

Domain Name Disputes and Unfair Trade Practices: An Analytical Legal Study

A Dissertation submitted

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PREFACE

As we are moving towards the new era of globalization, we should be careful of what technology can do for us. The increased use of new technological development of a constant and rapid integration beyond boundaries, but has also caused a growing interest in legal issues related to the global network. Nowadays one of the most popular matters, apart from copyright law or network security regulation, is that of legal aspects of internet domain names. The development of technology and easy access to internet has significantly influenced the commerce all around the world, opened up new markets etc., but simultaneously ‘enabled’ committing infringement, e.g. in the field of industrial property rights as well as personal rights, copyrights, trademarks (registered and unregistered), company names etc. Chapter I analyzed the topic as to how the development of internet took place and how it have accelerated and facilitated the trade activities. Chapter II analyzed existing legal framework in various countries. This chapter also includes the study of legal situation in USA, since this country has specific laws like “Anti-Cyber squatting Consumer Protection Act”. Chapter III analyzed unfair trade practices in domain name as domain name disputes is leading towards unfair trade practices. This chapter also includes various laws of unfair trade practices in different countries. Chapter IV analyzed the contentious issues of domain name like registration issues, unfair trade practices issues and jurisdiction issues and lastly Chapter V includes conclusion and suggestions of the stu

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LIST OF ABBREVIATION

AIR- All India Reports.

ARPA- Advanced Research Project Agency.

ACPA- Anti cybersquatting Consumer Protection Act.

Cr L J - Criminal Law Journal.

ccTLD- Country Code Top Level Domains.

COPRA - Consumer Protection Act, 1986.

DGIR - Director General of Investigation and Registration

DNS- Domain Name System.

FTDA - Federal Trademark Dilution Act of 1995.

IANA - Internet Assigned Numbers Authority

IETF - Internet Engineering Task Force

IP- Internet Protocol.

ICANN- Internet Corporation for Assigned Names and Numbers.

ICA- International Centre for Arbitration

ICADR- International Centre for Alternative Dispute Resolution

INDRP - .IN Dispute Resolution Policy.

M RTP - Monopolies and Restrictive Trade Practices Act.

NSI- Network Solution Inc.

OECD - Organisation for Economic Cooperation and Development.

RIR - Regional Internet Registry

SCC- Supreme Court Cases

TCP -Transmission Control Protocol

TLD- Top Level Domains.

TMA- Trademark Act.

TRIPS-Agreement on Trade related Aspects of Intellectual Property Rights

TTAB - Trademark Trial and Appeal Board

UDRP- Uniform Domain Name Dispute Resolution Policy.

UDTPA - Uniform Deceptive Trade Practices Act (1964/1966)

UNCITRAL- The United Nation Commission on International Trade Laws

UTP - Unfair Trade Practice

v. - Versus

WLR- Weekly Law Reports

WTO - World Trade Organization

CHAPTER 1: Introduction

The history of the internet begins with the development of electronic computers in the 1950s. Initial concepts of packet networking originated in several computer sciences laboratories in the United States, United Kingdom, and France. “Since that time and with the addition of the user-friendly World Wide Web in the year 1989 the Internet has been transformed into a multifaceted network for communication and commerce, whose purposes are as broad as the Internet community that employs it”. This Introduction of internet have accelerated and facilitated the trade activities hence the trend of trade practices through internet is increasing day by day. And people started creating web-site which they can use in their day to day business activities, advertisements, dispensing information, communicating with the people throughout the globe.

Now internet facilitated and one can register a domain name using their trademark and do business accordingly through the internet. The modern generation consumers instead of going to the malls and shops prefer to stay at home and shop online through various channels like Amazon, Myntra, and Jabong etc. Internet sites are also offering various services like online ticket booking of flight, train, and bus (Yatra.com, makemytrip.com) etc. There are also sites of Universities offering various educational programmes like Sikkim University, Delhi University, National Law School of India University, Bangalore etc. The sites are in the form of Uniform Resource Locator. These Uniform Resource Locator (hereafter referred to as URL), are called domain names. “A domain name is a computer address through which a company or an individual can be located by any other user with Internet access.

“Every website on the Internet has an ‘Internet Protocol’ (IP) address. The IP addresses, being all numeric and lengthy, are not easy to remember”. For the purpose of convenience, these all numerical addresses are expressed in the form of letters or words, popularly known as domain

name system. Domain names serve to distinguish and locate the various computers, users, files, and resources accessible over the Internet. Without a domain name, a company would be practically invisible on the Internet, as customers would not know where to find it. Every computer or user connected to the Internet must be distinguished and located by other users.

There are innumerable instances of misuse of domain names. For instance some people for earning money or with similar kind of intentions uses some popular brand names for getting domain address registered in their names before it got registered with the right owner. These practices are increasing day by day and taking the shape of unfair trade practices. “An unfair trade practice consists of using various deceptive, fraudulent or unethical methods to obtain business. Unfair trade practices include misrepresentation, false advertising, tied selling and other acts that are declared unlawful by statute. It can also be referred to as deceptive trade practices”. “According to Merriam dictionary unfair trade practice means any of various deceptive, fraudulent, or otherwise injurious (as to a consumer) practices or acts that are declared unlawful by statute (as a consumer protection act) or recognized as actionable at common law”.

With similar kinds of intention the people are using internet and getting domain name registered this practice is called cybersquatting. “Cybersquatting refers to illegal domain name registration or use. It can have a few different variations, but its primary purpose is to steal or misspell a domain name in order to profit from an increase in website visits, which otherwise would not be possible. Trademark or copyright holders may neglect to reregister their domain names, and by forgetting this important update, cybersquatters can easily steal domain names. Cybersquatting also includes advertisers who mimic domain names that are similar to popular, highly trafficked websites. It is one of several types of cybercrimes”. “Cybersquatting is also known as domain squatting. “According to the U.S. federal law known as the

Anti-Cybersquatting Consumer Protection Act, 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 derives from squatting, the Practice of inhabiting someone else's property without their permission". The Indian Court in *Yahoo Inc, Rediff Communications* and the *SatyamInfoway* brought the issues under two heads; infringement and passing off unlike US, which has a separate legislation to deal with domain name-trademark disputes. Indian line of action in the said case was similar to UK which also lack any specific legislation on domain name and the cases are dealt under Trademarks Act 1994. While infringement actions are available in case of registered trademarks, the passing off is invoked in case of unregistered trademarks.

Essentially, the Information Technology Act 2000, only legislation on cyber space in India, does not deal with the domain name-trademark disputes. In addition, the Trademark Act 1999 does not contain any provision relating to domain name. However, in the absence of any specific law on domain name Indian judiciary is dealing with some of the domain name disputes under the Trademark law. These disputes include cybersquatting, appropriation of goodwill, diversion of website, defamation etc. Judicial intervention is also made when the information or services that are provided through a domain name are related to the provisions of services within the meaning of Section 2 (1) (z) of the Trademark Act 1999. It is beyond doubt that the judicial settlement of domain name- trademark disputes has number of limitations. The dispute is settled under civil matter while when the malafide/bad intention is part or the cause of act, the criminal factor can't be ignored. But the laws are not on the direction of criminal liability. Unfair trade practice attracts some corporeal punishments in some serious cases because some miscreants are using sites for uploading porn or sometime defamatory data which may affect the reputation of the site owner. The time period required in judicial settlement itself is another major concern in the areas like domain name-trademark

disputes, since there is a possibility of huge loss to the parties within a short span of time. The ignorance of judges in this new field, limited application of Trademark Act, failure to settle the disputes between rightful claimants etc. remain as unresolved problems of judicial settlement in India. Just like the UK, too much reliance on the judicial trend in the determination of manifold aspects of domain name-trademark disputes is a matter of concern in India. The researcher in her research tried to point out some major problems of unfair trade practices in domain name.

STATEMENT OF PROBLEM

The main problems of domain name dispute emerge from explosion in the use and need of the internet. The boundryless nature of the internet directly conflicts with the very territorial nature of trademark law leading towards trademark and domain name dispute. The global aspect of internet makes it very difficult to blindly apply trademark law because trade mark law vary so much from country to country. Looking into the gravity of the problem and for convenience the statement of problem has been divided into five parts. First part deals with registration as cause of conflict. Second part deals with problem of authenticity as to who is the real owner of the domain name. Third part deals with domain name disputes in cross-border affairs. Fourth part deals with Problem in laws and dispute resolution mechanism and the last problem is relating to cross border.

1. The registration as cause of conflict

The first step in domain name is registration. Without a domain name, a company would be practically invisible on the Internet and the customers would not know where to find it. The process for registering domain name makes domain names a main ground for trademark disputes. The cost of registering a domain is extremely low in comparison to the economic

damages that it may cause, or the cost of litigation.

Domain names are fairly easy to register, the general practice of registries is to check the availability of second level domain (hereafter referred to as SLD)/ top level domain (hereafter referred to as TLD) combination and ensure no duplicate domain names are allocated, unlike trademarks registries who conduct a full examination process to determine possible conflicts. Thus, it is possible for a third party who has no connection at all with a trademark to register it as a second level domain and deprive the rightful owner of the mark the opportunity to register the mark in the same second level domain.

Another registration issue is that most registries implement first come, first served policy. Therefore whoever comes first will get the domain name. Since, no other searches are undertaken to check whether the domain name is in use for some other purpose, such as a trade name etc which is not a part of liability. Hence this practice provides another incentive to cybersquatters to register the trademark before the rightful owner of the mark and then offer it later at substantial fee. Cybersquatters register domain names containing popular trademarked, with a view to making an illegal profit from them or to misuse it, whereas in typosquatting, typosquatters register domain names using misspelled words or large popular websites, with malicious intent leading towards unfair trade practices.

The reputation and trademarks of company or business become a Uniform Resource Locator (URL). For instance, if a person has a huge business called 'abc' services and trademark saying 'abc' service; people will obviously think that the website will be www.abcservices.com. But since 'abc'company did not think about registering this domain the other people get the opportunity on the web and accordingly bought the URL. Now to host its own website and to prevent damage to its reputation, 'abc' services will have to buy back the URL from whoever purchased it. Even if a company have a site say www.abc.com, cybersquatters will register a

different top-level domain like say 'abc.net' or 'abc.in' in a hope that the main website will someday buy it off their hand at handsome profit.

People make typographical errors while typing in the address bar. If someone wants to benefit from a well-known reputation, he or she will buy domains looking like the genuine URL but contains a typo a very common practice in banking services. For example to fool people, someone might buy 'Instagrom' because 'Instagram' already exists and is popular amongst all people but has 'o' instead of 'a'. The intention in typosquatting is always harming people, stealing their identities and making profits while with cybersquatting. This act of cybersquatters and typosquatters are deceptive, fraudulent, unethical methods of obtaining business of others and it includes misrepresentation which is the essential requirements of unfair trade practices. These types of practices comes under the unfair trade practices because there is likelihood that consumers will be mislead or confused as to the source of origin of goods or services. Thus the main problem of domain name disputes leading towards unfair trade practices lies in registration of domain name.

2. Issues of authenticity as to who is the real owner of the domain name

There are also issues of domain name owing to the following reason: It is a virtual company registered online, one cannot know the authenticity of the company without special efforts. Therefore to know whether the authentic physical company has registered in its name or some other unauthorised person with various motives has registered, a proper investigation is required before registering the domain name which is not the part of procedure yet.

Further when the authentic physical company wants to register domain in its name there would be a problem for authenticity if domain name already registered with someone else. Here the

genuine domain name owner will be bound to face adversities because of someone's bad motive to earn out of this situation. Here the issue becomes more complex because the domain name cannot be legally own by the right owner since it is licensed to another person or company by the relevant registries in return for fee however with some hidden motive.

Another issue to know it before registering by the registrar, that is quite complex as the volume of new registration of domain name is 50,000 to 100,000 per week. Also it (URL) is case sensitive matter, they cannot identify domain name registration leading towards unfair trade practices while registering 50,000 to 100,000 domain name per week. Though unfair trade practices can arise from a variety of business practices, they frequently appear in connection with the domain name.

3. Domain Name disputes in Cross-border Affairs

When two or more parties with independent and legitimate rights for the same trademark in different lines of business or jurisdictions seek the same domain name, disputes occur. This kind of disputes occurred at two different levels, firstly, when the same mark owned and used by different persons in respect of different goods or services. Secondly, when the same mark owned and used by different persons in different countries in relation to the same goods or services.

The same trademark cases are the genuine cases of conflicts between trademark and domain names because of their fundamental characteristics. The difference in the areas and level of operation of trademarks and domain name has been great challenge to law across the border. Due to the national character, the trademark can be owned by two or more persons. It may be in different countries on the same goods or services but URL can't be allotted to both, only one can claim i.e. whoever is first.

Since all the owners of same trademark want to promote their business online, they all would be interested to get their trademark registered as domain name unfortunately; this cannot happen since the domain names are unique and can only be held by one person. The first in time would be able to register the trademark as domain name, depriving all other holders of trademark from enjoying similar form of privilege. This ultimately results in disputes between the owners of same trademark. At this kind of situation no alternative remedy is exists. Also registration is on a first come first serve basis. Simply because a person have a particular registered trade or service mark in the name of the company or have been using a trade name for a lengthy period of time does not mean that another person with a legitimate reason for registering the domain and who uses it in good faith must give it up. Thus, the disputes arising out of legitimate claims pose a serious challenge to the adjudicators that too in the absence of any legal solution.

4. Problem in laws and dispute resolution mechanism

Law is limited in nature to deal with such conflicts arising out of technological innovation. With regard to Indian legal position there is neither any separate law nor does existing law has any specific provision relating to domain name in the Trademark Act 1999, though on some occasion judiciary took an initiative in deciding domain name disputes under the Trademark Act. Because of the boundary-less nature of internet violation of trademark registered in one country may happen in another country owing to bad faith domain name registration. Such a situation would bring forward the problem of determination of jurisdiction and applicable law for solving the dispute.

The court is trying to deal with domain name conflicts under the Trademark laws. In case of Yahoo Inc vs. Akash Arora, the court has brought up the subject matter of domain name into trademark law by granting injunction for passing off here the Trademark Act 1999 does not

contain any provision relating to domain name. However, the Indian judiciary is dealing with some of the domain name disputes under the Trademark Act but it remains unattended in the absence of proper law.

Another problem of recent origin is 'reverse domain name hijacking'. It is an attempt by a trademark holder with bad faith, to take control over the domain name of another, who has not breached the trademark laws, and has a legitimate interest in the domain name. Here the person attempting to take control of the domain name has the knowledge of the fact that the owner of the domain name has legitimate interest in the domain name. Still in such a situation he resorts to legal action in bad faith with a primary intent to harass the domain name holder. This kind of conflict is also not properly addressed in law.

Domestic laws have been found inadequate in provisions to deal with the domain name disputes due to their international characters. In response to this, the Internet Corporation for Assigned Numbers and Names (hereafter referred to as ICANN) in consultation with World Intellectual Property Organization (hereafter referred to as WIPO) has provided a policy for domain name dispute resolution, which is known as Uniform Domain Name Dispute Resolution Policy (hereafter referred to as UDRP). UDRP provides for the resolution of domain name disputes through mandatory administrative proceedings, which are to some extent similar to arbitration proceedings. Despite the fact that the UDRP is increasingly popular in solving the domain name disputes, it is not free from some inherent loopholes.

Most strikingly, the limited scope of application, limited remedies, possibility of bias towards complainants, forum shopping, limited time gap resulting in hurried decisions without proper reasons, possible violation of due process and possibility of conflicting decisions by Panels are the major areas of concern. Therefore, most of the trademark holders are attracted towards the court litigation under national legislation. Finally, the existing domain name-trademark dispute

resolution mechanism is not comprehensive. Neither the court litigation under the domestic laws nor the mandatory administrative proceedings under UDRP can handle all types of domain name-trademark disputes.

5. Problem relating to cross border

The other type of the conflict occurs because the internet is global, not a geographical network. In physical world, holder of similar trademarks issued in different jurisdiction is rarely exposed to conflict because their systems for marketing are normally country-based, and thus match the geographical boundaries of the trade mark. However, the domain name system allows every server connected to the Internet to be accessed from anywhere else, which means that any trademarks registered in the domain owner's jurisdiction are displayed in other jurisdictions where different persons may hold the mark. This will lead to confusion of the mark, which have to be addressed carefully.

Doing business in internet is very easy and perhaps more complex which allows a person's to reach beyond his own jurisdiction. This way leads to overlapping of legislative and judicial competencies fostered by cyberspace. Although domain name owners creates website with the global online presence, that presence creates significant offline spill over effects in many domestic jurisdictions. This result has been a clash of duelling law making and adjudicating competencies, both between different domestic legislature and courts, and between domestic and international bodies.

If a dispute arise between two parties there is confusion as to which country law should be applied: Firstly, Choice of Forum (which country's courts should have jurisdiction to try the dispute), Secondly, Choice of Law (which country's laws should be applied to resolve the dispute, as the issues can be that the country may not have any law to deal with that particular

kind of issue i.e. absence of law) and lastly, whether any foreign judgment obtained abroad might be enforceable in the home country or not (Judgment Enforcement).

Although there are considerable differences and similarities between trademark law model and domain names, domain name literature suggests that trademark law is not fully applicable to domain names disputes. There are some reasons that cause the conflict between domain names and trademark law, these reasons show that trademark law is inadequate remedy to domain names. Trademark law is limited by geography and open by classification. Hence trademarks are attached to specific jurisdictions and specific goods or services. First, trademark law is national by nature despite some sort of international or regional harmonisation. Trademarks are registered on a territorial basis. Unregistered trademarks are limited to a particular geographical area within which the marks are actually used. Thus, it is common for a trademark to be Domain name and Trademark protection owned by different, unrelated companies in different countries or regions. Domain names, however, do not respect geographical borders. A domain name user can make a global use of a trademark.

While the major international organizations, like the Organisation for Economic Co-operation and Development (OECD) and the G-8 (Group of Eight), are seriously discussing cooperative schemes, but many countries do not share the urgency to combat cybercrimes (here cybersquatting) for many reasons, including different values concerning piracy or espionage or the need to address more pressing social problems. These countries, inadvertently or not, present the cyber-criminal with a safe haven to operate. Never before has it been so easy to commit a crime in one jurisdiction while hiding behind the jurisdiction of another. Though the issue of jurisdiction in cyberspace cannot be settled spontaneously, but still a global effort in this direction is the need of hour. Apart from tangible rights, some intangible rights called as 'intellectual property rights' such as trademarks, copyrights and patents etc. are also infringed

in the cyberspace. Hence this poses a challenge for further study and investigation.

LITERATURE REVIEW

1. Gayle Weiswasser (2003) in his article "*Domain Name, the Internet, and Trademark: Infringement in Cyberspace*", he discusses that how the digital transmission of data over the Internet, the world's largest computer network has challenged and tested traditional legal concepts and doctrines, especially in the area of intellectual property. The Internet poses unique problems for those trying to protect the goodwill and intangible value encapsulated in a trademark. This paper has addressed two specific areas in which the Internet has impacted trademark law: the alleged infringement of existing trademark rights by computer users who register allegedly infringing domain names, or computer addresses, as well as the resolution of disputes between two users with legitimate claims to the same domain name. The article does not deal with a problem relating to registration of domain name which is the main cause of the conflict in cyberspace. In case of domain name the main conflict is with the registration of domain name. The problem starts only after registering the domain name with one person which other claims to belong to him.

2. Sunando Mukherjee (2004) in his article "*Passing off in Internet Domain Name- a Legal Analysis*", he states that Internet today has revolutionized the world of communication; it has brought the whole world at the click of the mouse. It has removed all the trade barriers and has transformed the world into a small village. But as there is a growth in the Net subsequently a rise in interaction between more and more number of people, so arises a dispute with the interface, viz. the internet. The growth of the website has also given rise to a new area of dispute- domain name disputes. This article has tried to analyze the position of law (before the notification of the Trade Mark Act, 1999) governing such a tort in other countries in comparison to India and also such other international bodies, which have tried to allay the fears

of genuine users. In this article the author has also discussed that disputes under the UDRP are decided by independent panels appointed by the WIPO center. The remedies available to a complainant in a UDRP proceeding are limited to transfer of the disputed domain name registration to the complainant, or rarely requested option of cancellation of the domain name registration. Neither monetary nor injunctive relief is available. In the end the author didn't suggest a solution for the problem such as to include more effective laws to deal with domain name conflicts. The monetary relief is not available while injunctive relief is available under Trademark Act 1999 in India. Hence there is a need of comprehensive law in Trademark issues in India which is not discussed in this article.

3. Bukola Faturoti (2015) in his article "*Business Identity Theft under the UDRP and the ACPA: Is bad faith always bad for business advertising?*" he states that Websites have provided a very strong platform for businesses to reach their customers. They surpass the regular billboards by providing portals through which transactions are conducted without any physical contacts between a seller and a buyer. This usefulness underscores the importance of domain names through which websites are navigated. Cyber squatters have in bad faith targeted or hijacked domain names of famous and reputable businesses exploiting the goodwill of these names and misleading customers and other internet users. This paper has explores the construction of bad faith under both the Uniform Dispute Resolution Policy and the US Anti cybersquatting Consumer Protection Act. The paper argues that, despite some inconsistencies, "bad faith" elements have been broadly interpreted to embrace various activities of cyber squatters. In this article the author didn't mention about the jurisdiction issues which are most important issues. The main issue of the internet is the presence of multiple parties in various parts of the world. So, if the dispute arises between two parties residing in two different countries, at that time which country's law will be applicable is the complicated issue in case of cyberspace which need to be addressed carefully.

4. Christ Reed (2010) in his book “*Internet Law*” he explains about the fundamental principles of law which apply to internet. He does this by; a) identifying the special legal problems which the internet has created, b) examining the ways in which these are dealt with in different countries, and c) identifying the common principles which are used globally to regulate use of internet. He states that problem which does not exist in the physical world, or which are comparatively easily coped with becomes insoluble in the internet world. Though the author has almost cover all the aspects of internet law but he left out the matter relating to a dispute between two genuine users having same trade mark in different line of business or jurisdiction seeking the same domain name. Because it is not always a result of bad intention it is sometimes ignorant act or coincidence which needs to be taken care and need a lot of consideration while registering.

5. David S.Fleming, Laura Beth Miller, Brinks Hofer Gilson and Lione Chicago (2002) in their article “*IP: Trademarks/Unfair Trade Practices*” they discussed that the internet has created opportunities and challenges for trademark owners. Opportunities flow from the speed and ease of reaching consumers. Similarly, challenges flow from the speed and ease of proliferating unauthorized uses. While the internet has created new media for trademark uses and spurred the development of new legislation and forums for addressing disputes, trademark cases involving the internet ultimately are decided by applying traditional trademark law principles that have evolved in the brick and mortar world. This article discussed about brief overview of personal jurisdiction and availability of administrative proceedings for resolving domain name dispute under the Uniform Domain Name Dispute Resolution Policy required by the internet corporation for Assigned Names and Numbers. The authors didn’t mention about the interconnection between the registration of domain name and unfair trade practices which lead to various conflicts in cyberspace.

6. Aaron Schwabach his book *“Internet and the law; Technology, Society, and Compromises”*, he lays particular emphasis on Intellectual Property Law and Laws regarding freedom of expression. The internet, as this book shows, raises questions not only about how to protect intellectual creations but about what should be protected. Entries also discuss how the web has brought First Amendment rights and free expression into question as society grapples with attempts to control “links” and to restrict content such as pornography, spam, defamation, and criminal speech. The author has said that as information technology grows and the internet’s global reach strengthens, it is becoming more difficult to define rules to regulate it. Governments have tried for various reasons to restrict internet content but have not succeeded in part because the international nature of the Internet makes enforcement difficult. *“Internet and the Law”* focuses on law relating to intellectual property and freedom of expression, and presents information in a clear and concise manner, making it easily accessible to all.

7. Vivek Sood in his book *“Cyber Crimes, Electronic Evidence and Investigation: Legal Issues”* has suggested various strategies to curb cybercrimes. He says that since cybercrimes are technology based, so the best answer to these crimes is security technology. Fire-walls, anti-virus software and anti-intrusion systems are some of the effectively used security technologies. He concluded that “protect yourself” is the best mantra against cybercrimes. According to him, effective cooperation between the law enforcement agencies within the country and between nations is also necessary to challenge cyber criminals and bring them before the law. Further he calls for strengthening of extradition treaties and their implementation as a must in this digital age.

8. Dr. M. Dasgupta in his book *“Cyber Crime in India: A Comparative Study”* has succinctly defined the meaning, nature, scope, characteristics and elements of cybercrimes. Commenting on the scope of cybercrimes he has stated that “it is very essential to emphasize that the world is

not run by weapons anymore, or energy, or money. It is run by ones and zeros, little bits of data and it is all electrons. There's a war out here, a world war. It is not about who has the most bullets. It is about who controls the information – what we see and hear, how we work, what we think etc. It's all about information. "Further, he has critically analysed the modus operandi of some important cybercrimes like cyber hacking, cyber terrorism, cyber pornography, cyber fraud etc. and also stated the national and international initiatives to prevent and control such cybercrimes.

9. S.K. Verma and Raman Mittal in their book "*Legal Dimensions of Cyber Space*" have explained the basic concepts of cyber world like meaning, types, features and major components of computers; history and development of internet; merits and limitations of internet; various computer contaminants like virus, worms, Trojans etc. Emphasizing on the importance of computers and internet in day-to-day chores they have opined that "today it touches and influences almost every aspect of our lives. We are in the information age and computers are the driving force. We hardly do any activity that is not in some way dependent on computers." They further suggest that not only do we need to be computer-literate, but we also need to understand the myriad issues that surround our extensive and necessary dependence on computers. Commenting on the interlink of human-conflicts-law, they states that where humans are, crime and conflict of interests cannot be far behind, further, where crime and conflict of interests are, law must necessarily march in order to take control and regulate. Thus, they have made a detailed study on the indispensable role of computer and internet, and the resultant cybercrimes.

10. Ahmad, Farooq in his article "*Interplay of Internet Domain Names and Trademark Law*", the author has observed that internet domain names have spawned unprecedented legal issues which do not have express solution. Though the courts have accorded equal protection to

trademarks and domain names, but still domain names are at stake due to highly technical nature of computers and internet. He has given a detailed account of the role of Uniform Domain Name Dispute Resolution Policy (UDRP) in protecting domain names.

11. Bigos, Oren in his article "*Jurisdiction over Cross-Border Wrongs on the Internet*", has stated that internet knows no boundaries. He has critically analysed the issue of jurisdiction in cyber offences and advocated that an international law universally applicable to all the countries of the world is the need of hour to nip the evil of cybercrimes in the bud itself.

12. Justice Yatindra Singh in his book "*Cyber Laws*" has elaborately discussed the meaning and importance of intellectual property rights like trademarks, copyrights, patents etc. vis-a-vis cyber space. According to him, these rights refer to the property that is a creation of the mind i.e. inventions, literary and artistic works, symbols, names, images, and designs used in commerce. In one of the chapter in his book he has discussed about domain name, cybersquatting, typo squatting etc. What is missing here is an analysis of various laws relating to domain name and this book does not look at the jurisdiction issues.

13. Lisa M. Sharrock "*The Future of Domain Name Dispute Resolution: Crafting Practical International Legal Solutions from within the UDRP Framework*" has discussed that the UDRP, the comparatively fast and inexpensive option, has become the overwhelmingly preferred mechanism for domain name dispute resolution." Despite its widespread use, however, the UDRP is an imperfect system. Specifically, it provides too little guidance to arbitrators, a flaw that has led to inconsistent decisions on several key domain name use issues and, relatedly, concern that some decisions exhibit a bias toward corporate trademark holders. Additionally, to the extent that the UDRP has provided uniform principles of dispute resolution, these principles are inapplicable to a growing segment of domain names; namely, those obtained through registrars not accredited by ICANN or through a country code authority

that has not elected to bind its registrants to the UDRP. In this article the author has discuss these concerns and recommend several measures that will enable ICANN to craft the UDRP into a more effective and uniform international dispute resolution mechanism. She argue that the problem of inconsistent decisions should be addressed by amending the UDRP to add specific examples of conduct that violates the policy, as well as examples of conduct that should be considered explicitly outside its scope. Relatedly, the amendments to the UDRP should attempt to dispel any appearance of pro-corporation bias and should bolster fair use as a justification for registration and use of trademarked domain names. Finally, she conclude that the interests of the Internet community will be best served if all country code registration authorities and non-ICANN accredited providers submit to either the UDRP or an identical dispute resolution policy, and she suggest methods by which ICANN can encourage attainment of this goal.

14. Michael G. Walsh, Luh Luh Lan, May Lwinand Jerome D. Williams“*Marketers ‘ Boon in Cyberspace: the Anticybersquatting Consumer Protection Act* “they discussed that Cybersquatting continually has plagued Internet traders. The Anticybersquatting Consumer Protection Act is intended to protect trademark owners and consumers alike, especially in the Internet environment. This article evaluates the effectiveness of the act by reviewing recent cases that have interpreted the act, details remedies available to consumers and others under the act, and explains the defenses available to cybersquatters. The authors discuss the currently unresolved issues under the act, including those related to international protection of existing domain names. The act may have had an unintended consequence for Web site creators, however, considering that some corporations use it to bludgeon into submission former employees and others who have created Web sites critical of the respective corporation's policies and operations. A review of recent articles and court decisions casts light on whether the act is a help or a hindrance to marketers.

15. Joseph P. Bauer “*A Federal Law of Unfair Competition: What Should Be the Reach of Section 43(a) of the Lanham Act?*” the author has discussed that expanded availability of Section 43(a) to allow injured businesses to counter a wide variety of competitive wrongs. It is important that there be a uniform, federal law of unfair competition. Although imaginative attorneys have inappropriately attempted to use this statute for situations for which it was never designed, some courts have also refused to apply the statute to unfair and anticompetitive conduct which may demand relief. The first three sections of this Article briefly review the law of unfair competition prior to the enactment of Section 43(a) of the Lanham Act, the legislative history of that provision, and those cases marking its early development. The Article then presents a description of those activities which fall within the statute, and analyzes the limitations imposed by various other courts. The last section begins with an examination of the goals of the trademark laws and of the policy considerations implicated by a broader versus a narrower application of this particular statutory provision. It analyzes the need for a uniform federal approach to unfair competition and discusses particular problem areas under Section 43(a). Finally, this Article argues that the expansion of the Act to cover doubtful activities-harmful, unfair, or deceptive business practices is both necessary and appropriate, and that the extension of the statute to encompass certain other forms of unfair competition would also be desirable.

16. John Magee “*Domain Name Disputes: An Assessment Of The UDRP As Against Traditional Litigation*” the author has discussed that as the move towards the Information Society continues in Europe, and indeed globally, the recognition of the Internet as an exciting new commercial medium by companies and traders has been swift and widespread. The commercial sector has embraced this marketing and communications tool and today, virtually every company, from global conglomerates to one-man operations, has established its own Internet Web site. Web sites vary in their functions: some are merely another form of

advertisement, while others offer goods, services, and information about a company. One of the most important aspects of any Web site is its address or domain name. The domain name is the consumer's portal to the seemingly limitless Web sites available on the World Wide Web, and the global nature of the Internet has led to a new form of legal dispute in this regard. Unlike trademarks, which are territorial in their application, domain names have a global span in their operation, making it impossible for two companies to use the same Web address. Thus, although many companies worldwide may trade under the name McDonald's, only one company will be entitled to register the address mcdonalds.com.

RESEARCH OBJECTIVES

1. To find out various grey areas in registration policy with regard to domain name registration and also examine the extent of the liability of registrar of domain name in his act of registration.
2. To find out the various instances of unfair trade practices in domain name disputes and in such a scenario in the absence of domain name laws to what extent the court have ensure justice in domain name disputes.
3. To find out the issues of authenticity of genuine domain name and the extent of liability of registrar in controlling and preventing unfair domain name registration leading to domain name disputes.
4. To know the present domain name dispute resolution mechanism in cross-border cases and to find out the possibility of successfully introducing online dispute resolution mechanism.

RESEARCH QUESTIONS

1. What are the various grey areas in registration policy with regard to domain name registration and to what extent the registrar of domain name will be liable in his act of registration?
2. What Constitutes unfair trade practices in domain name disputes and in such a scenario in the absence of domain name laws to what extent the court have ensure justice in domain name disputes?
3. What are the issues of authenticity of genuine domain name and the extent of liability of registrar in controlling and preventing unfair domain name registration leading to domain name disputes?
5. What is the present domain name dispute resolution mechanism in cross-border cases and what is the possibility of successfully introducing online dispute resolution mechanism?

HYPOTHESIS

The existing legal and policy framework of the domain name dispute is not adequate to address the issues of unfair trade practices in domain name disputes.

RESEARCH METHODOLOGY

- In this paper methodology adopted by the researcher will be purely doctrinal in nature. It will involve in depth study of source materials, text review, and case studies of national and international countries. The research will be based on two types of material i.e., primary materials and secondary materials. In my Primary materials I will be analysing text of laws

like (Anticybersquatting Consumer Protection Act, 1999, The Federal Trademark Dilution Act, 1995, The Lanham (Trademark) Act, 1946, The Trademark Act, 1999 etc.) and various international declarations. Secondary materials will consist of books, articles, research papers and journal. The research will also include study of case laws. Use of the internet will also be made to gather important information relating to the subject of study.

