

Legal Issues
In
Domain Name Disputes, Cybersquatting and IP in Fonts & Characters,
Logographs & Ideographs

Legal Issue - I

Whether Use of Surnames and Family Names as Domain Names Manifest Bad Faith Registrations?

Introduction

❖ Domain Name:

- **WIPO:** A domain name is the human-friendly address of a computer that is usually in a form that is easy to remember or to identify, such as www.wipo.int.
- *People Interactive (India) Pvt. Ltd. v. Vivek Pahwa & Ors.* [Notice of Motion No. 1687 of 2015 in Suit No. 846 of 2015 (Bom)]

“..it [domain name] is the Internet equivalent of a physical or terrestrial address.”

❖ Registration of Common Surnames or Family Names as Domain Names:

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Provided such registrations are made in good faith and bear a legitimate interest with no intent to piggyback on the reputation or goodwill of the corresponding trademark, the registrant’s ‘Right to Use’ subsist and are not excluded from offering services, including but not limited to websites although websites are the predominant place of operation for domain names.

Modus Operandi of UDRP and Relevant Case Laws

- ❖ **Modus Operandi, UDRP:** For any **Uniform Domain Name Dispute Resolution Policy (UDRP)** complaint to succeed, the Complainant must establish the following three **cumulative** criteria under Paragraph 4(a):
 - (i) the domain name is **identical or confusingly similar to a trademark or service mark** in which the complainant has rights; and
 - (ii) the registrant of the domain name has no **rights or legitimate interests** in respect of the domain name; and
 - (iii) the domain name has been registered and is being used in **bad faith**.

- ❖ ***Modefine S.A. v. A.R. Mani* [WIPO Case No. D2001-0537 (July 20, 2001)] - <armani.com>**

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“Its apparent belief that simply because it is the undisputed owner of a world famous name it can use the ICANN procedure to dispossess summarily a third party of what is a combination of his initials and surname, which...he has used in a bona fide manner since the early 1990s, is simply wrong...the Respondent has a right to and/or a legitimate interest in the domain name by virtue of the domain name corresponding to the Respondent’s first two initials and his surname... the Complainant has failed to show ...bad faith ...The Panel finds this Complaint to be an abuse of the administrative proceeding.”

Relevant Case Laws (Contd.)

❖ *Marden Group B.V. v. Tucows.com.co* [WIPO Case No. D2011-1061 (August 24, 2011)] - <marden.com>

“Knowledge of a complainant’s trade marks (or perhaps use of a term in a trade mark sense) is usually a requirement for bad faith registration...There must also be intent to take unfair advantage of that trade mark use. In order to succeed the Complainant would still bear the burden of showing that the Domain Name has been used to take advantage of the trade mark rights of the Complainant. Given that in the present case there is no evidence that the Complainant even existed at the relevant time, the Complainant has failed to carry that burden.” [Emphasis supplied]

❖ *Olsen Holding GmbH of Hamburg v. Domain Admin* [WIPO Case No. D2018-0568 (May 15, 2018)] - <olsen.com>

5 *“...it is a matter of judicial notice that “Olsen” is a common surname ...and this registration was an early registration which has been extant for over 20 years. The Complainant has not shown on the balance of probabilities or provided any evidence that it was targeted by the registration and that this was not just a registration of a common surname for sale to anyone with an interest in that surname (and not just the Complainant or its competitors), in which case not using it and offering it for sale for a sum substantially above the out of pocket costs of registration of the Domain Name would not be in contravention of the Policy and would not be bad faith...”* [Emphasis supplied]

Legal Issue - II

**Are there Sufficient Legal Safeguards against Celebrity Name
Cybersquatting?**

Introduction and Relevant Provisions

❖ **Cybersquatting:**

- Also known as, **Domain Squatting.**
- Abusive and malicious Domain Name registrations or purchases solely to reap off benefits of the well-known trademark holders by ransoming the domain name back to them (trademark holder) or by using it to retract business from such a trademark holder to the abusive Domain.

❖ **Section 1.5.2, WIPO Jurisprudential Overview 3.0:**

- The UDRP does not explicitly provide standing for personal names which are not registered or otherwise protected as trademarks. In situations, however, where a personal name is being used as a trademark-like identifier in trade or commerce, the complainant may be able to establish unregistered or common law rights in that name for purposes of standing to file a UDRP case where the name in question is used in commerce as a distinctive identifier of the complainant's goods or services.
- Merely having a famous name (such as a businessperson or cultural leader who has not demonstrated use of their personal name in a trademark/source-identifying sense) or making broad unsupported assertions regarding the use of such name in trade or commerce, would not likely demonstrate unregistered or common law rights for purposes of standing to file a UDRP complaint.

