

DOMAIN NAME DISPUTE RESOLUTION IN INDIA: A MANIFESTATION OF THE ARBITRATION REGIME & PRIVACY ISSUES

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Abstract

The Domain Name Regulation in India is a wide umbrella of laws, regulations and policies that are both statutory and sub-delegated in nature. While domain names do usually come under the perspective of the Trademark Act, 1999, there is considerable legitimacy in the Domain Name Dispute Resolution Process provided under UDRP i.e. Uniform Dispute Resolution Policy and the WIPO being the Dispute Settlement Body and INDRP under the .IN Registry Dispute Resolution Policy with insights from UNDRP and the IT Act, 2000. While UDRP and INDRP appear as methods involving Alternative Dispute Resolution with the exception of a mandate to submit to arbitration, the common law remedy of Passing Off is still valid and used for domain name disputes. In this paper, it is attempted to observe and inquire into the intersection of remedies available under INDRP/UDRP, Arbitral Proceedings and the Common Law Remedy. Indian Judicial Approach towards Trademarks has been rather consistent in terms of bringing Domain Name Disputes under the ambit of Common Law..

Key words INDRP, Domain Names, Online Dispute Resolution, UDRP.

Introduction

Internet, defined usually, as a worldwide computer network organize giving a variety of data and correspondence offices comprising of interconnected systems utilizing normalized correspondence conventions generally utilizes Internet Protocol Address today as an identifier of a subject of the internet and a MAC address as an identifier of the machine that operates or uses the subject of the internet. Internet was primitively used by the Defence forces of the United States for communication in critical areas.

Internet protocol address protocol and method used by a computer to connect and upload / download data to a global computer network. Through the system which is also called as Domain Name System is the method by which Internet domain names can be gained and interpreted into Internet Protocol addresses. The above mentioned system places Unique Resource maps uploaded to the server using the Internet Protocol address on the website and onwards, the domain name is an IP address.

Emergence of ICANN

The Internet Corporation for Assigned Names and Numbers (ICANN) is a non-profit organization responsible for the storage and processing of a wide range of information related to domain name programs and redirecting applications that use name-based servers to targeted servers. (ICANN, 1998) The role of ICANN is in assignment of domain names and management, maintenance of protocols related to translation of domain names with the servers in order to create web analysis. (Hely, 1999)

Internet, having evolved from an infrastructure developed by the U. S. Department of Defence, the government has sponsored and implemented many of the key network infrastructure that has made the domain name system work. From 1998, the Government began transferring the Domain Name System to a newly created international non-profit organization in California called the Internet Corporation for Assigned Names and Numbers (ICANN). However, the Department of Trade retained control over the National Telecommunications and Information Administration (NTIA) and after a series of Memorandum of Understanding and Joint Agreements,

a voluntary confirmation agreement (Aoc) entered into between NTIA and ICANN which agreed to both be reviewed and reviewed by the Review Boards. (Thatcher, 2002)

A separate contract between ICANN and NTIA created IANA to manage the technical foundations of the DNS system. IANA, which is regarded as the work of ICANN, can be further divided into Resources Number, Agreement Shares and Domain Names.

The ICANN Board finally in March 2016 approved the IANA Transition Stewardship Proposal combining three parameters taken into consideration viz. Numbers Resource for Internet Protocol Address, Protocol Parameters and the Domain Names. For Numbers Resource, proposals were made to continue with ICANN and perform the services under five Regional Internet Registries (RIRs) mentioned below. For Protocol Parameters, it was proposed to rely on the systems set up by ICANN and for discharge of IANA functions. For domain names, an autonomous authority under ICANN was to be created for discharging IANA functions of domain names.