CHAPTERIZATION

1. Introduction

2. Existing Legal Framework: India and U.S.A.

3. Unfair Trade Practices in Domain name

4. Contentious Issues of Domain Name

5. Conclusion and Suggestion

CHAPTER 2: Existing Legal Framework: U.S.A and India

“Domain name disputes in the context of trademarks arguably can be decided within the legal structure of trademark law”¹. This chapter will discuss about existing legal framework of India and U.S.A. Since the USA has specific law “Anti-Cyber squatting Consumer Protection Act” which India lacks that’s why the study will include examining the legal situation in USA as well. Paris Convention and the Agreement on Trade related Aspects of Intellectual Property Rights (TRIPS) is the guiding principles on the basis of which the various laws are based. The legal term of “well-known trademark” first appeared in 1883. Paris Convention for the protection of industrial property which sets forth the principles for granting special protection to the well-known trademarks. Though the convention does not specify measures for protection of well-known trademarks or their recognition procedures, leaving room for each signatory country to decide how it wishes to address these matters. “Paris Convention is the oldest major multilateral treaty designed to improve the international protection of trademark rights”². “The Agreement on Trade- Related Aspects of Intellectual property Rights , the intellectual-property treaty concluded as one of the foundational agreements of the World Trade Organization (hereafter referred to as WTO), includes all substantial obligations of the Paris Convention with respect to trademarks and expands upon them as well. For example, the signatory nations agreed to extend the Paris Convention well-known marks obligation to include service marks as well as trademarks. The TRIPS Agreement also expanded protection for well-known foreign marks beyond uses or registrations that would create a likelihood of confusion. TRIPS mandate protection against unauthorized use or registration with goods or services dissimilar from those associated with the well-known mark, provided that the use would indicate a connection with

¹ Mohammad S. Al Ramahi, “Internet domain names & Trademark Law: Does the current legal Scheme provide an adequate protection to domain names under the US & the UK jurisdictions”.

² Honoring International Obligations in U.S. Trademark Law: How the (Nov.27, 2017, 9:40 PM) https://digitalcommons.law.lsu.edu/cgi/viewcontent.cgi?article=1301&context=faculty_scholarship.

the foreign owner and would likely damage the interests of that owner”³.

2.1 The Paris Convention

“The impetus of the Paris Convention appears to have been two-fold: to avoid the unwanted loss of eligibility for patent protection through publication of patent applications and participation in international exhibitions in advance of filing national patent applications; and a desire that the diverse patent laws of nations be harmonized to some degree. Prior to the Convention, those wanting protection for inventions in multiple countries needed to file patent applications in all such countries simultaneously, and needed to do so prior to any publication or exhibition of the invention at a trade fair, in order to avoid the unintentional loss of eligibility of patent protection in one or more of the countries. The challenge then facing inventors caused many who had been invited to the Austria-Hungary international exhibition of inventions held in Vienna in 1873 to be unwilling to exhibit their inventions, leading to the enactment of a special Austrian law that secured temporary protection to exhibitors and to the Congress of Vienna for Patent Reform convened that same year. The Congress of Vienna led in turn to an International Congress on Industrial Property, convened at Paris in 1878. That congress resolved that an international diplomatic conference tasked with determining the basis of uniform legislation in the field of industrial property should be convened. A draft convention proposing an international “union” for the protection of industrial property was circulated by the French Government together with an invitation to attend the International Conference in Paris in 1880. The 1880 Conference adopted a draft convention containing many of the provisions that underlie the Paris Convention today. That draft convention concluded at a further Diplomatic Conference convened in Paris in 1883. Those approving and signing the original 1883 version of the Paris Convention were Belgium, Brazil, El Salvador, France,

³ *Supra* note 2.

Guatemala, Italy, the Netherlands, Portugal, Serbia, Spain and Switzerland. The Convention became effective on July 7, 1884, at which time Great Britain, Tunisia and Ecuador were also adherents. The United States joined soon after in 1887. By the end of the 19th Century, the Convention had only 19 members. It was not until after World War II that the membership in the Paris Convention increased significantly. Today the Convention boasts of 172 members. Taiwan and Kuwait remain outside the Union, while Taiwan commits to recognize priority claims of Union members pursuant to Article 27 of its Patent Act. The Paris Convention underwent revisions, in Rome in 1886, in Madrid in 1890 and 1891, in Brussels in 1897 and 1900, in Washington in 1911, in The Hague in 1925, in London in 1934, in Lisbon in 1958, and in Stockholm in 1967, and was further amended on September 28, 1979. Many of the revisions are significant, particularly those concerning unfair competition. Most Union members adhere to the latest revision concluded in Stockholm, known as the Stockholm Act. Concurrent with the 1967 revision at Stockholm was the establishment of the World Intellectual Property Organization (“WIPO”). WIPO assumed responsibility from its predecessor international organization, the United International Bureau for the Protection of Intellectual Property, for administering the Convention. Nations not yet members of the Paris Union that are members of the World Trade Organization (“WTO”) are obliged to comply with the substantive provisions of the Convention from the date of their application to the WTO. Article 2 of the TRIPS Agreement requires WTO members to comply with Articles 1 through 12 and 19 of the Paris Convention.”⁴ “The Paris Convention is the oldest major multilateral treaty designed to improve the international protection of trademark rights”.⁵ “The Paris Convention for the

⁴ Commentary on Paris Convention for - Lex-ip.com (Nov.27, 2017, 9:45 PM) <http://www.lex-ip.com/Paris.pdf>.

⁵ Much ink has been spilled in the legal literature about the self-executing or non-self-executing nature of the Paris Convention. But with respect to the question specifically addressed in this Article, that issue falls somewhat to the side. In this Article, I focus on the case of a mark that is well known in the United States but not yet used or registered here. A minimalist interpretation of the Paris Convention does not create a requirement for protection of a well-known mark in the absence of use of the mark in the protecting country. See, e.g., Dinwoodie, *supra* note 25, at 912-13. Instead, a minimalist interpretation holds that the Paris Convention only mandates protection of a

Protection of Industrial Property (“Paris Convention” or just “Convention”) is one of the first, and arguably most important, of the various multilateral treaties protecting intellectual property. It addresses patents, marks, unfair competition whether or not implicating marks, and the related industrial property of industrial designs, utility models, geographical indications, trade names, possibly trade secrets within the context of unfair competition, but not copyright. The Convention secures for nationals, those domiciled, and those having a real and effective industrial or commercial establishment within a country party to the Convention, the important procedural advantages of national treatment and priority rights in respect of patents and trademarks. The Convention for the most part neither defines the rights it purports to protect nor guarantees any minimum level of protection for these rights. The scope and quality of the protection member nations are obligated to provide under the Convention are, in most instances, left to domestic legislation and tribunals to develop and define. While the enumerated protections serve primarily industrial interests, the Convention allows party states to retain some protectionist legislation, in the form of limited working requirements and compulsory licenses. The lack of provisions defining minimum substantive rights and mandating enforcement of those rights is thought to be justification for the Agreement on Trade Related Aspects of Intellectual Property Rights (“TRIPS”), a multilateral treaty that seeks to address these observed shortcomings.”⁶ “Since 1925, it has required member nations to protect well-known foreign marks”⁷. “The Paris Convention's major advance in international intellectual property relations was implementing the principle of national treatment within a treaty intended for widespread, rather than only limited or regional implementation. Substantive rights obligations were minimal in the first incarnation of the treaty, but its

well-known mark in the absence of a registration, leaving room for a country to require use. See *id.* The Lanham Act's provisions providing rights to unregistered marks that have been used in commerce would therefore comply with that minimum requirement set forth in the Paris Convention. See 15 U.S.C. § 1125(a)(1)(A) (2006); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768-69 (1992).

⁶ Commentary on Paris Convention for - Lex-ip.com (Nov.27, 2017, 9:45 PM) <http://www.lex-ip.com/Paris.pdf>.

⁷ G.H.C. Bodenhausen, *Guide to the application of the Paris Convention for the protection of Industrial Property* 89 (1968).

coverage was not then, and is not now, limited to national treatment. The Convention also obligates member nations to provide certain minimum substantive trademark rights to nationals of other member nations. One of those minimum substantive rights is the right of a foreign national to obtain protection against the use or registration of a mark in a member nation if the foreign national's mark is well known, a third party registers or uses the mark for identical or similar goods, and the complained-of mark is liable to create confusion. The basic obligation is to allow an "interested party" to intervene in a registration proceeding, to request cancellation of a registration, or to object to the use of a mark under certain conditions:

- (1) the mark is "a reproduction, an imitation, or a translation" of a well-known foreign mark,
- (2) the well-known mark and the mark being objected to are used for identical or similar goods, and
- (3) the domestic use is "liable to create confusion." Well-known mark status is defined in the Paris Convention only by the following characterization: "a mark considered ... to be well known in (a protecting) country as being already the mark of a (protected foreign national)." This only seems to mean that well-known status is to be determined by each nation on an individual basis and that renown on a global scale is not required. No more specific scope is provided, nor is the standard for how much local knowledge of a mark would be required for the mark to be "well known" in a country where protection is sought. The United States fulfill its obligations under article 6bis for well-known foreign marks that have been either:

- (1) used in the United States and registered on the Principal Register or

(2) used in the United States without registration but with protection as a common law trademark under section 43(a) of the Lanham Act.⁸ But if the Second Circuit's recent decision is correct and if the Paris Convention requires the United States to protect well-known foreign marks not used in this country, we fall short of full compliance. Interestingly, the United States has advocated in both the distant and recent past in favour of such an obligation. Moreover, many Paris Convention nations provide more extensive protection, even though many or even most of those nations typically do not provide any trademark-specific protection without registration. Instead, many nations protect unregistered marks, in certain circumstances, by applying their broader laws against unfair competition. The United States, on the other hand, has a long tradition of providing trademark protection without registration. So of all nations, one might think the United States should be at the forefront of a broad article 6bis obligation”⁹.

2.2 The TRIPS Agreement

The Agreement on Trade related Aspects of Intellectual Property Rights (hereafter referred to as TRIPS) of the World Trade Organisation (hereafter referred to as WTO) is commonly known as the TRIPS Agreement or simply TRIPS. TRIPS is one of the main agreements comprising the World Trade Organisation (WTO) Agreement. This Agreement was negotiated as part of the eighth round of multilateral trade negotiations in the period 1986-94 under

⁸ See 15 U.S.C. § 1052(d) (stating that a mark cannot be registered with the Patent and Trademark Office if it "consists of or comprises a mark which so resembles mark registered in the Patent and Trademark Office or a mark or trade name previously used _ in the United States and not abandoned, as to be likely when used on in connection with the goods of the applicant, to cause confusion or to cause mistake or to_ deceive"); 15 U.S.C.A. § 1057(b) (West 2011) (making a certificate of registration on the principal register "prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate"); 15 U.S.C. § 1063(a) (allowing for an opposition proceeding based on a belief by "any person . . . that he would be damaged by the registration of a mark upon the principal register"); id. § 1064 (allowing a cancellation proceeding to be filed by "any person who believes that he is or will be damaged ... by the registration of a mark on the principal register"); id. § 1114(1) (Lanham Act section 32's protection for registered marks in a civil infringement proceeding); id. § 1125(a) (Lanham Act section 43(a)'s protection for any trademark, whether registered or unregistered, via a civil infringement proceeding).

⁹ How the Lanham Act Protects Well-Known Foreign Marks - LSU Law (Nov. 27, 2017, 10: 45 PM) http://digitalcommons.law.lsu.edu/cgi/viewcontent.cgi?article=1301&context=faculty_scholarship.

General Agreement on Tariffs and Trade (GATT) commonly referred to as the Uruguay Round extending from 1986 to 1994. It appears as Annex 1 C of the Marrakesh Agreement which is the name for the main WTO Agreement. The Uruguay Round introduced intellectual property rights into the multilateral trading system for the first time through a set of comprehensive disciplines. The TRIPS Agreement is part of the “single undertaking” resulting from the Uruguay Round negotiations. This implies that the TRIPS Agreement applies to all WTO members, mandatorily. It also means that the provisions of the agreement are subject to WTO dispute settlement mechanism which is contained in the Dispute Settlement Understanding (the “Understanding on Rules and Procedures Governing the Settlement of Disputes”). The TRIPS Agreement is one of the most important agreements of the WTO.¹⁰

“The Agreement on Trade- Related Aspects of Intellectual property Rights, the intellectual-property treaty concluded as one of the foundational agreements of the World Trade Organization includes all substantial obligations of the Paris Convention with respect to trademarks and expands upon them as well. For example, the signatory nations agreed to extend the Paris Convention well-known marks obligation to include service marks as well as trademarks. The TRIPS Agreement also expanded protection for well-known foreign marks beyond uses or registrations that would create a likelihood of confusion. TRIPS mandates protection against unauthorized use or registration with goods or services dissimilar from those associated with the well-known mark, provided that the use would indicate a connection with the foreign owner and would likely damage the interests of that owner. The TRIPS Agreement did not define the term "well-known mark," and, as noted above, the Paris Convention provides no firm meaning for "well known." The TRIPS Agreement states only that member nations "shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the

¹⁰ *Supra* note 6.

promotion of the trademark. “As a result, the exact meaning of "well-known mark" may continue to vary internationally, but certain contours are consistent. Additional consistency within international application of the concept of a "well-known mark" may also arise from recent, although nonbinding, international negotiations”¹¹.

2.2.1 Post-TRIPS Developments

“The most recent, although nonbinding, multilateral effort to improve protection for well-known marks in foreign markets is the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks ("Joint Recommendation on Well-Known Marks" or "Joint Recommendation"), which was negotiated through the World Intellectual Property Organization. For most nations, the Joint Recommendation on Well-Known Marks is simply an agreed but nonbinding recommendation on well-known marks. The United States, however, has bound itself to observe the Joint Recommendation through at least one bilateral agreement, a free trade agreement with Singapore. And in light of the most-favoured-nation treatment provision in the TRIPS Agreement, the United States must now provide to the nationals of all WTO Member nations the advantages provided to Singaporean nationals under the binding bilateral agreement.

The Joint Recommendation lists the following factors for the analysis 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/or services to which the mark applies;
4. the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;
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.

Countries guided by the Joint Recommendation on Well-known Marks will look to whether the foreign mark is well known in at least one relevant sector of the public in that country. Relevant sectors of the public include:

- (i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;
- (ii) persons involved in channels of distribution of the type of goods and/or services to which the mark applies;
- (iii) business circles dealing with the type of goods and/or services to which the mark applies. Perhaps most important for purposes of this study, however, is the following provision, which sets forth factors that "shall not" be used when determining if a foreign mark is well-known:

- (a) A Member State shall not require, as a condition for determining whether a mark is a well-known mark:

(i) that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, the Member State;

(ii) that the mark is well known in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, any jurisdiction other than the Member State; or

(iv) that the mark is well known by the public at large in the Member State.

The United States, in joining the Joint Recommendation, has quite clearly entered into a group of nations that officially profess to protect well-known foreign marks without domestic use and that advocate for such protection. And as noted above, because these provisions are expressly binding in at least one bilateral agreement the obligations of the United States to all WTO ' member nations have now been heightened. By providing factors to guide domestic decision makers, the Joint Recommendation certainly advanced common understanding related to, and was aimed at leveling the international playing field with respect to, enforcement of the well-known foreign marks doctrine. But even with these agreed factors, there is no agreed standard that a country's decision makers are obligated to apply in judging these factors. Exactly how deep or broad knowledge of a mark must be within: that country for the mark to be "well known" within the meaning of the Joint Recommendation, the TRIPS Agreement, or the Paris Convention remains internationally undefined. The absence of an international standard when a mark is "well known" means that the United States may set a relatively high standard. It may not, however, refuse altogether to recognize or to apply the doctrine. Recent decisions within the Second Circuit may frustrate the policies and obligations established and accepted by the executive and legislative branches with respect to well-known foreign marks. These judicial decisions do not conclusively establish non compliance by the United States, as there are also other

decisions protecting well-known foreign marks and a strong statutory argument to support Lanham Act protection.

The early developments of the Internet have always been attributed to the effort of the United States as the vast majority of domain names are registered in the US. Consequently, the majority of disputes have originated there. The courts in the US have struggled to address the disputes of domain names in the context of trademarks law in light of two important policies of trademark law:

(1) to prevent confusion in the public and

(2) to protect the trademark owner's investment in its mark.¹² It must be noted that US trademark system is uniquely a common law use-based system, combined with elective federal registration. Trademarks used in interstate commerce are protected under the Lanham Act, while those used locally are protected under common law.”¹³

2.3 The U.S.A

“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”.¹⁴ “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

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

¹³ How the Lanham Act Protects Well-Known Foreign Marks - LSU Law (Nov. 27, 2017, 10: 45 PM) http://digitalcommons.law.lsu.edu/cgi/viewcontent.cgi?article=1301&context=faculty_scholarship.

¹⁴100 Best Global Brands, Bus. WK., http://www.businessweek.com/interactive_reports/best_global_brands_2009.html (ranking the one hundred most valuable global brands and finding half to be owned by U.S. companies); The 100 Top Brands, Bus. WK, at 90-94 (ranking fifty-three U.S. brands among the top 100 global brands in terms of economic value).

local infringer in South Africa before beginning to operate in that country.”¹⁵ “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.”¹⁶

2.4 Historical development of trademark law: Global Scenario

“In many instances, 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 inextricably tied to that physical location.”¹⁷ This is because the common law traditionally limited rights in a mark to the geographical areas in which customers recognized the mark as identifying that particular business. This customer recognition, called goodwill, could only travel as far as¹⁸ those goods or services bearing the corresponding trademarks. As early trademark law¹⁹ developed prior to the ubiquity of automobiles, trains, airplanes, and the Internet, the

¹⁵ 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>; see also 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 29:62 (4th ed. 2010) (discussing the McDonald's case in South Africa); cf. McDonald's Corp. v. McDonald's Corp. Ltd., [1997] F.S.R. 200 (Jam. Sup. Ct.) (refusing a preliminary injunction against a Jamaican restaurant operator using the name "McDonald's" and leaving for a full trial the question of the relevant date by which McDonald's Corp. would be required to prove its trademark goodwill had reached Jamaica and whether such goodwill is obtainable under Jamaican law without local business operations).

¹⁶ David Yan, Virtual reality: can we ride trademarks law to surf cyberspace? 10 Fordham I.P., Media & Ent. L.J. 773, (2000) at 782.

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

¹⁸ Julius R. Lunsford, Jr., Trademarks: Prestige, Practice and Protection, 4 GA. L. REV. 322, 323 (1970) (“Good will is that which makes tomorrow's business more than an accident. It is the reasonable expectation of future patronage based on past satisfactory dealings Only second in importance to the building of good will is the establishing of the marks by which it is fixed and visualized.”).

¹⁹ United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 97 (1918) (“There is no such thing as property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed.”).

geographical reach of such goodwill was initially quite limited. As the law was created within the confines of geographical limitations, courts could not predict the creation of a cyber market that transcended physical borders. Today, however, businesses are not inextricably linked to a²⁰ geographical location because the Internet allows a business to transcend physical boundaries. The Internet's pervasiveness offers a global, borderless dimension for marketing, advertising, and selling services and products. Trademark law, however, has not moved as quickly a technological advancement, and the application of geography-based modes of trademark protection persists even today. Trademarks have been territorial in scope since their inception.

A. Marketplace basis for establishing common –law trademarks rights

The fundamental rule of trademark ownership is that the first party to use a designation as a trademark acquires intellectual-property rights in that designation, irrespective of registration.²¹ If a party does not register the mark, however, the unregistered, common-law trademark is geographically limited in scope. The territorial scope of protection of common-law trademark is comprised of four interrelated zones: “sales, advertising, reputation, and expansion.” The term “zone of actual goodwill” is typically used to encompass sales, advertising, and reputation, while the term “zone of natural expansion” stands apart as a

²⁰ Johnson v. Sosebee, 397 F. Supp. 2d 706, 710 n.1 (D.S.C. 2005).

²¹ This is typically called the first-to-use doctrine. In re Trade-Mark Cases, 100 U.S. 82, 94 (1879) (“At common law the exclusive right to it grows out of its use, and not its mere adoption It is simply founded on priority of appropriation. We look in vain in the statute for any other qualification or condition.”) (Emphasis omitted). Inherently distinctive trademarks fall squarely within this rule. On the other hand, trademarks that are not inherently distinctive must acquire secondary meaning before they are protectable. As such, rights in such marks ordinarily go to the first person to acquire secondary meaning. This Article presumes that a trademark is either inherently distinctive or has acquired secondary meaning.

relatively controversial and sometimes disfavoured measurement mechanism. The scope of the “zone of actual goodwill” and the “zone of natural expansion” are outlined below.

1. The Zone of Actual Goodwill

The zone of actual goodwill is typically bifurcated into (1) the zone of actual market penetration and (2) the zone of reputation. A trademark owner may establish the zone of actual goodwill by making a showing of these two categories either together or independently of the other. The zone of actual market penetration includes the areas where products have actually been sold to consumers. Furthermore, courts have always required something more than a de minimis amount of sales. Today, most jurisdictions apply some derivation of the following factors in determining the territorial limits of a trademark’s protection: (1) the amount of sales of products using the trademark, (2) positive and negative growth trends in the geographical region, (3) the number of purchasing customers compared to the total number of possible customers, (4) the amount of advertising in the geographical region, and (5) the trademark owner’s market share. Where the zone of actual market penetration is limited, the zone of reputation encompasses areas where consumers recognize the products using the trademark but are not direct consumers of those products. This zone is made of areas where goodwill has been created among consumers through mechanisms such as traditional and Internet media, advertising, and word- of-mouth. Though physical distance is a helpful starting point in determining the zone of reputation, the zone of reputation can extend much further than bordering towns or states. Unlike the early days of trademark law, perambulating customers are much more common and can transport a trademark’s goodwill thousands of miles from a brick-and-mortar location. Some early commentators have argued that the distinction between the zone of actual market penetration and the zone of reputation should be eliminated in favor of one unified test. Eliminating the current bifurcated system is

short-sighted, however, when assessing the zone of actual goodwill in the Internet context. In particular, the zone of reputation is largely ignored by such proposals. Whereas business reputations in the late twentieth century largely stemmed from actual sales, the Internet has allowed businesses to establish lasting impressions, and thus build goodwill, even without sales.²²

2. The Zone of Natural Expansion

Unlike the zone of actual goodwill, which is based on the presence of the mark, the zone of natural expansion covers a geographical area completely untouched by the putative trademark owner. The zone of natural expansion provides a narrow amount of “breathing space” so that the trademark owner’s goodwill is protected for future development efforts. These development efforts must be articulable and concrete. Some courts outline specific considerations used to create boundaries for the zone of natural expansion, including:²³

(1) How great is the geographical distance from the [trademark owner’s] actual location to a point on the perimeter of the zone of expansion?

(2) What is the nature of the business? Does it already have a large or small zone of actual market penetration or reputation?

(3) What is the history of the [trademark owner’s] past expansion? Has it remained static for years, or has it continually expanded into new territories? Extrapolating prior expansion, how long would it take the senior user to reach the periphery of the expansion zone he claims?

²²Johnson Shontavia, Trademark Territoriality in Cyberspace: an Internet Framework for Common-Law Trademarks, 29 BerkeleyTech. L.J. . (Dec. 12, 2017, 11 PM)
<http://scholarship.law.berkeley.edu/btlj/vol29/iss2/5>.

²³ *Supra* note 18.

(4) Would it require an unusual “great leap forward” for the [trademark owner] to enter the zone, or is the zone so close to existing locations that expansion would be (or is) a logical, gradual, step of the same length as those previously made?

Other courts have used a more general, fact-specific inquiry focusing on the senior user’s expansion efforts. Several courts, however, have criticized the zone of natural expansion as imprecise and unpredictable. First, it can be difficult for courts, attorneys, and the²⁴ putative trademark owners to discern the borders of the zone. In addition, it can harm a good-faith, subsequent adopter of the trademark, also known as the junior user, who has no way of predicting whether or not a particular location falls within the zone. Though relatively disfavoured in the brick-and-mortar context, the Internet may breathe new life into the zone of natural expansion. The zone of natural expansion only applies to areas that are not considered “remote,” and much of the criticism regarding this zone revolves around the innocent junior user being unable to discover another company’s use in a far away region of the country. Given that the Internet is increasingly removing such geographical limitations, the historical criticisms carry less weight. Generally, however,²⁵ the bifurcated zone of actual goodwill and the zone of natural expansion form the basis for protecting common-law trademarks, and thus unregistered trademarks, in the United States. Under the first-to-use doctrine, once a trademark owner demonstrates that it is the first to establish goodwill in either or both of these zones, it has exclusive priority in the mark in those areas for the specific category of goods or services offered using that mark. That trademark owner, however, does not have priority in the

²⁴ Raxton Corp. v. Anania Assocs., Inc., 635 F.2d 924, 930 (11th Cir. 1980) (noting that the doctrine of natural expansion is “unworkable, unfair, and, in the light of statutory protection available today, unnecessary”); *beef & brew, inc. v. Beef & Brew, Inc.*, 389 F. Supp. 179, 185 (D. Or. 1974) (“[T]he zone of [natural] expansion doctrine has a more than usually unclear place in the law of unfair competition. This is so because the doctrine is more than usually imprecise and yet very powerful. . . . [It] can easily range too far and be ‘inconsistent with the objectives of free competition.’”). The modern Restatement of Unfair Competition also rejects trademark rights based wholly on a zone of natural expansion. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 19 cmt. c (1995).

²⁵ David S. Barrett, *The Future of the Concurrent Use of Trademarks Doctrine in the Information Age*, 23 HASTINGS COMM. & ENT. L.J. 687, 687 (2001).

mark in other geographically remote areas. As an outgrowth of the first- to-use doctrine, the judicially created concurrent-use doctrine grants permission to other unrelated entities to use the same or a similar trademark under certain circumstances.²⁶

B. Concurrent use and the territorial limits of common law trademarks

Prior to 1870, the United States did not have a national trademark registration system. Businesses essentially sold products and services to customers within their physical reach extending from a brick-and-mortar location, and eventually the inevitable collision of common-law trademarks took place. For example, the goodwill of Midwest as it expands eastward from Nebraska is²⁷ bound to collide with the goodwill of Sothern's business as it expands westward from South Carolina at some point. The response to this problem came in two different forms:

(1) Congressional enactment of a comprehensive federal trademark statute that included a federal registration system, and (2) Judicial creation of the concurrent-use doctrine. In 1870, Congress enacted a statute that attempted to provide nationwide trademark rights to entities that registered their marks with the United States Patent Office. This first federal trademark statute was enacted under Article I, Section 8, "Clause 8 of the U.S. Constitution, which empowers Congress "to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."²⁸ In *re Trade-Mark Cases*,²⁹ however, the Supreme Court held that the recently enacted statute was unconstitutional, despite its noble purpose. In striking down the statute, the Supreme Court noted that Article I, Section 8, Clause 8 only protects writings that "are the

²⁷ Jane C. Ginsburg, Jessica Litman & Mary L. Kevlin, *Trademark And Unfair Competition Law* ,13 (4th ed. 2007).

²⁸ (Dec.30,2017, 11 AM)<https://www.duo.uio.no/handle/10852/22910>.

²⁹ *In re Trade-Mark Cases*, 100 U.S. 82 (1879).

fruits of intellectual labour, embodied in the form of books, prints, engravings, and the like.” Trademarks, according to the Supreme Court, did not fall into these categories. As such, Congress did not have the power to create a trademark³⁰ statute under Article I, Section 8, and Clause 8. The Supreme Court was also concerned that Congress had undertaken to regulate both intrastate and interstate commerce under the Commerce Clause, which was unconstitutional. A comprehensive trademark statute would not be enacted under the Commerce Clause until the Lanham Act almost eighty years later. The Lanham Act was created to provide greater consistency in a nation with growing interstate commerce and more societal mobility. It provides nationwide trademark rights for those applicants that are successful in prosecuting a trademark before the United States Patents and Trademark Office (hereafter referred to as USPTO). A trademark registered before the USPTO gives constructive notice of the registrant’s claim of ownership to everyone in the United States. Registration, therefore, is a powerful sword possessed, and sometimes wielded, by the trademark owner. Even given the significant geographical benefits provided by registration, however, the use of unregistered trademarks persists. There may be any number of reasons why an entity does not take advantage of the USPTO registration system. Perhaps it filed a trademark application in the USPTO but was unsuccessful. Maybe it believed that trademark counsel would be too expensive. Or, it may simply have no understanding of intellectual property and the value of this intangible asset. At any rate, there are countless unregistered trademarks being used in the United States, and the concurrent-use doctrine attempts to strike a balance between two equally important goals of trademark law: (1) protecting consumers from confusion and (2) protecting a trademark’s goodwill. The promulgation of the Lanham Act complicated this balance, particularly in instances where the original trademark owner, or “senior user,” did not register its mark and a subsequent junior user received a federal trademark registration for the same or

³⁰ In particular, the Supreme Court was concerned that the new statute conflicted with the fundamental principle of common-law trademarks, in which rights to a trademark stem from use, not adoption. The subjects of Article I, Section 8, and Clause 8 have no such use limitation.

a confusingly similar mark. The jurisprudential context for the creation of the concurrent-use doctrine and federal interpretation of the doctrine after the Lanham Act's creation illustrates the complexity of balancing a trademark's goodwill and protecting against customer confusion.

1. The Creation of the Concurrent-Use Doctrine

The concurrent-use doctrine establishes the territorial limits of common-law trademarks. The Supreme Court announced the doctrine in two cases from the early twentieth century: *Hanover Star Milling Co. v. Metcalf*³¹ and *United Drug Co. v. Theodore Rectanus Co.*³². These two cases are outlined below.

a) *Hanover Star Milling Co. v. Metcalf* Hanover involved a multi-party dispute in two different cases over the trademark TEA ROSE for flour packages, wrappings, and labels. The first case³³ concerned Illinois-based Hanover Star Milling Company, which had expended considerable marketing efforts throughout Alabama, Mississippi, Georgia, and Florida since 1904, and Steeleville Milling Company, also an Illinois company, that sold and marketed its flour in Illinois, Tennessee, Indiana, Arkansas, and Mississippi, with occasional shipments to Alabama. Hanover developed a significant reputation among flour traders in its four-state region³⁴, and no competing TEA ROSE flour products had been sold in the region since 1905. When Metcalf, a third-party distributor, wanted to sell Hanover's flour in Alabama, he could not do so because of an exclusive distribution agreement between Hanover and its distributor. Thus, Metcalf instead began distributing Steeleville TEA ROSE flour in that state. Thereafter, Hanover sued Metcalf for trademark infringement and unfair competition. In the second case, Allen & Wheeler Company, an Ohio corporation that sold TEA ROSE flour in Ohio,

³¹ *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403 (1916).

³² *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90 (1918).

³³ The two cases were filed within two months of each other and argued together, so the Supreme Court addressed both in one opinion. *Hanover*, 240 U.S. at 405.

³⁴ In fact, the company "had come to be known as the Tea Rose mill, and the words 'Tea Rose' in the flour trade in that territory meant flour of [Hanover's] manufacture and nothing else."

Pennsylvania, and Massachusetts, sued Hanover. Allen & Wheeler alleged that Hanover's use of TEA ROSE in Alabama, Florida, and Mississippi infringed its trademark. Allen & Wheeler had used the TEA ROSE trademark since as early as 1872, but made no showing regarding the extent of this use in the aforementioned markets. In addition, the Allen & Wheeler TEA ROSE flour had never been advertised, sold, offered for sale, or even heard of in the flour markets of Alabama, Florida, or Mississippi. The Court first addressed the Allen & Wheeler dispute by applying trademark common law. In finding that Allen & Wheeler could not preclude Hanover from using TEA ROSE in the south-eastern states of Alabama, Georgia, Florida, and Mississippi, the Court noted that the purpose of trademarks is to protect the goodwill built by a company through years of effort. The Court emphasized that a trademark owner is entitled to protection and redress only in those markets where the trademark had actually been used in some meaningful capacity. The Court further emphasized that its holding should not be limited solely by the physical boundaries of states and municipalities: Since it is the trade, and not the mark, that is to be protected, a trade-mark acknowledges no territorial boundaries of municipalities or states or nations, but extends to every market where the trader's goods have become know of the mark. But the mark, of itself, cannot travel to markets where there is no article to wear the badge and no trader to offer the article. Because Hanover had built goodwill in its four-state³⁵ area and adopted TEA ROSE in good faith and without notice of Allen & Wheeler's use, Allen & Wheeler was estopped from claiming trademark protection Alabama, Florida, and Mississippi. Hanover also prevailed in its case against Metcalf. Because Metcalf was selling Steepleville's TEA ROSE flour in the same Alabama counties as Hanover's distributor, and Hanover had earlier established a large amount of goodwill in those counties through sales and advertising, the Court held that Metcalf had run afoul of unfair competition

³⁵ (noting that Allen & Wheeler's sales were at least 250 miles from the nearest location of Hanover's sales). The Court noted that Hanover could only take advantage of this doctrine because it had not adopted its trademark "with some design inimical to the interests of the first user, such as to take the benefit of the reputation of [Allen & Wheeler's] goods."

law. In addition, the Court was convinced that Metcalf had acted in bad faith, noting that Metcalf intended to “take advantage” of Hanover’s reputation. In summary, Hanover established the territorial limits of a common-law trademark. Under Hanover, the scope of protection for such marks is limited to the geographical area where the mark is both known and recognizable by an articulable segment of possible customers. A second case, *United Drug Co. v. Theodore Rectanus, Co.*, answers the next logical question raised by the Hanover holding: if a common-law trademark is protected in one geographical area, are remote, unrelated users allowed to use the same or a similar mark in a different geographical area?³⁶

b) *United Drug Co. v. Theodore Rectanus Co.* Two years after Hanover, the Supreme Court revisited the issue of concurrent use in *Rectanus*, albeit for a different purpose. In *Rectanus*, a dispute arose over the trademark REX in the medical drug context. In 1877, Ellen Regis adopted REX as a trademark for her medicinal product used to treat indigestion. Regis sold her products in the New England states, with additional “inconsiderable sales in New York, New Jersey, Canada, and Nova Scotia.” She sold her business, including the trademark, to United Drug Company in 1911, which continued to use the REX trademark in connection its Rexall retail drug stores around the United States. Meanwhile in Louisville, Kentucky, a druggist named Theodore Rectanus had been using the trademark REX for his “blood purifier” product since 1883. Rectanus selected the REX trademark without any knowledge of Regis or United Drug’s use of REX. In 1906, Rectanus sold his business and trademark to the Theodore Rectanus Company, and both he and the company continued to use the mark. Rectanus expended money and effort to build a viable, albeit localized, business in Louisville and the contiguous area before United Drug entered the market. Though United Drug heard about Rectanus in June of 1911, it began to ship boxes of “[REX] Dyspepsia Tablets” to Louisville in

³⁶ *Supra* note 30.

