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A New Front in Infringement War Cyber Squatting

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ABSTRACT

The Internet is the most powerful network as it has the connectivity capacity at a towering speed and the main application of the Internet is e-commerce. As Internet grows, several legal issues arise. A business name is identified through a domain name in the Internet, which is generally the trademark of an existing business. A domain name is part of the address, which is assigned to each and every service on the Internet. An illegal usage of this domain name is called as Cybersquatting.

This paper has varied aims, which have been discussed separately in several heads: Firstly, the main aim of this paper is to analyze the infringement in the internet realm; Secondly, to show the inter-relation between the IP law (trademark) and the Cybersquatting; Thirdly, what are the various classifications of cybersquatting; Fourthly, what is the governing law and the legal pattern of the cybersquatting; Fifthly, what is the policy adopted for resolving cybersquatting; Sixthly, what are the three essential ingredients and the procedure of mandatory proceedings; Lastly it ends with the suggestions in the legal regime and the conclusion.

I. INTRODUCTION

As Development in the technology not just broadens the scientific scope but it also poses various challenges to the legal system. The existing legal framework should also evolve to tackle the various obstacles, which are coming in the almost all the categories. It requires new definitions, interpretations and understandings to strengthen the legal regime. As Internet grows, several legal issues arise. One of the main significant matters concerning today is that of cyber squatting, which is a cyber crime. The practice of this cyber squatting came into the limelight when most of the businesses across the Internet are not famous. Cybersquatting is the whirl in the field of domain name related disputes.

Cybersquatting has taken the front row seats in intellectual property right matters. Generally, companies obtain the domain names, which are similar to their establishment trademarks so that it will help the public to identify the company even without any physical connection. Both the domain names and the trademark of the establishment are generally coupled to each

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other. Domain names are generally nothing but these are the forms of address in the Internet, these will enable the users to track the relevant website. Every resource on the internet like a web page or a file that has any information has its own specific address known as Uniform Resource Locator (URL). A domain name is part of this address, which is assigned to each and every service on the internet.

“Cybersquatting is the internet version of a land grab Cyber squatters register well-known brand names as Internet domain names in order to force the rightful owner of the marks to pay for the right to engage in electronic commerce under their own name.”² The current legal framework regarding the domain names is The National Trademark law and Internet Corporation for Assigned Names and Numbers (ICANN) Uniform Dispute Resolution Policy (UDRP)³. These can be registered by approaching to any Internet Corporation for Assigned Names and Numbers (ICANN) accredited registrar.

It is a most pivotal type of domain dispute prevailing around the world. Using a domain name with a bad intention to get the valuable premium and consideration from the goodwill of a company is prohibited under the law in all the jurisdictions across the world. Furthermore, the domain names are classified as a different class in intellectual property rights and should enjoy the protection equal to that of a trademark.⁴

II. TRADEMARKS AND CYBERSQUATTING

Trademark law has made a head way to certify a product or a service as bona fide. The trademark which is allotted, it helps the consumer in identifying the source and the benefits even extends to the owner by providing protection from trademark infringement. Trademarks are the valuable assets to the company as it acts as a medium of recognition of the products and services in the market.

In order to fulfill the trademark infringement there should exist a trade and the mark, which is used, should be for similar or identical goods or services.⁵ A registered domain name, which consists of a trademark for a non-commercial website cannot be considered as an

²*InterstellarStarship Services, Ltd v Epix, Inc*, 304 F.3d 936, 946 (9th Cir. 2002); See also *Harrods Ltd v Sixty Internet Domain Names* 302 F.3d 214, 219-20, 238 (4th Cir. 2002).

³ *Uniform Domain Name Dispute Resolution Policy*, hereinafter UDRP policy, INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS, (June 16, 2020), <https://www.icann.org/resources/pages/policy-2012-02-25-en>.

⁴ *Rediff v. Cyberbooth*, A.I.R. 2000 Bom 27.

⁵ Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, WORLD INTELLECTUALPROPERTYORGANIZATION, <http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/nice.pdf> [hereafter WIPO NICE classification].

infringement.⁶ Several actions can be taken for blurring,⁷ tarnishing⁸ or disparaging the trademark⁹, which mainly focuses on the value or the good will of the trademark¹⁰. Based upon the conduct of the defendant by using a similar trade name¹¹ if the defendant is misappropriating the trade reputation of the complainant¹² then according to the national laws a claim can be brought alleging passing of or unfair competition. Even though such conduct did not cause any damage to the goodwill of the trade mark but likely to cause damage to the goodwill of the trademark and action can be brought¹³.

Cybersquatting cannot be contemplated as a direct act of a trademark infringement¹⁴ because there exists no trade¹⁵. In spite of that, courts in numerous cases have held that an attempt to successive sale of the domain name will amount to commercial use¹⁶ and further any future use of the domain name will be considered as passing off¹⁷. Through the advertising-based model¹⁸, cybersquatting has even involved revenue in the process. A few jurisdictions have introduced specific legislations¹⁹ to deal with the issue in hand, but there is a need for a more efficient process.

III. CLASSIFICATION OF CYBERSQUATTING

Internet being the most conventional tool, company's haven been encircled by cyber squatters.²⁰ There are various forms of cybersquatting, which are as follows,

- **Typo squatting:**

Typo squatting defined as the intentional registration of misspellings of popular website

⁶ Panavision International LP v Toeppen 945 F Supp 1296 (CD Cal, 1996); Academy of Motion Picture Arts & Sciences v Network Solutions Inc 989 F Supp 1276, 1997 WL 810472 (CD Cal, 22 December 1997); Lockheed Martin Corp v Network Solutions Inc 985 F Supp 949 (CD Cal, 1997); Avnet Inc v Isoact Ltd [1998] F.S.R. 16.

⁷ Jaguar Cars Ltd v Skandrani 18 USPQ 2d 1626 (SD Fla, 1996) [Jaguar cars].

⁸ Chemical Corp of America v Anheuser-Bush Inc 306 F.2d 433 (5th Cir. 1962); Hasbro v Internet Entertainment Group Ltd 40 USPQ 2d (BNA) 1379 (1996).

⁹ *Deere & Co v MTD Products* 41 E.3d 39 (2nd Cir, 1994).

¹⁰ REED C, INTERNET LAW: TEXT AND MATERIALS 48 (London Butterworths 2000).

¹¹ Adidas v O'Neill, 122 I.L.R.M. 115(1983) ; Burford v Mowling 8 C.L.R. 212 (1908); Fisons v Godwin [1976] R.P.C. 653; Parkdale Pty Ltd v Buxu Pty Ltd 149 C.L.R. 191 (1982).

¹² Reed, *supra* note 9, at 50-51.

¹³ McCambridge Ltd v. Joseph Brennan Bakeries (2013) 1 I.L.R.M. 369; Miss World Ltd. & Ors v. Miss Ireland Beauty Pageant Ltd. & Ors (2004) 2 I.R. 394.