- American Registry for Internet Numbers (ARIN)
- Asia-Pacific Network Information Centre (APNIC)
- Reseaux IP Europeens Network Coordination Centre (RIPENCC)
- Latin America and Caribbean Network Information Centre (LACNIC)
- African Network Information Centre (AFRINIC)

Disputes in Domain Names

The Domain Name Registration Dispute Resolution Strategy put forth out a lawful outline for resolving disagreements between the owner or interested party in Domain Name and any other person involved in the interest with aggressive recordkeeping and the use of an Internet domain name on high-level domains (gTLDs) or high-country code. (ICANN, 2019) The legal status of UDRP is as acceptable to ICANN and is included as a mandatory part of any agreement between a domain name registrar and a registrar. (Kesan & Gallo, 2005)

Paragraph 4 (a) sets out the types of disputes in which any person or company has the right to bring about the necessary administrative procedure.

- i. The same is true or confusing the trademark or service mark of the plaintiff
- ii. The person who is going to register the domain name will not be having any rights or lawful benefits in respect of a domain name
- iii. The subscriber has enumerated and making use of the domain name infrequently. (San, 2019)

Bad faith is further explained and sets out what would serve as evidence of registration in bad faith under Para 4(b) as

- i. Acquisition of sale, lease or transfer to the Trademark-owned claimant to consider what is more important than your pocket-sized direct costs associated with the domain name;
- ii. Acquisition prohibits an owner of trademark or service mark from displaying such a mark on the consistent domain name, as long as it is involved in a way of such behavior.
- iii. Registration with the intention of disrupting a competitor's business
- iv. Deliberately attempting to attract Internet operators to your website or working site, by generating opportunities for confusion by the plaintiff's brand about availability, sponsorship, merging or approving your website or your site or product or service on your website or site. (Bloom, 2018)

ICANN has provided under Part 4 of the UDRP that the process will be directed in front of one of the organizational service providers as approved by ICANN and the option to remain with the Applicant under Paragraph 4 (d) unless there is a dispute application for conciliation in the presence of the Administrative Panel. The ICANN Approved Administrative Dispute Service Providers include; (Bousta & Sagar, 2014)

- a) Arab Center for Domain Name Dispute Resolution
- b) Asian Domain Name Dispute Resolution Centre
- c) Czech Arbitration Court for Internet Disputes
- d) National Arbitration Forum (United States of America)
- e) World Intellectual Property Organization

Para 4(h) absolves Registrar of all liability or involvement in the process as stated under Para 3 that the Registrar shall cancel or transfer or change a domain name in any way only if authorization is obtained from registrant, upon order of adjudicating authority or an Arbitral Tribunal or as per the decision of the Administrative Panel in this regard.

Resolutions obtained through the Dispute Resolution Process only by the termination of the Registrar domain name or the transmission of the domain name specified by the claimant. (Thompson, 2015) Para 4 (k) provides that the UDRP will not prevent any complainant or registrant from submitting a dispute to a competent court. If the decision reached by the procedure is cancelled the domain name, the registrar will be required to wait for a period of ten business days for the domain to be cancelled unless a communication has been established that the case has been filed by the Registrar against the Applicant.

Para 8(a) provides for restrictions on transfer of domain name *lis pendens*.

- i. During the pendency of the administrative proceeding or within fifteen days from the resolution of the administrative proceeding
- ii. Continuing Court proceedings or arbitral proceedings relating to a domain name unless the party transferred to the domain agrees to be bound by a court decision or arbitrator in writing.

Para 8(b) provides for restriction on transfer of registrar of domain registration during a pending administrative proceeding or fifteen days thereafter. Transfer of registrar is possible during *lis pendens* in case of pending court or arbitration proceedings, however, the dispute and proceedings shall be unaffected due to the transfer of registrar. (Larissa D'angelo, 2011)

The UDRP is subject further to the Guidelines for Uniform Domain Name Dispute Resolution Policy laid down by ICANN.