April of 1912. Shortly thereafter, United Drug sued Rectanus for trademark infringement and unfair competition. United Drug's basic argument was that its reasonable diligence in extending Rexall's geographic reach should protect its Louisville use, even though it was the last to enter the market and Rectanus had already built goodwill there. The Court noted that this argument was based on the "fundamental error" that trademark rights exist in gross. It further emphasized that ownership rights in a trademark can exist only so long as it is attached to an existing company that sells products or services using that mark. Accordingly, the Court found that Regis had not established common-law trademark rights in Kentucky. It noted that, generally, "as between conflicting claimants to the right to use the same mark, priority of appropriation determines the question." The Court found, however, that the rule did not apply in cases where two different companies were selling products in remote markets without knowledge of the other. Such an application of the rule would allow United Drug to unfairly obtain the benefit of the goodwill that Rectanus had created for the REX mark in Louisville. Therefore, the Supreme Court enjoined United Drug 41 from using REX in the Louisville territory. nationwide, common-law rights in a mark may not preclude a junior user who adopted a mark—in good faith and without knowledge of the senior user—in a geographically remote territory in cases where the junior user was the first to adopt that mark. The senior user, according to Rectanus, must bear the risk that a junior user will adopt the same mark and build goodwill in remote territories.

3. Federal Court Interpretations of the Concurrent-Use Doctrine Post– Lanham Act

The basic rule from Hanover and Rectanus is that the concurrent-use doctrine applies only where two questions can be answered affirmatively:

- (1) Is the junior user operating in a geographically remote market? And

(2) Did the junior user adopt the trademark in good faith and without knowledge of the senior user? While the United States did have a national trademark registration system at the time of *Hanover* and *Rectanus* through the Trademark Act of 1905, this law did not extend nationwide rights to trademarks or provide any rights greater than then-existing common law rights. The enactment of the Lanham Act in 1946, however, brought about a wave of change. The Lanham Act created, among other things, a federal registration system that provides nationwide protection to trademarks registered with the USPTO. It also provides that this registration establishes “constructive notice of the registrant’s claim of ownership. This constructive notice provision eliminates a junior user’s claim of good faith and lack of knowledge in every jurisdiction in the United States. By enacting the Lanham Act, Congress intended to reduce instances of, and the uncertainty associated with, court-sanctioned concurrent use. The Act additionally created an “innocent prior user provision,” also known as the “limited-area exception.” The limited-area exception does not substantively change the concurrent-use doctrine as outlined in *Hanover* and *Rectanus*, but essentially creates a law—grounded in concurrent use—that applies when one party has registered the trademark at issue. The limited-area exception allows a junior user to continue its use of a mark in a remote area, even in the face of an incontestable trademark registration, provided the user meets two requirements. First, the junior user must have adopted the trademark in good faith and without knowledge of the senior user. Second, the junior user must have continuously used the trademark prior to the senior user’s priority date. Though the statutory language only mentions senior users that possess incontestable marks, the limited-area exception applies regardless of whether a trademark has achieved incontestable status.³⁷

2.5 Historical development of domain name

³⁷ *Supra* note 17.

“A domain name is a computer address through which a company or an individual can be located by any other user with Internet access. Domain names serve to distinguish and locate the various computers, users, files, and resources accessible over the Internet. Without a domain name, a company would be practically invisible on the Internet, as customers would not know where to find it. Every computer or user connected to the Internet must be distinguished and located by other users. Thus, every user is assigned an Internetworking Protocol Address (IP Address), a unique combination of numbers separated by periods to represent different fields”,³⁸ such as 44 123.101.23.128. These strings of digits contain a network portion that locates the specific network to which the user is connected, as well as a local address that identifies the user within the network. IP addresses are, unfortunately, unwieldy and difficult to remember.

2.5.1The Digital Era

“In 1969, one of the first wide area networks (WAN) began to operate [Guice, 1998; Rogers, 1998]. This network was dubbed ARPANET after the funding organization, The U.S. Department of Defense Advanced Research Projects Agency (ARPA). The system that administered the translations of names to addresses for each ARPANET host computer at that time was called HOSTS.TXT, named after the core data file in the system.

At first only four nodes connected by 50kbps lines spanned the west to east coasts of the United States, but by 1971 a total of fifteen nodes with twenty-three hosts linked major universities across the country. Updates to the HOSTS.TXT system were performed by e-mail change

³⁸ Gary. W. Hamilton , *Trademarks on the Internet: Confusion, Collusion, or Dilution?* 4 TEX. INTEL. PROP. L.J. 1, 2 (1995); Dan L. Burk, Trademarks along the Infobahn: A First Look at the Emerging Law of Cyber marks, I RICHMOND J.L. & TECH. 1, § 2 (April 10, 1995).

requests and FTP transfers. These updates were constantly required in order to avoid confusing the network with out-of-date versions. Although inconvenient, this allowed a primitive form of name-based references to be used over ARPANET [Sun, 2009].

2.5.2 The Development Era

In 1972, shortly after the development of the Ethernet network protocol by Bob Metcalfe and his colleagues at Xerox PARC, the ARPANET expanded internationally by adding nodes in England and Norway and bringing the node total to twenty-nine [Harvard University, 2000]. A connection problem made by the lack of protocol standardization was being tackled by the International Network Working Group (INWG), leading the way for systems such as Telnet and Datapac, and creating the Internet we know today [Cerf, 1995; Edmondson-Yurkanan, 2007].

ARPANET continued to grow, and by 1975 a total of sixty-one nodes were in existence. Separate networks with connections to ARPANET began to spring up, including NASA's SPAN, BITNET at the City University of New York, and CSNET. The latter was the result of collaboration between the University of Delaware, Purdue University, the University of Wisconsin, RAND Corporation, and Bolt Beranek and Newman (BBN), funded by the National Science Foundation (NSF). The goal of CSNET was to connect computer science departments at institutions that were without ARPANET access. By 1983, the node count totaled 113 and security concerns resulted in the ARPANET being split into the MILNET network for military sites with sixty-eight nodes, leaving the remaining nodes of ARPANET to be used by the computer research community [Harvard University, 2000; NSF, 2009; Sun, 2009]. The NSFNET, a backbone network built in 1985 by the NSF originally to connect five NSF-supported supercomputers, created such demand that it needed a major upgrade in 1988, plus plans in 1989 to move from a T1 to a T3 connection [NSF, 2009]. An explosion of

connections from non-computer science researchers at universities and other organizations, followed when the NSF agreed to allow self-organized networks connection to NSFNET. By 1989, ARPANET no longer existed [Harvard University, 2000].³⁹

2.5.3The Domain Name Era

When ARPANET moved to the Transmission Control Protocol/Internet Protocol (TCP/IP) suite of protocols in 1983 [Harvard University, 2000] and became known as the Internet, the population of networks exploded. The centrally maintained HOSTS.TXT file became plagued with problems, such as traffic and load, name collisions, and consistency anomalies. It was clear that HOSTS.TXT no longer met the needs of the rapidly expanding Internet, and that a more robust system was needed. A group composed of Jon Postel, Paul Mockapetris, Craig Partridge, and others [Harvard University, 2000] met the need when they published RFC 882 in 1984 which resulted in the creation of the distributed naming system known as the DNS.

The DNS is a distributed database that allows local administration of the segments on the overall database. Data in each segment of the database are available across the entire network through a client-server scheme consisting of name servers and resolvers [Mockapetris and Dunlap, 1995]. Just as each telephone number is a unique sequence of numbers, so is the IP address for each computer on the Internet. Rather than memorizing 192.0.34.65, we can simply enter www.icann.org and the DNS translates, or resolves, the domain name to the IP address [InterNIC, 2002a].⁴⁰

2.5.4The Dot-Com Era

³⁹ *Supra* note 37.

⁴⁰ Pope, MB,(2012) "The Domain Name System—Past, Present, and Future" (Dec. 13, 2017, 10:30 AM)aisel.aisnet.org > Journals > CAIS > Vol. 30 (2012).

Throughout the mid-90s, access to the Internet had been text-based and relatively cumbersome, assuring its use to remain with the academic and technical populations. The potential of the Internet as a medium for information sharing had just begun to be explored in full. In 1989, Tim Berners-Lee, working for CERN, proposed a new system for linking together information using hypertext [Berners-Lee, 1996]. The concept of “hypertext”—a form of document that links together other documents—was not a new one. First traced back to a paper written by Vannevar Bush in 1945, it had been addressed by other scholars and engineers such as Douglas Englebart and Ted Nelson in the 1960s. However, it was Berners-Lee who proposed the well-known standard for hypertext on the modern Internet. One further component, an easy-to-use interface, was needed for the World Wide Web to become the successful phenomenon it is today, and it did not take long for an interface to be created. University of Illinois who recognized this need and created Mosaic, the first modern Web browser [Borland et al., 2003; Yamamoto, 2003]. In 1994, Marc Andreessen joined with Jim Clark to form Netscape and release the Netscape Navigator browser, which was followed in 1995 by Microsoft’s Internet Explorer browser [Borland, 2003]. Expansion of the Internet was inevitable with the graphic-based browsers empowering virtually anyone to experience it, making a properly and reliably functioning DNS more critical than ever.

As Internet connections continued to explode, it became clear that an administering body was needed, and, in 1993, InterNIC was created by the NSF to provide Internet directory and database services, registration services, and information services [Adler et al. 1994]. Of the three participants—AT&T, General Atomics, and Network Solutions, Inc. (NSI)—NSI was by far the most important to the DNS administration of the era, providing registration services for domain names. As such, it was particularly influential in establishing the Internet during this critical period of growth and formation, becoming, for a time, synonymous with domain registration. The DNS uses a tree directory structure with the right-most portion of each

domain name made of three letters and being the base, or root, of the directory structure, called the top level domain (TLD). The first TLD names included the following seven familiar extensions; .com, .edu, .gov, .int, .mil, .net, and .org. Besides the three-letter TLDs, over 250 two-letter TLDs were established for countries and territories, and a single unique TLD, .arpa, was established for administrative purposes [ICANN, 2008b]. As use of the Internet increased, so did domain name registrations? Between 1993 and 1996, registrations of the TLDs .com, .net, and .org rose from an average of 400 per month to 70,000 per month [Mueller, 1997]. While the number of possible character iterations for a domain name is limitless, the number of sensible and useful names is actually quite limited. Fueled by the realization of this limitation, in 2000, new TLD additions were discussed and between 2001 and 2003, a total of thirteen new general and special-use TLDs were introduced. The new general TLDs were .biz, .info, .name, and .pro. The new special-use TLDs were .aero, .coop, .museum, .asia, .cat, .jobs, .mobi, .tel, and .travel [ICANN, 2008b].⁴¹

2.5.5 The Dot-Crunch Era

Through 1995, the NSF had subsidized the domain name registration costs, but with Internet use becoming mainstream and commercialized, and with the number of registrations skyrocketing, the NSF implemented a registration fee of \$50 to begin on September 14, 1995 [NSF, 1995]. This new cost slowed down what had become a domain name grabbing free-for-all by some speculators, known as cyber squatters, who registered domain names with the hopes of making a profit by selling the name. Speculation was curbed, but not completely stopped, as some names had and were expected to be worth well over the new \$50 registration fee. In fact, examples of a few of the outrageous amounts domain names sold include business.com for \$7.5 million, loans.com for \$3 million, autos. For \$2.2 million, and

⁴¹ *Supra* note 35.

savings.com for \$1.9 million [DomainNameStuffetc.com, 2002]. Two of the more famous cyber squatters' cases include that of toysrus.com and mtv.com. By the time each of these well-established companies realized the future impact of the Internet and the associated requirement to own their respective company name domains, they each found themselves unable to obtain them. In the case of Toys R Us, a young boy who saw the opportunity for free toys and bikes purchased toysrus.com. With MTV, it was a VJ seeking leverage in an upcoming contract negotiation who predicted mtv.com would be his job security guarantee [Warkentin, 1999]. The Internet, which had started as a network for scientific and military purposes, rapidly became an integral part of everyday life for many organizations and people around the world. As an unregulated form of communication, majority acceptance of the policies required administrative governance by an unbiased organization. In 1998, "the Internet Corporation for Assigned Names and Numbers (ICANN)"⁴², a nonprofit Department of Commerce contractor [Fuller, 2001] was formed to fill that need. Besides overseeing the security, stability, and interoperability of the Internet, ICANN's duties included two that were DNS specific; the coordination of allocations and assignments of the DNS and the coordination of the operation and evolution of the DNS system [ICANN, 2008c].⁴³

Ownership of domain names continued to be a frequent problem, along with complaints about the process of domain name sales, the majority of which were being handled by Network Solutions, Inc. (NSI). ICANN hoped to improve the resolution of both of these issues by allowing more competition and by establishing mandatory arbitration of trademark claims. Competition was established by allowing America Online and register.com, among others, to

⁴² (Dec.31, 2017, 7

PM)<http://www.mondaq.com/india/x/425096/Trademark/DNS%252Bthe%252BMenace%252BCybersquatting>.

⁴³ Pope, MB,(2012) "The Domain Name System—Past, Present, and Future" (Dec. 13, 2017, 10:30 AM)aisel.aisnet.org > Journals > CAIS > Vol. 30 (2012).

join in the sale of domain names. Ownership disputes related to gTLD or certain country-code TLDs (ccTLD) where claims of trademark or service mark infringements existed, or where accusations of abusive domain name purchase intent were present, would be resolved through an arbitration process. Beginning in late 1999, in order to be allowed to process a purchase, purchasers would be required to agree to the Uniform domain name Dispute Resolution Policy (UDRP) [Dieguez, 2008; Elias and Stim, 2007; InterNIC, 2002b]. The UDRP process includes five steps, beginning with the accuser filing a complaint and followed by the accused party filing a response. Next, a panel selected by the dispute resolution service provider reviews the complaint and makes a decision. Once decided, all parties are notified, and finally the change to the domain name ownership is implemented [WIPO, n.d.].

The last DNS “era” and the one in which we now reside we call the Decay Era. The DNS has remained the accepted system for the Internet, but problems have occurred, and more are expected; some are due to flaws known since the beginning, and some are due to flaws like the “Kaminsky bug” discovered in 2008 [Prince, 2008; Wattanajutra, 2008]. DNS is further challenged by the progressive push to change the Internet from the traditional Internet Protocol version 4 (IPv4) to the sixth version (IPv6) to solve a myriad of technical problems with the original implementation, not the least of which is the theoretical maximum number of addresses available within the protocol [Lee et al., 1998]. While most major DNS server programs have been updated to support the necessary changes, such a fundamental shift in the infrastructure of the Internet makes it a ripe time for advocates of particular technologies that might replace DNS to push for the implementation and proliferation of such protocols. DNS will have to adapt to these changes and may find itself facing increasing competition—factors such as politics [Greenemeier, 2011; Kravets, 2011] and technological availability [Greere, 2010] may make a replacement viable.⁴⁴

⁴⁴ *Supra* note 37.

2.5.6 The Domain Name System (DNS) Present

Although indisputably the worldwide standard at present, the domain name system does not find itself facing a lack of challenges in the immediate future. We continue, therefore, with an outline of some of the more serious challenges.

Organizational: The ICANN domain name system is the most prevalent one, but its dominance is not absolute; there are several smaller systems available using the same protocols. OpenNIC [OpenNIC, 2009], Unified Root [Unified Root, 2009], and Public-Root [Public-Root, 2009] are but three alternative registrars for Internet domain names. Although all three of these are miniscule compared to ICANN's mainstream offerings, it does not take much imagination to see that, given the political unrest seen in the early 2000s, as well as in the name of general independence, a number of larger organizations, including the Chinese government or Russian government, may wish to begin their own registry to keep tighter control on the Internet use of their citizens, both in terms of communication and as commercial interests. It is possible that these could run alongside the ICANN system somehow, through various means such as Web portals or automated software reconfiguration, but it is likely that these would be too cumbersome for most users to bother with—and legislation may even require the use of a government-approved registry system.

Technical: A number of technical issues must be addressed for the domain name system to continue as the standard in the future. Not the least of these is the change of the Internet Protocol IPv4 to IPv6. IPv4, the predominant version as of 2011, is ubiquitous on networking equipment throughout the world, which is, ironically, part of the problem. Due to the 32-bit length of IPv4 addresses, there are nearly 2^{32} , or approximately 4 billion, addresses possible. The Internet Engineering Task Force (IETF) is an international organization, chartered by the Internet Society (ISOC), and comprised of voluntary Internet professionals whose mission is to

“make the Internet better” [IETF, 2009]. The Internet Assigned Numbers Authority (IANA), chartered by the ISOC and run by ICANN, is the IP address allocation agency as of 2011. After allocating an IP address to a Regional Internet Registry (RIR), the IANA reports the assignment to the IETF [IANA, 2009]. IP address networks are divided into five different classes [Held, 2002]. There can be sixty-four classes “A” networks, with each of these holding onto over 16 million addresses, most of which are unused. Similar problems occur with class “B” networks. This has made most networks, with a tiny allocation of 256 addresses per network, comprise the vast majority of Internet address allocations to date. Class “D,” reserved for multicast, and class “E,” reserved for experimental allocations, are both considered unsuitable for general use, which leaves a rapidly dwindling number of addresses, necessitating the shift to the newer 128-bit IPv6, which can support up to 2¹²⁸ addresses [IANA, 2009], or more than 1028 times the number of addresses available with IPv4.

Adoption of the IPv6 protocol is occurring most rapidly in Asian countries, particularly in Japan and China. European countries are moving more slowly but continue to steadily move to the new standard, fueled by a mandate of the European Union Commission. The United States, however, continues to move more slowly than the rest of the world in adoption of IPv6, proposed by some to be the result of a struggle among issues such as maintaining its historical powerbase over the IPv4 Internet, justifying the costs of upgrading, and the gamble of becoming incompatible with the rest of the world [Hovav and Schuff, 2005]. The DNS system with the IPv6 protocol will be able to handle new aspects of the network, but are confounded by the numerous issues of adopting IPv6 in the first place, including speculation that the transition may not actually happen at all. A more thorough discussion of these issues is beyond the scope of this article, but that does not downplay their importance to the DNS. In short, the DNS faces

a major overhaul and update, while needing to retain some degree of backwards-compatibility during the long and painful transition to IPv6, if it actually succeeds.⁴⁵

Integrity : Security problems are an extreme concern for the DNS, because it is the first (and often the only) line of defense ensuring unsuspecting Internet users are not fraudulently redirected to websites masquerading as other popular websites, or otherwise stealing traffic that is not rightfully theirs. A number of DNS attack techniques have been identified, which grow increasingly sophisticated over time [Carli, 2003]. These include DNS cache poisoning, which involves fraudulent information in a legitimate DNS server's cache; DNS spoofing or pharming, where an adversary redirects DNS queries from a legitimate server to an illegitimate or compromised server [Bose and Leung, 2007]; and DNS ID hacking, a key technique needed to permit other attacks. Solutions to these problems are limited. However; due to the necessity of maintaining backwards compatibility, design flaws will remain. Given the bugs discovered in 2008 which cut across numerous software packages requiring many software vendors to release simultaneous releases to repair a fault [US-CERT, 2008], it is a distinct possibility that many more bugs of this nature may exist, possibly even more serious than those already encountered. This casts doubts on the reliability of the DNS standard in terms of the ability to continue serving the Internet community in a secure manner. Researchers such as Dan Kaminsky have made many other flaws with the system public, further increasing scrutiny on its efficacy in an era of heightened security concerns [Kaminsky, 2008]. In fact, Paul Mockapetris, creator of DNS, has gone on record to state that more security needs to be added, citing regrets that the original implementation overlooked such concerns and praising attempts to make it more secure, such as DNS Security Extensions (DNSSEC) [Espiner, 2008].

⁴⁵ Gary. W. Hamilton , *Trademarks on the Internet: Confusion, Collusion, or Dilution?* 4 TEX. INTEL. PROP. L.J. 1, 2 (1995); Dan L. Burk, Trademarks along the Infobahn: A First Look at the Emerging Law of Cyber marks, I RICHMOND J.L. & TECH. 1, § 2 (April 10, 1995).

First formally discussed in 1993, the purpose of using DNSSEC is to add a layer of security to the DNS with public key encryption and digital signatures. In the case of receiving an e-mail, use of DNSSEC provides a method to verify that the domain the e-mail indicates it is from is actually where it is from, potentially reducing the amount of spam e-mail transmissions. When an individual accesses a website, use of DNSSEC helps to ensure that the domain of the website is truly the domain the individual intends to access thereby reducing potential phishing threats. Since DNSSEC was not part of the original DNS, global use would have required voluntary adoption by DNS Server owners and solution providers. Adoption did not occur due to various implementation issues including the knowledge that DNSSEC was not a perfect solution. By the late 1990s, rather than waiting for a perfect DNSSEC, the development of alternate hardware and software-based security systems and solutions occurred [Berlind, 2003]. As of July 15, 2010, however, the thirteen Internet root servers began to support DNSSEC, and by March of 2011, DNSSEC had been implemented in 20 percent of the TLDs around the globe [Mohan, 2011; Vaughan-Nichols, 2010]. Different language alphabets frequently contain letters that are 56 visually the same as those in other alphabets. A homograph is a form of misspelling that uses non-Latin characters that are visually the same as a Latin character. Use of non-Latin characters that are visually the same as Latin characters in a domain name introduces a new form of phishing security issue known as homograph phishing attacks [Gabrilovich and Gontmakher, 2002]. Luckily, as domain names with non-Latin characters became available in the late 2000s, no noticeable trends were identified toward this form of phishing [Aaron and Rasmussen, 2010].⁴⁶ Some of the reasons are speculated to be that the possibility of this form of phishing was not overlooked by ICANN and Internet browser programmers and, therefore, safeguards have been set in place [Johanson, 2005; Neylon, 2010], and that professional phishers don't need to use this

⁴⁶ *Supra* note 37.

method to fool potential victims since they are having enough success without it [Aaron and Rasmussen, 2010]. A problem some may find not quite as severe, but a serious problem nonetheless, is the integrity of lower-level registrars. Reports have been made of these organizations behaving improperly and exhibiting a lack of good faith in their access to the namespace in what has become known as domain tasting [Healey, 2007]. The namespace is the total of valid domain names possible, such as yahoo.com, google.com, or thisdoesnotexist.com. A domain is “tasted” by registering the domain name and then tested to see how much traffic it received [Fulton, 2008]. If the name attracted the desired amount of traffic, the domain was retained. If, however, the domain name did not perform as hoped, the name was returned, and the registration fee was refunded as allowed by the Add Grace Period (AGP) rule provided by ICANN. This resulted in 32.7 million out of 35 million—more than 93 percent—of registrations being refunded in April of 2006 alone [Parsons, 2006]. Such gross abuse has led to policy changes which have significantly curtailed this practice [ICANN, 2009].

Unfortunately, there are still more issues that call into question the integrity of at least some lower-level registrars [Alexander, 2006]. Through what is known as domain pinching, domain names that a registrar believes are likely to be highly popular are claimed for themselves and later auctioned off to the highest bidder. Another form of inappropriate behavior called domain stuffing is the all-too-often-seen practice of pointing a domain name to a generic index page that may include targeted ads or pay-per-click links. This form of misdirection may succeed by using a domain name that is similar to or a common misspelling of an existing legitimate domain name.

Structural: DNS is highly prolific and most exchanges on the Internet involve DNS at least at some level. However, many critics have leveled considerable negative assessment to the DNS

system as it exists in 2011, which is arguably not well designed for the purpose that it serves. Problems include security, vulnerability, political aspects, [Ramasubramanian and Sirer, 2004] intellectual property, and the concerns of private individuals [Foner, 2001]. Some, in fact, call for the outright replacement of DNS, despite the difficulties it may present [Foner, 2001]. However, it is likely that the DNS is too deeply intertwined with network software to be completely replaced at the interface level [Deegan, Crowcoft, and Warfield, 2005]. Nevertheless, major structural changes can be affected that would have negligible impact on client applications in terms of functionality or code changes.⁴⁷ These changes are not inaccurate. The DNS system is not perfect. Many efforts have been undertaken to attempt to overcome its shortcomings, including attempts at altering its structure. Peer-to-peer technology is one likely candidate for this, due to its resiliency against denial-of-service attacks, high-level scalability, and load balance assistance in handling the network demands that DNS faces; as such, systems such as the Cooperative Domain Name System (CoDoNS) have been proposed to attempt to leverage the benefits of peer-to-peer strategies [Ramasubramanian and Sirer, 2004]. The introduction of more secure protocols such as DNSSEC may make it more practical to execute such changes, which we may see now that DNSSEC is supported on the thirteen root servers and support is rapidly spreading on others, [Mohan, 2011; Vaughan-Nichols, 2010]. On the other end of the spectrum, some propose reengineering the DNS from its distributed system to a centralized overall system for performance purposes [Deegan, Crowcoft, and Warfield, 2005]. As such, the very physical structure of the DNS is not a static entity; rather, it is in flux and may considerably develop, or may eventually even be totally replaced.

⁴⁷ Pope, MB,(2012) "The Domain Name System—Past, Present, and Future" (Dec. 13, 2017, 10:30 AM)aisel.aisnet.org > Journals > CAIS > Vol. 30 (2012).

Political: As mentioned previously, the possibility exists that other countries or organizations may start their own domain name registries for their own purposes. This is not the limit for potential political interference in domain name registration. Moves to censor the Internet in western countries such as Italy [Warner, 2007], Australia [Bryant, 2008], and the United States [Bambauer, 2011] join other well-known censorship initiatives in other countries such as China [Zittrain and Edelman, 2003]. That the governments of these influential countries seem to be pushing for such movements in their own sphere of influence makes it quite possible that they may move their interests abroad and attempt to exert pressure on ICANN to modify their policy to better fit their demands. ICANN is under the employ of the U.S. Department of Commerce as a contractor and is a private organization with nonprofit status dedicated to maintaining the coordination of aspects of the Internet such as the DNS [Fuller, 2001; ICANN, 2007]. These services are vital, but ultimately ICANN's authority is derived by the mutual consent of the Internet community. That authority theoretically could be revoked at any time, and in many cases it would take only a relatively limited amount of legislation to entirely deprive ICANN of power in a country, and possibly many countries. In order to prevent the emergence of alternative domain registrars backed by the resources of a large country, ICANN may need to at least partially acquiesce to such interests.

Governance: As with all sizable organizations, there have always been those who have disagreed with their decisions, and ICANN is no exception. In this vein, decisions to modify the DNS hierarchy caused considerable controversy (see Figure 1 for the DN. In particular, significant changes to the way that TLDs are handled have occurred. ICANN has historically been well-known for tightly regulating the TLDs with their addition or subtraction being cause for considerable publicity. However, the process to allow the public to purchase top-level domains for the first time was finalized in June of 2011, albeit accompanied by a hefty \$185,000 price tag, no guarantee of approval, and limited to a three-month application window

[Rashid, 2011; Shankland, 2011]. This raises a number of issues with censorship being among them. The .xxx TLD has often been proposed for pornography-related websites, raising issues about ICANN entering the content-compliance business, was initially rejected [ICANN, 2006], only to be reconsidered in June of 2010. ICANN determined the application should be reconsidered since the last application rejection in 2007 was cited as going against the policy to be neutral, objective, and fair. At that time, one registrar estimated a \$30 million/year revenue stream would result from the sale of .xxx domain names [White, 2010]. To the confusion of and disapproval by family, religious, free speech, and adult entertainment groups, ICANN approved the addition of the .xxx TLD in March of 2011 [Blue, 2011; Cheng, 2011]. The registrar ICM Registry, considered to be the driving force behind the push for the TLD approval, has already presold more than 250,000 domain names equating to roughly \$20 million, and are projecting annual sales of about \$200 million for domain names under the new porn TLD [Blue, 2011]. ICM Registry not only submitted an application for the unsponsored gTLD .xxx, but for a .kids gTLD as well [ICANN, 2000] under the auspices that if the application is accepted, such gTLDs may further provide separation of content-specific sites and ideally provide simpler methods to prevent the unintended access of sites with inappropriate content for children. The controversy continues, however, as the majority of the .xxx presales are believed to have been made not for the expected use, but for the purpose of preventing the domain name use [Blue, 2011]. Another example, quality control, was once very tightly regulated with care being taken to ensure that the domain names assigned to TLDs complied with the guidelines keeping the categories meaningful [Postel and Reynolds, 1984]. Some TLDs are tightly regulated, such as those under .edu [EDUCAUSE, 2009]. On the other hand, others, such as .com, have little to no regulation, in part due to the fact that one can purchase a domain name under some TLDs in seconds, precluding much, if any,

human involvement.⁴⁸ As an example, consider a proposed geographically- oriented TLD such as .paris which would be a TLD for websites related to Paris, France. A lack of domain name regulations opens up the possibility for a domain name like ihate.paris, a website unlikely to be positively focused on Paris, France, and raising the larger question of who determines the criteria for admission. Trademark issues may also become a factor, as these new TLDs could end up contested in court on trademark and other issues, as other domain names are. Of greater concern, however, is the proposal that new TLDs can have non-Roman characters within them [ICANN, 2008a]. On the surface this may not seem to be a problem; however, Roman characters are the standard for keyboards throughout the world, and users would have to exert considerable effort to enter characters in a language other than their own. This could be used as a mechanism for limiting effective access to some websites from the outside world.

The Business of the DNS As the Internet develops into multiple knowledge repositories, social networks, e-businesses, virtual educational institutions and a myriad of other tools for personal, business, and educational use, DNS issues must be contended with, for example, those related to the global expansion of the Internet as illustrated by the global IP address distribution shown in Figure 2, as well as the numerous new issues that continue to surface. As the Internet expands, becoming integrated into our daily lives and increasingly more critical to the livelihood of organizations and individuals, so it becomes not only a tool or a resource but a business in itself. As a result, networks are becoming increasingly complex, requiring the multiple IP resources being used by organizations to be managed. This critical need is being met by tools such as IP address management (IPAM) software [Garrison, 2011], and by registrars like Oversee.net providing services beyond the simple purchase of a domain name [Oversee.net, 2010]. For example, Oversee.net offers brokerage services for the buying and selling of domain names, comparing their service to that of the brick-and-mortar real estate

⁴⁸ *Supra* note 41.

brokering that has been taking place for centuries. Much like a sophisticated advertising firm, Oversee.net also assists with attracting customers to websites through their “monetizing direct navigation traffic” services. Even those who wish to build their e-business on the Internet itself can do so with Oversee. Net’s Emerging Business Division.

2.5.7 The Domain Name System (DNS) Future

To presume to be able to predict the future with great accuracy, particularly in a realm so rapidly changing as technology, especially when it is so deeply intertwined with many other dynamic factors from across the modern world structure, may seem a bit presumptuous. We must recognize the limitations of trying to predict the future in a realm that changes so rapidly, and with so many technological, political, and economic influences. Nevertheless, based on an objective assessment of these trends and using a reasonable extrapolation to guide our analysis, we offer forecasts for the answers the DNS and ICANN may present for the challenges facing it in the decade of the 2010s. Use of Extended Characters in TLDs.

Chinese Characters As a step toward a globally compatible Internet, in June of 2010 ICANN approved Chinese language TLDs, an approval preceded by approvals for Egypt, Russia, Saudi Arabia, and the United Arab Emirates IDNs in April of the same year. This change to allow new internationalized domain names (IDNs) to now be registered using non-Latin characters, such as Arabic, Cyrillic, or Chinese, that are local to a specific country opens up Internet use to large groups of individuals in the world who have so far been unable to access the Internet due to this language barrier [Abolins, 2010; Sayer, 2010].

