand reputation, the court found, acknowledging the possibility of consumer confusion. To ensure the preservation of their trademark rights, the court consequently ordered the transfer of the domain name "rediffmail.com" to Rediff Communication Limited.

- **Domain name Intellectual property or not?**

²⁸Tata Sons Limited v. Manoj Pitti, (2017) SCC Online.

²⁹Rediff Communication Limited v. Cyberbooth and Anr., (2000).

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One of the essential requirements of intellectual property is to ascertain whether or not the domain name is property. The application of various intellectual property requirements, such as rights and duties, legislative requirements, territoriality, and some justification for the protection of intellectual property to domain names, are the primary topics of discussion in this area. Intellectual property has an incorporeal, intangible quality.

Intellectual property rights encompass all aspects of property, including ownership, enjoyment, transferability, and transmissibility. If these intellectual property rights are violated, the holders of such rights may pursue legal action against the infringer and seek damages, much like the owners of real estate. These rights may also be enforced under the applicable national laws.

As far as domain names are concerned, they are essential for business, and their legal nature is uncertain. For treating domain name as a property, the economic value of domain names, and the bundle of rights theory can be the significant justifications.

For determining the monetary value of domain names is dependent on a variety of factors like they can be sold at different prices; there are numerous disputes that are decided and instituted regarding the ownership of domain names. Though this fact is present, Justice Holmes in *International News Services v Associated Press*³⁰ has held that property is a creation of a law that does not arise from value. “Property depends upon exclusion by law from interference, and a person is not excluded from using any combination of words merely because some other individual had used it before, though it took labour and genius to make it.”

- **Position in India.**

High Court of Bombay in *Rediff Communication v. Cyberbooth & Anr & Nr* stated, “The Internet domain names are important and can be a valuable corporate asset. A domain name is more than an Internet address and is entitled to equal protection as a trademark.” Further to add to this aspect, the Delhi High Court in “*Tata Sons Limited v. Manu Kishori and Others*”³¹ said that “with the advent of modern technology, particularly that relating to cyberspace, domain names or Internet sites are entitled to protection as a trademark because

³⁰International News Service v Associated Press, 248 U.S. 215 (1918).

³¹Tata Sons Limited v. Manu Kishori and Others 2001 PTC 432 (Del).

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they are more than a mere address. The rendering of Internet services is also entitled to protection in the same way as goods and services are, and trademark law applies to activities on the Internet.”

Hon'ble Supreme Court in the case of “*Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd*”³² had expressed, "domain name is a sign which can have a distinguishing function indicating the source of a good or of service and that it thus has the usual features of a trademark."

Citing these authorities, Income Tax Appellate Tribunal, Delhi in *Godaddy.Com Llc, Gurgaon vs Dcit*³³, had decided that paying for the use of the domain name is related to using intangible property that is the same as the trademark and is therefore taxable as royalty. The provision of services for domain registration is considered to be providing services in connection with the use of an intangible property that is similar to the trademark.

So if Indian Judiciary recognised domain names are as important as to trademark, and hence also need protection. So instead of holding domain name as a contractual right or personal property, the Indian Judiciary has treated them at par with the Intellectual Property. Looking towards this aspect it seems that responsibility of ensuring domain name is not violating the IP rights of the holder is to be put on domain name registries.

- **Need of legislation in India.**

In *Raymond Ltd vs. Raymond Pharmaceutical Pvt Ltd*,³⁴The Bombay High Court has noted that "in India, conflicts pertaining to domain names are brought before the court for resolution through passing off actions, as there is no specific statute addressing these matters. There is no indication in the Trade Mark Act, 1999 Statement of Objects and Reasons that the modified Act would be expanded to protect trade marks in domain names expressly.

Legislation is also required because, although parties and dispute resolution organisations refer to earlier rulings in domain name disputes, it is essential to remember that these rulings have no precedential significance and are still subject to review by a court with appropriate

³²Infoway Ltd. v. Sifynet Solutions Pvt. Ltd. (SC) 2004 supp (2) SCR 465.

³³Godaddy.Com Llc, Gurgaon v. Dcit,ITA No. 7123/DEL/2017.

³⁴Raymond Ltd v. Raymond Pharmaceutical Pvt Ltd SUIT (L) NO.957 OF 2014.

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jurisdiction. As a result, under the current legal system, domain name conflicts will undoubtedly be a complex topic when pursuing legal action over the internet.

CONCLUSION AND SUGGESTION

The prospects and views of intellectual property rights have evolved to the point where they need to be revised due to the rapidly expanding and developing sector of technology. Significant advancements in the creation of new goods and services, as well as in the economy and lifestyle of the country's citizens, have been made possible by the protection of intellectual property rights. Therefore, any damage or degradation of it can impede the growth of all parties' economies. The digital age has made it easier for a wide range of people to access, duplicate, and share a lot of information. Many obstacles to the preservation of intellectual property rights are brought about by this technological revolution. This miracle of technology makes it possible to access, share instantly, and duplicate information anywhere in the world.

Revolutionary technological innovation has been brought forth by the Internet's global presence. Distance never matters in online transactions, but on the other hand, when an unauthorised third party registers a well-known or registered trademark as a domain name, the trademark holder's legal rights are violated. Therefore, there are two steps to take: first, register the domain name before a trademark domain name dispute arises, and second, if the domain name proceeding is handled correctly, all conflicting interests will be resolved immediately.

- **SUGGESTIONS**

SUGGESTION ABOUT REGISTRATION OF DOMAIN NAMES

1. In addition to enforcing a “first-come, first-served policy for domain name registration”, domain name registries ought to take proactive measures to furnish information about already-registered trademarks, rather than assuming full responsibility for ensuring that the proposed domain name registrant's name does not violate the intellectual property rights of any third party.
2. This should be the only stage in the domain name registration process, rather than posting all information regarding policies for resolving disputes over domain names under the terms and conditions page. After receiving a request, the domain name

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registry must conduct a first-level screening before approving registration on this basis. This screening can be done by asking the applicant for the domain name to submit business-related documents, such as articles of incorporation or a statement of doing business, which attests to the applicant's legal right to use the requested domain name.

SUGGESTION FOR INDIAN JUDICIAL SYSTEM

1. **Bolster legal provisions:** In Indian trademark law, strengthen the rules pertaining to domain name trademark disputes. This would entail adding explicit clauses that deal with typosquatting, cybersquatting, and domain name hoarding, as well as offering more precise rules for resolving disputes.
2. **Unambiguous standards for trademark infringement:** Provide precise standards for judging if a domain name violates a trademark. This may involve elements including the domain name's resemblance to the brand, the possibility of customer confusion, and the registrant's dishonest intentions.
3. **Streamlined conflict resolution procedure:** Create a cost-effective, accessible, and efficient streamlined dispute settlement procedure. This could entail setting up courts or panels specifically designed to handle issues involving domain names and trademarks, guaranteeing prompt resolution and uniform application of the law.
4. **Court expertise and education:** Provide judges and other court officials with specific education and training in handling domain name-trademark issues. They would have a better understanding of internet governance, domain name technology, and the difficulties in settling such disputes as a result.