¹⁴ Reed, *supra* note 9, at 62.

¹⁵ M. MCDONAGH & M. O'DOWD, CYBER LAW IN IRELAND 266 (Wolters Kluwer 2015).

¹⁶ *Panavision International LP v Toeppen* 141 F.3d 1316 (9th Cir. 1998).

¹⁷ Marks & Spencer plc and others v. One in a Million Ltd (1998) F.S.R. 265; Bonnier Media Ltd v Smith (2002) S.C.L.R 977..

¹⁸ WILSON C, DOMAIN NAMES AND TRADE MARKS: AN UNCOMFORTABLE INTER RELATIONSHIP' in 3 LAW AND THE INTERNET 320 (Edwards L. & Waelde C eds., Oxford: Hart, 2009) [hereinafter Wilson].

¹⁹ Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d) (1999).

²⁰ *Cybersquatting*, LAWTEACHER (Feb. 2, 2018), <https://www.lawteacher.net/free-law-essays/business-law/business-law-law-essays.php?vref=1> [hereafter LawTeacher].

addresses in order to garner large amount of traffic.²¹ This is also called as URL hijacking. In this typo squatting, while registering the domain name, cyber squatters willfully make typographical errors while typing the website name or address. As a result when a user types any incorrect address, they will lead to a new website created by the cyber squatter. Typo squatters live on the fact that every internet user makes an typographical error from time to time and hence typo squatters purchase domains with typos in them that are similar to a business name and establish what are called phishing sites²².

An action can be brought²³ by the complainant for the typo squatting under the UDRP Policy for the same. A study in 2010 concluded that at least 938000 typo squatting domain names target the top 326 .com websites.²⁴

- **Reverse Domain name Hijacking:**

Reverse Domain name Hijacking²⁵ is also called as reverse cybersquatting. This happens when a trademark owner tries to secure a domain name by making false cybersquatting claims against a domain name's rightful owner through legal action or UDRP²⁶. These actions particularly intimidate the domain name owners to transfer the ownership of the domain name, specifically when the owners of the domain name belong to a small organization or else we are without financial resources to fight back. A judge has awarded Scott Day's DigiMedia.com LP \$103,717.66 because of failed reverse domain name hijacking attempt by Go For It Entertainment under 15 U.S.C. § 1114(2)(d)(iv).²⁷

- **Gripe Sites**

Gripe sites exists not just for criticism but also for the profit. These are the trickiest to handle because these does not come under the definition of using the trademark in ill will with intend of profit. In many a cases court decides that as it does not exist with intend to obtain profit it cannot be considered as an infringement. To succeed in the claim the complainant should prove all the elements mentioned under paragraph 4(a) of the UDRP policy. On the other

²¹ Mary McMahon, *What is Typosquatting?*, WISEGEEK (June 26, 2020), <https://www.wisegeek.com/what-is-typosquatting.htm#>.

²² *What is Cybersquatting? Examples and What You Need to Know*, UNIVERSITY HEARLD (Jan. 15, 2020), <https://www.universityherald.com/articles/77157/20200115/what-is-cybersquatting-examples-and-what-you-need-to-know.htm>[hereinafter University Hearld].

²³ UDRP policy, *Supra* note 2 paragraph 4(a)

²⁴ Tyler Moore & Benjamin Edelman, *Measuring the Perpetrators and Funders of Typosquatting*, SCHNEIR ON SECURITY, (Mar. 15, 2015, 6.13Am),<https://www.schneier.com/blog/archives/2010/03/typosquatting.html>

²⁵ Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en> at Paragraph 1 [hereafter UDRP Rules].

²⁶ *Reverse Domain name Hijacking*, DOMAINSHERPA, <http://www.domainsherpa.com/domain-name-dictionary/reverse-domain-name-hijacking/>.

²⁷ *GoForIt Entertainment, LLC, vs. Digimedia.com L.P* 750 F. Supp. 2d 712 (2010).

hand, the complainant can succeed in a defamation case in the court of law. US courts have held that even if the site is intended to cause economic damage, it is not a commercial use²⁸. Unless the other party is a competitor, the right to criticize is paramount.²⁹

- **Identity theft**

Identity theft can also be called as drop catcher. All the Internet domain name registrations have a specific expiry dates. Re-registration of the domain name is essential and if it does not get the re-registration then the domain name will be open for the public to buy. Cyber squatters use special and specific software, which identifies the expiration dates of the target domain names easily. These cyber squatters will register the domain name right after the expiry and link that with websites, which duplicate the websites of the previous domain, name owners which leads to misleading the visitors of the website and making them think that they are actually visiting the website of the previous domain name holder.³⁰

- **Name Jacking**

Name jacking refers to the registration of a domain name related with the name of an individual, generally well known public figures. Name-jackers will obtain profits through the web traffic related to the targeted individual. A personal name can obtain trademark if they fulfill the criteria of ‘distinctiveness’ under US law. If a personal name does not fulfill this criterion they cannot get the trademark registered on their personal name.

In 2006 a celebrity, Tom Cruise approached WIPO filing a case³¹ against Jeff Burgar, who created and registered the domain name ‘Tomcruise.com’ and has been using for more than ten years. In this case court has transferred the domain name to tom cruise according to Paragraph 4(1) and Rule 15 of the UDRP.

In the case of *Donald J. Trump v. Web-adviso*³². Donald Trump owns a distinct trademark of ‘TRUMP’. He approaches WIPO stating that when the company Web-adviso has registered four domain names, which infringed his trademark. The websites were registered in 2007 and in late 2010 when the trump lawyers requested the company to remove the websites and pay

²⁸ *Lamparello v. Falwell*, 420 F.3d 309 (4th Cir. 2005); *TMI, Inc. v. Maxwell*, 368 F.3d 433 (5th Cir. 2004); *Lucas Nursery and Landscaping, Inc. v. Grosse*, 359 F.3d 806 (6th Cir. 2004); *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002 (9th Cir. 2004); *Taubman Co. v. Webfeats*, 319 F.3d 770, 778 (6th Cir. 2003); *Taylor Building Corp. of Am. v. Benfield*, 507 F. Supp. 2d 832, 844 (S.D. Ohio 2007).

²⁹ *Utah Lighthouse Ministry, Inc. v. Discovery Computing Inc.*, 506 F. Supp. 2d 889, 895-98 (D. Utah 2007); *Northland Ins. Co. v. Blaylock*, 115 F. Supp. 2d 1108, 1120 (D.C. Minn. 2000); *Bihari v. Gross*, 119 F. Supp. 2d 309, 322 (S.D.N.Y. 2000); *Penn Warranty Corp. v. DiGiovanni*, 810 N.Y.S.2d 807, 817 (N.Y. Sup. Ct. 2005).

³⁰ Daniel Dimov & Rasa Juzenaite, *Latest Trends In Cybersquatting*, INFOSEC (Jan. 11, 2017), <https://resources.infosecinstitute.com/latest-trends-in-cybersquatting/#gref>.