Grounds for Opposition

There are three grounds for opposing domain names. If the domain is registered with .IN Registry i.e. the domain name ends with .IN or .CO.IN or the like, the complaint is to be made under the INDRP or .IN Dispute Resolution Policy while if the domain is a GTLD or a Global Top Level Domain the domain opposition or complaint for domain dispute is to be filed under the UDRP with the Regional Domain Dispute Resolution Service Providers under the WIPO and ICANN arrangement. The grounds for opposition under the UDRP and INDRP are similar and there are three grounds provided for opposition including

1. The domain name of the person who has registered with the same or confusing as the name, trademark or service mark The Appellant has rights;

2. The registrant has no rights or legal interests in respect of a domain name
3. The domain name registrar is recorded or make use of it dishonestly.

Opposition in case of Concurrent Use of Trademark

Section 12 provides for registration of similar or identical marks in respect of same or similar goods may be allowed by Registrar on honest concurrent use. This provision is negative in nature and is brought in in order to protect the legitimate interest of a concurrent user.

In *Vodafone Group PLC v. Rohit Bansal* (Arbitration under INDRP) it was held that an elevated level of importance was to be vested in domain names for there can be no two users of one domain and therefore the plausible solution appears to be first come, first serve. (Bhattacharya, 2019)

The alternative of **domain name auctions** is not famous in India (not per se illegal) famous among customers of GoDaddy & BigRock – The costliest domain name was sold in April 2010 for name carinsurance.com for a staggering \$49.7 million.

Dispute Resolution under UDRP

The Dispute Resolution Plan sets out the lawful guidelines for resolving disagreements between a lawful owner and any other party or interested person. Notable features of the UDRP agreement include (Encyclopaedia of Genetics, 2008)

A) Mandatory Administrative Proceeding under Para 4: The method of dispute resolution adopted by the UDRP is Mandatory Administrative Proceeding under Para 4 which is recognized as alternative dispute resolution under WIPO mandate.

B) Grounds for seeking Remedy: It has similar grounds for seeking appropriate remedy and is identical to INDRP in that respect having grounds of Identical Domain Name having little or no rights accrued in favour of the person who owns domain name or else interest and recording of the domain name done in bad faith so as to prevent the legitimate holder from using it.

C) Definition & Expanse of Bad Faith: Bad faith defined as acquisition with intent of sale, rent or transfer to complainant/owner of Trademark/competitor (or) prevent Trademark owner from reflection in domain name (or) registered only to disrupt business (or) committed Phishing of any sort.

Procedure under UDRP

1. A complaint is registered and filed with the international community named as Internet Corporation for Assigned Names & Numbers (ICANN) which commences the process of Mandatory Administrative Proceeding under the mandate of the WIPO (Christie, 2014)

2. The Mandatory Administrative proceeding under Para 4 continues and the Complainant is then directed to select the provider for settling disputes - a medium or organization that acts an arbitrator in settlement of the disputes from the following

- a. Arab Center for Domain Name Dispute Resolution
- b. Asian Domain Name Dispute Resolution Center
- c. Czech Arbitration Center for Internet Disputes
- d. National Arbitration Forum, U.S.A.
- e. World Intellectual Property Organization

3. Consolidation of disputes occur at this stage. For instance, if both parties file cross complaints against each other or if there are more than one claimant for seeking authorized use of domain name etc., all such disputes are consolidated and heard jointly in the Mandatory Administrative Proceeding.

4. The next stage proceeds with the appointment of the Administrative Panel for Dispute Resolution. The Administrative Panel deals with the dispute in detail, list down facts, call for parties, hear arguments, accept and admit evidence and finally decide the dispute basis merits and following Principles of Natural Justice and necessary procedures that the provider may, in addition to the principles of WIPO, prescribe.

5. The remedies secured by Complainants in these disputes range from fine-based remedies to non-fine based remedies viz.

- a. Termination of Domain Name ownership
- b. Transmission of Domain Name ownership
- c. Shift of Global Top-Level Domain (GTLD) for a domain name
- d. Fine & Monetary Remedies

6. The decision of the Administrative Panel is then published and notified to the WIPO and ICANN and published in the list of decisions maintained.

