

All Things IP



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Domain Protection under INDRP:

With the rapid growth of internet and dilution of geographical boundaries, marketing of products and services through websites and domain names are becoming an increasingly important mode of brand building and channels of commerce for trademark owners. Domain name/website names forms an essential part of the trademark assets and represent the virtual address of an organisation in the internet space in relation to its brand that is the subject matter of such domain name.

The domain names indicating source from Indian jurisdiction is “.IN”. For example, domain name of the official intellectual property website owned by Indian Government is “www.ipindia.nic.in”. In the recent years India has witnessed various cases of people unlawfully holding websites containing trademark of others, commonly referred to as “cybersquatting”, in relation to the “.IN” domain names. The Indian Domain Dispute Resolution Policy (INDRP) was formulated and is administered by the National Internet Exchange of India (NIXI), for filing of any cybersquatting complaints pertaining to “.IN” domain names held by any cyber squatter and the decisions based on the outcome of such proceedings are binding and enforceable under the provisions of the Arbitration and Conciliation Act, 1996 as arbitral awards.

In order to succeed in a complaint under the INDRP the complainant being the trademark owner has to prove the existence of all the three following essential elements in respect of the .IN domain under dispute:

- a. the domain name of the Respondent is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- b. the Respondent has no rights or legitimate interests in respect of the domain name; and
- c. the domain name has been registered and is being used in bad faith

On receiving complaint from the Complainant, NIXI shall appoint an arbitrator out of the list of arbitrators maintained by the registry, who shall conduct the arbitration proceedings in accordance with the Arbitration & Conciliation Act 1996 as amended from time to time and also in accordance with the INDRP and the Rules made thereunder. The arbitrator shall forward its decision on the complaint to NIXI within sixty calendar days of commencement of the arbitration proceedings.

Under the INDRP, the remedies available to a complainant pursuant to any proceeding before an arbitrator shall be the following:

- (i) cancellation of the domain name held by a third party or
- (ii) the transfer of the disputed domain name registration to the complainant.
- (iii) Costs as may be deemed fit may also be awarded by the Arbitrator

INDRP has been very effective in disposing of cases pertaining to domain name disputes including those owned by well-known personalities, public figures and world-renowned brand owners. Some of the notable domain name decisions under the INDRP include well-known brands such as adityabirla.in, subway.in, Instagram.co.in, ibmglobal.in, vogueindia.co.in etc

In India it is common practice for brand owners to engage third parties as domain name registration service providers who sometimes may wrongfully hold back the domain name and may also get their name entered as the “Registrant” (owner) of the domain name in the “whois” data. An INDRP action may be pursued, in those peculiar instances against such “Registrants”. However, in such cases it may become difficult for the complainant to establish



the third essential element of the INDRP pertaining to- “the Registrant's domain name has been registered in bad faith”, as the said domain name has been registered under the behest or express authorisation of the complainant itself. Accordingly, in such instances it is important for brand owners and complainants to carefully strategize and record the various correspondences exchanged with such “cybersquatters” that would go a long way in establishing “bad faith” of the respondent in the registration and usage of the domain name, which will eventually help the complainant in a successful INDRP action.

We at Eshwars regularly advise the clients on domain name protection. For more details, please send an email to saisunder@eshwars.com.