³¹ Tom Cruise vs. Network Operations Center / Alberta Hot Rods, WIPO (Case No. D2006-0560).

³² WIPO (Case No. D2010-2220).

compensation of \$100,000 for each of the domain names, the Web-advso refused and they approached before WIPO. In 2011 the panel held that the respondents had a knowledge of the announcement made by the complainant in 2007 which proves the bad faith of the respondents and therefore the respondents exists no legitimate interest on the domain names and the panel ordered for the transfer of the domain names to the complainant. In addition to these cases, there are numerous cases³³ by administrative panel in which the panel has ordered to transfer the domain name if they satisfy the conditions under Paragraph 4(i) of UDRP policy.

The classification is not just limited to these but there are many other types of cybersquatting like. A domain can also be owned based on a five-day trial period, which can be refundable after the lapse of five days. But if the owner wishes to continue he can buy the domain name altogether, this is generally called as 'Domain Tasting'. Another popular way of making money through cybersquatting is domain parking, in this just by having a small site through advertising linked to a related or a similar domain name the owner will get money each and every time when a person clicks on that advertisement³⁴. Hit stealing is another method in which the user who visits the cyber squatted website is redirected to the website of the competitor. For the exchange of the commission on the sale of the product or services a webpage will be redirected which is used for the sale of the product or a service, this is called as 'Affiliate Marketing'³⁵.

An ounce of protection is always in need. Its easier to prevent rather than becoming the victim of a cyber squatter. In order to prevent from loosing the domain name, domain names should be registered as straight away, because generally cyber squatters register the domain names, which are recently searched for, with an intention to sell it to the original owner at a higher price. And registering all possible similar names to the trademark with multiple extensions from preventing them from squatters from buying is another necessary step that should be considered; moreover this is also called as preventive domain name.

IV. ICAAN POLICY: A NEW AMENDS AGAINST CYBER SQUATTING

The organization that is responsible for assigning Domain name is Internet Corporation for Assigned Names and Numbers (ICANN). It is a multi-stakeholder roup and a non-profit

³³ Paris Hilton v. Turvill Consultants (Case No. D2012-0965); Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com" (Case No. D2000-0847); The Jennifer Lopez Foundation v. Jeremiah Tieman, Jennifer Lopez Net, Jennifer Lopez, Vaca Systems LLC, (Case No. D2009-0057).

³⁴ LawTeacher, *Supra* note 19.

³⁵ Josaih Bussing, *Everything You Need to Know About Cybersquatting*, MOUNTAINTOP, (Oct.16, 2017), <https://mountaintopwebdesign.com/everything-need-know-cybersquatting/>.

organization. ICAAN performed the Internet Assigned Numbers Authority (IANA) Functions on behalf of the global Internet community since 1998. It has various responsibilities like maintenance of the registry of technical internet protocol parameters, the administration of certain responsibilities associated with the Internet Domain Name System (DNS) root zone and the assigning of Internet numbering resources³⁶.

It supervises the procedures of various databases related to the numerical spaces or the name spaces of the internet, ensuring the secure operations in the internet through the bylaws³⁷. It was created in September 17, 1998³⁸ and it formally came into effect on September 30, 1998 in California.

The primary principles of ICAAN's operations are to preserve the operational stability in the Internet and to promote competition in the Internet. ICAA wants to achieve a broad representation of the global Internet country. It's another main principle is to develop policies which are appropriate to its work and to achieve a consensus-based processes³⁹.

ICAAN validated the multi-stakeholder model of internet governance after the contrast between ICAAN and the United States Department of Commerce National Telecommunications and Information Administration (NTIA) expired⁴⁰. Privatization started in 2014 when NTIA asked ICANN to call for a global multi-stakeholder community, which consists of the private sector representatives, technical experts to improve the accountability mechanisms⁴¹.

ICANN meeting are conducted thrice a year in different regions, so that it gives an opportunity to for all the participants over the world. The meetings proffer various types of sessions in the form of workshops; open forums or else in the form of working meetings on

³⁶ Indian Minister of Electronics and Information Technology Reaffirms Support of Multi stake holder Model at ICANN's 57th Public Meeting, INTERNET CORPORATION OF ASSIGNED NAMES AND NUMBERS (Nov. 5, 2016), <https://www.icann.org/resources/press-material/release-2016-11-05-en>.

³⁷ Bylaws For Internet Corporation For Assigned Names And Numbers A California Nonprofit Public-Benefit Corporation, INTERNET CORPORATION OF ASSIGNED NAMES AND NUMBERS, <https://www.icann.org/resources/pages/governance/bylaws-en>.

³⁸ Gabe Battista, *A Brief Explanation of the Joint IANA and NSI Documents Defining the New Internet Corporation* by Jon Postel, INTERNET ARCHIVE (Sep.17, 1998), <https://web.archive.org/web/19990219132906/http://www.netsol.com:80/policy/icann/>.

³⁹ *Stewardship of IANA Functions Transitions to Global Internet Community as Contract with U.S. Government Ends*, INTERNET CORPORATION OF ASSIGNED NAMES AND NUMBERS, (Dec. 31, 1999), <https://www.icann.org/resources/unthemed-pages/icann-mou-1998-11-25-en>.

⁴⁰ *Stewardship of IANA Functions Transitions to Global Internet Community as Contract with U.S. Government Ends*, INTERNET CORPORATION OF ASSIGNED NAMES AND NUMBERS, (Oct. 1, 2016), <https://www.icann.org/news/announcement-2016-10-01-en>; See also, *Statement of Assistant Secretary Strickling on IANA Functions Contract*, NATIONAL TELECOMMUNICATIONS AND INFORMATION ADMINISTRATION, (Oct. 1, 2016), <https://www.ntia.doc.gov/press-release/2016/statement-assistant-secretary-strickling-iana-functions-contract>.

⁴¹ WIPO NICE Classification, *supra note 4*.

the implementation and the development of the Internet related policies. This meeting acts as a window for the exchange of ideas and enables a face-to-face discussion among the participants. Which helps in continuing the stable and secure operation in DNS⁴².

Even After the ICANN is free from the legal contract with the USA government, by virtue ICANN still remains at incorporated at US and it is still subjected to US laws. The US Congressional committees or else the Senate Committee can still summon any of the ICANN executives into the insights of the ICANN's actions or else it's schemes. The main turn around point is the power, which USA has on ICANN, is not available with any other government around the world. Thus, resulting in many challenges with respect to the positioning of ICANN as a transnational institution⁴³.

ICANN makes arrangements with various registries to conduct the top-level domains. Successively, these accredited registries⁴⁴ handle the material on the left side of the dot in the form of selling or else in providing domain name of the website or the email providers⁴⁵. Without the coordination the Internet would have collapsed and there are a good deal of prime and dominant things, which are not regulated by ICAA. ICAA's regulations and role doesn't cover the area of investigating of hackers or spammers or any of those who are accused of trademark violations. It doesn't monitor the content in the internet and does not proof read the content to remove any illegal material.

