

*Legal Issues*  
*in*  
*Protection and Enforcement of Domain Names under IN Dispute Resolution*  
*Policy (INDRP)*

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## INTRODUCTION

- ❖ Domain names are registered on a “first come, first served” basis
- ❖ Automated registration process
- ❖ No oversight or assessment of the legitimacy of domain name
- ❖ Country specific dispute resolution policy for ccTLD (country code top-level domains) disputes
- ❖ Position before establishment of .IN Registry in India- Cybersquatting and domain name disputes not explicitly addressed in any legislation in India
- ❖ IN Dispute Resolution Policy (INDRP) formulated by .IN Registry [established by the National Internet Exchange of India (NIXI)]

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## LIMITED SCOPE OF INDRP

- ❖ Para 1 – Purpose – *“This .IN Domain Name Dispute Resolution Policy (the " Policy") sets out the legal framework for resolution of dispute(s) between a domain name Registrant and the Complainant, arising out of the registration and use of an .IN or .Bharat (Available in all Indian Languages) Domain Name.”*
- ❖ WIPO’s Final Report on Internet Domain Name Process –
  - *“First, the scope of the procedure is limited so that it is available only in respect of deliberate, bad faith, abusive, domain name registrations or “cybersquatting” and is not applicable to disputes between parties with competing rights acting in good faith”.*
- ❖ Relevant courts (and not INDRP proceedings) appropriate forum for issues of infringement, priority of rights, damages, etc.
  - ***Citi Corp. & Anr. v. Todi Investors & Anr.*** [2006 (33) PTC 631 (Del)]

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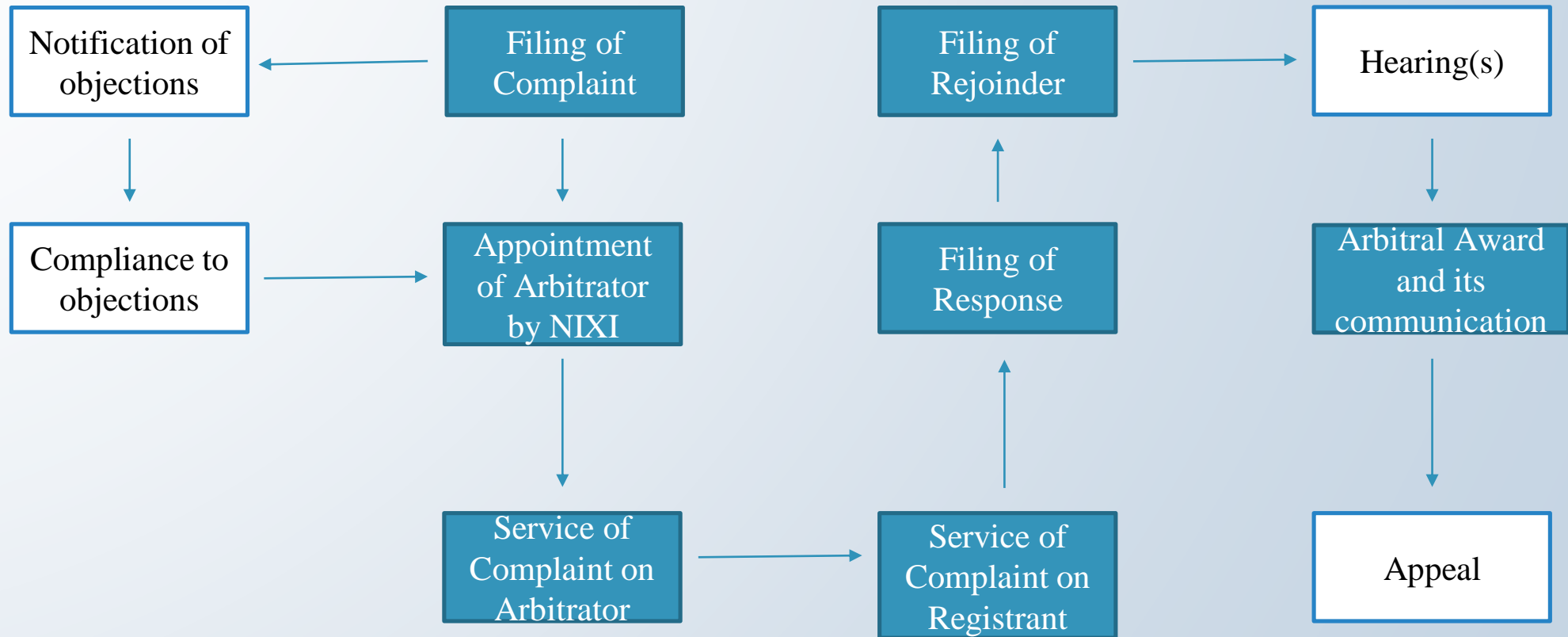
## REMEDIES UNDER INDRP