Latin Characters Use of non-Latin characters requires solutions to technological hurdles, with the Internet Engineering Task Force providing the base technology solutions. The IDNs will begin with the characters xn with a series of letters and numbers to represent the non-Latin

characters, translated by the users' browser into the international characters [Sayer, 2010]. Input of the non-Latin characters from a user's keyboard in order to access the website or to use network tools such as nslookup or WHOIS, however, will require a keyboard or other input device capable of entering the special characters [Abolins, 2010]. This difficulty may play a large part in whether the IDNs will be used very much beyond China and other cultures that tend to be more insular. The driving force behind this will likely be commerce, as well as a desire to communicate with one another; furthermore, the use of standard TLDs is something that Internet users overwhelmingly prefer. Many subtle technical challenges also come with the change to Unicode [Abolins, 2010]. Many network tools which are considered ubiquitous to administrators were originally written long before Unicode was even considered as a possible element in DNS records, instead using ASCII, which relies on single-byte character codes. Fortunately, solutions exist, such as converting Unicode records into ASCII-compliant strings known as Punycode with the aid of various utilities and using these Punycode strings in lieu of the real domain name. Nevertheless, this is an awkward solution, and proper Unicode support will require modification of the software, which may prove extensive in more sophisticated programs. Unicode Problems with authentication are also found with the Unicode transition [Abolins, 2010]. WHOIS, the standard for identifying who is responsible for a DNS record, has difficulty with these strings. Although alternatives exist, such as using Punycode with more cooperative utilities and then doing a reverse lookup using the IP address, these are awkward and are likely to cause problems for applications that may rely on more traditional WHOIS commands and interfaces.⁴⁹

The problems in the Unicode arena span from annoyances to severe potential threats with the prospect of homographic attacks [Abolins, 2010]. These attacks use the extensive library of

⁴⁹ Pope, MB,(2012) "The Domain Name System—Past, Present, and Future" (Dec. 13, 2017, 10:30 AM)aisel.aisnet.org > Journals > CAIS > Vol. 30 (2012).

characters available to Unicode to find specific characters that look identical to legitimate characters. Thus, you might attempt to log in to your mail account at mail.yahoo.com by clicking a link. It would look the same to the human eye, and the URL would look legitimate. Unfortunately, one of those characters could be altered to look like the original, sending you to a completely different site—possibly a fraudulent one, which may attempt to intercept passwords or accomplish other damage. Although removing offending sites from the records, once found, would be simple, a question arises in terms of how long a hypothetical site could get away with it. Furthermore, simply disabling such a site is cold comfort for anyone who has had their e-mail compromised by individuals with unknown intent on another continent. While homographic attacks are mostly hypothetical at this time, it is hardly difficult to imagine phishers and others beginning to use this potential security hole in earnest in the near future.

New TLDs Will Become a Norm Significant changes were made in the ICANN handling of TLDs in 2010 and 2011, ultimately leading to the viability of purchasing new TLDs for use by private entities [Shankland, 2011]. The new generic TLDs (or gTLDs) will enable addresses to end in almost any word in any language, thereby enabling stronger and more creative brand identification [ICANN, 2011]. This may lead to a new round of domain name and trademark disputes, historically a source of considerable legal activity [Davis and Warkentin, 2001], and may be even more heated, as a custom TLD is more difficult to replace than a regular domain name with a generic TLD. Existing TLDs will still see much contention for domain names—many companies will want to be available at a more “traditional” address, at least for a long while, so Google may be reachable with main.google and google.com simultaneously. This may eventually also result in ICANN being forced to judge content even more than before to determine how to handle TLD management.⁵⁰

⁵⁰ *Supra* note 43.

Uneventful IPv6 DNS Conversion This will be relatively painless, as many, if not most, major DNS software packages support the IPv6 version alongside IPv4. As such, any well-maintained site with updated software may very well need only some slight reconfiguration to provide full IPv6 functionality. A far more pressing concern is in the actual deployment of IPv6; in short, DNS is the least of the problems that IPv6 adoption should be concerned with.

DNS Fragmentation At least one major attempt will be made to create an alternative DNS, backed by a government or state. Additionally, at least one large-scale commercial venture will do the same. The government entity may succeed, but the commercial venture will fail unless it is also backed by a major government, if for nothing more than sheer lack of profit, unless it fulfills a specific niche market, such as some network built on the Internet for a special purpose such as high security. Alternatively, attempts by governments to control DNS and the Internet, such as copyright-related domain name seizures executed by the United States in 2011 [Kravets, 2011] or attempts to seal off parts of the Internet in politically volatile regions [Greenemeier, 2011], may lead to the adoption of a peer-to-peer based DNS system, with at least one project garnering significant interest after only a short time [Greere, 2010]. This approach would be considerably more difficult to force into compliance by any government and, much like faith-based currency, may become more influential than the “traditional” DNS if it is considered more valuable and adopted by the majority of Internet users.

The DNS Architecture Will Remain a Standard If IPv4 to IPv6 conversion is difficult, converting from DNS to a completely new system will probably not be much better, and have far fewer short-term benefits that are visible to the end user. Any changes will have to be client-transparent, as there is far too much software written with DNS in mind to make a switchover feasible except in the most extreme circumstances. IPv6 DNS is designed to address many of these issues, so if and when the conversion of the main Internet to IPv6 is activated, many flaws should, with luck, become irrelevant [Carli, 2003].

Third Party Registrar Corruption Will

Reach Critical Levels Third party registrars do not seem to have the same spirit of community that helped to build the Internet from scratch. Although it is arguable that organizations like ICANN are no longer in possession of this quality, it is more likely that they at least retain some of the cultural mindset within the organization, not to mention some of the veterans; as such, many of the lower-level, third party registrars will continue to attempt to extract as much profit from their position as possible, even at the possible long-term detriment of the Internet at large. Eventually there will likely be some critical turning point that leads to heavy re-evaluation of the entire system.

UDRP Will Change Significantly the UDRP has worked so far, but not without problems. Some shortcomings of the procedure include requisite “bad faith” is ill-defined; complaining parties (often trademark holders) seem to have bias in their favor; the UDRP is not legal arbitration nor binding, allowing litigious intervention; parties such as large, corporate interests can more easily afford associated costs; and English dominates the process [Diéguez, 2008]. The UDRP has existed for over a decade [InterNIC, 2002b], providing sufficient experience to learn where it needs improvement [Diéguez, 2008]. Given the increase in corporate influence on the Internet, as well as public awareness, it is likely that there may be a struggle, with corporate interests gaining the upper hand and possible changes due to backlash; however, given the legal position of the UDRP, it may ultimately end up a supplement to the court system as opposed to an attempt at manifesting a final authority as originally intended.

Increasing Governmental Influence As of 2011, legislative action in several countries has indicated that DNS may encounter influence by governments as a method of filtering out undesirable Internet sites, as a result of pressure from both political and corporate forces. This may create considerable problems for its continued acceptance as a standard, as it is likely that the marketplace will gain support for a replacement resistant to external changes, regardless of

its legality [Bambauer, 2011]. Such competition may place considerable strain on the primary implementation of DNS to remain relevant and address the needs of many on the Internet, though it may be questionable how much support such a shift in naming technology could actually gather if it should retain a reputation as contraband or be challenging for a user to install and utilize. It may also endure the abuses DNS already struggles with, as well as additional, unanticipated abuses that may accompany any new technology used in potential replacements. Although highly unlikely, a worst- case scenario may result in a period of considerable ambiguity if no single DNS implementation maintains universal global acceptance.”⁵¹

DNS Will Never be perfect almost all systems have flaws. Even if the oft-cited IPv6 version of DNS corrects all the major structural flaws in the IPv4-based DNS, it remains under the radar and relatively new, whereas IPv4 DNS is ubiquitous and has been around for over two decades for analysis and dissection by would-be attackers. Furthermore, national governments will always squabble, as will agencies that govern systems like the DNS, whether they are government backed, corporate backed, independent, or otherwise. Ultimately, there will always be problems with the DNS, even if we fix all of those that are in existence; it is, in the end, a never-ending cycle, which, with luck, will continue to induce a net strengthening of the system as a whole.⁵²

2.6 The USA Court Approach

⁵¹ The Domain Name System: Past, Present, and Future (PDF Download (Dec. 13, 2017, 10 AM) https://www.researchgate.net/.../268521730_The_Domain_Name_System_Past_Present.

⁵² Pope, MB,(2012) "The Domain Name System—Past, Present, and Future" (Dec. 13, 2017, 10:30 AM)aisel.aisnet.org > Journals > CAIS > Vol. 30 (2012).

“The early developments of the internet have always been attributed to the efforts of the United States as the vast majority of domain names are registered in the United States”⁵³. Consequently, the majority of disputes have originated there. The courts in the US have struggle to address the disputes of domain name in context of trademark laws in light of two important policies of trademark law 1) to prevent confusion in the public and 2) to protect the trademark owner’s investment in its mark. It must be noted that US trademark system is uniquely a common law use based system, combined with elective federal registration. Trademark used in interstate commerce are protected under the Lanham Act, while those used locally are protected under common law. Nevertheless, both common law and federal law apply the same principles in protecting trademarks and resolving disputes. The following are the laws under which trademarks are protected”⁵⁴.

2.6.1 Trademark Infringement:

“The Lanham Act of 1946, also known as the Trademark Act (15 U.S.C.A. § 1051, is a federal statute that regulates the use of Trademarks in commercial activity. Trademarks are distinctive pictures, words, and other symbols or devices used by businesses to identify their goods and services. The Lanham Act gives trademark users exclusive rights to their marks, thereby protecting the time and money invested in those marks. The act also serves to reduce consumer confusion in the identification of goods and services. The Lanham Act was not the first federal legislation on trademarks, but it was the first comprehensive federal legislation. Before the Lanham Act, most of trademark law was regulated by a variety of state laws.

The first federal trademark legislation was passed by Congress in 1870 and amended in 1876.

In 1879 the U.S. Supreme Court found that legislation unconstitutional. Two subsequent atte

⁵³ (Dec. 31, 2017, 6

AM) [http://biletta.ac.uk/content/files/conference%20papers/2006/Internet%20domain%20names%](http://biletta.ac.uk/content/files/conference%20papers/2006/Internet%20domain%20names%20)

⁵⁴ David Yan, Virtual reality: can we ride trademarks law to surf cyberspace? 10 Fordham I.P., Media & Ent.L.J.773, (2000) AT 782.

mpts at federal trademark legislation provided little protection for the rights of trademark users. The movement for stronger trademark legislation began in the 1920s, and was championed in the 1930s by Representative Fritz Lanham, of Texas. In 1946 Congress passed the act and named it the Lanham Act after its chief proponent.

Lanham stated in 1946 that the act was designed "to protect legitimate business and the consumers of the country."⁵⁵

"The Lanham Act protected trademarks used in commerce and registered with the Patent and Trademark Office in Washington, D.C. It expanded the types of trademarks that deserved legal protection, created legal procedures to help trademark holders enforce their rights, and established an assortment of rights that attached to qualified trademarks. Congress has amended the act several times since 1946. The most sweeping changes came in 1988. Those changes included an amendment that authorized the protection of trademarks that had not been used in commerce but were created with the intent that they be used in commerce."⁵⁶

"Owners of federally registered trademarks can bring actions against trademark infringement under section 32 (1) of the Lanham Act.⁵⁷ S.32 (1) provides that infringement occurs when one uses a registered mark in commerce or applies it to goods or services without the consent of the trademark registrant, and such use is likely to cause confusion. If trademark were established, monetary damages and/or injunctive relief would be granted. To prevail under S.32 (1), a plaintiff must prove that the defendant use of trademark-based domain names results in a likelihood of confusion regarding the origin of the goods and services. The touchstone of liability under this Act is that of confusion. However, given the technical aspects of the

⁵⁵ *Supra* note 51.

⁵⁶ Lanham Act legal definition of Lanham Act (Dec. 14, 2017, 10 AM)
<https://legal-dictionary.thefreedictionary.com/Lanham+Act>.

⁵⁷ Lanham Act s32 (1), 15 U.S.C. s 1114(1)(1994).

Internet, the plaintiff may also prevail if initial interest confusion occurs as a result of the defendant's use of the trademark, via domain or metatags.⁵⁸

2.6.2 Likelihood of Confusion:

Likelihood of confusion is crucial standard for trademarks infringement claim. The test for determining the likelihood of confusion in the Internet context is essentially the same, with only slight variations. Courts look at the totality of factors and circumstances of the case in determining likelihood of confusion. It is important, however, to note that test for likelihood of confusion only applies to goods or services that are related. Meaning those goods or services which would reasonably be thought by the public to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the trademark owner.⁵⁹ If the goods or services are totally unrelated, there can be no infringement because consumer confusion is unlikely. This requirement that the goods be related may limit the cases in which the mark owner can obtain a legal remedy in domain name disputes. Considering the specialty and technical quality of numerous novel issues arising out of the domain name-trademark disputes, the inventive US courts developed a flexible approach in analysing likelihood of confusion to reflect the changing circumstances.

2.6.3 Initial Interest of Confusion

The traditional likelihood of confusion test may be problematic to establish trademark Infringement when the violating party diverts consumer initial interest from the trademark

⁵⁸ Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d at 1036, 1062 (9th Cir. 1999).

⁵⁹ Donna L. Howard, Trademarks and service marks and Internet domain names: Giving ICANN deference, 33 Ariz. St. L.J. 637 (2001), at 644, quoting Bally total fitness holiday group v. Faber, 29 F. Supp. 2d 1161, 1163 (C.D. Cal. 1998).

owner without causing origin confusion.⁶⁰ In these situations the Internet user is likely to enter a trademark as a SLD but get another web page, though he is aware of this fact but he is likely to stay. Therefore, the domain name holder catches a new user by using the goodwill of the trademark. Many courts in the US apprehend the Act in abroad sense and create this new concept, which is actionable under the Act.⁶¹ This concept largely broadens the ambit of traditional test by permitting a finding of a likelihood of confusion even though the consumer immediately knows the Source actually identity.

2.6.4 Functional TLDs:

The US courts split on the issue of whether functional TLDs are the contributing factor of finding likelihood of confusion or dilution. The minority of courts, represented by the Avery Dennison Court, drew a line between domain names under .com and under .net, and inferred that confusion or dilution arose from a domain registration under .com TLD, but not under .net TLD.⁶²

2.7 Unfair Competition

The Lanham Act goes beyond trademark infringement and creates a federal statutory tort, which provides wide protection against various aspects of unfair competition. Causes of action for unfair competition can be brought under section 43(a) of the Lanham Act⁶³ for all marks,

⁶⁰Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d at 1036, 1062 (9th Cir. 1999).

⁶¹ *Supra* note 60.

⁶² Avery Dennison Corp v. Jerry Sumpton, 189 F.3d 868, 880-81 (9th Cir. 1999).

⁶³ Lanham Act s43 (a), 15 U.S.C. s1125 (a) (1994).

registered or not, as well as trade names. S.43 (a) is often referred to as the Federal Unfair Competition Law and provides another channel to deal with domain name-trademarks disputes.

2.8 Trademark Dilution

The Federal Trademark Dilution Act of 1995 (FTDA), signed into law in 1996, amended the Lanham Act to create a federal cause of action for the dilution of famous marks. The Act affected domain name disputes in that famous mark were automatically protected, and unlike infringement or unfair competition claims, likelihood of confusion is not a requirement.⁶⁴ The FTDA defines dilution as the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and the other parties, or (2) likelihood of confusion, mistake or deception.⁶⁵ Thus, it provides for claims against non-competing and non-confusing uses if they diminish or dilute the effectiveness or distinctiveness of the mark.

Dilution of trademarks by domain name has been considered by US courts. Historically, three types of dilution have been recognized; blurring, tarnishment, and disparagement. Dilution by blurring anticipates the whittling away the selling power and value⁶⁶ of an original mark by using a similar mark even if on dissimilar products or services and thereby creating in the consumers mind a new association with the original mark. Dilution by tarnishment occurs when a mark is used by a third party in a manner that is inconsistent with the use of the mark by its original owner such that the goodwill associated with the original owners mark becomes

⁶⁴ Avery Dennison Corp v. Jerry Sumpton, 189 F. 3d at 873, 879.

⁶⁵ 15 U.S.C. 1127 (1996)

⁶⁶ Panavision Int l, L.P. v Toeppen, 141 F3d 1316, 1324 (9th Cir. 1998)

degraded or tarnished.⁶⁷ Although the FTDA has been applied in a number of domain name disputes because of its advantages, there are two principle weaknesses constraints FTDA's application to resolve domain name disputes. Firstly, the threshold that the mark must be famous is hard to meet. The second limitation is the requirement of commercial use in commerce.

⁶⁸As to the first limitation, the FTDA lists eight non-exclusive factors for evaluating whether a mark is famous.⁶⁹ The standard for fame is very high and the evaluation is often subjective. Federal courts have concluded that to be famous, under dilution a mark [must] be truly prominent and renowned, and therefore most likely to be adversely affected by dilution. However, this limitation seems to have been ameliorated by some recent cases in which the courts have adopted a relatively lower threshold in favour of finding trademark dilution in the Internet context. Commercial use in commerce requirement involves two-steps analysis. First, the defendant must meet the definition of use in commerce, i.e. use in the regular course of interstate trade. This means the domain name must be attached to some commercial goods and services of the registrant. Second, the defendant's use must be commercial; i.e. proposes a commercial transaction. Mere registration of a domain name without more does not constitute a commercial use.⁷⁰ The non-commercial use of a domain name that hinders a trademark owner's exploitation of the value of its trademark on the Internet will not cause dilution. Therefore, in cases where there are no goods or services sold or advertised on the Internet, the courts have to stretch the meaning of the statute so as to find commercial use and thus establish

⁶⁷ Toys R Us v Akkaoui, 1996 U.S. Dist. Lexis 17090 (N.D. Cal. Oct.29,1996)

⁶⁸ Jews for Jesus v. Brodsky, 993 F. Supp. 282, 308 (D.N.J. 1998); Playboy Enterprises, Inc. v. Asia focus International, Inc. 1998 U.S. Dist. Lexis 10359, (E.D. Va. Feb. 2, 1998) at 20, and Playboy Enterprises International, Inc. v Global Site designs, Inc. 1999 WL 311707, at 2.

⁶⁹ 15 USC s1125 © (1) (a)-(h) (1996)

⁷⁰ Jews for Jesus v. Brodsky, 993 F. Supp. At 307.

dilution. Moreover, if the cyber squatter does not attempt to sell trademark-based domain names to the rightful trademark owner, but rather sits on it to curtail the trademark owners use, it seems that the cyber squatter can avoid commercial use, and escape liability under dilution.

2.8.1 State Cause of Action

Besides the federal law, there are basic state law causes of action available for domain

Name-trademark disputes;

- Common law trademark infringement;
- State anti-dilution statutes;
- Unfair competition and deceptive trade practices under common law and state Statutes;
- Claims under other state laws.⁷¹

Perhaps the biggest problem in these causes is that before the court can approach the underlying issues, personal jurisdiction over the defendant must be established. Jurisdiction must satisfy the forum state's long arm jurisdiction statute (LAJS) and meet certain minimal constitutional thresholds under the Due Process Clause of the Fourteenth Amendment. Establishing personal jurisdiction in domain name disputes can be a difficult issue due to the global character of the Internet and a lack of any calculated activity targeting the forum state. It is interesting to note that recently a so-called sliding scale approach based mainly on the degree

⁷¹ Some states have made efforts to propose solution of disputes. City California for example. a state senator in California introduced a bill to protect trademarks used in electronic mail user names, Which addresses the unreachability of pseudo domain names under unfair competition. 41 see, Joan Meadows, Trademark protection for trademark used as Internet domain names, 65 U. Cin. L. Rev.1323, at 1355.

and type of interactivity on the Web site at issue has been developed by the US courts in addressing personal jurisdiction issues in Internet trademark cases.”⁷²

2.9 Anticybersquatting Consumer Protection Act

“Cyber squatting is the act of purchasing a domain name that uses the names of existing businesses, which are usually trademarked, for the sole purpose of either profiting from the goodwill of that person’s business/trademark or holding the domain name hostage in exchange for a sum of money from the business or person that owns the trademark in order to acquire the domain. In 1999, Congress enacted the Anti-Cyber squatting Consumer Protection Act (“ACPA”). 15 U.S.C. § 1125(d). The Act creates a cause of action for anyone who registers or uses a domain name that is confusingly similar to, or dilutive of, the trademark or personal name. Cyber squatting became apparent during a time when the Internet was first blossoming in some corporations were not savvy enough to realize the opportunities that existed on the Internet.”⁷³ “The legal remedies available for victims of cyber squatting before the enactment of the ACPA were viewed by the Congress as expensive and uncertain. The ACPA amends the trademark act of 1946, creating a specific federal remedy for cyber squatting”.⁷⁴ “In the leading *Sporty's Farm v. Sportsman's Market*⁷⁵, the second circuit outlined five-step process for the ACPA analysis. The first issue before the court is the applicability of the ACPA to the case in question and whether the court can exercise personal jurisdiction over the defendant or if an in rem jurisdiction over the domain name itself can be obtained. Secondly, the court must decide whether the plaintiff’s trademark is famous or distinctive and thus entitled to the

⁷² David Yan, Virtual reality: can we ride trademarks law to surf cyberspace? 10 Fordham I.P., Media & Ent.L.J.773, (2000) AT 782.

⁷³ The Anti-Cybersquatting Consumer Protection Act (“ACPA”) – JUX (Nov. 28, 2017, 8:22 AM) <https://jux.law/the-anti-cybersquatting-consumer-protection-act-acpa/>.

⁷⁴ *Ibid.*

⁷⁵ 202 F.3d 489 (2nd Cir. 2000)

protection under ACPA. Thirdly, the court must determine whether the defendant's domain name is identical or confusingly similar to the plaintiff's trademark. The fourth step is to identify whether the defendant has acted with bad faith intent to profit at the time of registration. And finally, the court must grant proper remedy. One of the most significant aspects that the ACPA adds to the traditional trademark law is the establishment of in rem jurisdiction. It is now possible for a legitimate mark owner to file an in rem action against the domain name itself rather than the registrant when the domain name infringes or dilutes the owner's trademark.⁷⁶The ACPA also creates a specific civil cause of action by the trademark owner against any person who registers, traffics in or uses a domain name that is identical or confusingly similar to or dilutive of a trademark (on the condition that the trademark was distinctive or famous at the time of registration) where the domain name is registered with a bad faith intent to profit. The creation of a separate and unique cause of action for living individuals to recover domain names containing their personal names where the name is registered with bad faith intent to profit. However, the ACPA is by no means beyond criticism and further improvements need to be made. The Act firstly fails to effectively curb reverse domain name hijacking by large corporations. Mark Grossman argues, the act has little to do with consumer protection, and more to do with protecting the behemoth companies who want to protect every conceivable variation of their name. To solve this public policy problem, steeper punishments for plaintiffs that exercise such practices are suggested.⁷⁷Secondly, it fails to address the disputes of two or more legitimate owners of the same trademark in different classes or countries seeking the same domain name. ACPA should be amended to indicate whether a first come, first served rule or some other rules would apply. Thirdly, the issue of

⁷⁶ 15 U.S.C.S s 1125 (2000).

⁷⁷ Jason H. Kaplan, The Anticybersquatting Consumer Protection Act: will it end the reign of the Cyber squatter? 8 UCLA Ent L. Rev. 43, (2000) At 78.

whether the trademark owner should sue possible infringers so as to reduce the risk of weakening or abandoning the mark as a result of failure to police it remains unclear.”⁷⁸

2.10 India

“Unlike many developed countries, in India we have no Domain Name Protection Law and cyber squatting cases are decided under Trade Mark Act, 1999”.⁷⁹ “Although the Indian Courts have drawn the distinction between trademark and domain name; wherein the Hon'ble Supreme Court in *Satyam Info way Ltd vs Siffynet Solutions Pvt Ltd*⁸⁰; AIR 2004 SC 3540 has observed that the "distinction lies in the manner in which the two operate. A trademark is protected by the laws of a country where such trademark may be registered. Consequently, a trade mark 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.”⁸¹ The outcome of this potential for universal connectivity is not only that a domain name would require worldwide exclusivity but also that national laws might be inadequate to effectively protect a domain name". The Indian Courts though have recognized the lacuna; however, in the absence of a explicit legislation, courts apply provisions of the Trade Marks Act to such disputes. The Court in Case (Supra) further observed that "As far as India is concerned, there is no legislation which explicitly refers to dispute resolution in connection with domain names. But although the operation of the Trade Marks Act, 1999 itself is not extra territorial and may

⁷⁸ David Yan, Virtual reality: can we ride trademarks law to surf cyberspace? 10 Fordham I.P.,Media & Ent.L.J.773, (2000) AT 782.

⁷⁹ Cyber Squatting Laws In India - Intellectual Property - India (June, 27,2017, 9 AM)
<http://www.mondaq.com/india/x/208840/Trademark/CYBER+SQUATTI+NG+LAWS+IN+INDIA>

⁸⁰ AIR 2004 SC 3540.

⁸¹ *Ibid.*

not allow for adequate protection of domain names, this does not mean that domain names are not to be legally protected to the extent possible under the laws relating to passing off⁸².

2.10.1 Dispute Resolution

“Dispute involving bad faith registrations are typically resolved using the Uniform Domain Name Dispute Resolution Policy (hereafter referred to as UDRP) process developed by the Internet Corporation for Assigned Names and Numbers (hereafter referred to as ICANN). Under UDRP, WIPO is the leading ICANN accredited domain name dispute resolution service provider and was established as a vehicle for promoting the protection, dissemination, and the use of intellectual property throughout the world. India is one of the 171 states of the world which are members of WIPO. A person may complain before the administration dispute resolution service providers listed by ICANN under Rule 4 (a) that:

- (i) A domain name is "identical or confusingly similar to a trademark or service mark" in which the complainant has rights; and
- (ii) The domain name owner/registrant has no right or legitimate interest in respect of the domain name; and
- (iii) A domain name has been registered and is being used in bad faith.

Rule 4 (b) has listed, by way of illustration, the following four circumstances as evidence of registration and the use of a domain name in bad faith:

- (i) Circumstances indicating that the domain name owner/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 is the owner of the trademark or service

⁸² *Supra* note 76.

mark; or to a competitor of that complainant for valuable consideration in excess of its documented out of pocket costs, directly related to the domain name; or

(ii) The domain name owner/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 it has engaged in a pattern of such conduct; or

(iii) The domain name owner/registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) By using the domain name, the domain name owner/registrant has intentionally attempted to attract, for commercial gain internet users to its web site or other online location by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the domain name owner/ registrant web site or location or of a product or service on its web site or location. India has also established its own registry by the name INRegistry under the authority of National Internet Exchange of India (NIXI), wherein the dispute related to the domain name are resolved under the .IN Dispute Resolution Policy (INDRP). The Policy has been formulated in line with internationally accepted guidelines, and with the relevant provisions of the Indian Information Technology Act 2000. Under INRegistry, disputes are resolved under .IN Domain Name Dispute Resolution Policy (INDRP) and INDRP Rules of Procedure. These rules describe how to file a complaint, fees, communications and the procedure involved.”⁸³

2.10.2 Role of Judiciary

⁸³ Cyber Squatting Laws In India - Intellectual Property - India (June, 27,2017, 9 AM)
<http://www.mondaq.com/india/x/208840/Trademark/CYBER+SQUATTI+NG+LAWS+IN+INDIA>.

“Though domain names are not defined under any Indian law or are covered under any special enactment, the Courts in India have applied Trade Marks Act, 1999 to such cases. Like in other cases under Trademarks Act, 1999 two kind of reliefs are available:

1. Remedy of infringement⁸⁴

2. Remedy of passing off⁸⁵

Remedy of Infringement: Trade mark Act permits owner of the trade mark to avail the remedy of infringement only when the trade mark is registered. Remedy of Passing off: No registration of the trade mark is required in case the owner intends to avail the relief under passing off.

The first case that came up before the Indian Courts was *Yahoo! Inc. v. Akash Arora and Another*⁸⁶ [1999 II AD (Delhi)]; in which an attempt was made to use the domain name yahooindia.com for Internet related services as against domain name i.e. yahoo.com, The Court observed that usually the degree of the similarity of the marks is vitally important and significant in an action for passing off for in such a case there is every possibility and likelihood of confusion and deception being caused. When both the domain names are considered, it is crystal clear that the two names being almost identical or similar in nature, there is every possibility of an Internet user being confused and deceived in believing that both the domain names belong to one common source and connection, although the two belongs to two different concerns.

⁸⁴ Section 29 of the Trademark Act-1999 talks about various aspects related to infringement as given in S.29(1) that a registered trade mark 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 trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

⁸⁵The specific description of passing off is not given in the trademark act but the courts have drawn its meaning from common law that if the infringement of trademark done in such a manner where the mark is not only deceptively similar to the trademark of other company but also creating confusion for the customers, which ultimately results in damage for business of the company.

⁸⁶ [1999 II AD (Delhi)].

In *Tata Sons Limited and Anr Vs fashion ID Limited*⁸⁷ (2005) 140 PLR 12; the Hon'ble High Court of Delhi Court held that "The use of the same or similar domain name may lead to a diversion of users which could result from such users mistakenly accessing one domain name instead of another. This may occur in e-commerce with its rapid progress and instant (and the erotically 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 web site which offers no such services. Such users could well conclude that the first domain name owner had misrepresented its goods or services through its promotional activities and the first domain owner would thereby lose their customer. It is apparent therefore that a domain name may have all the characteristics of a trademark and could found an action for passing off".

In *Dr Reddy's Laboratories Limited Vs Manu Kosuri and Anr* 2001 (58) DRJ241⁸⁸ Hon'ble High Court of Delhi Court held that "It is a settled legal position that when a defendant does business under a name which is sufficiently close to the name under which the plaintiff is trading and that name has acquired a reputation the public at large is likely to be misled that the defendant's business is the business of the plaintiff or is a branch or department of the plaintiff, the defendant is liable for an action in passing off and it is always not necessary that there must be in existence goods of the plaintiff with which the defendant seeks to confuse his own domain name passing off may occur in cases where the plaintiffs do not in fact deal with the offending goods. When the plaintiffs and defendants are engaged in common or overlapping fields of activity, the competition would take place and there is grave and immense possibility for confusion and deception. The domain name serve same function as the trademark and is not a mere address or like finding number of the Internet and, therefore, plaintiff is entitled to equal

⁸⁷ (2005) 140 PLR 12.

⁸⁸ 2001 (58) DRJ241.

protection as trade mark. The domain name is more than a mere Internet address for it also identifies the Internet site to those who reach it. In an Internet service, a particular Internet site could be reached by anyone anywhere in the world who proposes to visit the said Internet site. In a matter where services rendered through the domain name in the Internet, a very alert vigil is necessary and a strict view needs to be taken for its easy access and reach by anyone from any corner of the world. The trademarks/domain name 'DR. REDDY'S' of the plaintiff and 'dr reddy's lab.com' of the defendants are almost similar except for use of the suffix 'lab.com' in the defendant's domain use. The degree of the similarity of the marks usually is vitally important and significant in an action for passing off as in such a case, there is every possibility and likelihood of confusion and deception being caused. Considering both the domains' name, it is clear that two names being almost identical or similar in nature, there is every possibility of an Internet user being confused and deceived in believing that both the domain names belong to plaintiff although the two domain names belong to two different concerns".

In *Aqua Minerals Limited Vs Mr Pramod Borse & Anr*⁸⁹; AIR 2001 Delhi 467 the Hon'ble High Court of Delhi Court has held that Unless and until a person has a credible Explanation as to why did he choose a particular name for registration as a domain name or for that purpose as a trade name which was already in long and prior existence and had established its goodwill and reputation there is no other inference to be drawn than that the said person wanted to trade in the name of the trade name he had picked up for registration or as a domain name because of its being an established name with widespread reputation and goodwill achieved at huge cost and expenses involved in the advertisement.

⁸⁹ AIR 2001 Delhi 467.

In *Nestle India Limited Vs Mood Hospitality Pvt Limited*;⁹⁰ 2010 (42) PTC 514 (Del) the Hon'ble High Court of Delhi Court has held that in case of interim relief/injunction test of prima facie case as traditionally understood has been replaced, at least in trademark matters, by the test of comparative strengths of the rival cases. This is also in keeping with the requirements of the said Act in as much as it not only describes what amounts to infringement (Section 29) but it also makes provision for what does not amount to infringement (Section 30). Thus, apart from examining the case in the context of Section 29 of the said Act only from the stand point of the respondent/ plaintiff, it was also incumbent upon the learned Single Judge to consider the relative or comparative strength of the appellant's/defendant's case both under Section 29 and Section 30 (2) (a) of the said Act"⁹¹.

⁹⁰ 2010 (42) PTC 514 (Del).

⁹¹ *Supra* note 80.

CHAPTER 3: Unfair Trade Practices in Domain Name: USA and India

“The term Unfair Trade Practice (hereafter referred to as UTP) broadly refers to any fraudulent, deceptive or dishonest trade practice; or business misrepresentation of the products or services that are being sold; which is prohibited by a statute or has been recognised as actionable under law by a judgement of the court. However, the term does not have a universal standard definition. Misrepresentations can be about any characteristic of a good or service, real or imagined. Consequently laws prohibiting unfair trade practices often include a general provision and more specific provisions addressing some of the more common types of misrepresentations.”⁹² “Unfair trade practices encompass a broad array of torts, all of which involve economic injury brought on by deceptive or wrongful conduct. The legal theories that can be asserted include claims such as trade secret misappropriation, unfair competition, false advertising, palming-off, dilution and disparagement”⁹³. “UTPs can arise in any line of business and also frequently appear in connection with the more traditional intellectual property claims of patent, trademark and copyright infringement. At the international level, the World Bank and the Organisation for Economic Cooperation and Development (OECD) Model Law list the following trade practices to be unfair”⁹⁴ :

- “distribution of false or misleading information that is capable of harming the business interests of another firm;

⁹² Buik, Carl, “Dealing with Unfair Trade Practices”, Addis Ababa (Sep. 14, 2017, 10:30 AM) http://www.circ.in/pdf/CPS-06- Unfair_Trade_Practices.pdf.