The UDRP was adopted by ICANN to deal with cybersquatting on generic top-level domains. Domain Name Registrations are often accepted with little screening or examination,⁴⁶ and there was a need to deal with any disputes that may arise in an efficient manner. The UDRP was primarily to avoid a lawsuit from aggrieved litigants,⁴⁷ and was based on a report from the World Intellectual Property Organization.⁴⁸ The policy is funded through the domain

⁴² Jaguar Cars, *supra note 6*.

⁴³ Neha Alawadhi, *India can have bigger say with ICANN managing internet*, THE ECONOMIC TIMES, (Oct. 4, 2016, 11.48 Am), https://economictimes.indiatimes.com/tech/internet/india-can-have-bigger-say-with-icann-managinginternet/articleshow/54664943.cms?utm_source=contentofinterest&utm_medium=text&utm_campaign=cppst.

⁴⁴ *Descriptions and Contact Information for ICANN-Accredited Registrars*, INTERNET CORPORATION OF ASSIGNED NAMES AND NUMBERS (June 30, 2020), <https://www.icann.org/registrar-reports/accredited-list.html>.

⁴⁵ *What happens to the internet after the U.S. hands off ICANN to others?*, PEW RESEARCH CENTER (Mar. 20, 2014), <https://www.pewresearch.org/fact-tank/2014/03/20/what-happens-to-the-internet-after-the-u-s-hands-off-icann-to-others>.

⁴⁶ W.B. Chik, *Lord of Your Domain, But Master of None: The Need to Harmonize and Recalibrate the Domain Name Regime of Ownership and Control*, 16 Int J Law Info Tech 8, 18 (2008).

⁴⁷ P. Cortes, *Developing Online Dispute Resolution for Consumers in the EU: A Proposal for the Regulation of Accredited Providers*, 19 Int J Law Info Tech 1, 20 (2011); See, *Lockheed Martin Corp. v. Network Solutions, Inc* 194 F.3d 980 (9th Cir. 1999).

⁴⁸ *Final Report of the WIPO Internet Domain Name Process*, THE WORLD INTELLECTUAL PROPERTY ORGANIZATION, (Apr. 30, 1999), <https://www.wipo.int/amc/en/processes/process1/report/finalreport.html>.

name registration fees.⁴⁹

V. UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP)

Any disputes, which involve any registration with a bad faith are typically resolved using the Uniform Domain Name Dispute Resolution Policy (UDRP). In 1999 ICAAN Board of Directors adopted this policy to resolve the disputes between a domain name registrant and a third party over any registration or else over any Internet domain name⁵⁰. The procedures and the requirements at every stage of the dispute settlement are clearly mentioned in the UDRP Rules⁵¹ and are to be complied with.

The policy offers an expedited administrative proceeding for trademark holders to contest “abusive registration of domain names”⁵², and may result in the cancellation, suspension or transfer of a domain name by the registrar.⁵³ The dispute resolution service providers who are recognized by ICAAN will administer the procedure for the dispute settlement. The WIPO Arbitration and Mediation Center (WIPO Center) is the dispute settlement service provide accredited by ICANN⁵⁴. WIPO center has also developed WIPO Supplement Rules⁵⁵ for the UDRP Policy, which supplements the UDRP Policy and Rules.

The domain name panelists⁵⁶ appearing on WIPO center list for resolving the disputes these are selected after considering different criteria such as their reputation for their impartiality, sound judgement and experience as decision makers and their knowledge in the area of international trademark law, electronic commerce and internet related issues. The WIPO’s center’s list is international and it consists of around 400 panelists from round 50 countries around the world among which many are multilingual⁵⁷.

Any individual or company can file a complaint regarding a domain name to UDRP and it will be solved through UDRP administrative procedure. Not only that but any trademark holders can file a case at the WIPO against cyber squatters. The complaint should show that the recorded domain name is unexceptionally relating to their trademark. More over the

⁴⁹ B. Beheshti, *Cross-Jurisdictional Variation in Internet Contract Regulation*, 8 JICLT 49, 66 (2013).

⁵⁰ *WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP)*, WORLD INTELLECTUAL PROPERTY ORGANIZATION, <https://www.wipo.int/amc/en/domains/guide/#a1>.

⁵¹ UDRP Rules, *supra* note 24.

⁵² UDRP Policy, *supra* note 2 at paragraph 4(a).

⁵³ Vaibhav Priyadarshi & Sujesh Somanathan, *Global Analysis of Laws Related to Cyber Squatting - Opening a New Front in War against Infringement Done on Internet*, 22 Sri Lanka J. Int'l L. 107 (2010).

⁵⁴ M. Mc Donagh & M. O'dowd, *supra* note 14.

⁵⁵ *World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy*, WORLD INTELLECTUAL PROPERTY ORGANIZATION, <https://www.wipo.int/amc/en/domains/supplemental/eudrp/newrules.html> [hereinafter WIPO Supplementary Rules].

⁵⁶ *WIPO Domain Name Panelists*, WORLD INTELLECTUAL PROPERTY ORGANIZATION, <https://www.wipo.int/amc/en/domains/panel/panelists.html>.

⁵⁷ UDRP Policy, *supra* note 2.

complaint should also show that and there is no legitimate interest in the domain name by the user and is only used in bad faith⁵⁸ by the registrant. All the registers shall follow the procedure under UDRP. Any action related to cancellation or withdrawal of the domain name by the registrar, under this policy it must resolve most of the domain name disputes through court action. The mandatory UDRP administrative procedure doesn't Bar Any party who approach the court⁵⁹. The UDRP policy provides that if there is any mandatory administrative proceeding, which is required, in such a scenario the UDRP proceeding shall not abstain any party to approach the court. It is possible for either of the party (Complainant/respondent) to start a lawsuit in the court before starting an administrative proceeding. In the same way a party is even free to commence a lawsuit after the administrative proceedings, if any of the party is not satisfied with the outcome of the administrative proceeding⁶⁰. The procedure for complying when there is an interference with a court proceeding is mentioned in UDRP Rules⁶¹.

The main benefit by opting UDRP administrative procedure is it typically provide a faster and a cheaper way to resolve a dispute in respect of registration and use of Internet Domain name rather than going to court. The procedures opted by UDRP administrative panel are Considered more informal rather than in comparison with litigation. The administrative panel members are experts in the related areas of the dispute such as international trademark law, issues related to domain name, Internet and dispute resolution. The main advantage of this procedure is it has an international school it provides a single mechanism to resolve any domain name related dispute irrespective of where the domain name holder or the complainant or the registrar are located⁶².

VI. MANDATORY ADMINISTRATIVE PROCEEDINGS: THE THREE SINE QUA NON

Among various types of disputes that can occur, there are few disputes⁶³ that are required to submit before mandatory administrative proceeding. These proceedings are to be conducted before any of the administrative dispute resolution service providers⁶⁴.

