

LEGALFOXES LAW TIMES

.IN Dispute Resolution Process

This Paper deals with the Dispute Resolution process prescribed by National Internet Exchange of India (NIXI). NIXI is a Company registered under the Companies Act¹. The Purpose of the Dispute Resolution process is to resolve the Dispute concerning the domain name between the Complainant and the Respondent. The Dispute Resolution Process is facilitated with the help of following two documents:

1. **.IN Domain Name Dispute Resolution Policy (INDRP)**- The Policy prescribes the terms and conditions to resolve the dispute between the parties.
2. **INDRP Rules of Procedure**- This covers the procedural aspect regarding filing of Complaint, Appointment of Arbitrator, Fees of Arbitrator and other related aspects.

In furtherance to objectify the provisions of Policy and Rules of Procedure , it is imperative to understand some terms. The word “**Registrant**” denotes holder of internet domain name. Another important term is “.IN Registry” which refers to the National Internet Exchange of India.

There are some declarations made by the Registrant before registering the domain name. Some of the important **declarations** made by the Registrant are that the Registrant domain name does not violate the rights of any third party, the domain name is not used for any illegal purpose and it complies with all the laws.

If the Complainant files Complaint to the Registry and the Complaint complies with policy and rules then there will be mandatory arbitration proceeding and the Registrant cannot withdraw from such proceeding.

The Important provisions of the **INDRP** are as follows:

Reasons for filing Complaint

¹NIXI is a not for profit Organization under section 8 of the Companies Act 2013.

The Complainant can file the Complaint on the basis of following reasons:

1. If the Registrant domain name is identical or similar to the Plaintiff's mark.
2. If the Registrant does not have any rights w.r.t domain name.
3. If the domain name of Registrant is registered in bad faith.

What Constitutes Registration and Use of Domain Name in Bad Faith

Any of the following acts shall constitute the **bad faith** on the part of Registrant:

1. The Registrant has registered the Domain name primarily for the purpose of transferring it to the Complainant who is the owner of mark related to that domain name for a consideration exceeding the expenses incurred in the registration of Domain name.
2. The Registrant has registered the Domain name in order to prevent the owner of mark from using the mark in Domain name and has engaged in a number of such conducts.
3. The Use of Domain name by Registrant is done intentionally to bring users to the Registrants website by creating confusion with the Complainant's Mark.

How to Prove Registrant rights in the Domain Name

Any of the following acts shall prove Registrant's **right** in the Domain Name:

1. The Registrant was using the Domain Name in respect of goods or services before any notice of dispute to him.
2. The Registrant has been widely known by the Domain name even if the Registrant has acquired no mark in respect of Domain name.
3. Registrant is making a fair use of the domain name without having any motive for profit.

The Policy clearly states that there will be no involvement of .In Registry in the proceedings of Arbitration and the Registry **shall not be liable** in respect of decisions of the Arbitrator.

Remedies Available to the Complainant

The Remedies available to the Complainant in respect of Arbitration proceedings are:

1. Cancellation of the Registrant's Domain Name or

2. Transfer of the Registrant's Domain name to the Complainant.

The **costs** may also be awarded by the Arbitrator to the Complainant.

Changes in Policy

The Policy can be **modified, updated or deleted** by the Government of India at any point of time. The updated policy shall be published on the website www.registry.in .

Rules of Procedure

The important aspects of Rules of Procedure are as follows:

How to file a Complaint against Registrant?

1. Any person can file a Complaint by submitting a **request** to Registry complying with the Policy and Rules. The Complaint should be addressed to the Registry with the proper address, telephone no., fax and email address mentioned on the website of Registry. The Complaint shall be submitted in **three hard copies** and **one soft copy**.
2. The Complaint shall contain a request by the Complainant to submit the dispute to arbitration
3. The Complaint should state **the adequate details** of the Complainant like Telephone no, Email, Postal Addresses etc. as well as that of Respondent which is known to the Complainant.
4. The Complaint shall specify the domain name which is the **subject matter of the dispute**.
5. It shall state the **mark** on which the Complaint is based and for each mark shall specify the goods or services which is associated with the mark.
6. The most important component of the Complaint should denote the **grounds** on which the Complaint is based which are as follows:
 - a) How the Domain Name which is the subject matter of dispute is identical or similar to the mark of the Complainant.

