Domain name and Trademark rights in India

Domain names are integral parts of businesses having any online commercial activity. Since the commercial activities on the Internet are increasing every day, the usefulness and purpose of domain names cannot be ignored. These days, domain names are not just names of websites of different entities, but serve as business identifiers and promoters. Some may refer to domain names as the online equivalents of trademarks. However, views differ on if domain names should be given the same treatment under law as trademarks.

**Domain name:**

Domain names are user friendly and easy to remember addresses that internet surfers use to locate any website. A domain name, quite simply, can be referred to as an ‘online identity’ of one’s business. Technically speaking, because the Internet is based on IP addresses, every web server requires a **Domain Name System (DNS)** server to translate domain names into IP addresses. Each website has a domain name that serves as an address, which is used to access the website. Domain names are usually [xyz] followed by .com; .org; .gov; .net; .in; etc.

The Bombay High Court in *People Interactive (India) Pvt. Ltd. vs. Vivek Pahwa & Ors*¹ held, “it [domain name] is the Internet equivalent of a physical or terrestrial address. It directs a user to a particular part of the Web where a domain name registrant stores and displays his information, and offers his services.”

**Trademarks:**

A trademark is “a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours.”²

A mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any such combinations.³

The registered proprietor of a trademark obtains the right to exclusively use the mark in respect of his goods and services that serve to distinguish his products from those of his competitors in trade. Trademark also enable consumers to associate the goods/services they want to avail with a distinctive mark.

Therefore, in essence, a trademark and domain name serve the same function as “identifiers.” But, unlike trademarks, the process of acquiring a domain name involves no examination as to whether the domain name is distinctive or capable of distinguishing itself. Descriptive words or even names of people can be registered as domain names. Some businesses also use their registered trademarks as domain names. On the other hand, once a domain name

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¹ (2016) 6 AIR Bom R 275
² Section 2(zb) of the Trademarks Act, 1999.
³ Section 2(m) of the Trademarks Act, 1999.
has been chosen, the holder can also apply to obtain trademark protection in order to prevent others from using the name. In the absence of a specific law governing domain names, Trademark Law is applied for the same.

**Domain names as trademarks**

Domain names can be registered as trademarks upon fulfilling all the conditions that are required to be registered as a trademark.

Hence, any domain name which is **unique, capable of identifying itself and distinguishing its goods and services from those of others and acts as a reliable source identifier of concerned goods and services on the internet**, may be registered as a trademark.

A dispute had arisen before the Supreme Court in *Satyam Infoway Ltd. vs. Siffynet Solutions*⁴, as to whether domain names are recognizable as intellectual property, such as trademarks. The court held, “The original role of a domain name was no doubt to provide an address for computers on the internet. But the internet has developed from a mere means of communication to a mode of carrying on commercial activity. With the increase of commercial activity on the internet, a domain name is also used as a business identifier. Therefore, the domain name not only serves as an address for internet communication but also identifies the specific internet site, and distinguishes specific businesses or services of different companies. Consequently, a domain name as an address must, of necessity, be peculiar and unique and where a domain name is used in connection with a business, the value of maintaining an exclusive identity becomes critical. As more and more commercial enterprises trade or advertise their presence on the web, domain names have become more and more valuable and the potential for dispute is high.”

In a more recent judgment, in 2017, the Calcutta High Court in *Rajat Agarwal vs. Spartan Online*⁵, citing the *Satyam case* held that a domain name is chosen as “an instrument of commercial enterprise not only because it facilitates the ability of consumers to navigate the Internet to find websites they are looking for, but also at the same time, serves to identify and distinguish the business itself, or its goods or services, and to specify its corresponding Internet location.” The Court went on to state that a domain name must necessarily be peculiar and unique to the business, as maintaining an exclusive identity was critical. However, unlike the *Satyam case*, the court did not restrain the Defendants from the use of spartanpoker.com observing that the Plaintiffs only registered the domain name but did not spend on developing the web page, trade dress and designing of the mark and related expenses for its registration.

**Protection of domain names in India**

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⁴ (2004) 6 SCC 145
⁵ AIR 2017 (NOC 846) 287
The domain names as trademarks or service marks are registered and protected at the entire global level supremely by only one organization which is ICANN [Internet Corporation for Assigned Names and Numbers] along with the national and international protection under the directly concerned national Trademark Law and diverse International Trademark Treaties of the world.

In India, domain names may be granted protection as a trademark or service mark under the provisions of Trademarks Act, 1999 (hereinafter referred to as “the Act”), provided that the domain name fulfils all requirements to be properly registered under the Act (as enumerated above). Once registered, the registered proprietor of a domain name will have all those legitimate rights and authorities which are commonly availed by the owners of registered trademarks or services marks in India. This also includes the right to sue for infringement or passing off.

a. **For infringement**: Any person violating a domain name which is registered as a valid and subsisting trademark under the Indian Trademark Law will be held liable for infringement of Trademark under section 29 of the Act.

b. **For passing off**: An owner of a trademark who has not registered his mark is also entitled to protection of his mark if he is the prior user, his mark has acquired distinctiveness and there is misrepresentation by anyone else with regard to his goods which is likely to deceive the relevant public.

The Bombay High Court in *People Interactive (India) Pvt. Ltd. v Vivek Pahwa & Ors.*, dealt with a passing off dispute between shaadi.com and secondshaadi.com. The court ruled in favour of the defendants and held that the word “shaadi” is generic and commonly descriptive. The court held that acquiring a secondary meaning would necessarily imply that the word has transcended its original connotation and references exclusively in the public mind the particular holder of the mark; the primary meaning must have been lost. This was not the case here, said the court, as the only primary meaning was the destination on the internet.

In 2018, in *Bigtree Entertainment v Brain Seed Sportainment*, the Delhi High Court recently denied the Plaintiffs, proprietors and owners of the website bookmyshow.com, an interim injunction against the Defendant’s use of the domain bookmypsports.com. The court, considering that prefix BOOKMY of the Plaintiff’s trademark BOOKMYSHOW was descriptive, **not an arbitrary** coupling of words and the Plaintiff’s **failure to prove that “BOOKMY” has acquired distinctiveness or secondary meaning**, dismissed the application for interim injunction filed by the Plaintiffs.

Hence, it is abundantly clear that domain names serve as important elements in trade and any commercial activity on the internet. Especially, for those businesses, who work solely on the online platform, protection of their domain names is of paramount importance. Since, domain names transcend geographical boundaries, a harmonious international law on

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7 CS(COMM) 327/2016
protection of domain names is essential, in addition to the protection offered by Trademark Law in various jurisdictions individually.

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