“4(a). **Applicable Disputes.** You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider,

⁵⁸ UDRP Policy, *supra* note 2 at Paragraph 4(b).

⁵⁹ UDRP Policy, *supra* note 2 at Paragraph 4(k).

⁶⁰ University Hearld, *supra* note 21.

⁶¹UDRP Rules, *supra* note 24 at Paragraph 18.

⁶²WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP), WORLD INTELLECTUAL PROPERTY ORGANIZATION, <https://www.wipo.int/amc/en/domains/guide/#a>.

⁶³ UDRP Policy, *supra* note 2 at Paragraph 4(a).

⁶⁴ List of Approved Dispute Resolution Service Providers, INTERNET CORPORATION OF ASSIGNED NAMES AND NUMBERS, <https://www.icann.org/resources/pages/providers-6d-2012-02-25-en>.

in compliance with the Rules of Procedure, that

- (i) Your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) You have no rights or legitimate interests in respect of the domain name; and
- (iii) Your domain name has been registered and is being used in bad faith.

In the administrative proceeding, the complainant must prove that each of these three elements are present.”⁶⁵

- **Identical or Confusingly Similar:**

Of the three elements, the first element adheres Issues of trademark law to a wider extent than the other elements⁶⁶. Under the first element the complainant under UDRP must prove that the disputed my name is identical or confusingly similar to the trademark or the service mark rights of the complainant. This element has two prerequisites (i) the complainant must have rights relating to the alleged trademark (ii) the domain name of the respondent must be identical or confusingly similar to the trademark of the complainant. While finding the similarity the administrative panels had no difficulty to find the slight variation between the mark and the domain name. In cases where the differences are more pronounced, the UDRS probably is not the proper forum for the dispute.

Two issues had come up before the administrative panel with respect to the identical or confusingly similar ingredient. The foremost issue is whether and intentionally misspelt name, Referred to as ‘typo squatting’ maybe ‘confusingly similar’.⁶⁷ In many of the cases the ICANN panels have either cancelled the door my name or transferred the misspelt names. In the case of *Microsoft Corp. v. Microsoft.com*⁶⁸ the panel held that the domain name ‘Microsoft.com’ was confusingly similar time that of the trademark of ‘Microsoft’ and it directed the respondent to transfer the name to the complaint. The second issue is whether the respondent can use the trademark for creating a ‘gripe site’.⁶⁹ A Respondent cannot create a new mark by the addition of a common and generic term.⁷⁰ However, it is common for gripe site creators to use pejorative terms like ‘sucks’, ‘bites’, or ‘I hate’ as an affix to the

⁶⁵ UDRP Policy, *supra* note 2 at Paragraph 4(a) Mandatory Administrative Proceedings, Applicable Disputes.

⁶⁶ Robert Badgley, *Internet Domain Names and ICANN Arbitration The Emerging Law of Domain Name Custody Disputes*, 5 Tex. Rev.L. & Pol. 343,349, 356 (2001).

⁶⁷ Wilson, *Supra* note 17.

⁶⁸ WIPO (Case No. D2000-0548)

⁶⁹ COLLINSDICTIONARY, <https://www.collinsdictionary.com/dictionary/english/gripe-site>.

⁷⁰ Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico (WIPO Case No. D2000-0477); The Salvation Army v. Info-Bahn, Inc. (WIPO Case No. D2001-0463); Dr. Martens International Trading GmbH and Dr. Maertens Marketing GmbH v. MCPS, Timothy Marten (WIPO Case No. D2011-1728).

trademark name. To succeed in their claim, the complainant must prove each of the three elements under paragraph 4(a). Each element will be considered in the context of a gripe site. In the case of *Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico*⁷¹, the panel has ordered to transfer the name ‘walmartcanadasucks.com’ to the complainant Wal-Mart, Inc. The panel has also stated that even though the site is not satisfying the standard of confusingly similar to that of the complainant, it would however derive the business off of customers looking for the complainant.

- **No Rights or Legitimate Interest:**

It is for the complainant to prove that the respondent lacks rights or legitimate interests⁷². A respondent may prove that they do have a legitimate interest if they fall into any of the safe harbor provisions. However, if the information is primarily within the knowledge of the complainant, this will only require establishing a *prima facie* case, at which point the burden will shift to the respondent.⁷³ The panel should consider if the respondent is involved in the “bona fide offering of goods or services”,⁷⁴ or has been commonly known by the name.⁷⁵ Additionally, making legitimate fair or non-commercial use can be argued if there is a lack of intent to divert customers for commercial gain or to tarnish the trademark.⁷⁶ As there are no submissions other than the complaint and response to the complaint, generally a complainant will doesn’t get a chance to rebut to the respondent's story until and unless a panel specifically requests for additional submission.

- **Bad Faith:**

The third element, which is mentioned in the policy, is to prove that the domain name has been registered with bad faith.⁷⁷ The definition of “bad faith” is a crucial element of the policy.⁷⁸

The policy has formulated four different situations in which the bad faith criteria can be

⁷¹ WIPO Case No. D2000-0477.

⁷² EAUTO, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc. (WIPO Case No. D2000-0047); Sermo, Inc. v. CatalystMD, LLC (WIPO Case No. D2008-0647); Digicel Caribbean Limited v. Domains By Proxy, LLC / Jamie McCullan (WIPO Case No. D2015-1854); Shaw Cablesystems G.P. v. Domain Admin / Whois Privacy Corp. (NAF Case No. FA1603001666578).

⁷³ Document Technologies, Inc. v. International Electronic Communications, Inc. (WIPO Case No. D2000-0270); Do The Hustle, LLC v. Tropic Web (WIPO Case No. D2000-0624); TotalFinaElf E&P USA, Inc. v. Marilyn Farnes (NAF Case No. FA 117028); G.D. Searle & Co. v. Martin Marketing (NAF Case No. FA118277).

⁷⁴ UDRP Policy, *supra* note 2 at Paragraph 4(c)(i).

⁷⁵ UDRP Policy, *supra* note 2 at Paragraph 4(c)(ii).

⁷⁶ UDRP Policy, *supra* note 2 at Paragraph 4(c)(iii).

⁷⁷ UDRP Policy, *supra* note 2 at Paragraph 4(a)(iii).