- b) Reasons stating why the Respondent should be considered as having no right in respect of domain name.
 - c) Why the domain name is considered having registered and used in bad faith by the Respondent.
7. The Complaint should clearly state the **remedies** sought by the Complainant.
 8. **Annexure** containing any evidence relied by the Complainant should be attached with the complaint.

The Registry on receiving Complaint shall forward it to the Respondent.

Communication to Respondent

The Registry can send the Complaint to the Respondent by sending it to:

1. All the mail addresses shown in the data base of the registry.
2. To the email address as shown in the registration data of Domain name maintained by the registry.
3. Sending the Complaint in writing to Respondent.

All the Communications made among parties or between party and registry or between arbitrator and parties shall be **governed by the communication prescribed under the rules.**

Notification of Complaint

1. The Registry shall forward the Complaint to the Respondent within three working days if it is found in accordance with the policy and rules.
2. If there are deficiencies, the Registry shall notify the Complainant of such deficiencies within three working days of deficiencies identified and the Complainant shall modify it within five working days failing which the arbitration proceedings shall be deemed withdrawn.

3. The Registry shall on the receipt of the correct Complaint shall appoint Arbitrator to adjudicate the dispute.

Appointment of Arbitrator

1. The Registry is required to maintain a list of Arbitrator and their qualifications on its website.
2. It shall appoint an Arbitrator out of that list within five working days of receipt of correct Complaint.
3. The Registry shall notify the parties of the Arbitrator appointed after appointment of Arbitrator by the Registry.
4. The Arbitrator shall pass a reasoned award and forward the copy of award to the Complainant, Respondent and Registry.
5. The award shall be passed **within sixty days from the commencement of proceedings**. This period may be extended by thirty days in case of exceptional circumstances.
6. The Arbitrator shall issue notice to the Respondent within three days from the receipt of the Complainant from the Registry.

Arbitrator shall be Impartial and Independent

1. If at any time during Arbitration proceeding, new circumstances arise which gives rise to a doubt regarding the impartiality and independence of Arbitrator, the Arbitrator shall disclose such circumstances to the Registry. The Registry shall have the discretion to substitute the Arbitrator from the list of Arbitrators maintained by it.
2. If the Arbitrator **dies or is unable to act** then the Registry shall upon written request by either party appoint a **new Arbitrator** from the list of Arbitrators.
3. The impartiality of the Arbitrators can be challenged by the either party within seven days of appointment and by filing a written request to the Registry stating the circumstances justify giving rise to doubt regarding impartiality of Arbitrator. The Registry shall decide on its own discretion whether the doubt is justified or not.

Powers of Arbitrators

1. The Arbitrator shall conduct the proceedings in accordance with **Arbitration & Conciliation Act 1996² and these rules and policy prescribed.**
2. The Arbitrator shall ensure that the **Principles of Natural Justice** is followed in conduct of its proceedings.
3. The Arbitrator shall conduct **proceedings with due expedition.**
4. The Arbitration proceedings shall be conducted in **English language.**
5. The Arbitrator shall **not conduct personal hearings** except when it is required so.
6. The Arbitrator shall decide the matter on the basis of documents and statements furnished by parties.
7. The Arbitrator shall forward its decision to the Registry within sixty days of the commencement of the proceedings.

Arbitral Decisions

The decision of the Arbitrator shall be in **writing** and shall specify the name of Arbitrator. The decision of the Arbitrator shall be **final and binding on the parties**. But, in case the parties enter into settlement before the Arbitration proceedings then the Arbitrator shall **terminate its proceedings** and the settlement shall be binding.

Provision regarding Fees

1. The entire fees of the Arbitrator shall be paid by the **Complainant**.
2. In case the personal hearing is required by the Arbitrator, then the fees for personal hearing shall be **split up equally between the parties**. Otherwise, the party who makes the request for personal hearing shall pay the fees.
3. The entire administration fees shall be paid by the **Complainant**.