⁹³ Pham, Alice (2007), “Competition Law in Vietnam: A Toolkit”, CUTS HRC, Hanoi (Sep. 14, 2017, 10:30 AM) http://www.cutsinternational.org/HRC/pdf/Vietnam_Toolkit.pdf.

⁹⁴ UNFAIR TRADE PRACTICES – A LOST IMPERATIVE OF THE (Sep. 14, 2017, 11 AM) http://www.arresearchpublication.com/images/shortpdf/1447868434_1205J.pd..

- distribution of false or misleading information to consumers, including the distribution of information lacking a reasonable basis, related to the price, character, method or place of production, properties, and suitability for use, or quality of goods;
- false or misleading comparison of goods in the process of advertising;
- fraudulent use of another’s trade mark, firm name, or product labelling or packaging; and
- Unauthorised receipt, use or dissemination of confidential scientific, technical, production, business or trade information”⁹⁵.

“Article 10bis of the Paris Convention prohibits the following components of unfair competition:

- (i) all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;
- (ii) false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor; and
- (iii) indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.”⁹⁶

“Unfair business practices include oppressive or unconscionable acts by companies against consumers and others. In most countries, such practices are prohibited under the law. Unfair

⁹⁵ *Supra* note 3.

⁹⁶ WIPO (1883), “Paris Convention for the Protection of Industrial Property”, (Sep.14,2017,11AM) <http://www.wipo.int/treaties/en/ip/paris/>.

trade practices can occur in many different areas such as insurance claims and settlement, debt collection, and tenancy issues”⁹⁷.

“Unfair trade practices also include such acts as:

- Fraud: This is an intentional deception made for the company’s gain or to damage the other party.
- Misrepresentation: This is a false statement of fact made by one party to another party, which has the effect of inducing that party into the contract. For example, under certain circumstances, false statements or promises made by a seller of goods regarding the quality or nature of the product may constitute misrepresentation.

In addition to providing for the award of compensatory damages, laws may also provide for the award of punitive damages as well as the payment of the plaintiff’s legal fees. When statutes prohibiting unfair and deceptive business practices provide for the award of punitive damages and attorneys’ fees to injured parties, they provide a powerful incentive for businesses to resolve the claim through the settlement process rather than risk a more costly judgment in court.

In the European Union, each member state must regulate unfair business practices in accordance with the Unfair Commercial Practices Directive, subject to transitional periods. This is a major reform of the law concerning unfair business practices in the European Union”.⁹⁸

“In some countries unfair trade practices falls within the purview of the competition statutes, in some others, that of Consumer Protection law and in some other cases they are dealt with by a

⁹⁷Unfair Trade Practices - Boundless..., (Sep. 14, 2017, 11:14 AM)
<https://www.boundless.com/marketing/textbooks/boundless-marketing-textbook/pricing-8/pricing-legal-conc>.

⁹⁸ *Supra* note 6.

separate law/act. In India, Brazil, Israel unfair trade practices are dealt under consumer law. This chapter will deal with how the unfair trade practices leads towards domain name disputes and it will also provide unfair trade practices laws both in national and international level.”⁹⁹

3.1 USA

Similarly, Section 5 of the Federal Trade Commission Act, 1914 (“FTC Act”) of the United States of America (USA) prohibits “unfair and deceptive acts or practices” in or affecting commerce. Such practices broadly include¹⁰⁰ :

- an act or practice that causes or is likely to cause substantial injury to consumers, that cannot be reasonably avoided by the consumers and is not outweighed by countervailing benefits to consumers or to competition; and
- an act or practice where a material representation, omission or practice misleads or is likely to mislead the consumer, who has reasonably interpreted such representation, omission or practice.

“There are two basic anti-competitive laws in USA, namely, the Sherman Act, 1890 and the Clayton Act, 1914. Both the laws are enforceable either by the Antitrust Division of the Department of Justice, the Federal Trade Commission (FTC) or private persons alleging economic injury caused by violation of either of them. In addition to the above two laws, the Federal Trade Commission Act, 1914 (the FTC Act), which is enacted to protect trade and commerce against unlawful restraints and monopolies, may also be utilized by FTC and private persons. However, only FTC, and not the Antitrust Division nor private

⁹⁹ Unfair Trade Practices and Institutional Challenges in India - cuts ccier (Sep. 14, 2017, 11:30 AM) http://www.cuts-ccier.org/pdf/Unfair_Trade_Practices_and_Institutional_Challenges_in_India-An_Analysis.

¹⁰⁰ unfair trade practices and its emerging challenges - Abhinav Journal (Sep.14,2017,11:35 AM) https://abhinavjournal.com/journal/index.php/ISSN-2277-1166/article/viewFile/871/pdf_195

persons, may enforce the FTC Act. Section 5 of the FTC Act prohibits unfair or deceptive acts or practices in or affecting commerce. The prohibition under the FTC Act applies to all persons engaged in commerce. This empowers FTC to prevent a person, partnership or corporation from engaging in incidences of unfair methods of competition in or affecting commerce and unfair or deceptive acts or practices in or affecting commerce. FTC Act is also given the power to investigate the relevant person, partnership or corporation for the non-compliance of anti-trust laws. At the federal level, FTC is the only entity regulating UTPs. But, along with UTPs, it also deals with other anti-competitive activities like mergers, cartelization, etc., at the same time. No specific, dedicated agency to watch over unfair trade practices exclusively has been established in USA at the federal level as yet. Due to efforts and initiation by individual states some special agencies dealing with such UTPs have been established at the state level. USA has a Uniform Deceptive Trade Practices Act (1964/1966) (hereafter referred to as UDTPA) in place which has been accepted by several states including Colorado, Delaware, Georgia, Hawaii, Illinois, Ohio, etc. The law addresses deceptive practices such as passing off of goods or services as those of another, causing likelihood of confusion or misunderstanding as to the source, sponsorship, approval of goods and services, “Bait and Switch” advertising, etc.”¹⁰¹ “The law focuses on protecting both competitors as well as consumers. The State of California has a specific law that prohibits unfair business practices, namely, California’s unfair competition law (hereafter referred to as UCL). The UCL was first enacted in the year 1933 and was modelled after the federal FTC Act, which prohibits unfair trade practices. As per UCL unfair competition shall mean and include any unlawful, unfair or fraudulent business act or practice and unfair, deceptive, untrue or misleading advertising and any act

¹⁰¹ *Supra* note 8.

prohibited by the law.¹⁰² Under UCL, any member of the public, including consumers, business enterprises as well as the competitors may sue on his/her own behalf or on behalf of the public generally. Therefore, it can be seen that, UCL does not only limit itself to anticompetitive business practices but also takes care of the right of the public to protection from fraud and deceit. Further, unlike the Indian situation, the definition of “unfair competition” in UCL is not restricted only to deceptive or fraudulent conduct but extends to any unlawful business practice thus giving the right to sue for an unfair practice to everyone including a natural person, corporation, firm, partnership, etc. However, it is observed that the UCL does not constitute a special agency for dealing with such unfair trade practices. The most common remedies sought under the UCL are injunctive relief and restitution of illegal business profits and there is no recovery for damages. However, section 17200 of the law authorizes injunctive relief and restitution, which the District Court of Columbia in the case *United States v. Philip Morris*, 449 F. Supp 2d 1 has been interpreted as including “disgorgement of ill-gotten gains or unlawful profits”. Additionally, in a recent development, in 2011 a new Unfair Competition law, titled “Sale of Products - Stolen or Misappropriated Information Technology” was passed, which impacts manufacturers worldwide and deals with the manufacturing of articles or products using stolen or misappropriated information technology (IT), i.e., non-genuine and unlicensed software. As per Section 2 of the law, such manufacturer engages in unfair competition when it sells an article or a product in the state, either separately or as a component of another article or product, in competition with a product made without use of stolen IT.¹⁰³ While, the first laws were passed in the States of Washington and Louisiana, on November 4, 2011, Attorney Generals of 39 other US States have also signed a resolution to combat unfair trade practices in manufacturing by preventing usage of illegal or stolen IT, which provides

¹⁰² Unfair Competition Law, 1933, i.e., Section 17200 of the Business and Professions Code.

¹⁰³ 1 “New U.S. Unfair Competition Laws Require ‘IT Compliance’ From Manufacturers Who Export”, (Sep. 14, 2017, 11:35 AM) <http://www.amchamindia.com/AMCHAM-UCA-Member-Advisory.pdf>.

an unfair advantage in the market place. The Attorney Generals of various states have also urged FTC to consider introducing a Federal Unfair Competition Law at the federal level to prevent IT theft.¹⁰⁴ Under the law a new cause of action allows private plaintiffs or the Attorney General to sue anyone who engages in this unfair competition, or to bring a claim against products made using stolen IT.¹⁰⁵ Although FTC is a fully functional and is the competent federal agency to look after the cases of UTPs in the USA, yet various states have always been aware about the fact that UTPs need special attention and from time to time have enacted specific legislations to this effect. Additionally, the concept of “unfairness” also has been under discussion time and again by the courts as encompassing more than just conduct which would violate the Sherman Act or other antitrust statutes and the conduct which runs counter to established public policy may also be deemed “unfair”. It was held in the case *Federal Trade Commission v. Sperry & Hutchinson Co.*, 405 U.S. 233, 244 (1972)¹⁰⁶, that unfair practices may extend to “public values beyond simply those enshrined in the letter or encompassed in the spirit of the antitrust laws¹⁰⁷.”

3.1.1 Effects of Unfair Trade Practices on the Consumers and the Economy

“The law of unfair competition serves five purposes;

- First, it protects the economic, intellectual, and creative investments made by businesses in distinguishing themselves and their products.
- Second, it preserves the good will that businesses have established with consumers.
- Third, it deters businesses from appropriating the good will of their competitors.

¹⁰⁴ Ibid.

¹⁰⁵ Section 6(1).

¹⁰⁶ 405 U.S. 233, 244 (1972),

¹⁰⁷ Unfair Trade Practices and Institutional Challenges in India - cuts ccier (Sep. 14, 2017, 11:30 AM) http://www.cuts-ccier.org/pdf/Unfair_Trade_Practices_and_Institutional_Challenges_in_India-An_Analysis.

- Fourth, it promotes clarity and stability by encouraging consumers to rely on a merchant's good will and reputation when evaluating the quality of rival products and,
- lastly, it increases competition by providing businesses with incentives to offer better goods and services than others in the same field.

Thus, the law of unfair competition covers both, the interest of consumers as well as the business enterprises and competing firms. Impact on Price and Quality of Goods and Services Prevalence of UTPs in a market adversely affects the price and the quality of goods and services. In the face of prevalence of unchecked UTPs, consumers may get attracted towards the product of a single producer. This assures the producer a fixed and assured consumer base and income and thus impedes competition. Once a producer or a service provider achieves a strong foothold in the market with the help of such UTPs the confidence of their position in the market and their base of consumers may lead them to increase the prices of the goods or services. The assurance of consumer loyalty may also entice the producer to compromise with the quality of their products to obtain additional profits. When a manufacturer engages in unfair trade practice to sell its own good, it mainly tries to increase the sale of its product/service by engaging in fraudulent, deceptive activity such as making its product look better than the other products of similar nature in the market by misrepresenting and deceiving the consumer about the quality of the product or giving incomplete or false information about the sale price of the goods of services. Impact on Micro, Small and Medium Enterprises It is pertinent to note here that most of the manufacturers that engage in UTPs that subsequently lead to deterioration in quality or increase in the prices of the goods or services, are the big market players who

cash on their brand value and cheat consumers with their false and short-lived promises. As a result of which, the other producers in the market, especially the small enterprises, who might deserve their dues but are too small to fight back on the same scale slowly get eliminated, thereby also eliminating competition from the market. Additionally, UTPs are generally carried out by the producers/sellers in an organised manner where most of the time the large industries with clout and resources work in tandem in distributing false or misleading information capable of harming the business interests of small firms working in the same sector. The large industries also use puffery, misleading statements or set a price which is lower than cost in order to throw out competitors from the market and attracting consumers to their product or service. The small and medium industries due to lack of sufficient resources are unable to meet this competition and face losses, even if the quality and the standard of the product is the same or better. For example, it was reported that in Korea, Lotte Group, which owns food manufacturing companies and retail companies, tried to discriminate against small-scale retailers by supplying their products at lower prices to their own retail stores, such as Lotte Department Stores and Lotte Mart. By doing this, Lotte tried to strengthen its position in the retail market. Because Lotte is currently the largest department store operator, and the third largest discount store and supermarket operator, its attempts to discriminate against small retailers might increase the concentration of food retailing and consequently strengthen Lotte's superior market position.”¹⁰⁸

¹⁰⁸ *Supra* note 9.

3.1.2 Impact on Consumer Confidence

“A revelation that they are cheated by a producer, or a group of businesses, might also lead the consumers to doubt the integrity of an entire industry or to distrust markets generally, which in turn will affect sales in that market negatively. Thus, UTPs not only harm the consumers, but also victimise other market players in the process, especially the smaller enterprises, competing firms and more importantly, take away consumer’s faith from the services and goods that they purchase thereby causing damage to the market as a whole.”¹⁰⁹

“In *Maison Prunier v. Prunier's Restaurant & Cafe, Inc.*,¹¹⁰ a New York court granted relief to the owner of a mark alleged to have "developed international fame." The mark, "Prunier," had been in continuous use in Paris, France for restaurant services from 1872 through the time of the case in 1936. The senior user had no operations in the United States. The restaurants, which operated under the name "Prunier" and "Maison Prunier," specialized in seafood. The junior user had opened a restaurant in New York City under the name "Prunier's Restaurant & Cafe, Inc." with menus carrying the legend "The Famous French Sea Food Restaurant." The trial court issued a temporary injunction against the junior use, although the senior use was exclusively foreign. In *Vaudable v. Montmartre, Inc.*, the New York trial court issued a permanent injunction to protect the senior user's "Maxim's" mark, used for a restaurant in Paris, from a junior use of the same name for a New York City restaurant. As stated by the court, "There is no doubt as to [the Paris restaurant's] unique and eminent position as a restaurant of international fame and prestige. It is, of course, well known in this country, particularly

¹⁰⁹ Unfair Trade Practices and Institutional Challenges in India - cuts ccier..., (Sep. 14, 2017, 11:40 AM) http://www.cuts-ccier.org/pdf/Unfair_Trade_Practices_and_Institutional_Challenges_in_India-An_Analysis.p

¹¹⁰ 159 Misc. 551, 557-58, 288 N.Y.S. 529, 535-36 (N.Y.Sup. Ct.1936).

to the class of people residing in the cosmopolitan city of New York who dines out." The senior user had a registration in the United States for catering services and wines, but the registration did not appear to weigh significantly in the court's decision. In enjoining the domestic use, the court emphasized the defendant junior user's apparent intent to appropriate the widespread goodwill that the plaintiffs had built up in the "Maxim's" name. As noted above, these New York cases did not rely on federal trademark law or the Paris Convention's obligation related to well-known marks, a point emphasized by the Second Circuit in refusing to recognize federal protection in 2007. Failure to refer to the Lanham Act in the *Maison Prunier* case is, of course, completely irrelevant in light of the fact that the Lanham Act became effective in 1947, eight years after the decision. And *Vaudable*, decided only twelve years after the Lanham Act shifted the emphasis within U.S. trademark law from the state to the federal level, had no need to make a specific citation to federal law. The court was able to rely almost entirely on New York state case law, specifically *Maison Prunier*. *Vaudable* did refer to the Lanham Act generally to support its statement that "the trend of the law, both statutory and decisional, has been to extend the scope of the doctrine of unfair competition." The doctrine recognizing well-known foreign marks remained relatively dormant for over forty years, with sporadic references in the decisions of the Trademark Trial and Appeal Board ("TTAB") and other cases where it was mentioned by a court in passing. But the doctrine was generally not relied on by any party to the case, and it did not form the sole basis of any of the decisions. For example, a 1983 TTAB decision declined to recognize priority in a senior foreign user of a mark as against a domestic, good-faith junior user, "at least unless it can be shown that the foreign party's mark was, at the time of the adoption and first use of a similar mark by the first user in the United States, a 'famous' mark within the meaning of *Vaudable v.*

Montmartre, Inc." The marks in that case were not alleged to have been "famous" or "well known" or otherwise to have a significant consumer reputation, so the TTAB did not further address the issue. Another 1983 TTAB decision rested on two bases: first, that oppose, All England Lawn Tennis Club, owned a U.S. registration for the mark WIMBLEDON for wearing apparel and that the applicant's proposed mark would create a likelihood of confusion with that registered mark, and second, that opposer had acquired rights in the term WIMBLEDON in the United States in connection with its annual tennis championship and that the term had acquired "fame and notoriety [in the United States] ...within the meaning of Vaudable."¹¹¹

“In late 2004, the Ninth Circuit issued the first in a flurry of well-known foreign marks decisions. Its decision allowed a foreign senior user of a mark to assert priority over a domestic junior user of a mark by relying on the mark's well-known status, based on use outside the United States, as of the time of adoption of the mark by the junior user. Grupo Gigante operated a grocery-store chain in Mexico under the store name "Gigante." The chain expanded from one Mexico City store in 1962 to almost one hundred stores by 1991. Six stores were in the Baja area of Mexico, and two of those stores were in Tijuana, located on the U.S.-Mexican border near San Diego, California. The Mexican company operated no stores in the United States before 1999. In mid-1991, Michael Dallo opened a grocery store in San Diego called "Gigante Market," and in 1996, he and his brother Chris opened a second area store under the same name. In 1998 and 1999, the Dallos and Grupo Gigante began their legal skirmish, and Grupo Gigante sued for trademark infringement. The Ninth Circuit, upon reviewing the district court's judgment recognizing potential rights in a well-known foreign mark, began by holding that the well-known marks doctrine did exist in the United States: We

¹¹¹ *Supra* note 18.

hold that there is a famous mark exception which the Ninth Circuit equated with a well-known mark exception to the territoriality principle. While the territoriality principle is a long-standing and important doctrine within trademark law, it cannot be absolute. An absolute territoriality rule without a famous-mark exception would promote consumer confusion and fraud. Commerce crosses borders. In this nation of immigrants, so do people. Trademark is, at its core, about protecting against consumer confusion and "palming off."¹¹² There can be no justification for using trademark law to fool immigrants into thinking that they are buying from the store they liked back home. The Ninth Circuit did not specify where in the rather large body of federal trademark law it located this protection. In applying the exception for a well-known mark, allowing the foreign senior user of the mark to assert priority over a domestic junior user, the Ninth Circuit set what might be termed a "secondary meaning plus" standard for which marks could be protected in the United States as well-known foreign marks. It held that "where the mark has not before been used in the American market, the court must be satisfied, by a preponderance of the evidence, that a substantial percentage of consumers in the relevant American market is familiar with the foreign mark."The court expressly limited the relevant American market to the geographic area of the defendant's allegedly infringing use. The concurring opinion in Grupo Gigante agreed with the legal standard announced, but it also explained in some detail why the evidence available in the case did not meet that standard. The concurring judge believed that for the grocery store services at issue, survey evidence related only to "Spanish-speaking persons who had recently purchased Mexican-style food at a supermarket or other food store"-the only survey presented by the senior user-would never be sufficient because the survey emphasized the target market of

¹¹² 159 Misc. 551, 557-58, 288 N.Y.S. 529, 535-36 (N.Y.Sup. Ct.1936).

Spanish-speaking grocery purchasers rather than the general category of the service provided, namely, retail grocery store services. Moreover, the concurring judge carefully set forth his view that a majority of the junior user's customers and potential customers must be familiar with the foreign mark before well known status can be found for that foreign mark. Also in 2004, the Southern District of New York held that section 43(a) of the Lanham Act provided protection to the owner of a foreign mark that was well known in the United States as of the time of the defendant's adoption of the mark.”¹¹³ “In *Empresa Cubana del Tabaco v. Cul bro Corp.*,¹¹⁴ although a Cuban cigar manufacturer was the senior user of the mark "Cohiba," a domestic junior user had registered the mark in the United States and had used it in connection with cigars at various times over a fifteen-year period before the immediate legal dispute had begun in earnest. The court referenced the common law "well-known" or "famous marks" doctrine as well as article 6bis of the Paris Convention, and it declared that the 6bis rights were "subsumed by federal and common law." The court referenced Vaudable and TTAB decisions referencing Vaudable, as well as the treatise McCarthy on Trademarks and Unfair Competition, to determine that "Cuba tabaco need only show that the COHIBA mark had a 'known reputation' to premium cigar smokers" at the time of the defendant's adoption of the mark. The court then looked to the World Intellectual Property Organization's Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks for guidance in applying a standard for well-known marks to the facts before it. Upon deciding that the "Cohiba" mark was well known, or famous, within the meaning of the doctrine, it found that the plaintiff senior user had a protectable right in the mark at the relevant time, and it proceeded to apply a standard likelihood of confusion analysis under section 43(a). The court found the junior use

¹¹³ Unfair Trade Practices and Institutional Challenges in India - cuts ccier (Sep. 14, 2017, 11:30 AM) http://www.cuts-ccier.org/pdf/Unfair_Trade_Practices_and_Institutional_Challenges_in_India-An_Analysis

¹¹⁴ 399 F.3d 462 (2nd Cir. 2005)

likely to cause confusion and cancelled the junior user's registration. When the *Empresa Cubana* case reached the Second Circuit, however, the senior user's victory proved short-lived. Although the court recognized and left open the possibility that well-known foreign marks were protected in the United States, it barred Cubatabaco, the plaintiff in the case, from using the doctrine to acquire trademark rights in the United States, basing its decision on the Cuban embargo regulations, stating Cubatabaco may be correct that Sections 44(b) and (h) incorporate article 6bis and allow foreign entities to acquire U.S. trademark rights in the United States if their marks are sufficiently famous in the United States before they are used in this country. That is the view expressed by some commentators'. However, we need not decide that broad question here because even assuming that the famous marks doctrine is otherwise viable and applicable, the embargo bars Cubatabaco from acquiring property rights in the U.S. COHIBA mark through the doctrine. In two separate 2005 decisions, the Southern District of New York again served as the forum for the question of protecting well-known marks in the United States. The court in *ITC Ltd. v. Punchgini, Inc.*¹¹⁵ assumed without deciding that such protection was available. It then stated that at a minimum, the owner of a foreign mark alleged to be well known in the United States must demonstrate that the mark had secondary meaning for the foreign owner in the United States market at the time the junior use began. The court determined that the senior user of the "Bukhara" mark for restaurant services had not demonstrated the existence of secondary meaning in the relevant market of trademark rights based on use of the mark in U.S. commerce, it had abandoned its U.S. rights after closing the restaurants for which the mark was used. Six months later, in *Almacenes Exito S.A. v. El*

¹¹⁵ 482 F.3d 135 (2nd Cir. March 28, 2007).

*Gallo Meat Market*¹¹⁶, Inc., another judge in the same district expressly held that federal trademark law does not protect well-known foreign marks: To the extent the doctrine is a creature of common law it may support state causes of action, but it has no place in federal law where Congress has enacted a statute, the Lanham Act, that carefully prescribes the bases for federal trademark claims. The Lanham Act nowhere specifies the well-known or famous marks doctrine. Although the court rejected a federal claim, it allowed the foreign senior user to proceed with its New York state law claims, relying on *Maison Prunier*. When the Second Circuit reached its initial decision in the ITC appeal in 2007, it ended most, although not all, doubt as to the state of the law in that circuit as to well-known foreign marks. ITC lost its effort to obtain federal protection for its Bukhara mark at the district court level for two main reasons:

(1) the court had determined that ITC abandoned through non use its U.S. priority based on its registered mark, and

(2) the court did not believe the mark met the standard for a well-known foreign mark.

The Second Circuit confirmed the abandonment finding. It also refused to allow ITC recourse to the well known foreign mark doctrine to obtain a different form of trademark priority over the defendants with respect to the Bukhara mark. In refusing to follow the only appellate decision on point, the Second Circuit accurately observed, "in *Grupo Gigante*, the Ninth Circuit did not reference either the language of the Lanham Act. Article 6bis of the Paris Convention to support recognition of the famous mark doctrine. The court concluded that the Ninth Circuit had rested its decision solely on "sound policy. Then, following a review of the recent Southern District of New York decisions on the well-known foreign marks doctrine, the Second Circuit endorsed the

¹¹⁶ 381 F. Supp. 2d 324, 326 –28

approach of the Almacenes Exito Court. In that decision, the well-known foreign marks doctrine was deemed to be an unacceptably "radical change in basic federal trademark law" due to its conflict with "the territoriality principle which is 'a bedrock principle of federal trademark law.' "The court appeared to be most convinced by its own reading of section 44 of the Lanham Act: We do not ourselves discern in the plain language of sections 44(b) and (h) a clear congressional intent to incorporate a famous marks exception into federal unfair competition law. Section 44(b) guarantees foreign mark holders only "the benefits of this section ... to the extent necessary to give effect to any ... convention, treaty or reciprocal law," as well as the "rights to which any owner of a mark is otherwise entitled." In short, whatever protections Article 6bis and Article 16(2) of the TRIPS Agreement might contemplate for famous marks, section 44(b) grants foreign mark holders covered by these treaties only those protections of United States law already specified in the Lanham Act.

In *Maison Prunier v. Prunier's Restaurant & Cafe, Inc.*,¹¹⁷ a New York court granted relief to the owner of a mark alleged to have "developed international fame." The mark, "Prunier," had been in continuous use in Paris, France for restaurant services from 1872 through the time of the case in 1936. The senior user had no operations in the United States. The restaurants, which operated under the name "Prunier" and "Maison Prunier," specialized in seafood. ¹¹⁸The junior user had opened a restaurant in New York City under the name "Prunier's Restaurant & Cafe, Inc." with menus carrying the legend "The Famous French Sea Food Restaurant." The trial court issued a temporary injunction against the junior use, although the senior use was exclusively foreign. In

¹¹⁷ 159 Misc. 551, 288 N.Y.S. 529.

¹¹⁸ *Id.* at 552, 288 N.Y.S. at 530. The current online restaurant guides for Paris indicate that a restaurant called "Maison Prunier," which features an oyster bar, continues to operate there. See Zagat Survey LLC, Paris Restaurants Maison Prunier, <http://www.zagat.com/Nerticals/PropertyDetails.aspx?VID=8&R=69730>.

Vaudable v. Montmartre, Inc.,¹¹⁹ the New York trial court issued a permanent injunction to protect the senior user's "Maxim's" mark, used for a restaurant in Paris, from a junior use of the same name for a New York City restaurant.¹²⁰ As stated by the court, "There is no doubt as to [the Paris restaurant's] unique and eminent position as a restaurant of international fame and prestige. It is, of course, well known in this country, particularly to the class of people residing in the cosmopolitan city of New York who dine out."¹²¹ The senior user had a registration in the United States for catering services and wines, but the registration did not appear to weigh significantly in the court's decision. In enjoining the domestic use, the court emphasized the defendant junior user's apparent intent to appropriate the widespread goodwill that the plaintiffs had built up in the "Maxim's" name. As noted above, these New York cases did not rely on federal trademark law or the Paris Convention's obligation related to well-known marks, a point emphasized by the Second Circuit in refusing to recognize federal protection in 2007.¹²² Failure to refer to the Lanham Act in the Maison Prunier case is, of course, completely irrelevant in light of the fact that the Lanham Act became effective in 1947, eight years after the decision. And Vaudable, decided only twelve years after the Lanham Act shifted the emphasis within U.S. trademark law from the state to the federal level, had no need to make a specific citation to federal law. The court was able to rely almost entirely on New York state case law, specifically Maison Prunier.¹²³ Vaudable did refer to the Lanham Act generally to support its statement that "[t]he trend of the law, both statutory and decisional, has been to extend the scope of the

¹¹⁹ 20 Misc. 2d 757, 193 N.Y.S.2d 332 (Sup. Ct. N.Y. Cnty. 1959).

¹²⁰ Id. at 758, 760, 193 N.Y.S.2d at 334, 336. The defendant also used a similar color scheme for its decor and imitated a particular script printing of the name "Maxim's" on an awning, over the door, and in advertising. See id. at 758, 193 N.Y.S.2d at 334. The script appears to remain the same even today. See, e.g., U.S. Trademark Reg. No. 580,091 (filed Mar. 20, 1952); Maxim's, <http://www.maxims-de-paris.com>.

¹²¹ Vaudable, 20 Misc. 2d at 758, 193 N.Y.S.2d at 334.

¹²² ITC Ltd. v. Punchgini, Inc., 482 F.3d 135, 157-58 (2d Cir. 2007).

¹²³ Vaudable, 20 Misc. 2d at 759, 193 N.Y.S.2d at 335.

doctrine of unfair competition."¹²⁴The doctrine recognizing well-known foreign marks remained relatively dormant for over forty years, with sporadic references in the decisions of the Trademark Trial and Appeal Board ("TTAB") and other cases where it was mentioned by a court in passing. But the doctrine was generally not relied on by any party to the case, and it did not form the sole basis of any of the decisions.¹²⁵ For example, a 1983 TTAB decision declined to recognize priority in a senior foreign user of a mark as against a domestic, good-faith junior user, "at least unless it can be shown that the foreign party's mark was, at the time of the adoption and first use of a similar mark by the first user in the United States, a 'famous' mark within the meaning of *Vaudable v. Montmartre, Inc.*"¹²⁶The marks in that case were not alleged to have been "famous" or "well known" or otherwise to have a significant consumer reputation, so the TTAB did not further address the issue. Another 1983 TTAB decision rested on two bases: first, that opposer, All England Lawn Tennis Club, owned a U.S. registration for the mark WIMBLEDON for wearing apparel and that the applicant's proposed mark would create a likelihood of confusion with that registered mark, and second, that opposer had acquired rights in the term WIMBLEDON in the United States in connection with its annual tennis championship and that the term had acquired "fame and notoriety [in the United States] within the meaning of *Vaudable*."¹²⁷

¹²⁴ *Supra* note 35.

¹²⁵ see e.g., *Buti v. Impresa Perosa, S.R.L.*, 139 F.3d 98, 102-07 (2d Cir. 1998); *Persons Co. v. Christman*, 900 F.2d 1565, 1570-72 (Fed. Cir. 1990); *First Niagara Ins. Brokers Inc. v. First Niagara Fin. Group Inc.*, 77 U.S.P.Q.2d (BNA) 1334, 1345-47 (T.T.A.B. 2005), overruled on other grounds by *First Niagara Ins. Brokers, Inc. v. First _ Niagara Fm. Group, Inc.*, 476 F.3d 867 (Fed. Cir. 2007); *All England Lawn [tennis club ltd. v. Creations Aromatiques, Inc.]*, 220 U.S.P.Q. (ENA) 1069, 1072

¹²⁶ *Mother's Rests. Inc. v. Mother's Other Kitchen, Inc.*, 218 U.S.P.Q. (BNA) 1046, 1048 (T.T.A.B. 1983). A second opinion in that case, concurring in part and dissenting in part, opined that "application of the well-known marks doctrine depends upon whether the applicable text of the Paris Convention, in this case, the 1934 London text, and, in particular, Article 6bis of that Convention, is self-executing," although the opinion agreed that the marks in question had never been well known in the United States. *Id.* at 1051-52 (Allen, J., concurring in part and dissenting in part).

¹²⁷ *All England Lawn Tennis Club*, 220 U.S.P.Q. (BNA) at 1071-72.

In late 2004, the Ninth Circuit issued the first in a flurry of well-known foreign marks decisions. Its decision allowed a foreign senior user of a mark to assert priority over a domestic junior user of a mark by relying on the mark's well-known status, based on use outside the United States, as of the time of adoption of the mark by the junior user.¹²⁸ Grupo Gigante operated a grocery-store chain in Mexico under the store name "Gigante. " The chain expanded from one Mexico City store in 1962 to almost one hundred stores by 1991. Six stores were in the Baja area of Mexico, and two of those stores were in Tijuana, located on the U.S.-Mexican border near San Diego, California. The Mexican company operated no stores in the United States before 1999.¹²⁹ In mid-1991, Michael Dallo opened a grocery store in San Diego called "Gigante Market," and in 1996, he and his brother Chris opened a second area store under the same name. In 1998 and 1999, the Dallos and Grupo Gigante began their legal skirmish, and Grupo Gigante sued for trademark infringement. The Ninth Circuit, upon reviewing the district court's judgment recognizing potential rights in a well-known foreign mark, began by holding that the well-known marks doctrine did exist in the United States: We hold ... that there is a famous mark exception [which the Ninth Circuit equated with a well-known mark exception] to the territoriality principle. While the territoriality principle is a long-standing and important doctrine within trademark law, it cannot be absolute. An absolute territoriality rule without a famous-mark exception would promote consumer confusion and fraud. Commerce crosses borders. In this nation of immigrants, so do people. Trademark is, at its core, about protecting against consumer confusion and "palming off." There can be no justification for using trademark law to fool immigrants into thinking that they are buying from the store they liked back home. The Ninth Circuit did not specify where in the rather large body of federal trademark

¹²⁸ Grupo Gigante SA de CV v. Dalio & Co., 391 F.3d 1088, 1094 (9th Cir. 2004).

