

INDIA

Fighting Online Infringement

The emergence of the digital era, aided by computer networks and the internet, has brought many obvious advantages, along with many complex intellectual property issues resulting in significant changes to the legal landscape. Contrary to allocation of rights in the physical world, which is geographically limited, the internet provides colossal opportunity for a brand to globally communicate its message. Its unfettered nature and anonymity have provided new avenues for infringement of IP rights in the virtual world.

IP Infringement on the Internet

The most frequent cause of disputes on the internet has been the infringement of copyright and trademark rights. Online illicit activities include search engine marketing abuse, search engine optimization manipulation, cybersquatting and typosquatting and the Adwords issue, not to mention the trademark violations caused by deep linking, meta-tagging, banner advertising, framing, etc. This often results in exploitation of the rights holder's brand, counterfeit and grey market sales.

Tackling IP Infringement

In India, though the Copyright Act does not address the liabilities of online intermediaries, the Information Technology (Amendment) Act, 2008, though not directly addressing any IPR issues, provides provisions which would have impact on IPR in the digital environment. It also tends to clarify the scope of immunities available to intermediaries. The decision of the Delhi High Court in the case of *Super Cassettes India Ltd. (SCIL) v. MySpace* on the issue of intermediary liability for copyright infringement of works owned by SCIL (T-Series) also plays significant role in defining safe harbor provisions for intermediaries. There are instances where producers of movies also seek *John Doe* orders to prevent online piracy.

Since, unlike offline media, rights holders have little control over brand-related content online, a comprehensive strategy for online brand protection should be adopted. Cease and desist notices should be sent immediately to ensure that infringing content is

removed from the internet. Action should be taken against infringers on multiple fronts, including getting the infringing sites disabled.

Owing to the frequent difficulty of ascertaining the jurisdiction where the infringement is occurring, it is complicated and cumbersome to claim damages for online infringement. Still, courts and competent administrative authorities play a crucial role in stopping the illegitimate online use of brands. Rights holders should realize the importance of securing evidence and the underlying facts as these play significant roles in court proceedings, particularly in suits for interim relief.

For domain name disputes, the proceedings will need to be initiated in the jurisdiction where the country code top level domain (ccTLD) is registered. As the cost of registering a domain name is extremely low in comparison to the cost of litigation, traditional court proceedings are not always practical for resolution of domain name disputes.

The Uniform Domain Name Dispute Resolution Policy adopted by ICANN offers an expedited administrative proceeding for trademark holders to contest "abusive registrations of domain names." In India, the same is provided by the IN Dispute Resolution Policy (INDRP) formulated by the .IN registry. The INDRP is available for complaints regarding any domain names within the ".in" and ".co.in" ccTLD, and the decision of the same is made binding under the Arbitration and Conciliation Act, 1996 of India. Some of the domain names which have been transferred after the dispute was referred to the INDRP include www.pizzahut.in, www.gmail.co.in, www.nescafe.co.in, and www.starbucks.co.in. However, in *Citi Corp and Another v. Todi Investors and Another*, the High Court of Delhi clarified that the INDRP policy does not prescribe a mandatory procedure for the resolution of domain name disputes. The legal position involving .in domain names would also fall within the jurisdiction of the Civil Courts in India.

Jurisdiction Issues

As far as jurisdiction is concerned, the online availability of copyrighted materials goes on to highlight the complex enforcement issues involving the owner of IP rights, the infringer and the ISPs. The place from where the work is posted on the net or where the website server is located or from where the user downloads the work



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may all play a role in determining the jurisdiction. The case of *Himalaya Drug Company v. Sumit* is one such case where the Delhi High Court exercised its jurisdiction over the overseas defendant as the infringing copies were accessible to internet users in Delhi. The plaintiff had an herbal database which was allegedly copied and posted on the defendant's website that was hosted by a server in the United States. An ex parte injunction was granted following which the plaintiff served the copy of the order to the US-based ISP requesting it to deny access to or disable the infringing website. The US-based ISP server later removed the site.

Effective IP enforcement in the online world is a complex affair. The ever-increasing online sales of counterfeit and gray market products as well as online infringement can, however, be efficiently dealt with if proactive defense and decisive enforcement actions are taken by rights holders.

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