Recent Judgements

In a very recent judgement of *M/s Patagonia v M/s Doublefist Ltd*³ the disputed domain name was www.patagonia.co.in. The Complainant was in the business of outdoor apparel company and

²The Arbitration and Conciliation Act, 1996, No. 26, Acts of Parliament, 1996 (India).

the Complainants products and services enable the customers to pursue outdoor activities. The Complainant was well known for its products by producing highest quality and distinguishing the products. The Respondent's activities were not known.

The Complainant contended that each of the elements specified in Domain Name Dispute Resolution Policy was present. The Complainant was the registered proprietor of the trademark "PATAGONIA" and the said trademark acquired high degree of distinctiveness, distinguishing character. The Complainant contended that the words "co" and "in" in a domain name is insignificant and it will not be perceived by the public as a different, eligible to distinguish the Respondent. The disputed Domain name clearly leads the public to believe that it relates to the services offered by the Complainant.

The Second contention of the Complainant was that the Respondent was not commonly known by the trademark "PATAGONIA". The Complainant argued that the Respondent doesn't own any trademark registration as "PATAGONIA" and also doesn't have any license from the Complainant to use the expression "PATAGONIA".

The third contention of the Complainant was that the Respondent has created the website with the intention of misleading the members of trade and public that the disputed domain name belongs to the Complainant and related to the Complainant's business.

The Respondent did not give any evidence indicating his relation with Domain Name.

The Arbitrator held that though the Complainant has not given any explanation for the delay of more than 8 years in filing the Complaint but all the elements of Dispute Resolution Policy are proved and accordingly transferred the Domain Name to the Complainant. The Arbitrator relied on a very important judgement of Supreme Court *Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.*⁴ in which it was held that the domain name has become a business identifier. It was observed in Satyam case that a Domain Name helps identify the subjects of trade or services that an entity seeks to provide to its customer.

³M/s Patagonia v M/s Doublefist Ltd INDRP/1185/2019 (India).

⁴Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd **2004 Supp(2) SCR 465 (India)**

In another recent judgement *Hotel Cipriani S.p.a v. HridayTulsiani*⁵ the disputed domain name was www.cipriani.in. The Complainant submitted that Hotel Cipriani is the proprietor of one of the most prestigious hotels of the world. The Complainant submitted that it is the registered proprietor of the mark “CIPRIANI” and it owns various domain name in the Trademark. The Complainant contended that all three pre requisites of Domain Name Policy are proved.

Upon the receipt of Complaint, the Respondent agreed to transfer the domain name to the Complainant. The Arbitrator concluded that the Respondent does not have any legitimate interest in the Domain Name and the Domain name is used in the bad faith and accordingly transferred the domain name to the Complainant. The Arbitrator relied on the judgement of *Satyam Infoway v. Sifynet Solutions Pvt Ltd.*⁶ in which it was held that the Domain name has all characteristics of Trademark.

Conclusion

With the digital medium getting increased day by day, more domain names are being registered every day. More the number of registration of domain names, it will enhance the chances of disputes. This Dispute Resolution process prescribed by the Government saves time and protects the Complainant from the action of Respondent.

⁵Hotel Cipriani S.p.a v. HridayTulsianiINDRP/1179/2019 (India).

⁶Satyam Infoway v. Sifynet Solutions Pvt Ltd2004 Supp(2) SCR 465

One of the lacunas in this process is that the entire cost of the proceeding is borne by the Complainant. It places a heavy burden on the Complainant considering the current business environment. Another shortcoming in the process is the way of appointment of arbitrator and no mandatory in-person hearings. The provision of Appointment of Arbitrator from the list of Arbitrators provided by Registry is a very rigid provision. The parties should be given opportunity to appoint the arbitrator provided the Arbitrator fulfills the criteria of Appointment laid down by the Registry. The discretion to hold in person hearings is on the Arbitrator and even if the party requests so, the burden of cost of such hearings is on him. This provision should be relaxed.

Overall, the policy is a booster to the business community to settle the dispute faster and redress their claims.

References

1. Website of Registry (www.registry.in)
2. Case Decisions (<https://www.registry.in/Policies/DisputeCaseDecisions>)

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