7. Para 5 refers to the flexibility to adopt other source of quarrel determination including negotiation, conciliation and/or litigation. With reference to litigation and holding of the domain name within the said period, the rule of *lis pendens* would apply to the effect that the ownership of the domain name shall be locked and rest with the WIPO and ICANN and therefore prohibiting any transfer of domain name and/or any other aspect of the domain name which cannot be regulated.

8. The conditions under which transferor cancellation of a domain name is permitted include the following instances

- a. Voluntary Transfer of Domain Name
- b. Court or Arbitration Induced
- c. Mandatory Proceeding under Para 4

Dispute Resolution under INDRP (Nakornphanom, 2017)

IN Registry Dispute Resolution Policy provides for arbitration as the method of dispute resolution and only applies to domains under .IN CC TLD (Country Code Top Level Domain Name) .IN Registry's mode of dispute resolution is an ADR approach however, it's genesis appears to be out of a mandatory arbitration process thereby raising a doubt as to the efficacy of the ADR process when the fundamental element I.e. consent based resolution of mutual disputes is premised upon mandatory adoption of ADR.

A) Mandatory Arbitration: The method of dispute resolution adopted by the INDRP is Mandatory Arbitration which is recognized as alternative dispute resolution, however, since the nature of the proceeding being arbitration is founded upon consent, it causes a infirmity in the foundation of Alternative Dispute Resolution

B) Grounds for seeking Remedy: It has similar grounds for seeking appropriate remedy and is identical to UDRP in that respect having grounds of Identical Domain Name having little or no rights accrued in favour of the person who owns domain name or interest and recording of the domain name done in bad faith so far as to prevent the legitimate holder from using it.

C) Definition & Expanse of Bad Faith: Bad faith defined as acquisition with intent of sale, rent or transfer to complainant/owner of Trademark/competitor (or) prevent Trademark owner from reflection in domain name (or) registered only to disrupt business (or) committed Phishing of any sort.

Procedure under INDRP for Complaint Resolution (Falcon Chambers, 2018)

1. A complaint is filed with the IN Registry for initiation of mandatory arbitration under Para 4 of the INDRP under the aegis of the Ministry of Electronics & Information Technology.
2. The Registry along with the aid of the representation of the Ministry in the Registry, appoints an arbitrator to resolve the dispute from the list of arbitrators maintained by the .IN Registry under Para 5
3. The demeanor of arbitration proceedings will be administered by the statutory framework of arbitration in India as per the structure of the Arbitration & Conciliation Act, 1996 and ensuring conformity to Principles of Natural Justice being challengeable as per the scheme of the statute.
4. Arbitration Proceedings will also be governed by the Rules of Procedure set out in the IN Domain Name Dispute Resolution Policy. Where such rules meet or are found to be in conflict with the effective provisions of the Mediation and Reconciliation Act, 1996, the rules / procedures provided under the Act will apply.
5. The remedies available under Para 10 of the INDRP may be any of the following viz.
 - a. Dissolution of Domain Name
 - b. Transference of Domain Name
 - c. Costs
6. The decision of the arbitral tribunal shall be published and notified by the IN Registry as per extant rules of the Ministry.
7. The grounds for opposition of the domain remain similar to the grounds mentioned under UDRP of the WIPO with slight modifications viz.
 - a. The domain name of the Registrar is the same or similar in confusion to the name, TM / SM where the Appellant has the rights
 - b. The administrator has no lawful privileges or interests with regard to a domain name
 - c. The domain name administrator is recorded or make use of it dishonestly.

Substantive Aspects of Differentiation between INDRP & UDRP (Roy & Marsoof, 2016)

1. INDRP deals only with .IN while UDRP deals with all Global Top Level Domains (GTLDs) which allows a lot flexibility to the UDRP in terms of remedies. Further, INDRP does not optimally utilize the Sub-Domains in CCTLD of .IN it has control over in terms of exercising remedies to appropriate parties for alternate registration.
2. Grounds for and Circumstances under which cancellation or transfer of a domain name is permitted is laid down in UDRP and not laid down in INDRP.
3. Choice of Arbitrator/Adjudicating Party rests with Complainant in UDRP. However, in case of INDRP the Registry exercises such choice from its list of arbitrators.