Relevant Case Laws

- ❖ *Julia Fiona Roberts v. Russell Boyd* [WIPO Case No. D2000-0210 (May 29, 2000)] – <juliaroberts.com >

“...The Respondent admits that he has registered other domain names including several famous movie and sports stars... The Panel concludes (a) that the domain name <juliaroberts.com> is **identical to Complainant’s common law trademark** in her name "Julia Roberts," (b) that Respondent has **no rights or legitimate interest in the domain name** and (c) that Respondent registered and **used the domain name in bad faith**. Therefore, pursuant to paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <juliaroberts.com> be transferred to Complainant Julia Fiona Roberts.”
[Emphasis supplied]

- ❖ *Arun Jaitley v. Network Solutions Private Limited and Ors.* [AIR 2011 SCC Online Del 2660]

8 “[Cybersquatting is]the act of registering or utilising a domain name with the malicious goal of profiting from someone else's property. **The cyber squatter then offers to sell the domain at an inflated price to the individual or corporation who holds a trademark in the name**...Some cyber squatters make nasty comments about the person who wants to acquire the domain from them in order to force the innocent person to do so. As a result, it is necessary to secure domain names so that distinctive names of firms and persons do not fall into the hands of those who are uninterested in those names and have (Contd.)

Relevant Case Laws (Contd.)

- ❖ ***Arun Jaitley v. Network Solutions Private Limited and Ors.*** [AIR 2011 SCC Online Del 2660]
.... obtained them simply because they are more familiar with computer skills and internet usage. To put it another way, in order to combat cybersquatting, trafficking, or dealing in domain names or marks, trademark law has been expanded to include the internet, allowing domain names to be protected in the same way that trademarks are.” [Emphasis supplied]

- ❖ ***Madonna Ciccone, p/k/a Madonna v. Dan Parisi*** [WIPO Case No. D2000-0847 (Oct. 12, 2000)], - <madonna.com>
“[We find]...that name was selected and used by Respondent ...for commercial gain...by trading on the fame of Complainant’s mark. We see no other plausible explanation for Respondent’s conduct and conclude that use which intentionally trades on the fame of another can not constitute a "bona fide" offering of goods or services. To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy...The disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights; Respondent lacks rights or legitimate interests in the domain name; and the domain name has been registered and used in bad faith.” [Emphasis supplied]

Legal Issue - III

Are Typefaces and Fonts Protected under Copyright Law?

Relevant Provisions

- ❖ **Section 2 (c) of The Copyright Act, 1957:** “*artistic work*” means,
 - (i) *a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality;*
 - (ii) ¹*[work of architecture]; and*
 - (iii) *any other work of artistic craftsmanship;*

- ❖ **Section 45 (1) of The Copyright Act, 1957:**

The author or publisher of, or the owner of or other person interested in the copyright in, any work may make an application in the prescribed form accompanied by the prescribed fee to the Registrar of Copyrights for entering particulars of the work in the Register of Copyrights:

[Provided that in respect of an artistic work ..., the application shall include a statement to that effect and shall be accompanied by a certificate from the Registrar of Trade Marks referred to in section 4 of the Trade and Merchandise Marks Act, 1958 (43 of 1958), to the effect that no trade mark identical with or deceptively similar to such artistic work has been registered under that Act in the name of, or that no application has been made under that Act for such registration by, any person other than the applicant.”] [Emphasis supplied]

Relevant Provisions and Definitions

❖ Section 15 (2) of The Copyright Act, 1957:

*(2) “Copyright in any design, which is capable of being registered under the¹ [***] Designs Act, 1911 (2 of 1911)² , but which has not been so registered, shall cease as soon as any article to which the design has been applied has been reproduced more than fifty times by an industrial process by the owner of the copyright, or, with his licence, by any other person.”*

❖ **Typefaces:** A “typeface” is a set of letters, numbers and other symbols whose forms are related by repeating certain design elements that are consistently applied (sometimes called glyphs), used to compose text or other combination of characters. (Times New Roman, Helvetica)

❖ **Glyphs:** A “typeface” is a specific design of characters, such as numerals and letters.

❖ **Fonts:** The multiple weights and sizes of these characters within a typeface. (Helvetica Regular, Helvetica Italic, Helvetica Bold).

Aananda Expanded v. Unknown [2002 (24) PTC 427 CB]

- *“Fonts or typefaces are not classified as works in which copyright subsists...Vide provisions of Section 16, it is clear that there is no copyright other than that specifically provided in the Act. Thus there is no common law copyright. A work has to be clearly within the definition of works protected in the Act to attract copyright.” [Emphasis supplied]*
- *“Thus while we see that principle of 'ejusdem generis' limits the meaning of "any other work of artistic craftsmanship", ... In the absence of such specific provision in the Indian law, following the principle of ejusdem generis, it is concluded that typefaces are not included in the genre of artistic work as defined in Section 2(c), especially in view of Section 16 of the Indian Copyright Act.” [Emphasis supplied]*
- *“This makes it clear that traditional copyright law was not extended to typefaces and Legislature intervened to provide protection with express provisions. While providing such specific rights, Legislature also provides specific exceptions as shown above. Without these exceptions, the balance of authors' rights and public interest which copyright system maintains will be affected. For example, if typeface design is registered as artistic work it will enjoy the same rights and period of protection as artistic works. The British law shows Legislature keeps this balance in mind when rights are granted. Unless such specific provisions exist, a work does not get protection under copyright. This is clear from section 16 of our Act also.”*

THANK YOU!

Questions?

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