❖ Para 10 – Remedies – *“The remedies available to a Complainant pursuant to any proceeding before an Arbitrator shall be limited to requiring the cancellation of the Registrant's domain name or the transfer of the Registrant's domain name registration to the Complainant. Costs as may be deemed fit may also be awarded by the Arbitrator.”*

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- *Stephen Koenig v. Arbitrator, National Internet Exchange of India (NIXI) & Anr.* [2015 (64) PTC 406 (Del)]
- *Lens.com, Inc. v. Ju J Friend International* [2018 (3) ArbLR 46 (Delhi)]

# PROCEDURE



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## GROUND S UNDER INDRP

- ❖ Para 4 - *“Types of Disputes: Any person who considers that a registered domain name conflicts with his legitimate rights or interests may file a complaint to the .IN Registry on the following **premises**:*
  - (i) the Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights; **and***
  - (ii) the Registrant has no rights or legitimate interests in respect of the domain name; and*
  - (iii) the Registrant's domain name has been registered **or** is being used in bad faith.”*

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- *Stephen Koenig v. Arbitrator, National Internet Exchange of India (NIXI) & Anr. [2015 (64) PTC 406 (Del)]*

## LEGITIMATE INTEREST

- ❖ Para 6 - Registrant's rights and Legitimate Interests in the Domain Name- *“Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purposes of Clause 4(b):*
  - (a) *before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;*
  - (b) *the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or*

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## LEGITIMATE INTEREST (Contd.)

*(c) the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”*

- *FDC Limited v. Christian Schmidt* [INDRP/913, decided on November 6, 2017]

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- *Sazerac Brands, LLC v. Dean Chandler* [INDRP/1243, decided on September 23, 2020]



## BAD FAITH

❖ Para 7 - Evidence of Registration and use of Domain Name in Bad Faith – *“The following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:*

(a) *circumstances indicating that the 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 bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or*

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## BAD FAITH (Contd.)

- (b) the 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 the Registrant has engaged in a pattern of such conduct; or*
- (c) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.”*

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- ***Tata Motors Limited v. Amit Badyani*** [INDRP/1020, decided on October 16, 2018]
- ***RPS Infrastructure Limited v Jayanta Barua*** [INDRP/149, decided on May 8, 2010]

## REVERSE DOMAIN NAME HIGH JACKING

- ❖ The Uniform Domain-Name Dispute-Resolution Policy (UDRP)
  - *"Reverse Domain Name Hijacking means using the [UDRP] in bad faith to attempt to deprive a registered domain-name holder of a domain name."*
- ❖ WIPO Panel Views on Selected UDRP Questions, Second Edition:
  - *"To establish Reverse Domain Name Hijacking, a respondent would typically need to show knowledge on the part of the complainant of the complainant's lack of relevant trademark rights, or of the respondent's rights or legitimate interests in, or lack of bad faith concerning, the disputed domain name."*

## REVERSE DOMAIN NAME HIGH JACKING (Contd.)

- *“Evidence of harassment or similar conduct by the complainant in the face of such knowledge (e.g., in previously brought proceedings found by competent authorities to be groundless, or through repeated cease and desist communications) may also constitute a basis for a finding of abuse of process against a complainant filing under the UDRP in such circumstances.”*

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- ***Tickets Worldwide LLP v. India Portals*** [INDRP/1187, decided on March 17, 2020]
- ***Mr. Shevaldas C. Raghani v. Mr. Stephen Koeing*** [INDRP/008, decided on, May 3, 2006]

## RECENT AMENDMENTS IN THE INDRP

With effect from – October 1, 2020

- ❖ Electronic filing allowed (but hard copy needed for Registrant)
- ❖ Limiting the size of pleadings (5000-word) and annexures (100 pages)
- ❖ Electronic payment allowed
- ❖ Implementation of cost not to be supervised by .IN Registry
- ❖ Domain transfer when not allowed (90 days)
- ❖ Limitation of hearings
- ❖ Arbitrators disallowed to represent parties in INDRP matters

# THANK YOU!

## Questions?

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