¹²⁹ *Supra* note 40.

law it located this protection.¹³⁰ In applying the exception for a well-known mark, allowing the foreign senior user of the mark to assert priority over a domestic junior user, the Ninth Circuit set what might be termed a "secondary meaning plus" standard for which marks could be protected in the United States as well-known foreign marks.¹³¹ It held that "where the mark has not before been used in the American market, the court must be satisfied, by a preponderance of the evidence, that a substantial percentage of consumers in the relevant American market is familiar with the foreign mark."¹³² The court expressly limited the relevant American market to the geographic area of the defendant's allegedly infringing use. The concurring opinion in *Grupo Gigante* agreed with the legal standard announced, but it also explained in some detail why the evidence available in the case did not meet that standard. The concurring judge believed that for the grocery store services at issue, survey evidence related only to "Spanish-speaking [persons who] had recently purchased Mexican-style food at a supermarket or other food store"-the only survey presented by the senior user-would never be sufficient because the survey emphasized the target market of Spanish-speaking grocery purchasers rather than the general category of the service provided, namely, retail grocery store services. Moreover, the concurring judge carefully set forth his view that a majority of the junior user's customers and potential

¹³⁰ It did rely, almost certainly, on federal law, since it expressly rejected the plaintiff alternative arguments based on California state law and on the Paris Convention. It stated that a direct claim under article 6bis would be duplicative of the Lanham Act claim. *Id.* at 1099.

¹³¹ "Secondary meaning means . . . at consumers in the relevant market--whether the market is define by geography or types of goods or services or some other form of market segmentation-see a word, name, or symbol used in connection with goods or services and think first of the brand or source significance of the mark rather than the primary ' or "dictionary" or other common meaning, of a word, name, or symbol. See *Amazng Spaces, Inc. v. Metro Mini Storage* 608 F.3d 225 237 (5th c. 2010). Some authorities prefer to refer to secondary meaning by the Some authorities prefer to refer to secondary meaning by acquired distinctiveness in order to more clearly differentiate this type of trademark distinctiveness from "inherent distinctiveness " See e g *Wal Mart store, Inc v. Samara Bros., Inc.*, 529 U.S. 205, 205--06 (2000). Marks that are inherently distinctive are protected under U.S. law from the time of use or registration, while non-inherently distinctive marks are not protected until they develop secondary meaning or acquired distinctiveness among consumers through use in the relevant market. See *Commerce Bank & Trust Co. v. TD Bank north, Inc.*, 554 F. Supp. 2d 77, 84 (D. Mass. 2008). There is no specific standard for the level of familiarity required among consumers before secondary meaning will be found by the courts or the trademark office.

¹³² *Grupo Gigante*, 391 F.3d at 1098.

customers must be familiar with the foreign mark before well-known status can be found for that foreign mark.¹³³ Also in 2004, the Southern District of New York held that section 43(a) of the Lanham Act¹³⁴ provided protection to the owner of a foreign mark that was well known in the United States as of the time of the defendant's adoption of the mark.¹³⁵ In *Empresa Cubana del Tabaco v. Culbro Corp.*,¹³⁶ although a Cuban cigar manufacturer was the senior user of the mark "Cohiba," a domestic junior user had registered the mark in the United States and had used it in connection with cigars at various times over a fifteen-year period before the immediate legal dispute had begun in earnest. The court referenced the common law "well-known" or "famous marks" doctrine as well as article 6bis of the Paris Convention, and it declared that the 6bis rights were "subsumed by federal and common law." The court referenced *Vaudable* and TTAB decisions referencing *Vaudable*, as well as the treatise McCarthy on Trademarks and Unfair Competition, to determine that "Cubatabaco need only show that the COHIBA mark had a 'known reputation' to premium cigar smokers" at the time of the defendant's adoption of the mark. The court then looked to the World Intellectual Property Organization's Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks for guidance in applying a standard for well-known marks to the facts before it. Upon deciding that the "Cohiba" mark was well known, or famous, within the meaning of the doctrine, it found that the plaintiff senior user had a protectable right in the mark at the relevant time, and it proceeded to apply a standard

¹³³ *Ibid*

¹³⁴ 15 U.S.C. § 1125(a) (2006). Section 43(a) provides, in relevant part, that the use in commerce, *Id.* on or in connection with any goods or services, ... [of] any word, term, name, symbol, or device ... which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, [provides a civil cause of action to] any person who believes that he or she is or is likely to be damaged by such act.

¹³⁵ *Empresa Cubana del Tabaco v. Culbro Corp.*, No. 97 Civ. 8399, 2004 WL 602295, at *30 (S.D.N.Y. Mar. 26, 2004).

likelihood of confusion analysis under section 43(a).¹³⁷ The court found the junior use likely to cause confusion and cancelled the junior user's registration. When the *Empresa Cubana* case reached the Second Circuit, however, the senior user's victory proved short-lived. Although the court recognized and left open the possibility that well-known foreign marks were protected in the United States, it barred *Cubatabaco*, the plaintiff in the case, from using the doctrine to acquire trademark rights in the United States, basing its decision on the Cuban embargo regulations, stating *Cubatabaco* may be correct that Sections 44(b) and (h) incorporate article 6bis and allow foreign entities to acquire U.S. trademark rights in the United States if their marks are sufficiently famous in the United States before they are used in this country. That is the view expressed by some commentators. However, we need not decide that broad question here because even assuming that the famous marks doctrine is otherwise viable and applicable, the embargo bars *Cubatabaco* from acquiring property rights in the U.S. *COHIBA* mark through the doctrine. In two separate 2005 decisions, the Southern District of New York again served as the forum for the question of protecting well-known marks in the United States. The court in *ITC Ltd. v. Punchgini, Inc.*¹³⁸ assumed without deciding that such protection was available. It then stated that at a minimum, the owner of a foreign mark alleged to be well known in the United States must demonstrate that the mark had secondary meaning for the foreign owner in the United States market at the time the junior use began. The court determined that the senior user of the "Bukhara" mark for restaurant services had not demonstrated the existence of secondary meaning in the relevant market of New York City. The court therefore denied the claims based on the alleged status of the mark as a well-known foreign mark. The court also found that although the senior user possessed a U.S.

¹³⁸ 373 F. Supp. 2d 275 (S.D.N.Y. 2005), *affd.*, 518 F.3d 159 (2d Cir. 2008).

registration for its mark and had previously owned U.S. trademark rights based on use of the mark in U.S. commerce, it had abandoned its U.S. rights after closing the restaurants for which the mark was used.”¹³⁹

3.2 India

“The term Unfair Trade Practice broadly refers to any fraudulent, deceptive or dishonest trade practice; or business misrepresentation of the products or services that are being sold; which is prohibited by a statute or has been recognised as actionable under law by a judgement of the court. However, the Indian statute dealing with the term is Consumer Protection Act, 1986. General unfair trade practices may include unfairly refusing a transaction, discriminating against a transacting party, unfairly excluding competitors, unfairly soliciting customers, unfairly coercing customers, trading with a transacting party by unfairly taking advantage of one's bargaining position, trading under terms and conditions which unfairly restrict business activities of a transacting party, disrupting business activities of another enterprise, and unfair provision of capital, assets, manpower, etc”¹⁴⁰ .

“In India, till 2002, the Monopolies and Restrictive Trade Practices Act (MRTP), which was enacted to prevent monopolies and restrictive trade practices, was the foremost legislation to deal with unfair trade practices in the country. The MRTP Act was repealed giving way to the Competition Act, 2002, thus transferring all the pending cases in the MRTPC to Competition Commission of India (CCI) for adjudication from the stages they were in. However, no provision to deal with unfair trade practice was incorporated in the Competition Act and thus this was, instead, given effect under Consumer Protection Act, 1986 (COPRA) which was

¹³⁹ Unfair Trade Practices and Institutional Challenges in India - cuts ccier (Sep. 14, 2017, 11:30 AM)

http://www.cuts-ccier.org/pdf/Unfair_Trade_Practices_and_Institutional_Challenges_in_India-An_Analysis

¹⁴⁰ Growing Incidences Of Unfair Trade Practices In India - Consumer (Sep. 14, 2017, 11:40 AM)
<http://www.mondaq.com/india/x/343952/Consumer+Trading+Unfair+Trading/Growing+Incidences+Of+Unf>

already dealing with unfair trade practices. Section 2(1)(r) of COPRA defines unfair trade practice as: "a trade practice which, for the purpose of promoting the sale, use or supply of any goods or for the provision of any service, adopts any unfair method or unfair or deceptive practice, including any of the following practices, namely":¹⁴¹—

“1.making any statement, whether orally or in writing or by visible representation which:

- i. falsely represents that the goods are of a particular standard, quality, quantity, grade, composition, style or model;
- ii. falsely represents that the services are of a particular standard, quality or grade;
- iii. falsely represents any re-built, second-hand, renovated, reconditioned or old goods as new goods;
- iv. represents that the goods or services have sponsorship, approval, performance, characteristics, accessories, uses or benefits which such goods or services do not have;
- v. represents that the seller or the supplier has a sponsorship or approval or affiliation which such seller or supplier does not have;
- vi. makes a false or misleading representation concerning the need for, or the usefulness of, any goods or services;
- vii. gives to the public any warranty or guarantee of the performance, efficacy or length of life of a product or of any goods that is not based on an adequate or proper test thereof.”¹⁴²

“Prior to 1984, the MRTP Act contained no provisions for protection of consumers against false or misleading advertisements or other similar unfair trade practices and a need was

¹⁴¹ Growing Incidences Of Unfair Trade Practices In India - Consumer ...(Nov.19, 2017,7 AM)
<http://www.mondaq.com/india/x/343952/Consumer+Trading+Unfair+Trading/Growing+Incidence+Of+Unfa>

¹⁴² *Supra* note 141.

felt to protect the consumers from practices resorted to by the trade and industry, to mislead or dupe them. The GoI thus appointed a high power expert committee on the MTRP Act, under the chairmanship of Justice Rajindar Sachar (Sachar Committee), to review and suggest changes required to be made in MRTP Act in light of the experience gained in administration and operation thereof¹⁴³. “The Sachar Committee recommended that a separate chapter should be added to the MRTP Act defining various unfair trade practices so that the consumer, the manufacturer, the supplier, the trader and other persons in the market can conveniently identify the practices, which are prohibited”.¹⁴⁴ “This led to introduction of provisions relating to Unfair Trade Practices in the MRTP Act in the year 1984. The 1984 amendment also created a new authority in form of an independent body known as the Director General of Investigation and Registration (DGIR) which was supposed to work closely with MRTP Commission and on the basis of a complaint, or suo motu, DGIR was entitled to investigate into a claim of a restrictive or an unfair trade practice as listed out in Section 36A of the MRTP Act and bring the matter before the MRTP Commission (MRTPC) established under the MRTP Act to assess the need for MRTPC to initiate an enquiry. The MRTPC, on determining a practice to be an unfair, was entitled to order the offending party to cease and desist the practice under Section 36D of the MRTP Act, if the practice was found to be ‘prejudicial to the public interest or to the interest of any consumer or consumers generally’. Apart from MRTPC taking suo motu action, the other people who can approach MRTPC with a complaint under MRTP Act included the individual consumer, trade associations and registered association of consumers. To meet the growing needs of liberalization and globalization and to arrive at a

¹⁴³ Chakravarthy, S., “Evolution of Competition Policy and Law in India”, Evolution of Competition Laws and their Enforcement: A Political Economy Perspective, Editor: Mehta S., Pradeep, Routledge Studies in Global Competition, Routledge, Oxon,(Sep. 14, 2017, 11:45 AM) <http://books.google.co.in/>.

¹⁴⁴ “Report of the High-Powered Expert Committee on Companies and MRTP Acts, 1977” Ministry of Law, Justice and Company Affairs, Government of India, New Delhi, August, 1978, Committees and Commissions in India, 1977, Volume 15, Part B(Sep. 14, 2017, 11:45 AM) <http://books.google.co.in/>.

better mechanism for regulating business practices and settling disputes, the Government of India appointed a committee on Competition Policy and Law under the chairmanship of Mr. S.V.S. Raghavan in October 1999 (Raghavan Committee) with an aim to shift the focus of the law from curbing monopolies to promoting competition in line with the international environment. The Raghavan Committee concluded that the MRTP Act is limited in its sweep, and was deficient in many ways either to allow reaping of full benefits from the new economic opportunities or to meet the challenges thrown up by the policies of liberalisation, privatisation and globalisation”¹⁴⁵ “Following Raghavan Committee’s recommendations, the government repealed the MRTP Act and gave way to the Competition Act, 2002. A Competition Commission of India (CCI) was established under the Competition Act with effect from October 14, 2003. Also, as per the recommendation, it was decided that all the cases pending in the MRTPC will be transferred to the CCI for adjudication from the stages they are in. However, the Raghavan Committee was of the view that the Competition Act should not be burdened with UTPs and thus this was, instead, given effect under COPRA which was already dealing with unfair trade practices.”¹⁴⁶ “Thus, since a consumer needed protection not only from being supplied with defective goods and deficient service but also unfair trade practices, the provisions on unfair trade practices were transferred from the MRTP Act into the COPRA. COPRA is an important milestone in the field of consumer protection in India and it created three-tier quasi-judicial bodies: (a) the District Forum; (b) the State Forum; and (c) the National Forum; through which a consumer could seek remedy in the event any of his/her rights as a consumer are violated. These quasi-judicial redressal agencies have the power to adjudicate

¹⁴⁵ Keynote Address of Shri Vinod Dhall, during “Competition Advocacy Seminar for States” in New Delhi, May 19, 2005(Sep. 14, 2017, 11:45 AM)
http://www.cci.gov.in/images/media/Advocacy/Awareness/speech_member.pdf?phpMyAdmin=NMPFRahGKYeum5F74Pp stn7Rf00.

¹⁴⁶ Report of High Level Committee on Competition Policy, 2000 (Sep.14, 2017, 11:47 AM)
<http://ebookbrowse.com/gdoc.php?id=115899518&url=4a6c2f5ebd6e8ca816bdb382dd05a63e>.

complaints received from consumers against any defect in goods or services purchased by the consumer as well as against unfair trade practices. However, as discussed later in this paper, these agencies do not have any investigative powers and suffer from a lack of infrastructure and qualified personnel, especially at the local level. Also, it is important to note that, in the course of being transferred from the MRTP Act into the structure of COPRA, the definition of a 'consumer' was narrowed and a person purchasing the goods/services for reselling or with a commercial purpose could not take up a case of an unfair trade practice before a consumer forum"¹⁴⁷.

“In the recent past, the prevalence of Unfair Trade Practice has been on a rise and various instances have come to light bringing the issue at hand in discussion. In a recent case where Big Bazar, a departmental store declared Republic Day as Mega Savings Day, which led to an unmanageable consumer rush. To restrict entry to legitimate purchasers, the store came up with a scheme of issuing an entry coupon of Rs 50. The government of Gujarat filed a complaint before the district forum alleging that Big Bazar had adopted unfair and restrictive trade practices by collecting Rs 1, 95,000 from the sale of the 3,900 coupons. The issue to be decided was whether the imposition of an entry fee amounts to an unfair or restrictive trade practice? Upholding the Government's contention, the Forum held that if the crowd was uncontrollable, the store should have called the police, but had no right to refuse entry or impose an entry fee. The Forum directed Big Bazaar to pay the amount collected along with the interest. Big Bazaar appealed the order in State Consumer Disputes Redressal Commission, which rejected the appeal. Big Bazaar then approached the National Consumer Redressal Commission in revision. The store contended that it had the right to restrict customer entry to the store. It also argued that the purpose of the coupons was to regulate the crowd of customers, and no unfair trade practice had been adopted. The National Commission concluded that Big Bazaar had not

¹⁴⁷ *Ibid*

indulged in unfair or restrictive trade practice. It held that an entry fee does not bring about a manipulation in the price of a product or service, but merely regulates customer crowd. The practice is prevalent worldwide, and is permissible”¹⁴⁸.

“In another case, leading real estate firm Unitech Ltd. has been held guilty of resorting to "unfair trade practice" by a consumer forum and directed to pay a customer Six Hundred Sixty Thousand Indian Rupees for making "illegal demands" from him after he booked a flat with it and paid the booking amount. The District Consumer Disputes Redressal Forum, in its order, observed that the firm and its agent made "unjustified" demands from the customer and also threatened to forfeit his deposited money”.

“Another case dealt with Spice Jet being directed by a consumer forum to pay One Hundred Thousand Indian Rupees to a passenger for not allowing all members of his family to board the plane despite having confirmed tickets and making them travel on two different flights while returning to Delhi from Goa. The East District Consumer Disputes Redressal Forum noted that it was "cruelty" on the part of Spice Jet to split the family into two groups especially when they had children with them and held it guilty of unfair trade practice”¹⁴⁹.

“The awareness among consumers in today's modernized world is giving way to consumers ascertaining the rights provided to them under Consumer Protection Act and seeking redressal against the unfair trade practice. The prospect of the consumer justice system in our country appears to be bright in view of the provisions available in the Indian statutes and legislation and various proactive policies, schemes/programmes being adopted by the Government. Involvement of trade and industry, civil society organizations and above all consumer themselves is vital to keep a check on the practice of unfair trade in the years to come.”

¹⁴⁸ *Super* note 146.

¹⁴⁹ *Supra* note 146.

CHAPTER 4: Contentious Issues of Domain Name

The main problem in domain name is with its registration as there is no proper investigation before registering the domain name to avoid the possible conflict. So the person with bad intention register domain which looks similar to a well known domain creating consumer confusion and disparaging the goodwill of the well known domain leading towards unfair trade practices. When these kinds of disputes arise there is a problem of jurisdiction as the internet is global and it is not a geographical network, it knows no boundaries. This chapter will discuss about the issues of domain name like registration issues, unfair trade practices issues, jurisdiction issues and particularly on the issues of non availability of direct laws on domain name.

4.1. The Registration Issues

“The first step in domain name is registration. Without a domain name, a company would be practically invisible on the Internet and the customers would not know where to find it. The process for registering domain name makes domain names a main ground for trademark disputes. The cost of registering a domain is extremely low in comparison with the economic damages that it may cause, or the cost of litigation.

Domain names are fairly easy to register, the general practice of registries is to check the availability of second level domain (hereafter referred to as SLD)/ top level domain (hereafter referred to as TLD) combination and ensure no duplicate domain names are allocated, unlike trademarks registries who conduct a full examination process to determine possible conflicts. Thus, it is possible for a third party who has no connection at all with a trademark to register it as a second level domain and deprive the rightful owner of the mark the opportunity to register

the mark in the same second level domain”¹⁵⁰.

“Another registration issue is that most registries implement first come, first served policy. Therefore whoever comes first will get the domain name. Since, no other searches are undertaken to check whether the domain name is in use for some other purpose, such as a trade name etc. Hence this practice provides another incentive to cybersquatters to register the trademark before the rightful owner of the mark and then offer it later at substantial fee. Cybersquatters register domain names containing popular trademarked, with a view to making an illegal profit from them or to misuse it, whereas in typosquatting, typosquatters register domain names using misspelled words or large popular websites, with malicious intent leading towards unfair trade practices.

The reputation and trademarks of company or business become a Uniform Resource Locator (URL). For instance, if a person has a huge business called ‘abc’ services and trademark saying ‘abc’ service; people will obviously think that the website will be www.abcservices.com. But since ‘abc’ company did not think about registering this domain the other people get the opportunity on the web and accordingly bought the URL. Now to host its own website and to prevent damage to its reputation, ‘abc’ services will have to buy back the URL from whoever purchased it. Even if a company have a site say www.abc.com, cybersquatters will register a different top-level domain like say ‘abc.net’ or ‘abc.in’ in a hope that the main website will someday buy it off their hand at handsome profit.”¹⁵¹

People make typographical errors while typing in the address bar. If someone wants to benefit from a well-known reputation, he or she will buy domains looking like the genuine URL but

¹⁵⁰ Internet domain names & Trademark Law: Does the current legal ...(Nov.29,2017, 5 PM)
<http://www.bileta.ac.uk/content/files/conference%20papers/2006/Internet%20domain%20names%20and%20tr>

¹⁵¹ *Ibid.*

contains a typo a very common practice in banking services. For example to fool people, someone might buy 'Instagrom' because 'Instagram' already exists and is popular amongst all people but has 'o' instead of 'a'. The intention in typosquatting is always harming people, stealing their identities and making profits while with cybersquatting. This act of cybersquatters and typosquatters are deceptive, fraudulent, unethical methods of obtaining business of others and it includes misrepresentation which is the essential requirements of unfair trade practices. These types of practices comes under the unfair trade practices because there is likelihood that consumers will be mislead or confused as to the source of origin of goods or services. Thus the main problem of domain name disputes leading towards unfair trade practices lies in registration of domain name.

“When two or more parties with independent and legitimate rights for the same trademark in different lines of business or jurisdictions seek the same domain name, disputes occur.”¹⁵²

“This kind of disputes occurred at two different levels, firstly, when the same mark owned and used by different persons in respect of different goods or services. Secondly, when the same mark owned and used by different persons in different countries in relation to the same goods or services.”¹⁵³

“The same trademark cases are the genuine cases of conflicts between trademark and domain names because of their fundamental characteristics. The difference in the areas and level of operation of trademarks and domain name has been great challenge to law. Due to the national character, the trademark can be owned by two or more persons. It may be in different countries on the same goods or services”¹⁵⁴.

¹⁵² William A. Tanenbaum. Rights and Remedies for three common trademark-domain name disputes , at 9.

¹⁵³ Internet domain names & Trademark Law: Does the current legal ...(Nov.29,2017, 5 PM)
<http://www.bileta.ac.uk/content/files/conference%20papers/2006/Internet%20domain%20names%20and%20tr>

¹⁵⁴ *Supra* note 153.

Since all the owners of same trademark want to promote their business online, they all would be interested to get their trademark registered as domain name unfortunately; this cannot happen since the domain names are unique and can only be held by one person. The first in time would be able to register the trademark as domain name, depriving all other holders of trademark from enjoying similar form of privilege. This ultimately results in disputes between the owners of same trademark. At this kind of situation what alternative should be done?

Registration is on a first come first serve basis. Simply because a person have a registered trade or service mark, have a registered company name, or have been using a trade name for a lengthy period of time does not mean that another person with a legitimate reason for registering the domain and who uses it in good faith must give it up. Thus, the disputes arising out of legitimate claims pose a serious challenge to the adjudicators that too in the absence of any legal solution.

There are also issues of domain name owing to the following reason: It is a virtual company registered online, one cannot know the authenticity of the company without special efforts. Therefore to know whether the authentic physical company has registered in its name or some other unauthorised person with various motives has registered, a proper investigation is required before registering the domain name which is not the part of procedure yet.

Further when the authentic physical company wants to register domain in its name there would be a problem for authenticity if domain name already registered with someone else. Here the genuine domain name owner will be bound to face adversities because of someone's bad motive to earn out of this situation. Here the issue becomes more complex because the domain name cannot be legally own by the right owner since it is licensed to another person or company by the relevant registries in return for fee however with some hidden motive.

4.2 Jurisdiction Issues

“A jurisdiction is a state or other area in which a particular court and system of laws has authority”¹⁵⁵. “Doing business in internet is very easy and perhaps more complex which allows a person’s to reach beyond his own jurisdiction. This way leads to overlapping of legislative and judicial competencies fostered by cyberspace. Although domain name owners creates website with the global online presence, that presence creates significant offline spillover effects in many national jurisdictions. This result has been a clash of dueling law making and adjudicating competencies, both between different national legislature and courts, and between national and international bodies.”¹⁵⁶ “The collisions between trademarks and the Domain Name System (hereafter referred to as DNS) are occurring more and more frequently. The first type of collision is the demand for the same domain name by multiple owners of the same mark (the "access conflict"). This problem would be bad enough if the only conflicts arose among owners of registered trademarks. In the U.S., it is exacerbated by U.S. legal recognition of so-called "common law" marks. Judicially recognized rights in a "common law" mark in the U.S. arise from use of the mark alone. There is no registration requirement of any kind. As a result, there can be multiple users of marks such as "Acme" or "Eagle" who have never registered the marks. Under the present DNS, however, there can be only one "acme.com", putting the "Acme" owner who got there first and registered "acme.com" in a significantly advantageous position.”¹⁵⁷

“In most countries outside the U.S., there is no concept comparable to "common law" marks; most countries require that a mark be registered in order to gain recognition by the courts and

¹⁵⁵ Jurisdiction definition and meaning | Collins English Dictionary..., Dec. 15, 2017, 10 PM) <https://www.collinsdictionary.com/us/dictionary/english/jurisdiction>.

¹⁵⁶ Trademark Law on the Internet: Will It Scale? The Challenge to Develop International Trademark Law (Dec. 15, 2017, 10:30 PM) https://www.isoc.org/inet97/proceedings/B5/B5_3.HTM.

¹⁵⁷ *Supra* note 156.

other government bodies. Registration systems, however, do not solve the multiple ownership problem. There are multiple federal registrations in the U.S. of some popular names, for example "Genesis", held by different trademark owners for various products and services. The same situation prevails in other countries.

Taking "Genesis" as an example, in the U.S. there are nine different owners of this mark in just one of the 42 classifications of products and services recognized by the trademark authorities of most countries throughout the world. National trademark law has been able to accommodate these multiple registrations because the marks function in the marketplace without colliding with each other. According to the test established by U.S. trademark law, there is not, in practice, a "likelihood of confusion" as to the sources of the various goods and services offered by the different owners of the same mark. It should be noted that this can change. Actual confusion may occur in the future; one user may abandon the mark or another user may embark on an expansion of its product line that causes confusion with an existing user. Trademark owners may be forced to resort to litigation as the situation changes, but the registration system by and large works well in the U.S. and in other countries."¹⁵⁸

"The DNS, as presently structured, allows no such accommodation for different owners of the same mark. Proposals have been made for the subdivision of ".com" into the internationally recognized trademark classifications of goods and services, allowing registration of "acme.1.com," "acme.2.com," and so on. Even this expansion of the DNS would not accommodate the multiple owners of "Genesis" in a single classification, nor would it accommodate the owners of common law marks.

Another area of collision is the practice referred to as "piracy" and "extortion," on the one hand, or "free enterprise" on the other, depending on one's point of view. A number of entrepreneurs

¹⁵⁸ *Supra* note 7.

have registered domain names, using trademarks (some famous, some not so famous) that belong to others. These entrepreneurs have then offered to transfer the domain name registration, for a price, to the owner of the trademark. Yet another type of collision occurs when a trademark owner who does not have a domain name registration believes that the use of the identical mark by another on the Internet is itself an infringement of the first owner's trademark rights (the "infringement" conflict). The best-known example of an attempt to resolve these conflicts is the dispute resolution policy of Network Solutions, Inc., the administrator of the ".com" domain. The policy allows the owner of a U.S. federal or other national registration to put "on hold" a domain name registration held by another party that has not registered the name as a trademark. This policy is applied even though the domain name registrant may have acquired significant and well-recognized common law trademark rights. The policy has led to numerous lawsuits involving trademark owners who are concerned about access or infringement or both. Collisions on the international level are occurring where the same trademark is owned by different parties in different countries. This can lead to an access conflict or an infringement conflict or both, with the added complication that separate national trademark laws, which may be significantly different, govern the issues. All of these collisions of trademark law and the DNS have already resulted in litigation. Most lawsuits have arisen in the U.S., probably reflecting the fact that there are far more users of the Internet in the U.S. than in any other country. However, there has also been litigation in England, Germany, and a number of other countries, and it seems fair to assume that this curve will continue geometrically, following the expansion of the Internet itself. It should be noted that the legal situation is complicated by the fact that there are other legal issues in addition to the technical trademark questions. The trademark-DNS cases that have already arisen present intriguing new problems about jurisdiction over the parties. In the U.S., a domain name owner in California may be the subject of a lawsuit filed by a trademark owner in New York. U.S. law has

well-established statutory and constitutional requirements (the "long-arm" and "due process" concepts) that have been applied to decide whether the Californian must come to New York to defend against the suit or the New Yorker must go to California.

In the international arena, there are no such well-established rules. The trademark owner in India who finds that its mark is being used as a domain name in ".com" by a U.S. company probably cannot force the U.S. entity to come to India to defend a claim of trademark infringement (assuming that the U.S. Company is not doing business in India). Conceivably the Indian company can go to the U.S. and file a lawsuit in a court having jurisdiction over the U.S. company, but the expense may be prohibitive. What if the Indian company persuades the Indian courts to consider the claim even in the absence (in a physical sense) of the U.S. Company? If the Indian company wins a judgment from the Indian court, it might then take its judgment to a U.S. court that has jurisdiction over the U.S. Company, and ask the U.S. court to recognize the Indian judgment as a matter of "comity," a well-recognized principle of international law. Comity, however, will probably not extend this far; U.S. courts can be presumed to be dubious about enforcing an Indian judgment rendered in an action where the U.S. defendant was not present, especially if the only contact between the U.S. defendant and India was its use of a ".com" domain name. Where multinational companies are doing business in jurisdictions outside their home country, the courts of the countries where business is being conducted will generally have jurisdiction, and each court will apply its own national law. This is a problem that has already been faced by multinationals in other legal contexts, but it becomes more complex because of the global scope of the Internet. A court in Malaysia may have jurisdiction over a German company because of the German company's factory in Malaysia, and the German company will take care to obey local law in its business affairs in Malaysia. However, if the German company is accused of violating Malaysian law based on

something available on its Web site originating in Germany, the German company may not consider it fair that it must answer in Malaysia for activity that is perfectly legal in Germany.

Returning to trademark law, the question of applying a universally accepted body of "international trademark law" has great appeal. However, there is no generally accepted international law of trademarks. Although national trademark law is similar in nearly all countries of the world, there are important differences that make it impossible to appeal to universally accepted principles when disputes arise in an international arena. A court today, in most instances, applies the law of the nation where the court is located to disputes that come before it. An important exception is that, when the parties to the lawsuit have agreed upon a choice of law, most courts will respect that choice, so long as there is some reasonable connection between the transaction and the law that is specified.”¹⁵⁹

4.2.1 Jurisdiction over Internet

The whole trouble with internet jurisdiction is the presence of multiple parties in various parts of the world who have only a virtual nexus with each other. Then, if one party wants to sue the other, where can he sue? Traditional requirement generally encompass two areas:-

- i. Firstly, the Place where the defendant reside, or
- ii. Secondly, where the cause of action arises.

However, in the context of the internet or cyberspace (Cyberspace is the electronic medium of computer networks, in which online communication takes place), both these are difficult to establish with any certainty. Considering the lack of physical boundaries on the internet, is it possible to reach out beyond the court’s geographic boundaries to haul a defendant into its

¹⁵⁹ Trademark Law on the Internet: Will It Scale? The Challenge to Develop International Trademark Law (Dec. 15, 2017, 10:30 PM) https://www.isoc.org/inet97/proceedings/B5/B5_3.HTM.

court for conduct in “Cyberspace”? Issues of this nature have contributed to the complete confusion and contradictions that plague judicial decisions in the area of internet jurisdiction.¹⁶⁰ Because cyberspace has no geographical boundaries, it establishes immediate long-distance communications with anyone who can have access to any website. Usually an internet user has no way of knowing exactly where the information on a site is being accessed from. Here, i.e., in cyberspace, jurisdiction issues are of primary importance. As Internet does not tend to make geographical and jurisdictional boundaries clear, Internet users remain in physical jurisdictions and are subject to laws independent of their presence on the Internet. Therefore, any kind of use of the World Wide Web and any related activities on the internet may expose the person to risk of being sued in any state or foreign country where another internet user may establish a claim. Accordingly, in each case, a determination should be made as to where an online presence will subject the user to jurisdiction in a distant state or a foreign company. As such, a single transaction may involve the laws of at least three jurisdictions:

- i. The laws of the state/nation in which the user resides,
- ii. The laws of the state/nation that apply where the server hosting the transaction is located, and
- iii. The laws of the state/nation which apply to the person or business with whom the transaction takes place.

So a user in one of the Indian States conducting a transaction with another user in Britain through a server in Canada could theoretically be subject to the laws of all three countries as they relate to the transaction at hand.. The laws of a nation may have extra-territorial impact extending the jurisdiction beyond the sovereign and territorial limits of that nation. This is

¹⁶⁰ Amita Verma, *Cyber Crimes and Law*,(Central Law Publications, Allahabad, 2009), p.318.

particularly problematic, as the medium of the Internet does not explicitly territorial limitations. There is no uniform, international jurisdictional law of universal application, and such questions are generally a matter of conflict of law, particularly private international law. An example would be where the contents of a web site are legal in one country and illegal in another. In the absence of a uniform jurisdictional code, legal practitioners are generally left with a conflict of law issue.

Thus the major problem of cyber law lies in whether to treat the Internet as if it were physical space, and thus subject to a given jurisdiction's laws, or to act as if the Internet is a world in itself, and therefore free of such restraints. Those who favor the latter view often feel that government should leave the Internet community to self-regulate.

But it is seen that in practical terms, a user of the Internet is subject to the laws of the state or nation within which he or she goes online. This system runs into conflicts, however, when these suits are international in nature. Simply put, legal conduct in one nation may be decidedly illegal in another.

4.2.2 Position in India

Personal Jurisdiction

The principle of 'lex foris' (The Law of the Court or Forum) is applicable with full force in all matters of procedure. No rule of procedure of foreign law is recognized. It was held in *Ramanathan Chettiar v Soma Sunderam Chettiar*¹⁶¹ that India accepts the well-established principle of private international law that the law of the forum in which the legal proceedings are instituted governs all matters of procedure.