⁷⁸ Milton Mueller, “*Rough Justice: An Analysis of ICANNs Uniform Dispute Resolution Policy*”, p.23

satisfied, which includes buying the domain name with intention to:

- a) Sell to the trademark owner or a competitor for excessive consideration;⁷⁹
- b) prevent the trademark holder from using it;⁸⁰
- c) disrupt the complainant's business as a competitor;⁸¹
- d) or attract users for commercial gain by creating likely confusion with the trademark.⁸²

The list that is mentioned above is not exhaustive but all the factors can be considered in combination.⁸³ Which enables the panelists for some flexibility in considering issues like retaliatory registrations,⁸⁴ the providing of false contact information upon registration,⁸⁵ and a lack of response to the complaint.⁸⁶ In many cases the panels have even abused this flexibility by identifying bad faith even in situations where the respondent did not get any commercial gain⁸⁷ nor he is a competitor of the complainant.⁸⁸ At the same time there are numerous decisions, which relies on the concept that a mere knowledge about the existence of any

⁷⁹ UDRP Policy, *supra* note 2 at Paragraph 4(b)(i); Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico (WIPO Case No. D2000-0477); Direct Line Group Ltd, Direct Line Insurance plc, Direct Line Financial Services Ltd, Direct Line Life Insurance Company Ltd, Direct Line Unit Trusts Ltd, Direct Line Group Services Ltd v. Purge I.T., Purge I.T. Ltd (WIPO Case No. D200-0583); Dixons Group PLC v. Purge I.T. and Purge I.T. Ltd (WIPO Case No. D2000-0584); Freeserve PLC v. Purge I.T. and Purge I.T. Ltd (WIPO Case No. D2000-0585); Standard Chartered PLC v. Purge I.T. (WIPO Case No. D2000-0681); The Salvation Army v. Info-Bahn, Inc. (WIPO Case No. D2001-0463); Suning Commerce Group Co., Ltd v. Zhao DongXu (ADNDRC Case No. HK-1600881) [hereinafter Suning]; Vivendi Universal v. Mr. Jay David Sallen and GO247.COM,INC. (WIPO Case No. D2001-1121); Cruzeiro Licenciamentos Ltda. v. David Sallen, Sallen Enterprises and J.D.Sallen Enterprises (WIPO Case No. D2000-0715); Dr. Martens International Trading GmbH and Dr. Maertens Marketing GmbH v. MCPS, Timothy Marten (WIPO Case No. D2011-1728). Bayer Aktiengesellschaft v. Dangos & Partners (WIPO Case No. D2002-1115).

⁸⁰ UDRP Policy, *supra* note 2 at Paragraph 4(b)(ii).

⁸¹ UDRP Policy, *supra* note 2 at Paragraph 4(b)(iii).

⁸² URDP Policy, *Supra* note 2 at paragraph 4(b)(iv); L'Oreal, Biotherm, Lancome Parfums et Beauty & Cie v. Unasi, Inc. (WIPO Case No. (D2005-0623); SURCOUF v. Topsafelistbiz.com (WIPO Case No. D2006-1508); HM Publishers Holdings Ltd v. Marcus Costa Camargo Peres (WIPO Case No. D2013-1597).

⁸³ RRI Financial, Inc. v. Chen (WIPO Case No. D2000-1483)

⁸⁴ Diageo plc v. John Zuccarini (WIPO Case No. D2000-0996)

⁸⁵ Wachovia Corporation v. Peter Carrington (WIPO Case No. D2002-0775); BellSouth Intellectual Property Corporation v. Texas Internet (WIPO Case No. D2002-0559); Carfax, Inc. d/b/a Carfax v. Auto Check USA (WIPO Case No. D2001-0929); Telstra Corporation Limited v. Nuclear Marshmallows (WIPO Case No. D2000-0003); Standard & Poor's Financial Services LLC v. Shaun Ray (WIPO Case No. D2013-1545); Discovery Communications LLC. v. Giovanni Santi, Erotikax.com (WIPO Case No. D2016-2314).

⁸⁶ TRS Quality, Inc. v. Gu Bei (WIPO Case No. D2009-1077); Sports Holdings, Inc v. Whois ID Theft Protection (WIPO Case No. D2006-1146).

⁸⁷ Boehringer Ingelheim Pharma GmbH & Co. KG v. Whoisguard Protected, Whoisguard, Inc. / ESQUIRE 5, J Gates (WIPO Case No. D2015-0978); Monty and Pat Roberts, Inc. v. J. Bartell (WIPO Case No. D2000-0300); Red Bull GmbH v. Carl Gamel (WIPO Case No. D2008-0253); Vanguard Trademark Holdings USA, LLC v. European Travel Network (WIPO Case No. D2008-1325); Southern California Regional Rail Authority v. Robert Arkow (WIPO Case No. D2008-0430) In this case panel allowed for registration where the respondent argued that it was to keep his site going in case he lost his primary domain name to the complainant.

⁸⁸ Compagnie Generale des Matieres Nucleaires v. Greenpeace International (WIPO Case No. D2001-0376); Banque Cantonale de Geneva v. Primatex Group S.A. (WIPO Case No. D2001-0477); Delta Air Transport NV (trading as SN Brussels Airlines) v. Theodule De Souza (WIPO Case No. D2003-0372).

trademark itself prima facie proves the presence of bad faith⁸⁹. Passive holding of domain names has been ruled as bad faith⁹⁰, even if the domain name resolves to no site at all⁹¹, and particularly if no explanation is provided⁹². However, if the trademark is not well known, passivity may not be sufficient⁹³.

Post *Jeanette Winterson v. Mark Hogarth*,⁹⁴ it has been established that the UDRP's reference to trademark encompasses both registered and unregistered trademark⁹⁵. The panel decided that the term 'trademark' in clause 4(a) extended to unregistered as well as to registered trademarks, referring to a number of English law causes on passing off.

- **PROCEDURE IN UDRP**

The first and the foremost stage of filing consist of filing⁹⁶ an electronic complaint⁹⁷ with the WIPO Center. A Complaint may even consist of more than one domain name but the registrant of the domain names which are specified in the complaint should belong to the same individual or an entity⁹⁸. The complainant must send a copy to the concerned registrar and the respondent together with complete transmittal cover sheet. After the Center Acknowledges the receipt the Center request concerned registrars to provide specific details regarding the concerning disputed domain names. The Center conducts formalities compliance review following the receipt of request information from the registrar.

In the complaints it review's the deficiencies and later it will be notified to the complainant and respondent if not remitted within five days of the calendar days the complaint deemed to be withdrawn. The payment⁹⁹ for filing the case should be totally paid by the complainant only, the only occasion in which the respondent needs to share is when, respondent chooses to get the case decide by three panelists and the complainant has chosen one. After the

⁸⁹ SportSoft Golf, Inc. v. Hale Irwin's Golfers' Passport (NAF Case No. FA0094956); Marriott International, Inc. v. John Marriot (NAF Case No. FA0094737); Centeon L.L.C./Aventis Behring L.L.C. v. Ebiotech.com (NAF Case No. FA0095037).

⁹⁰ Telstra Corporation Limited v. Nuclear Marshmallows (WIPO Case No. D2000-0003); Tommy Bahama Group, Inc. v. Domains by Proxy, Inc. / Aware Marketing (WIPO Case No. 2011-2127).

⁹¹ Adobe Systems Inc v. Domain OZ (WIPO Case No. D2000-0057).