4. Fee charged in regard to Dispute Resolution may be ordered to be evenly settled between Complainant and Respondent in UDRP while in INDRP, the fee is to be borne by the Complainant party alone and may be recovered in case of a successful disposal.

5. Parties may approach court under UDRP Rules of Procedure on merits, while in case of INDRP, parties can approach under S 34 of the Arbitration Act, 1996 only on grounds of incapacity of party, invalid agreement, no notice or audi alteram partem, arbitral award was beyond scope of submission or that composition of tribunal was faulty.

6. Remedy of Alternative Domain Name is present in case of UDRP but however rarely utilized in case of INDRP with regard to Sub-CCTLDs.

Concluding Note: Exploring potential of ODR further

Alternative Dispute Resolution is very effectively utilized in the Domain Name Dispute Resolution mechanisms. There are many more such disputes that arise in Internet Framework ranging from Disputes in Hosting Service Providers, Malware & Adware, DDOS Mechanisms, Bots etc., which may be resolved with the aid of Alternative Dispute Resolution.

Online Dispute Resolution is a change within the ADRS sector. Advances in technology have allowed it to enter the domain of resolving other disputes. Now there are online arbitration, online arbitration, and even arbitration using the same blockchain technology as cryptocurrencies: blockchain arbitration. These types of other dispute resolution solutions, known as "online dispute resolution", are increasingly making their presence heard. While intellectual contract disputes will benefit from arbitration due to its flexibility and its limited freedom of limitation of limitations, there are difficulties with the arbitral clause in intelligent contracts. It is not clear whether the smart contract containing the arbitral clause will meet the requirement set out in Article 2 section 2 of the New York Convention which requires that the arbitration clause be recorded. However, this problem can be overcome by translating Article 2 paragraph 2 according to the doctrine of practical equality as stated in section 16 of the UNCITRAL Model Law on Electronic Commerce 1996.

It is the analysis of the authors that there is an ardent need to include the Domain Name Dispute Resolution within the dominion of Online Dispute Resolution and engage public-private partnership in establishing centres where tools of ADR are applied to disputes emerging online to resolve them amicably and to ensure that Internet Dispute Resolution is carried out largely using Alternative Dispute Resolution mechanisms set up and running on the web. Complex disputes and high value will always be the province for resolving traditional disputes. However, with traditional mediation continuing to incorporate modern technology into its processes, the difference between online mediation and traditional interaction is becoming clearer. There is no denying that with advanced technology and automation, the most complex disputes the job will be sought by online dispute resolution services. It is therefore important for attorneys to continue to improve themselves and to be kept abreast of the latest legal and technical developments to avoid a fall behind the ongoing technical march.

Suggestions to improve Resolution Practice of INDRP

1. Employment of Online Dispute Resolution will empower all individuals as Registrants of .IN Domain names may not essentially be citizens of India or residents of India and therefore may face huge hurdles in attendance and complete participation in the mandatory arbitral proceedings of the .IN Registry

2. Precautions have to be taken to ensure that the dispute resolution mechanisms takes into consideration and takes good advantage of the remedies available in terms of alternative domain name registrations and resolution using innovative methods.

3. It is the need of the hour that a common redressal mechanism be present for resolving disputes emerging from transactions or conduct online therefore having clarity of jurisdiction and ability of online users to ensure resolution of disputes online using party-friendly methods of dispute resolution.

Grounds for Opposition for INDRP and UDRP must be uniformized to ensure that domain names across the world follow a standard mechanism of dispute resolution and also ensure that uniformity of terms in domain name registrations ensure larger number of people use the .IN CCTLD and all Sub-Domains under the same.

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