¹⁶¹ AIR 1964, Madras 527

In India, the law of personal jurisdiction is governed by the Code of Civil Procedure, 1908. The Code does not lay any separate set of rules for jurisdiction in case of international private disputes. It incorporates specific provisions for meeting the requirements of serving the procedure beyond territorial limits. In matter of jurisdiction what is treated differently is the question of subject-matter competence and not of territorial competence, i.e. the question of territorial jurisdiction arises in the same way in an international private dispute as in a domestic dispute. The Code provides general provisions regarding jurisdiction on the basis of pecuniary limit, subject matter and territory. Sections 16 to 20 of the Code regulate the issue of territorial jurisdiction for institution of suits.

Rules as to the nature of suit

Jurisdiction in case of cyberspace can be under S.20 of C.P.C. A court can exercise jurisdiction in actions involving persons where:

- (a) The defendant, or each of the defendants where there are more than one, at the time of the commencement of the suit, actually and voluntarily resides, or carries on business, or personally works for work; or
- (b) Any of the defendants, where there are more than one, at the time of commencement of the suit actually and voluntarily resides, or carries on business, or personally works for gain, provided that in such case with the leave of the court has been obtained or the defendants who do not reside or carry on business, or personally work for gain, as aforesaid, acquiesce in such institution; or
- (c) The cause of section wholly or partly arises.

Rules enforcing “agreement of parties”

It is well-established law in India that where more than one court has jurisdiction in a certain matter, an agreement between the parties to confer jurisdiction only on one to the exclusion of the other is valid.¹⁶² The Indian law therefore recognizes and gives effect to the principle of party autonomy.

Thus the position of law on the point is that first, a choice of law agreement is permissible; and secondly, the agreement operates only in respect of a court, which does not otherwise inherently lack jurisdiction. In any such case, the courts also consider the balance of convenience and interests of justice while deciding for the forum. Thus, in India, the principle is well settled that residence in the territorial limits of a court furnishes a ground for exercise of jurisdiction. Similarly, conduct of business by a defendant in a forum also gives to the forum court to exercise jurisdiction, irrespective of his non-presence within the jurisdiction.¹⁶³ The Indian courts also assume adjudicative jurisdiction on the basis of the territorial nexus with the cause of action. In this regard, the consistent view of the courts in India is that the courts are empowered to pass judgments even against non-resident foreigners, if the cause of action arises in whole or part within the territorial limits of court.

Jurisdiction in case of Cyber crime

In order for a national court to adjudicate criminal and regulatory sanctions internationally, there must be some connection, or nexus, between the regulating nation (the forum) and the

¹⁶² Hakkam Singh v Gammon (India) Ltd AIR 1971SC 740.

¹⁶³ Amita Verma, *Cyber Crimes and Law*, (Central Law Publications, Allahabad, 2009), p.318.

crime or criminal. Four nexuses have been invoked by courts to justify their exercise of jurisdiction.¹⁶⁴

i. The territoriality nexus holds that the place where an offense is committed-in whole or in part-determines jurisdiction.

ii. The nationality nexus looks to the nationality or national character of the person committing the offense to establish jurisdiction.

iii. The protective nexus provides for jurisdiction when a national or international interest of the forum is injured by the offender.

iv. The universality nexus holds that a court has jurisdiction over certain offenses that are recognized by the community of nations as being of universal concern, including piracy, the slave trade, attacks on or the hijacking of aircraft, genocide, war crimes, and crimes against humanity. It is not enough that these nexuses exist; the connection between the forum and the person or activity also must be “reasonable.” In determining reasonableness, courts consider one or more of the following factors, depending on the circumstances of the particular case:

The extent to which the criminal or regulated activity takes place, or has a substantial, direct, and foreseeable effect, within the territory of the forum; The extent to which the defendant or the injured party has a “genuine link” (i.e., an ongoing and real relationship) with the forum; The character of the activity (that is, its importance to the forum, whether other countries regulate it, and the extent to which countries generally regard it as appropriate for regulation); The extent to which justified expectations will be protected or harmed by the regulation; The extent to which another country has an interest in regulating the activity and

¹⁶⁴ Jurisdictional Issues in Cyber Crime | suneet dwivedi - Academia.edu (Dec. 17, 2017, 9:30 PM) http://www.academia.edu/3700793/Jurisdictional_Issues_in_Cyber_Crime.

the likelihood of a conflict with those regulations; The importance of the regulation to the international community; and The extent to which the regulation is consistent with the traditions of the international community.¹⁶⁵

Extra territorial jurisdiction

The main problem arises when a citizen of some other country causes harm to citizens of a native country, let's take for an example in India, though Information Technology Act, 2000 does have extra territorial jurisdiction but it's very difficult to enforce it and exercise it. If a crime is committed in Delhi by a citizen of US by hacking the systems of an Indian Company, that maximum the court can do is pass an order in favor of the plaintiff but the problem arises that how to punish the US citizen, the only thing which the hacker has to do is avoid coming to India, moreover as it's an international matter collection of evidence will also be a trouble for all. Hacking is still a crime of greater degree but it creates problem in case of crimes like publishing obscene materials on websites, if a citizen of U.K posts obscene material. Are the international Extradition laws strict enough enforce an arrest? What if the Act is an offence in India but not in his native country? Prosecuting and trying a person also raises difficult problem in the field of jurisdiction. These problems relate to determination of place where the offence was committed (locus delicti- The place where a crime was committed) and where several jurisdictions are equally competent.

Conflicts in national trademark law

Although there are basic similarities among the various national laws governing trademarks, the differences introduce an element of uncertainty that can be a matter of real concern to the owners of trademarks, especially those whose trademarks are well-known and international in

¹⁶⁵ *Supra* note 10.

scope. These marks, known generally as "famous" marks, are usually those that are supported by the largest expenditures for advertising and marketing.

The major differences in national treatment of trademarks are in the areas of dilution, geographical terms, famous marks, rights of publicity, and religious and social issues.

Dilution

Dilution is a concept of trademark law that allows the owner of a famous mark to assert an infringement claim against an entity using the same mark even though there is no competition between the two parties. In U.S. law, it is defined as "the lessening of capacity of a famous mark to identify and distinguish goods or services." By contrast, infringement claims are usually based on confusion or likelihood of confusion, which arises when there is competition or potential competition between two trademark users. The rationale for dilution protection comes from two concepts of unfair competition--first, that a mark's strength is diluted when a newcomer gets a free ride on the reputation established by the first user, and second, that a mark can be "tarnished" by being linked to products of lesser quality or by being used in a negative way.¹⁶⁶

"Dilution is now recognized as part of U.S. statutory law. The federal Dilution Act took effect in 1995 and establishes criteria for dilution protection:

- i. the degree of inherent or acquired distinctiveness of the mark;
the duration and extent of use of the mark in connection with the goods or services with which it is used;
- ii. the duration and extent of advertising and publicity of the mark;
- iii. .the geographical extent of the trading area in which the mark is used;

¹⁶⁶Jurisdictional Issues in Cyber Crime | suneet dwivedi - Academia.edu (Dec. 17, 2017, 9:30 PM)
http://www.academia.edu/3700793/Jurisdictional_Issues_in_Cyber_Crime.

- iv. the degree of recognition of the mark in the trade areas and channels of trade used by the mark's owner and the entity against whom the injunction is sought;
- v. the nature and extent of use of the same or similar marks by third parties; and whether the mark is federally registered.

“Until recently, the dilution concept has not been part of the law of many countries other than the U.S. This situation is now changing as a result of certain international treaties that require signatory nations to afford dilution protection to trademark owners”¹⁶⁷.

Geographical terms

Many geographic identifiers have, over the years, become identified with products and services and are protected in their country of origin. Well-known examples abound in the food and beverage areas: Chablis wine, Chianti wine, Camembert cheese, and Champagne sparkling white wine. It is equally well known that countries outside the country of origin have generally tended not to respect the rights of the original geographic region. Even today, in the U.S., gastronomic crimes are committed by the sale of sparkling white wine under the name "Champagne" with little or no relation to the famous product of the Champagne region in northern France. This gastronomic crime has no remedy in U.S. courts; despite years of effort by the French government, "champagne" is considered an unprotected descriptive term for sparkling white wine in the United States.

¹⁶⁷ (Jan. 2, 2018, 7 PM)<http://digitalcommons.lmu.edu/cgi/viewcontent.cgi?article=1390&context=elr>.

Famous marks

As noted above, famous marks are generally given a broader scope of protection than the more common terms used as trademarks. "Kodak" is an example of an arbitrary, coined term that has become famous on a worldwide basis. Protection of famous marks has long been a controversial subject in international commerce. Developing countries in particular have tended to disregard the fame of famous marks and have turned them into generic terms to describe products or services from various sources. The World Intellectual Property Organization (WIPO) has established a program to harmonize the laws of its member nations on this subject, but the effort still has a long way to go. Trademark treaties have also brought about increased protection for famous marks in many countries.

Rights of publicity

Closely related to the trademark arena are so-called rights of publicity--the rights of publicly prominent persons to prevent the use of their names and likenesses for commercial purposes. This is also a developing area of law, and the scope of protection for individuals' names varies widely from country to country.

Religious and social issues

Probably the most difficult and intractable of all problems of conflicting national law is the question of protection (or lack thereof) for religious terms and names. Harmonizing the conflicting linguistic and naming issues of Buddhism, Confucianism, Christianity, Hinduism, Islam, Judaism, and Taoism, to mention only the most populous world religions, is likely to be as easy as bringing lasting peace to the areas where religious wars are still being fought. Social issues, such as what constitutes obscenity, and commercial and intellectual property issues, such as the protection afforded to patented therapeutic drugs and their names, also offer a fertile field for disagreement on an international scale. These disagreements can and will spill

over into the DNS, and there is no body of international law to offer guidance to tribunals that will decide the “questions. It is found that the national legal systems relating to the resolution of the domain name-trademark disputes have suffered seriously due to the jurisdictional limitations and absence of equitable remedy in the cases involving justifiable rights of both the parties to the disputes, one relating to the trademarks and the other relating to the domain names. This is true both in the jurisdictions having separate law to deal with the domain name disputes (for example, US) as well as in the jurisdictions dealing with the domain name disputes under their traditional trademark laws (for example, UK and India). The UDRP, being international in nature, addresses the problem of jurisdiction.

However, it fails to address the second issue, that is, to provide justice to the genuine competing trademark and domain name right holders.”¹⁶⁸

“In light of the above factors, the ADR mechanisms are worth to look into as alternatives to resolve the class of domain name disputes involving genuine conflicting rights. However, the non adversarial ADR mechanisms would be of greater help in amicably settling the disputes between genuine right holders. Thus, both the systems must parallely exist to deal with different categories of the domain name-trademark disputes, and the hitherto unpopular ADR mechanisms must be popularized in resolving the domain name-trademark disputes. This would go a long way in promoting the cause of justice and winning the confidence of the disputing parties.”¹⁶⁹

The internet can be seen as a multi jurisdictional because of the ease which a user can access of website anywhere in the world. It can be even viewed as a jurisdictional in the sense that from

¹⁶⁸ (Jan. 2, 2018, 11

PM)<http://shodhganga.inflibnet.ac.in/bitstream/10603/71803/10/chapter%206.pdf>.

the user's perspective that the state and national borders are essentially transparent. For courts determining jurisdiction situation is more problematic. The court in *Zippo mfg. v. Zippo dot com*¹⁷⁰ inc said that there is a global revolution looming on the horizon and the development of the law in dealing with the allowable scope of personal jurisdiction based on internet use in its infancy.

The developing law of jurisdiction must address whether a particular event in cyberspace is controlled by the law of state or country where the website is located, by the law of the state or the country where the internet service provider is located. A number of commentators have voiced their opinion that cyberspace should be treated as separate jurisdiction. In practice this view has not been supported or addressed by the law makers, Cyber jurisdictional cases have been dealt with primarily in civil courts. Since the advent of *US v. Thomas, infra* and *Minnesota v. Granite gate resort*,¹⁷¹ Cyber jurisdictional issues have been begun to be examined in criminal courts as well.”¹⁷²

Cyber Jurisdiction in Criminal Cases: - the question of cyber jurisdiction came to a forefront of attention of early 1996 in *US. v. Thomas*¹⁷³ where the sixth circuit upheld the conviction of a couple operating a pornographic bulletin from their home. The defendant began, operating the amateur computer bulletin board system (hereafter referred to as AABBS) from their home. The AABBS content approximately 14000 gif files. These files should be easily accessed or retrieved or download by one who possessed a password. 1994, a US magistrate judge issued a search warrant which led to authorizing the confiscation of the defendant computers. The defendant was convicted in the district courts against which they appealed. The court held that

¹⁷⁰ 952 F.Supp.1119 (W.D.Pa.,Jan 16,199) (No. CIV.A.96-397 ERIE)

¹⁷¹ (State of Minn. Dist. Ct., Ramsey County, Dec. 11, 1996).

¹⁷² *Supra* note 17.

¹⁷³ 74 F.3d 701 6th Cir. 1996.

the statute must be construed to affect the intent of the Congress which was to prevent any obscene matter. —D argued that the internet environment provides broad ranging connections among people in cyberspace. As such that notion obscenity tied to geographical local would put a chill on protected speech. 'D' asserted a more flexible definition was needed was DMS operator could not select to receive their materials. The court ruled out that the D had pre existing method of screening potential members by pre-screening their members; they could protect themselves from being subjected to liability in jurisdiction with less tolerant standards. This could be further said that D was to tailor their message on as selective to the communities it should to serve so there no need to develop any definition.

Trademark owners would also have an unfair advantage with respect to personal names during the startup period. Under United States trademark law, a personal name may be protected as a mark, if it has become distinctive of particular goods or services.¹⁷⁴ 15 U.S.C. § 1052(f). This would mean that the Smith Drug Company, which has the registered trademark "SMITH,"¹⁷⁵ could register "smith. us" before any of the thousands of people named "Smith" could register the name. This result would be quite contrary to that in United States trademark law, which respects a right for individuals to use their own name, provided that it is not used in unfair competition with businesses of the same name.⁵⁰ Experience with the gTLDs shows that monopolizing second level domains corresponding to common last names has turned into a business.¹⁷⁶ There are obvious economic arguments against allowing monopolization of such a business--what would we think if the telephone company auctioned the right to be the only John Smith in the telephone book? But if last names are to be monopolized, the monopoly should be auctioned for the taxpayers' benefit rather than given away free to a lucky trademark owner.

¹⁷⁴ The '.us' Internet Domain by Peter B. Maggs::SSRN(Dec.19, 5:39 PM) <https://papers.ssrn.com>.

¹⁷⁵ Registration No. 2280225, available at <<http://www.uspto.gov>>.

¹⁷⁶ Taylor Wine Co. v. Bully Hill Vineyards, Inc., 569 F.2d 731 (2d Cir. 1978).

The present system of domain names in the ".us" gTLD is a disaster. It is based on totally obsolete twenty-year-old technology. It assumes that (as was the case in the 1980s) the purpose of a domain name is to refer to a specific computer in a specific physical location. But this is not the way domain names are used today. Domain names identify businesses, institutions, and individuals. Domain names stay stable, but the particular host computer (or computers) used for a domain name varies over time, sometimes even from minute to minute. Most small businesses, for instance, use web hosting services (sometimes called "Internet Presence Providers"), about whose physical location the businesses neither know nor care.¹⁷⁷ High volume websites use networks of cache computers, whose location also is totally unrelated to the location of the business. Virtual businesses may be huge, but own no bricks-and-mortar location and no host computers. Because domain names are used by people to identify businesses and institutions, it is important that they be easy to remember, easy to use, and have positive connotations. Ease of memory and use is also important when domain names are used in e-mail addresses. However, registrants in ".us" have had to use four-level domain names, such as "smith.philadelphia.pa.us". Four level domain names are hard to remember and hard to type and therefore are completely unattractive to businesses. The other problem with ".us" has been the existence of a cumbersome registration system. Registration has typically been done by delegated sub registrars or sub registrars, who charge no fees and so cannot afford to advertise or offer user-friendly on-line registration.

4.3. Unfair Trade Practices Issues

Another issue to know it before registering by the registrar, that is quite complex as the volume of new registration of domain name is 50,000 to 100,000 per week. Also it Uniform Resource Locator (hereafter referred to as URL) is case sensitive matter, they cannot identify domain

¹⁷⁷ To see the services offered by a large web hosting services, visit <<http://www.aitcom.net>>.

name registration leading towards unfair trade practices while registering 50,000 to 100,000 domain name per week. Though unfair trade practices can arise from a variety of business practices, they frequently appear in connection with the domain name. Following are the cases showing domain name disputes leading towards unfair trade practices:

1. *MTV v. Adam Curry*¹⁷⁸ In October 1994, MTV Networks (MTV) sued one of its former video disc jockeys, Adam Curry, alleging trademark violations in connection with Curry's use of the name "mtv.com" to locate his Internet site. The two parties went to court in the Southern District of New York to determine who had legal rights to the use of the mark. Curry claimed that he had been given permission, while he was employed by the network, to use the name to develop an Internet site which dispatched daily reports of gossip regarding the entertainment and music industries.¹⁷⁹ Curry registered the¹⁸⁰ name "mtv.com" under his own name, with his own money, and continued issuing his daily reports from the Internet site even after his employment at MTV was terminated. Curry's site was a popular one, with millions of Internet users accessing the site in the first ten months of its operation. After several unsuccessful requests that Curry cease using the "mtv.com" name for his site, MTV sued Curry for trademark infringement, as well as for breach of his employment contract. Despite Curry's pledge to take the case "all the way to the Supreme Court" and his characterization of the dispute as the "*Roe v. Wade*¹⁸¹ of the Internet and the information superhighway," the contentious case never reached final judgment in the district court. The two parties settled the dispute in March 1995, with Curry relinquishing the "mtv.com" domain name to MTV on undisclosed terms. Yet the importance of this dispute was unquestioned, ;it represented one of

¹⁷⁸ *MTV Networks v. Curry*, 867 F. Supp. 202 (S.D.N.Y. 1994).

¹⁷⁹ The only court document issued in the case was an order denying Curry's motion to dismiss two of MTV's counterclaims and an order granting Curry's motion for a more definite statement as to one of MTV's counterclaims.

¹⁸⁰ Gary W. Hamilton, Trademarks on the Internet: Confusion, Collusion, or Dilution?, 4 TEx. INTEL. PROP. L.J. 1, 2 (1995); Dan L. Burk, Trademarks Along the Infobahn: A First Look at the Emerging Law of Cybermarks, 1 RICHMOND J.L. & TECH. 1, § 2 (Dec. 25, 2017, 11:30 AM) <http://www.urich.edu/~jolt/vli/burk.html>.

¹⁸¹ 410 U.S. 113 (1973).

the first, and most notorious, attempts to address the potential for trademark infringement in cyberspace.

2. *Stanley Kaplan v. Princeton Review* In October 1994, two rival test-preparation companies, Stanley Kaplan and Princeton Review, agreed to arbitrate the first widely publicized case of "Internet address poaching and speculation," the practice of hoarding valuable trademarked names for use as Internet addresses and holding them for ransom. Stanley Kaplan attempted to register the domain name "kaplan.com" in May 1994 in order to develop an Internet site to advertise its services, only to learn that the name had already been registered by its main competitor, the Princeton Review.¹⁸² Although the president of the Princeton Review claimed that this company registered the site "kaplan.com" only to "mock and annoy" Stanley Kaplan, the namepoaching did have the potential to impact negatively Stanley Kaplan's business. Users who visited Princeton Review's "kaplan.com" site were "offered electronic materials disparaging the quality of Kaplan Review's services and extolling the comparative advantages of the Princeton Review courses." Furthermore, users were not alerted to the fact that the site was run by Princeton Review and not Stanley Kaplan, thus increasing the likelihood that users would be confused as to the true source of the information posted at the Internet site. Stanley Kaplan officials, who claimed that Princeton Review "hijacked [Kaplan's] name" and likened Princeton Review's actions to a second grade prank, charged its rival with trademark infringement and unfair competition. Kaplan sued Princeton Review for attempting to capitalize on "a whole bunch of positive attributions" that stands behind the Kaplan name. Princeton Review, in response, told Stanley Kaplan that the registration of the name "kaplan.com" had been done primarily as a joke, and offered to sell the name back to Stanley Kaplan for a case of beer. Stanley Kaplan turned down the offer, and the two parties submitted the matter to an arbitrator, who ruled that Princeton Review had to

¹⁸² *Supra* note 19.

give up the address, grant it to Stanley Kaplan, and switch its own site to a location with the address "review.com." The Stanley Kaplan¹⁸³/Princeton Review skirmish yielded no legal precedent, but it alerted companies to the practice of address poaching, which had become widespread as the Internet became more commercialized and valuable to large companies. By October 1994, "domain names suitable for 14 percent of the Fortune 500 companies had already been registered by someone else and a sizable chunk of the Fortune 500's domain names were still unclaimed, as well." Indeed, several well-known companies were dismayed to learn that the names "coke.com," "fox.com," "abc.com," and "polo.com" were already taken by the time they tried to register them with InterNIC--evidence that the Internet had begun to impact the trademark realm. However, it must be noted that in many of these cases, the names were not taken by would-be address poachers, but were registered to other companies who shared an acronym or a name with a more well-known counterpart, and therefore shared a legitimate claim to the name.

3. *McDonald's v. Quittner*¹⁸⁴ Another colorful and well-publicized case of Internet domain name poaching involved a magazine writer who, in October 1994, decided to test McDonald's reaction to his registration of the domain name of the famous fast-food chain. Joshua Quittner, a writer for *Wired* and *Newsday*, researched and wrote about the phenomenon of domain name poaching, a trend he termed the "Net Name Gold Rush." He decided to test the trend, and contacted McDonald's to see whether or not the corporation had registered its world-famous name as an Internet address. Upon learning that it had not, he did it himself; two weeks later, he received an e-mail notification from InterNIC that he was now the registrant on file for the domain "mcdonalds.com." He activated his site and circulated his new e-mail address as "ronald@mcdonalds.com". Quittner registered the name in jest, as a way to

¹⁸³ Chris Gulker, Firm Must Alter Name on Internet, *SAN FRANCISCO EXAMINER*, Oct. 6, 1994, at E1. Princeton Review apparently threatened to register the name "kraplan.com" instead.

¹⁸⁴ *McDonald's v. Quittner* (1994)

generate¹⁸⁵ entertaining and topical material for his column. He asked viewers for suggestions as to what he should do with the site, and even offered a few himself: I'd like to see if Burger King is interested in buying mcdonalds.com, taking it off my hands . I could auction it off. I could hold on to it as a trophy, A la Curry and mtv.com. I could set up a home page, explaining the difference between McDonald's and Josh "Ronald" Quittner. In the end, however, Quittner proved to be a serious adversary for McDonald's. Although he was not after a cash settlement in exchange for the name, Quittner refused to transfer the name to McDonald's unless the corporation donated \$3,500 to a junior-high school class in a Bedford-Stuyvesant, NY public school that badly needed improved computer equipment to maintain access to the Internet. At first, the company was not interested in settling with Quittner, and threatened instead to sue the writer to gain ownership of the domain name. Ultimately, the company quietly relented, donated the \$3,500 to the school, and put an end to the dispute.

4. *Better Business Bureau v. Sloo*¹⁸⁶ In another dispute that illustrated simply and vividly the interests at stake in Internet domain name conflicts, the Council of Better Business Bureaus (CBBB) in May 1995 sued a Kansas City man named Mark Sloo who had registered the domain names "bbb.com" and "bbb.org." CBBB, the umbrella organization for the country's Better¹⁸⁷ Business Bureaus, owned the "BBB" trademark, and wanted to establish an Internet site through which consumers could file complaints about businesses electronically and access information about businesses online. It was told by InterNIC, however, that the¹⁸⁸ names "bbb.org" and "bbb.com" had already been registered by Mark Sloo, who was not connected to CBBB in any way. CBBB tried unsuccessfully to negotiate with Sloo, beginning

¹⁸⁵ Burk, *supra* note 2.

¹⁸⁶ 326 U.S.279 (1945).

¹⁸⁷ Better Business Bureau Sues For Internet Address, NEWSBYTEs NEWS NETWORK, WESTLAW, All news Plus file.

¹⁸⁸ Martin Rosenberg, E-mail Conflict Triggers a Lawsuit; KC Man Controls Internet Address That a Business Council Wants to Claim, KANSAS CITY STAR, May 16, 1995, at 133; see also Council of Better Business Bureaus Sues Over Internet Plans, WALL ST. J., May 15, 1995, at B2.

in November 1994, but was forced to file suit in May 1995 to retrieve the domain names.' I According to CBBB's general counsel, the organization was concerned about protecting "the substantial goodwill and public recognition of what the BBB stands for," " ' and was afraid that "consumers and businesses would be misled into thinking that by contacting 'bbb.org' and 'bbb.com' they would obtain information from one of our member Better Business Bureaus."¹⁸⁹ The president of CBBB summed up the challenge faced by companies who want to establish an online presence using their protected trademarks: Responsible marketers wanting to use this promising medium realize that they will never be successful unless they develop and maintain consumer confidence by adhering to ethical business practices. We see this lawsuit not simply as an effort to reclaim our trademark rights, but as a demonstration of support for these responsible marketers." CBBB's suit against Sloo included trademark infringement and unfair competition claims, alleging that Sloo's "registration of the 'bbb' name prevented the Better Business Bureau system from using its own famous identifier as an Internet address." " CBBB also charged Sloo with name poaching, alleging that Sloo's only real interest was in bartering the name for compensation." Indeed, Sloo told CBBB that he would be willing to "donate" the name to the non-profit organization so that he could receive a tax deduction." CBBB refused to comply with Sloo's request, and was forced to file suit against him when he continued to demand compensation for the domain names." The case is still pending in federal court in Kansas City, MO. ¹⁹⁰

5. *WIRED v. Wire* One trademark/domain name dispute that considered a different issue - the registration of a domain name similar to one already in use-pitted wired magazine against WIRE, a computer network that used the domain name wire.net. Although the two

¹⁸⁹ *Supra* note 27.

¹⁹⁰ Better Business Bureau Sues For Internet Address, *supra* note 26. According to Steven Cole, the general counsel of the CBBB, Sloo represents another example of "an entrepreneur hoping to make a quick profit from selling [a domain name] back to the company."

companies¹⁹¹ offered very different services - Wired is a monthly magazine that covers computer technology-related topics and WIRE is a computer network devoted to women's issues" - Wired thought that WIRE's domain name was too similar to its own: wired.com. Although both sides hired lawyers to resolve the issue, the parties reached a settlement in February 1994 without stepping into a courtroom. Wired agreed to split the cost of changing WIRE's name to Women's Wire and also ran several ads for the network, while the newly-dubbed Women's Wire changed its Internet address to wire.net. However, even though the dispute was resolved peacefully, it raised an issue that had not yet been addressed in the trademark/domain name controversy: whether or not the registration of similar domain names caused such a likelihood of confusion that one of the names needed to be changed.

6. *KnowledgeNet v. Boone* In 1994, an Illinois-based computer consulting company called KnowledgeNet attempted to obtain a domain name address using its trademarked name, only to learn that the name "knowledgenet.com" had already been registered by David Boone, a Virginia man who was using the name for an Internet site for a "fledgling trade association of independent business consultants." KnowledgeNet¹⁹² filed suit against Boone in December 1994 for trademark infringement, demanding that he return the name and pay between \$25,000 and \$50,000 in damages. Boone¹⁹³ claimed, in defense, that he never used the mark to sell goods or services, nor did he ever intend to sell the type of services offered by the computer consulting firm. In the end, the parties were able to reach settlement, so no legal precedent was set by the dispute.¹⁹⁴ Boone, who's raising legal fees, drained his energy and his budget, agreed to the following: to transfer the name to KnowledgeNet; to send copies of the consent decree to all of the members of his trade association; to send up to four certified letters to

¹⁹¹ Weise, Elizabeth, Feud Highlights Growing Importance of Internet, B. GLOBE, Feb. 22, 1994, at 42.

¹⁹² Retreat and Surrender: Internet Trademark Suit Fizzles, Boone Folds and Agrees to Give Domain Name to KnowledgeNet, INFO. L. ALERT: A VOORHEES REPORT, July 7, 1995.

¹⁹³ KnowledgeNet v. David Boone: Parties Try to Settle Internet Trademark Suit, INFO. L. ALERT: A VOORHEES REPORT, May 12, 1995.

¹⁹⁴ Retreat and Surrender, supra note 31.

members, including a return postcard asking the members not to use the name "KnowledgeNet"; and to send a copy of the decree to the publications which had written about his association. The KnowledgeNet dispute was particularly significant because, for the first time, InterNIC and Boone's Internet access providers were named as defendants in the suit. Knowledge Net's suit contended that, "by allowing Boone to ¹⁹⁵register [knowledgenet.com], and by refusing to revoke it, InterNIC assisted, aided, and abetted Boone's illegal activities." KnowledgeNet also sued Boone's access provider, Digital Express Group, who hosted Boone's World Wide Web pages that mentioned the name of his Internet site. Although both InterNIC and Digital Express Group settled¹⁹⁶ with paper, the technology of the Internet cannot yet allow this differentiation to translate to domain name addresses. KnowledgeNet on undisclosed terms, had the case gone to trial, its outcome would have been instructive for InterNIC and the companies who provide Internet access services to parties in domain name trademark infringement actions.

7. *Hasbro v. Candyland* A recent Seattle case expanded the legal options available to a trademark owner who wants to protect his goodwill in cyberspace. In February 1996, toymaker Hasbro, Inc., the manufacturer of the popular children's board game "Candyland," sued Internet Entertainment Group Ltd. (IEG), a Seattle company who was using the address "candyland.com" for an Internet site featuring sexually explicit material, nudity, and cybersex. Hasbro alleged, in the U.S. District Court for the Western District of ¹⁹⁷Washington that IEG had diluted the value of Hasbro's CANDYLAND trademark through its use of the name to identify its Internet site. Further, Hasbro charged that IEG's conduct was causing irreparable injury to Hasbro through its use of the domain name, as the "pornographic Internet site [was

¹⁹⁵ Bruce Keller, *Electronic Property Rights and Licensing Online Uses of Intellectual Property*, 423 PLI/PAT 7/37 (1995).

¹⁹⁶ *KnowledgeNet v. David Boone*, supra note 32.

¹⁹⁷ Paul. Shukovzky, *Use of 'Candyland' Name on Web Halted*, SEATTLE POST-INTELLIGENCER, Feb. 7, 1996, at B1. The site offers live strip shows, private fantasy booths, and other interactive features. *There's Trouble In Candy Land*, BUFFALO NEWS, Feb. 11, 1996, at A13.

diluting] the wholesome nature of the name.¹⁹⁸ 'Hasbro petitioned the court for a temporary restraining order preventing IEG from "directly or indirectly using the name CANDYLAND, or the Internet domain name 'candyland.com,' or any similar name which is likely to dilute the value of Hasbro's CANDYLAND mark, in connection with the advertising, operation, or maintenance of any Internet site, including but not limited to any Internet site containing sexually explicit material or other pornographic content." In defense of its use of the name "candyland.com" for its Internet site, IEG claimed that it did not intend to capitalize on the toy maker's trademarked name. According to one IEG official, "We've never had a customer complain, 'Oh, I thought I was going to get the Candy Land board game of my childhood.' We've never attempted to confuse anyone into thinking they would get a child's board game."

" IEG also testified as to the popularity of its Internet site: since January 1,¹⁹⁹ 1996, there had been over ten million visits to the "candyland.com" site. Judge Dwyer of the Western District of Washington, who issued the temporary restraining order for Hasbro, was not convinced by IEG's defenses. In addition to restraining the company²⁰⁰ from using the "candyland.com" address, he ordered the company to post a referral notice at the original site providing the new location of IEG's Internet site, and forbade the company from establishing a "hyperlink" to any site. After ninety days, IEG was to remove the referral notice and discontinue all use of the "candyland.com" domain name. The ninety-day referral period was a concession by Judge Dwyer to IEG, who had invested substantial amounts of money in advertising and promoting the "candyland.com" site. But the decisive tone of his restraining order clearly indicated²⁰¹

¹⁹⁸ Thomas W. Haines, Judge Orders Porn Firm to Vacate Its Net Address, THE SEATTLE TIMES, Feb. 6, 1996, at B1.

¹⁹⁹ Shukovsky, at B 1. See also Toy Maker Takes on Cyber porn on the Internet, Bus. WIRE, Feb. 1, 1996, available in LEXIS, Nexis library ("PEG] insists there is no likelihood that consumers will be confused as to the affiliation, connection or association of IEG with Hasbro or as to the toy maker's sponsorship or approval of the 'candyland.com' adult-oriented Internet site.").

²⁰⁰ Hasbr, Inc., 1996 U.S. Dist. LEXIS 11626, at *3-4; Court Says Porno Operator Can't Use Toymaker's Name, NEWSBYTES NEWS NETWORK, (Dec. 26, 2017, 8 AM) WESTLAW, All news file.

²⁰¹ IEG requested the referral period from the judge, noting that "[g]iving up the location without notice ... would be like moving from a house without leaving a forwarding address. And that would mean lost business." Haines, supra note 37, at B1.

that the claim of trademark dilution could be an ineffective and persuasive legal doctrine to enforce trademark rights on the Internet.