⁹² Clerical Med Inv Group Ltd v Clericalmedical.com (WIPO Case No, D2000-128); Caravan Club v Mragsake (NAF Case No. FA95314); Quilogy, Inc v Rodney Ruddick (NAF Case No. FA0211000134653).

⁹³ Applied Systems, Inc. v. Atlantic Insurors, Inc (WIPO Case No. D2012-2617).

⁹⁴ WIPO (Case No. D 2000-0235)

⁹⁵ In this case, the respondent had registered the names of a number of British authors as domain names, including that of Jeanette Winterson.

⁹⁶ *UDRP Model Response and Filing Guidelines*, WORLD INTELLECTUAL PROPERTY ORGANISATION, <https://www.wipo.int/amc/en/domains/respondent/index.html>.

⁹⁷ URDP Policy, *Supra* note 2 at paragraph 3(b); WIPO Supplementary Rules, *Supra* note 54 at Paragraph 12(a).

⁹⁸ URDP Rules, *Supra* note 24 at Paragraph 3(c).

⁹⁹ *Schedule of Fees under the UDRP*, WORLD INTELLECTUAL PROPERTY ORGANISATION, <https://www.wipo.int/amc/en/domains/fees/index.htm>.

payment for the complaint has been made the Center will formally notify¹⁰⁰ the respondent of the complainant and the formal commencement of administrative proceedings will begin. If the response is not filed within twenty days¹⁰¹, based on the panel's discretion it will be either considered or rejected.

If both the complainant and the respondent designate a single panel then, the center will make appointment from is published list. But if either of the parties designates a three-member panel, the Center will appoint a three-person administrative panel. In so doing, Center will attempt to appoint one of the three candidates nominated by the complainant and one of the three appointed by the respondent. The presiding panel list in a three-person panel is appointed taking into consideration the party preferences. Disappointment of the panelist will be finalized within five to fifteen days. The panel is required to forward its decision to the Center within fourteen days¹⁰² of its appointment. After the Center receives within three days the Center will notify its decision to the parties, ICANL and the concerned registrar(s). Registrar notifies parties, ICANN and center, regarding the decision and it will be implemented unless the respondent makes a Paragraph 4(k) Filing.

Pursuant to the policy paragraph 4(k), the registrar is required to implement a system in favor of the company to ten business days of the receipt, unless it receives an official documentation that is has commenced a lawsuit against the complaint in a mutual jurisdiction. Registrar will take no action until it receives satisfactory evidence that the matter has been resolved or the lawsuit has been dismissed or with drawn or a copy of an order from the court dismissing that the respondent has no right to use the domain name. the entire procedure should be completed before 60 days, starting from the date on which the complaint is submitted to the WIPO.

If the parties come to any agreement regarding the dispute during the proceedings then the URDP proceedings can be suspended to implement a settlement agreement between the parties¹⁰³. If the parties agree on a settlement before Panel appointment, they should notify the WIPO Center of such settlement¹⁰⁴ by submitting the standard settlement form¹⁰⁵. If the administrative panel has not yet been appointed, the complainant it will be entitled to a partial refund of its filing fee.

¹⁰⁰ URDP Rules, *Supra* note 24 at Paragraph 2(A).

¹⁰¹ URDP Rules, *Supra* note 24 at Paragraph 5(a).

¹⁰² URDP Rules, *Supra* note 24 at Paragraph 15(b).

¹⁰³ URDP Rules, *Supra* note 24 at Paragraph 17.

¹⁰⁴ WIPO Supplementary Rules *Supra* note 54.

¹⁰⁵ URDP Rules, *Supra* note 24 at Paragraph 17(a)(iii).

The decisions by the Administrative Panel except in few exceptional circumstances, a dispute resolution service provider is required to publish all the decisions in full length¹⁰⁶ on the Internet. The decisions can even be accessed on WIPO's center's website. An online index of the decisions according to domain name category, procedure or substantive issues are also available¹⁰⁷. The WIPO's Center also makes a jurisprudential overview by the administrative panel¹⁰⁸.

WIPO UDRP cases in 2015 involved parties from 113 countries. The U.S., with 847 cases filed, was the first-ranked WIPO filing country, followed by France (337), Germany (272), the U.K. (229) and Switzerland (169). Among the top five users, Germany (48.6%) saw the highest growth in cases filed. The top three sectors of complainant activity were fashion (10% of all cases), banking and finance (9%), and Internet and IT (9%)¹⁰⁹

An enormous surge in the disputes related to do my names has raised many questions especially when it comes to adjudicating cybersquatting matters. There is a huge uncertainty when it comes to the question, which pertains to the status of genuine non-commercial criticism sites, which deceptively have similar domain names. In a situation where this issue arises WIPO panel for UDRP disputes has explicitly discussed this and there seems to be a disjunction of use.¹¹⁰ In a set of panel decisions in the cases related to US disputes, they held that the respondents will have a legitimate internet in using a trademark as the part of the domain name if the registration of the criticism site is used for fair and non-commercial use. On the other hand, there are few panel decisions that affirmed that there is no necessity to register and use domain name that are confusingly similar or identical to the trademark of the complainant and it doesn't extend the right to criticize.

VII. NEED FOR AN ENHANCEMENT

At the outset UDRP has originally designed as a simple, convenient and cost effective alternative remedy rather than court options in the ambit of clear cases of cybersquatting,

¹⁰⁶ *WIPO Domain Name Decisions* WORLD INTELLECTUAL PROPERTY ORGANISATION, <https://WorldIntellectualPropertyOrganisation/amc/en/domains/decisionsx/index.html>.

¹⁰⁷ *Search WIPO Cases and WIPO Panel Decisions*, WORLD INTELLECTUAL PROPERTY ORGANISATION, <https://www.wipo.int/amc/en/domains/search/index.html>.

¹⁰⁸ *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0")*, WORLD INTELLECTUAL PROPERTY ORGANISATION, <https://www.wipo.int/amc/en/domains/search/overview3.0/index.html>.

¹⁰⁹ *All gTLD's (Ranking) in WIPO Cases: 2015*, WORLD INTELLECTUAL PROPERTY ORGANISATION, https://WorldIntellectualPropertyOrganisation/export/sites/www/pressroom/en/documents/pr_2016_789_anxes.pdf#page=3

¹¹⁰ *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0")*, WORLD INTELLECTUAL PROPERTY ORGANISATION, <https://www.wipo.int/amc/en/domains/search/overview2.0/#24>.

which are operating across multiple legal jurisdictions.

The UDRP was not drafted to create a “new, globalized trademark law”, but to provide an efficient resolution to cases of abusive registration¹¹¹. The UDRP drafting was too broad,¹¹² as mentioned above some panelists in few cases have exploited this by considering issues that are better resolved and intended to fall within the jurisdiction of national courts¹¹³. One of the most biting criticisms of the UDRP is the fact that it runs based on the complainant driven selection process which provides a major incentive for dispute resolution providers and panelists to be complainant friendly¹¹⁴.