8. *Intermatic v. Toeppen* The Northern District of Illinois recently applied the federal trademark dilution act to a domain name registrant in *Intermatic v. Toeppen*. In *Intermatic*, the plaintiff, a²⁰² manufacturer and distributor of electronic products, sued Dennis Toeppen, an individual who had registered the domain name "intermatic.com," alleging that his use of the name for his website constituted trademark dilution of its registered trademark INTERMATIC. The court agreed with Intermatic, holding that Toeppen had violated the trademark antidilution act because his registration of Intermatic trademarked name "lessen the capacity of Intermatic to identify and distinguish its goods and services by means of the Internet." The defendant's conduct diluted the plaintiff's trademark by hindering Intermatic ability to "identify its goods to potential customers who would expect to locate Intermatic on the Internet through the 'intermatic.com' domain name." The court permanently enjoined Toeppen from using or infringing the INTERMATIC trademark, and specifically from using the "intermatic.com" domain name or preventing Intermatic to register it for itself. These disputes highlighted several important, recurring issues: (1) How can Internet domain name poaching be avoided?; (2) What happens when two companies own an identical trademark, and both want to use the mark as a domain name?; (3) How should disputes be resolved when two domain names are similar, but not identical?; and (4) Can domain names dilute registered trademarks? Many of these issues were addressed more extensively in InterNIC registration policy, which is issued in July 1995, and revised in September 1996.

9. *Google Inc. v. Gulshan Khatri*²⁰³ : "The complainant filed the instant complaint challenging the registration of the domain name <googlee.in> in favour of the respondent. The

²⁰² 1996 U.S. Dist. LEXIS 14878 (N.D. Ill., Oct. 7, 1996).

²⁰³ Google, Inc v. Gulshan Katri-Arbitration case No.8 of 2011.

grievance of the complainant was regarding the latter's act of adopting an identical domain name and that also in respect of similar service mark to that of the complainant. The complainant contended in its claim that the respondent simply wished to usurp the domain name and ride on the goodwill that the complainant has built over the years by its hard work. Further it was contended that the disputed domain name was visually, conceptually and substantially identical to the complainant's domain name and that there was no difference between both the domain name, The complainant further contended that the name <googlee.in> appeared immediately and obviously connected with the complainant and its business and the public would perceive it as such. It was also contended that both the domain names were used as search engines. The complainant further contended that the confusion which is likely to be brought into people's mind through the disputed domain name would not only improperly benefit the Respondent but also disrupt the business of the complainant, dilute its rights and expose it to the risk of fraud. ²⁰⁴The complainant further submitted that the disputed domain name was registered in the favour of the Respondent on 17th February 2001 whereas the same domain name <google.in> had been extensively operating and serving the market worldwide way back from 1997. Furthermore the complainant submitted that it had not authorized, licensed or otherwise consented to the respondent's use of its mark or brand. The respondent did not deny the knowledge and use of the domain name/ trademark GOOGLE by the complainant. The learned Arbitrator held that impugned domain name <goooglee in> was identical and confusingly similar to the other prior registered domain name and registered trademark of the complainant and directed the Registry to cancel the said domain name forthwith and transfer the said domain name in the favour of the Complainant."²⁰⁵

²⁰⁴ *Ibid.*

²⁰⁵ Domain Names Case Law in India, Domain cases in (Dec.30, 2018, 9 AM) India
<http://ssrana.in/Intellectual%20Property/Domain%20Names/Domain-Name-Case-Law-in-India.aspx>.

10. *Morgan Stanley v. Bharat Jain*²⁰⁶ : The disputed domain name www.morganstanleybank.co.in was registered by the respondent Morgan Stanley June 20, 2010. The complainant contended that addition of ccTLD “.co. in” was insufficient to render the disputed domain name dissimilar to MORGAN STANLEY. Hence the disputed domain name was confusingly similar to the above stated mark. Further it was contended that as the respondent was not commonly known by the mark MORGAN STANLEY he had no right or legitimate interest in respect of the disputed domain name. Regarding the element of bad faith, it was contended that the respondent had registered the above stated domain name with the intent of earning profit and mislead the customers/ users of the complainant’s domain name www.morganstanley.in. The learned arbitrator held that complainant’s mark and domain name MORGAN STANLEY was a coined word and highly distinctive in nature and as such the consumers looking for MORGAN STANLEY may instead reach the respondent’s website and hence the disputed domain name is confusingly similar to the complainant’s trademark. Regarding legitimate interest, the learned Arbitrator upheld the complainant’s contention that the respondent was in no way known with the said trademark and further held that as the complainant had not licensed or permitted the respondent to use the trademark the respondent did not have any legitimate interest in the disputed domain name. The respondent through one of its customers had tried to sell the disputed domain name to the complainant when a cease & desist letter was sent to the respondent which reflected that the domain name was registered and used in bad faith and with the intent to offer the disputed domain for sale to the complainant or to a competitor for a valuable consideration.

11. *Yahoo! Inc. v. Akash Arora & Anr*²⁰⁷ : “The present suit has been instituted by the plaintiff against the defendants seeking for a decree of permanent injunction restraining

²⁰⁶ Morgan Stanley v. Bharat Jain (2010).

²⁰⁷ 1999 IIAD Delhi 229,78 (1999) DLT 285.

the defendants, their partners, servants and agents from operating any business and/or selling, offering for sale, advertising and in any manner dealing in any services or goods on the Internet or otherwise under the trademark/domain name 'Yahoo India.Com' or any other mark/domain name which is identical with or deceptively similar to the plaintiff's trademark 'Yahoo!' and also for rendition of accounts and damages. The plaintiff has also filed an application under Order 39 Rules 1 & 2 CPC praying for an ad interim temporary injunction restraining the defendants from operating any business and/or selling, offering for sale, advertising and in any manner dealing in any services or goods on the Internet or otherwise under the trademark/domain name 'Yahoo India.Com' or any other mark/domain name which is identical with or deceptively similar to the plaintiff's trademark 'Yahoo!'. Mr. Kapil Sibbal, counsel appearing for the plaintiff submitted that the plaintiff is the owner of the trademark 'Yahoo!' and domain name 'Yahoo.Com', which are very well-known and have acquired distinctive reputation and goodwill and the defendants by adopting the name 'Yahooindia' for similar services have been passing off the services and goods of the defendants as that of the plaintiff's trademark 'Yahoo!' which is identical to or deceptively similar to the plaintiff's trademark. It was submitted that a domain name/trademark adopted by the plaintiff is entitled to equal protection against passing off as in the case of a trademark. In support of his submission, the learned counsel heavily relied upon the ratio of the decisions in *Marks & Spencer Vs One-in-a-Million*,²⁰⁸ reported in 1998 FSR 265. It was submitted that the trademarks and domain names are not mutually exclusive and there is an overlap between the trademarks and services rendered under domain names and thus by adopting a deceptively similar trademark 'Yahooindia', the defendants have verbatim copied the format, contents, lay out, colour scheme, source code of the plaintiff's prior created regional section on India at Yahoo.com.sg and thus passing off the services of the

²⁰⁸ 1998 FSR 265.

defendants as that of the plaintiff. He submitted that Internet users are familiar with the practice of companies to select domain names that incorporate their company name, well-known trademark, and/or product/service name and generally attempt to locate a particular company's Web site by simply typing in www.(company name).com or www.(product name).com when they are unsure of the Internet address of the Company. According to him, thus, it would not be unusual for someone looking for an authorised 'Yahoo!' site with India-specific content to type in 'Yahooindia.com', i.e., the defendants' domain name and thereby instead of reaching the Internet site of the plaintiff, the said person would reach the Internet site of the defendants'. He further submitted that the plaintiff in fact provides extensive content on India, both on its Yahoo! Asia site and at its main Yahoo.com site, under the categories "Regional:Countries:India". It was submitted that the defendants being in the same line of activity as that of the plaintiff, the defendants have tried to be 'cyber-squatters' and, thus, dishonesty is writ large as the defendants have adopted a trademark similar to that of the plaintiff which is 'Yahoo.com' which has acquired a distinctive name, goodwill and reputation. Aforesaid allegations and submitted that the trademark laws in India relate to goods and, therefore, the provisions of Indian Trade Marks Act are not applicable to the facts and circumstances of the present case which deals only with goods. It was also submitted that the trademark/domain name 'Yahoo!' of the plaintiff is not registered in India and, therefore, there cannot be an action for infringement of the registered mark nor could there be any action of passing off as the services rendered both by the plaintiff and the defendants cannot be said to be goods within the meaning of the Indian Trade Marks Act which is concerned only with goods and not services and thus the decisions relied upon by the counsel appearing for the plaintiff are not relevant for the purpose of deciding the present case. He further submitted that the word "Yahoo!" is a general dictionary word and is not vented and, therefore, it could not have

acquired any distinctiveness and since the defendants have been using disclaimer, there could be no chance of any deception and thus, no action of passing off is maintainable against the defendants. He also submitted that the persons using Internet and seeking to reach the Internet site are all technically educated and literate persons and, therefore, there is no possibility of any customer reaching the Internet site of the defendants with the intention of reaching the Internet site of the plaintiff and thus, it is not a case of unwary customer which is applicable in a case of infringement and passing off of the trademark. In the light of the aforesaid submissions, let me now consider as to whether the plaintiff has been able to make out a prima facie case for grant of temporary injunction as sought for in the application. The domain name 'Yahoo.com' is registered in the plaintiff's favour with Network Solution Inc since 18th January, 1995. The trademark 'Yahoo!' and its variance are registered or pending registration in 69 countries of the world. As is disclosed from the records, an application for registration of the trademark of the plaintiff 'Yahoo!' is also pending in India. The plaintiff is a global Internet media rendering services under the domain name/trade name 'Yahoo!'. The Internet is a global collection of computer networks linking millions of public and private computers around the world. The Internet is now recognized as an international system, a communication medium that allows anyone from any part of the globe with access to the Internet to freely exchange information and share data. The Internet provides information about various corporations, products as also on various subjects like educational, entertainment, commercial, government activities and services. A computer or device that is attached to the Internet has an address which is known as Domain name. The same is established by using suffix 'com' and registering with Network Solutions Inc. A domain name identifies a computer or a Sub Network of computers in the Internet. One way to establish a presence on the Internet is by placing a web page. The plaintiff, it is stated, was amongst the first in the field to have a domain name 'Yahoo' and also to start a Web directory and provide search services. In June, 1994, the said directory was named

'Yahoo!' which is a dictionary connotation which was adopted by the plaintiff and is providing the said service at the Internet under the domain name/trade name 'Yahoo!' The plaintiff is admittedly providing various services including services on the regional section also. In view of growing popularity of 'Yahoo!' of the plaintiff, it was submitted that many third parties started imitations by using sound-alike names in order to appropriate the reputation and goodwill acquired by the plaintiff in respect of the trademark/name 'Yahoo!' in India and that the defendant is one of such parties who in order to appropriate the reputation and goodwill acquired by the plaintiff in respect of the said trademark 'Yahoo!' adopted the trademark/domain name 'Yahooindia.com' for their Internet site although their trading name is Net link Internet Solutions. One of the submissions was that the domain name 'Yahoo!' of the plaintiff is not used in relations to goods, but, in relations to services and since services are not included within the ambit of section under Sections 27(2) and 29 of the Trade Mark Merchandise Act (referred to as the 'Act' in short) and, therefore, the plaintiff cannot plead for action of passing off in relation to such services. In support of his submission, the learned counsel drew my attention to the provisions of Section 2(5), Sections 27, 29 and Section 30 of the Act and contended that only goods are recognized for the purpose of preferring an action for infringement or passing off. Admittedly the present case is not for an action for infringement of a registered trademark, but, an action for passing off. The law relating to passing off is fairly well-settled. The principle underlying the action is that no man is entitled to carry on his business in such a way as to lead to the belief that he is carrying on the business of another man or to lead to believe that he is carrying on or has any connection with the business carried on by another man. It is also well-established that passing off action is a common law remedy. There are a plethora of cases wherein it has been held that the principles of common law govern actions of passing off and have been recognized by Section 27(2) and Section 106 of the Trade and Merchandise Marks Act, 1958. In this commentary, reference may be made to

the well-known treatise on the law of Trademarks and passing off, of P. Narayanan. In paragraph 25.102 of the fourth edition of the said treatise, it is stated thus:-

"The general principles of the law applicable to cases where a person uses a name or intends to use a name which is likely to deceive and divert the business of the plaintiff to the defendant or cause confusion between the two businesses are analogous to the principles which are applicable to ordinary cases of passing off relating to sale of goods." Reference may be made to the decision of this Court in *Monetary Overseas Vs. Montari Industries Ltd*²⁰⁹; reported in 1996 PTC 142, wherein it was found that the defendant adopted a trade name that was identical to that of the plaintiff and the court while injunctioning the defendant held thus:- "When a defendant does business under a name which is sufficiently close to the name under which the plaintiff is trading and that name has acquired a reputation and the public at large is likely to be misled that the defendant's business is the business of the plaintiff, or is a branch or department of the plaintiff, the defendant is liable for an action in passing off."²¹⁰

Law is limited in nature to deal with such conflicts arising out of technological innovation. With regard to Indian legal position there is neither any separate law nor does existing law have any specific provision relating to domain name in the Trademark Act 1999, though on some occasion judiciary took an initiative in deciding domain name disputes under the Trademark Act. Because of the boundary-less nature of internet violation of trademark registered in one country may happen in another country owing to bad faith domain name registration. Such a situation would bring forward the problem of determination of jurisdiction and applicable law for solving the dispute. The court is trying to deal with domain name conflicts under the

²⁰⁹ ILR 1997 Delhi 64.

²¹⁰ *Yahoo!, Inc. vs Akash Arora & Anr.* on 19 February, 1999 (Dec. 30,2017,9 AM)
<https://indiankanoon.org/doc/1741869/>.

Trademark laws. In case of Yahoo Inc vs. Akash Arora²¹¹, the court has brought up the subject matter of domain name into trademark law by granting injunction for passing off. Where Trademark Act 1999 do not contain any provision relating to domain name. However, the Indian judiciary is dealing with some of the domain name disputes under the Trademark Act but it remains unattended in the absence of proper law. Another problem of recent origin is 'reverse domain name hijacking'. It is an attempt by a trademark holder with bad faith, to take control over the domain name of another, who has not breached the trademark laws, and has a legitimate interest in the domain name. Here the person attempting to take control of the domain name has the knowledge of the fact that the owner of the domain name has legitimate interest in the domain name. Still in such a situation he resorts to legal action in bad faith with a primary intent to harass the domain name holder. This kind of conflict is also not properly addressed in law.

Domestic laws have been found inadequate in provisions to deal with the domain name disputes due to their international characters. In response to this, the Internet Corporation for Assigned Numbers and Names (hereafter referred to as ICANN) in consultation with World Intellectual Property Organization (hereafter referred to as WIPO) has provided a policy for domain name dispute resolution, which is known as Uniform Domain Name Dispute Resolution Policy (hereafter referred to as UDRP). UDRP provides for the resolution of domain name disputes through mandatory administrative proceedings, which are to some extent similar to arbitration proceedings. Despite the fact that the UDRP is increasingly popular in solving the domain name disputes, it is not free from some inherent loopholes.

Most strikingly, the limited scope of application, limited remedies, possibility of bias towards complainants, forum shopping, limited time gap resulting in hurried decisions without proper

²¹¹Yahoo!, Inc. v. Akash Arora & Anr. (1999) 78 (1999) DLT 285.

reasons, possible violation of due process and possibility of conflicting decisions by Panels are the major areas of concern. Therefore, most of the trademark holders are attracted towards the court litigation under national legislation. Finally, the existing domain name-trademark dispute resolution mechanism is not comprehensive. Neither the court litigation under the domestic laws nor the mandatory administrative proceedings under UDRP can handle all types of domain name-trademark disputes.

“In another case the defendant registered a number of domain names bearing the name Tata. It was held by the court that domain names are not only addresses but trademarks of companies and that they are equally important. (*Tata Sons Ltd v. Monu Kasuri & others 2001 PTC 432*²¹²). In a case which was taken up by the WIPO administrative panel where SBI Card and Payment Services Private Limited (a joint venture between GE Capital Services, the largest issuer of private label credit cards in the world, and the State Bank of India (SBI), the largest Indian bank) filed a case against an Australian entity on cybersquatting. Domain Active Pty Limited which was incorporated in Australia had registered a domain name www.sbicards.com. The administrative panel held that domain name registered by the Australian entity was in bad faith and it could have attracted attention from the public because of its affiliation to SBI Cards products and services.

12. In *Bennett Coleman & Co Ltd. v. Steven S Lalwani and Bennett Coleman & Co Ltd. v. Long Distance Telephone Company (Cases No D2000-0014 and 2000-0015, WIPO*²¹³), the arbitration panel gave a decision in favour of the plaintiff. In this to the respondent had registered domain names www.theeconomictimes.com and the www.timesofindia.com with network solutions of the United States. These two names are similar to the names of the Plaintiff's websites www.economictimes.com and www.timesoftimes.com. Another important

²¹² 2001 PTC 432 (Del).

²¹³ Cases No D2000-0014 and 2000- 0015, WIPO.

fact was that the respondent's websites using the domain names in contention redirect the users to a different website www.indiaheadlines.com which provided India related news.

13. In *Satyam Infoway Ltd. v Sifynet Solutions*²¹⁴, the Respondent had registered domain names www.siffynet.com and www.siffynet.net which were similar to the Plaintiff's domain name www.sifynet.com. Satyam (Plaintiff) had an image in the market and had registered the name Sifynet and various other names with ICANN and WIPO. The word Sify was first coined by the plaintiff using elements from its corporate name Satyam Infoway and had a very wide 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 that domain name has all the characteristics of a trademark and an action of Passing off can be found where domain names are involved. The decision was in favour of the plaintiff. Passing off action is where the defendant is restrained from using the name of the complainant to pass off the goods or services to the public as that of the complainant. It is an action to preserve the goodwill of the complainant and also to safeguard the public. In India cybersquatting cases are decided through the principle of Passing off. India does not have a law for prohibition of cybersquatting. Therefore, courts interpret the principle of Passing off with regard to domain names"²¹⁵.

²¹⁴ 2004 (6) SCC 145.

²¹⁵ Domain Names and Cybersquatting by Mr ... - India Law Journal (Dec.28, 2017, 7 AM)
http://www.indialawjournal.org/archives/volume1/issue_2/article_by_ashwin.html.

CHAPTER 5: Conclusion and Suggestions

Domain name as Intellectual Property Rights are of great value to everyone and to the world at large, but are not protected in the sense as it should be. Protection of domain name may definitely promote the online world to come with new market of products, services and national economy. Among the other, the main issues with domain name disputes are the existing laws as the court is relying only on the legal structure of trademark laws. Trademark is administered by a public governmental authority on territorial (either national or regional) basis which gives right to the trademark holder that may be exercised within a territory whereas domain name is usually administered by non-governmental organization (Neutronics) without any functional limitation, domain name are registered on first come first serve basis and offer unique, global presence on the internet. However, trademark and domain name works in two different fields. So forth there has to be two different and effective laws to deal with it. Though some of the countries have independent laws for handling the issues of domain name. Like USA has specific law to deal with domain name disputes i.e. "Anti-Cyber squatting Consumer Protection Act" whereas India lacks any such enactment. 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. 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. 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: i) The Paris Convention is the oldest major multilateral treaty designed to improve the international protection of trademark rights". Since 1925, it has required member nations to protect well-known foreign marks. The Paris Convention's major advance in international intellectual property relations was implementing the principle of national treatment within a treaty intended for widespread, rather than only limited or regional implementation. Substantive rights obligations were minimal in the first incarnation of the treaty, but its coverage was not then, and is not now, limited to national treatment. The Convention also obligates member nations to provide certain minimum substantive trademark rights to nationals of other member nations. One of those minimum substantive rights is the right of a foreign national to obtain protection against the use or registration of a mark in a member nation if the foreign national's mark is well known, a third party registers or uses the mark for identical or similar goods, and the complained-of mark is liable to create confusion. The basic obligation is to allow an "interested party" to intervene in a registration proceeding, to request cancellation of a registration, or to object to the use of a mark under certain conditions: (a) the mark is "a reproduction, an imitation, or a translation" of a well-known foreign mark, (b) the well-known mark and the mark being objected to are used for identical or similar goods, and (c) the domestic use is "liable to create confusion." Well-known mark status is defined in the Paris Convention only by the following characterization: "a mark considered to be well known in [a protecting] country as being already the mark of a protected foreign national." This only seems to mean that well-known status is to be determined by each nation on an individual basis and that renown on a global scale is not required. No more specific scope is provided, nor is the standard for how much local knowledge of a mark would be required for the mark to be "well known" in a country where protection is sought. The United States fulfill its obligations under article 6bis for well-known foreign marks that have been either:(i) used in the United States and registered on the Principal Register or (ii) used in the United States

without registration but with protection as a common law trademark under section 43(a) of the Lanham Act. But if the Second Circuit's recent decision is correct and if the Paris Convention requires the United States to protect well-known foreign marks not used in this country, we fall short of full compliance. Interestingly, the United States has advocated in both the distant and recent past in favour of such an obligation. Moreover, many Paris Convention nations provide more extensive protection, even though many or even most of those nations typically do not provide any trademark-specific protection without registration. Instead, many nations protect unregistered marks, in certain circumstances, by applying their broader laws against unfair competition. The United States, on the other hand, has a long tradition of providing trademark protection without registration. So of all nations, one might think the United States should be at the forefront of a broad article 6bis obligation. ii)The TRIPS Agreement, the intellectual-property treaty concluded as one of the foundational agreements of the World Trade Organization ("WTO"), includes all substantial obligations of the Paris Convention with respect to trademarks and expands upon them as well. For example, the signatory nations agreed to extend the Paris Convention well-known marks obligation to include service marks as well as trademarks. The TRIPS Agreement also expanded protection for well-known foreign marks beyond uses or registrations that would create a likelihood of confusion. TRIPS mandates protection against unauthorized use or registration with goods or services dissimilar from those associated with the well-known mark, provided that the use would indicate a connection with the foreign owner and would likely damage the interests of that owner. The TRIPS Agreement did not define the term "well-known mark," and, as noted above, the Paris Convention provides no firm meaning for "well known." The TRIPS Agreement states only that member nations "shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark. "As a result, the exact meaning of "well-known

mark" may continue to vary internationally, but certain contours are consistent. Additional consistency within international application of the concept of a "well-known mark" may also arise from recent, although nonbinding, international negotiations. Owners of federally registered trademarks can bring actions against trademark infringement under section 32 (1) of the Lanham Act. S.32 (1) provides that infringement occurs when one uses a registered mark in commerce or applies it to goods or services without the consent of the trademark registrant, and such use is likely to cause confusion. The Lanham Act goes beyond trademark infringement and creates a federal statutory tort, which provides wide protection against various aspects of unfair competition. Causes of action for unfair competition can be brought under section 43(a) of the Lanham Act for all marks, registered or not, as well as trade names. S.43 (a) is often referred to as the Federal Unfair Competition Law and provides another channel to deal with domain name-trademarks disputes. The Federal Trademark Dilution Act of 1995 (FTDA), signed into law in 1996, amended the Lanham Act to create a federal cause of action for the dilution of famous marks. The Act affected domain name disputes in that famous mark were automatically protected, and unlike infringement or unfair competition claims, likelihood of confusion is not a requirement. The FTDA defines dilution as the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and the other parties, or (2) likelihood of confusion, mistake or deception. Thus, it provides for claims against non-competing and non-confusing uses if they diminish or dilute the effectiveness or distinctiveness of the mark. In order to get protection under FTDA the mark have to be famous and the claimant have to prove that it diminish or dilute the effectiveness of distinctiveness of his mark. The second limitation is the requirement of commercial use in commerce. In late 1999, the US congress enacted the Anticybersquatting Consumer Protection Act (ACPA). The legal remedies available for victims of cyber squatting before the enactment of the ACPA were

viewed by the Congress as expensive and uncertain. The ACPA amends the Trademark Act of 1946, creating a specific federal remedy for cyber squatting. ACPA is also not free from loopholes as it fails to address the disputes of two or more legitimate owners of the same trademark in different classes or countries seeking the same domain name. ACPA should be amended to indicate whether a first come, first served rule or some other rules would apply. To be successful in an ACPA lawsuit, the mark owner must prove (1) that the mark is valid; (2) the website owner registered the site in bad faith in order to profit from the mark; (3) the mark was distinctive when the site was registered; and (4) the domain is identical or confusingly similar to the mark. Unlike many developed countries, in India we have no Domain Name Protection Law and cyber squatting cases are decided under Trade Mark Act, 1999. A trademark is protected by the laws of a country where such trademark may be registered. Consequently, a trade mark 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 not only that a domain name would require worldwide exclusivity but also that national laws might be inadequate to effectively protect a domain name". The Indian Courts though have recognized the lacuna; however, in the absence of a explicit legislation, courts apply provisions of the Trade Marks Act to such disputes. Dispute involving bad faith registrations are typically resolved using the Uniform Domain Name Dispute Resolution Policy (UDRP) process developed by the ICANN. Under UDRP, WIPO is the leading ICANN accredited domain name dispute resolution service provider and was established as a vehicle for promoting the protection, dissemination, and the use of intellectual property throughout the world. India is one of the 171 states of the world which are members of WIPO. India has also established its own registry by the name INRegistry under the authority of National Internet Exchange of India (NIXI), wherein the

dispute related to the domain name are resolved under the .IN Dispute Resolution Policy (INDRP). The Policy has been formulated in line with internationally accepted guidelines, and with the relevant provisions of the Indian Information Technology Act 2000. Under INRegistry, disputes are resolved under .IN Domain Name Dispute Resolution Policy (INDRP) and INDRP Rules of Procedure. These rules describe how to file a complaint, fees, communications and the procedure involved. There are innumerable instances of misuse of domain names. For instance some people for earning money or with similar kind of intentions uses some popular brand names for getting domain address registered in their names before it got registered with the right owner. These practices are increasing day by day and taking the shape of unfair trade practices. “An unfair trade practice consists of using various deceptive, fraudulent or unethical methods to obtain business. Unfair trade practices include misrepresentation, false advertising, tied selling and other acts that are declared unlawful by statute. It can also be referred to as deceptive trade practices”. “In India, till 2002, the Monopolies and Restrictive Trade Practices Act (MRTP), which was enacted to prevent monopolies and restrictive trade practices, was the foremost legislation to deal with unfair trade practices in the country. The MRTP Act was repealed giving way to the Competition Act, 2002, thus transferring all the pending cases in the MRTPC to Competition Commission of India (CCI) for adjudication from the stages they were in. However, no provision to deal with unfair trade practice was incorporated in the Competition Act and thus this was, instead, given effect under Consumer Protection Act, 1986 (COPRA) which was already dealing with unfair trade practices. Similarly, Section 5 of the Federal Trade Commission Act, 1914 (“FTC Act”) of the United States of America (USA) prohibits “unfair and deceptive acts or practices” in or affecting commerce. Such practices broadly include: (i)an act or practice that causes or is likely to cause substantial injury to consumers, that cannot be reasonably avoided by the consumers and is not outweighed by countervailing benefits to

consumers or to competition; and (ii) an act or practice where a material representation, omission or practice misleads or is likely to mislead the consumer, who has reasonably interpreted such representation, omission or practice. There are two basic anti-competitive laws in USA, namely, the Sherman Act, 1890 and the Clayton Act, 1914. Both the laws are enforceable either by the Antitrust Division of the Department of Justice, the Federal Trade Commission (FTC) or private persons alleging economic injury caused by violation of either of them. In addition to the above two laws, the Federal Trade Commission Act, 1914 (the FTC Act), which is enacted to protect trade and commerce against unlawful restraints and monopolies, may also be utilized by FTC and private persons. However, only FTC, and not the Antitrust Division nor private persons, may enforce the FTC Act. Section 5 of the FTC Act prohibits unfair or deceptive acts or practices in or affecting commerce. The prohibition under the FTC Act applies to all persons engaged in commerce. This empowers FTC to prevent a person, partnership or corporation from engaging in incidences of unfair methods of competition in or affecting commerce and unfair or deceptive acts or practices in or affecting commerce. FTC Act is also given the power to investigate the relevant person, partnership or corporation for the non-compliance of anti-trust laws. It is a serious issues that domain name registration is more or less like gambling game (lottery and betting) that whoever come first will be served first. There are various issues like registration issues that most registries implement first come, first served policy. Therefore whoever comes first will get the domain name. Since, no other searches are undertaken to check whether the domain name is in use for some other purpose, such as a trade name etc. Hence these practices are providing another incentive to cybersquatters to register the trademark before the rightful owner of the mark and then offer it later at substantial fee. Cybersquatters register domain names containing popular trademarked, with a view to making an illegal profit from them or to misuse it, whereas in typosquatting, typosquatters register domain names using misspelled

words or large popular websites, with malicious intent leading towards unfair trade practices. Another issue in domain name is jurisdiction issue; the whole trouble with internet jurisdiction is the presence of multiple parties in various parts of the world who have only a virtual nexus with each other. If a dispute arise between two parties there is confusion as to which country law should be applied: Firstly, Choice of Forum (which country's courts should have jurisdiction to try the dispute), Secondly, Choice of Law (which country's laws should be applied to resolve the dispute, as the issues can be that the country may not have any law to deal with that particular kind of issue i.e. absence of law) and lastly, whether any foreign judgment obtained abroad might be enforceable in the home country or not (Judgment Enforcement). Another issue to know it before registering by the registrar, that is quite complex as the volume of new registration of domain name is 50,000 to 100,000 per week. Also it Uniform Resource Locator (URL) is case sensitive matter, they cannot identify domain name registration leading towards unfair trade practices while registering 50,000 to 100,000 domain name per week. Domain name disputes is taking the shape of unfair trade practices due to bad intention of cybersquatters to gain out of well known trademarks, they are registering the trademark of another with bad faith and creating the consumer confusions. On the basis of my research finding the hypothesis is hence proved that the existing legal and policy framework of the domain name disputes is not adequate to address the issues of unfair trade practices in domain name disputes. Hence countries are suggested to unite together to bring uniform law to deal with this particular kind of issues.

Suggestions

After analyzing various approaches relating to domain name disputes, it is clear that two methods have developed in the form of dispute resolution by the regulatory authorities and the formal legal or court procedure. The majority of authorities has either implemented the UDRP

or has implemented one closely modeled on it. While some countries have implemented cybersquatting specific legislation, others have reacted rather indolently by simply applying trademark laws inappropriately. Some of the suggestions to reform the law to tackle the problem of domain name disputes are:

1. The most contentious issues in domain name are with its registration that most registries implement first come, first served policy. The cost of registering a domain is extremely low in comparison with the economic damages that it may cause, or the cost of litigation. Domain names are fairly easy to register, the general practice of registries is to check the availability of second level domain (SLD)/ top level domain (TLD) combination and ensure no duplicate domain names are allocated, unlike trademarks registries who conduct a full examination process to determine possible conflicts. Thus, it is possible for a third party who has no connection at all with a trademark to register it as a second level domain and deprive the rightful owner of the mark the opportunity to register the mark in the same second level domain. And also the volume of new registration of domain name is 50,000 to 100,000 per week; there are more chances of domain name disputes. Domain name can be held by single person; therefore whoever comes first will get the domain name. Since, no other searches are undertaken to check whether the domain name is in use for some other purpose, such as a trade name etc. In order to curb this menace by making the domain name registration more systematic can help in reducing domain name dispute. The authority should conduct full examination process by asking the applicant to show organizational paper (like article of incorporation or some genuine certificate) indicating a putative right to use the proposed domain name, thereafter granting the registration on a first-come first-served basis. The law should also make the registrar liable for domain name disputes. This way the registrar will be more diligent while registering a domain name. Certain observation

period should be kept for example a year within that period if any dispute of arises, at that time the domain name should be kept pending until the final verdict of the dispute.

2. Trademark is confine to a particular boundary whereas the domain name is in virtual world which knows no boundary. Trademark is administered by a public governmental authority on territorial (either national or regional) basis which gives right on the part of trademark holder that may be exercised within a territory whereas domain name is usually administered by non-governmental organization (Neutronics) without any functional limitation, domain name are registered on first come first serve basis and offer unique, global presence on the internet. However, trademark and domain name works in two different fields. As there is no interconnection between the Trademark and Domain Names, there has to be two different and specific laws to deal with Trademark and Domain Name Disputes. This can be done by bringing the domain name disputes under unfair trade practices law. The domain name disputes are taking the shape of unfair trade practices because cybersquatters with bad faith intention is registering the well known trademark to make gain out of it and creating the consumer confusion by making them believe that particular goods and services belongs to that very well known company.
3. The court system and regulatory system should go hand in hand and supplement each other in dealing with these disputes. It is important to have uniformity in laws dealing with the complexities of domain name and trademark issues.
4. Improving current alternative disputes resolution proceeding are key to achieve positive results. As it gives parties in dispute the opportunity to work through disputed issues with the help of a neutral third party. It is generally faster and less expensive than going to court. When used appropriately, it can save a lot of time by allowing resolution in weeks or months, compared to court, which can take years, Save a lot of

money, including fees for lawyers and experts, and work time lost, put the parties in control (instead of their lawyers or the court) by giving them an opportunity to tell their side of the story and have a say in the final decision. It focus on the issues that are important to the people in dispute instead of just their legal rights and obligations help the people involved come up with flexible and creative options by exploring what each of them wants to achieve and reduce stress from court appearances, time and cost.

5. There have to be criminal liabilities for unfair trade practices in domain name. As cyber squatters with bad intention to make profit out of it or to degrade the reputation of well known trademark are registering the domain which contains typographical error. Sometimes cybersquatters registered a domain name which leads to porn sites attracting criminal punishment.

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