Another important aspect that is to be considered is UDRP does not protect personal names that are not registered as trademarks. There are few cases in which UDRP panel has transferred the domain name or cancelled¹¹⁵ but at the same time the panel has even rejected stating that this does not come under the definition of cyber squatting¹¹⁶. Taking into account the wording of paragraph 4(a)(1) of UDRP Policy there is no justifiable reason to exclude famous individual names from the definition of cyber squatting, that too when cyber squatters target the names of famous people in the same way as a well-known trademark. UDRP became the welshing option of resolving all disputes regarding the domain name¹¹⁷, and panels have exploited and squeezed every scenario under the pretext of policy, leading to various interpretations and inconsistency. The utmost consequence of this is a discouragement of legitimate free speech¹¹⁸, as a complainant can use the UDRP to silence a sanctioned criticism of its business¹¹⁹.

Whilst an appeal system, and a clarification by ICANN on the issues of divergence¹²⁰ would

¹¹¹ M. Mueller, “*Success by Default: A New Profile of Domain Name Trademark Disputes under Icann’s UDRP*”, BOOKS.GOOGLE.CO.IN (24 jun. 2002), <https://dcc.syr.edu/markle-report-final.pdf>

¹¹² J. Lipton, “*Commerce Versus Commentary: Gripe Sites, Parody, and The First Amendment in Cyberspace*”, 84 Wash. U. L. Rev. 1327, 1371 (2006).

¹¹³ M. Mueller, “*Success by Default: A New Profile of Domain Name Trademark Disputes under Icann’s UDRP*”, BOOKS.GOOGLE.CO.IN (24 jun. 2002), <https://dcc.syr.edu/markle-report-final.pdf>; J. Lipton & M. Wong, “*Imperatives of Private Arbitration in International Intellectual Property Disputes*”, 24 Sac L J 978, 984-985(2012).

¹¹⁴ Laurence R Helfer & Graeme B Dinwoodie, ‘*Designing Non-National Systems: The Case of The Uniform Domain Name Dispute Resolution Policy*’, 43 Wm & Mary L Rev 144, 210 (2001).

¹¹⁵ Bruce Springsteen v Jeff Burgarand Bruce Springsteen Club (Case No D2000-1532) ; and Julia Fiowna Roberts v Russel Boyd (Case No D2000- 0210).

¹¹⁶ Gordon Sumner, p4/a Sting v Michael Urvan [2000] Case No D2000-0596.

¹¹⁷ J. Lipton & M. Wong, “*imperatives of private arbitration in international intellectual property disputes*”, 24 sac L J 978, 985 (2012).

¹¹⁸ J. Brand & M. Schruers, “*Toward a Bright-Line Approach to Trademarks*”, 20(7) Computer and Internet Lawyer 1, 10 (2003).; R. Braswell, “*Consumer Gripe Sites, Intellectual Property law, and The Use of Cease-and-Desist Letters to Chill Protected Speech on the Internet*”, 17 Fordham Intell. prop. media & Ent. L.J. 1241, 1279 (2006).

¹¹⁹ J. Hornle, “*Icann’s Dispute Resolution Procedure — The Good, The Bad and the Ugly*”, 4(8) EBL 5. (2002).

¹²⁰ J.P.C. Dieguez, “*The UDRP Reviewed: The Need for a "Uniform" Policy*”, 14(6) C.T.L.R 133, 139 (2008).

improve consistency, there is still the matter of national laws having such different approaches. The UDRP does not include recourse of appeal system; parties who wish to do so may pursue a matter *de novo* in court¹²¹. In the paper prepared by WIPO Arbitration and Mediation Center in August 2011, they clearly stated that if any appeals option has been introduced, as a matter of right within such framework would inevitably add time, complexity and uncertainty to the process¹²².

It has been contended that an appeal system should be initiated¹²³, irrespective of the fact that this would add hand some of expense and a worthwhile time to the proceedings, and could be argued to be redundant given that there is a possibility of subsequent legal proceedings¹²⁴. However, many parties, mainly respondents who are solely consumers, might not have the resources for an upcoming court action¹²⁵, and currently only a slight amount of disputes are re-litigated before national courts¹²⁶ and only trivial matters are accepted for re-filing.

VIII. CONCLUSION

The Internet industry must realize that IP rights are great assets and should take measures to protect it. Cyber squatting has become money making and flourishing online business, which has adverse negative repercussions on the owner of the trademark. This act diminishes the thin line that separates legality and illegality of the cybersquatting as it combines both legitimate and illegal activities.

There are appreciable and price worthy advantages by using ICANN's UDRP to resolve domain name disputes. The main conflict concerning the jurisdiction is no more a troubled problem because of the UDRP policy as it avoids all kinds of jurisdictional problems. On the top of it, the costs of a UDRP proceeding are critically lower than the litigation proceedings. The parties can even have the option in choosing the panel. Despite the fact that the proceedings are fast, it is pertinent to remember that the sole remedy, which can be availed, is to have the domain name transferred or extinguished. On the other side of the coin, the UDRP proceedings should be considered because of the fast remedy which can be possible by

¹²¹The Uniform Domain Name Dispute Resolution Policy and WIPO, WORLD INTELLECTUAL PROPERTY ORGANISATION (Aug. 2011) <https://WorldIntellectualPropertyOrganisation/export/sites/www/amc/en/docs/wipointaUDRP.pdf>.

¹²² *Burford v Mowling* 8 C.L.R. 212 (1908)

¹²³ M. Moore, "Cybersquatting: Prevention Better than Cure?", 17(2) INT J Law Info Tech 220, 228 (2009).; Deveci "Domain Names: has Trade Mark Law Strayed from its Path?", 11(3) int J law info tech 203 (2003).; J. Hörnle, "One Bite of the Apple — or More Than One?", 8(9) EBL 7 (2006).

¹²⁴ D.W. Maher, "The UDRP: The Globalization of Trademark Rights", 33(8) IIC 924, 940 (2002).

¹²⁵ M. Moore, "Cybersquatting: Prevention Better than Cure?", 17(2) int j law info tech 220,228 (2009).

¹²⁶ L. Helfer, "Whether the UDRP: Autonomous, Americanized, or Cosmopolitan?", 12 Cardo J Intl & Comp L 493, 495 (2004).

quickly removing the website.

Along with the advantages comes up the disadvantages, in order to achieve an ideal legal regime that is beneficial to the society at large and to promote justice, the evolution of law is essential and a definite law particular to the subject matter should exist in order to provide appropriate remedies. As far as India is concerned, the law is yet to be developed. Where as, USA has a specific law, U.S. Anti-cybersquatting Consumer Protection Act (ACPA) of 1999 governing the issue regarding cybersquatting. In India, as of now, even though there is no specific mention about cybersquatting in the Trademark Act, 1999 it is the governing law and there is no mention about cybersquatting even in Information Technology Act, 2000. Trademark law has never fully addressed cyber squatting and the new law pertinent to cyber squatting is the need of the hour!
