

उत्तर प्रदेश UTTAR PRADESH

AW 038420

18 NOV. 2011

BODHISATVA ACHARYA
ARBITRATOR

(Appointed by IN Registry-National Internet Exchange of India)

Case No. Of 2012.

ARBITRATION AWARD: DISPUTED DOMAIN NAME: www.mahindra.co.in

In the matter of:

Mahindra India
World Headquarters
Mahindra Towers,
Media cube,
G.M.Bhosale Marg,
Worli,
Mumbai 400 018

Filed by its authorized representative attorney -

Nidhish Mehrotra/Rodney D. Ryder

ANM Global, Advocates & Solicitors, A 6/21, Lower Ground floor,
Vasant Vihar, New Delhi

E-mail: nidhish.mehrotra@anmglobal.net/

Rodney.ryder@anmglobal.net

...Complainant

Vs.

**Wangyuan
Milwaukee
WI 53214,
USA
E-mail: ymgroup@msn.com**

Respondent.

A W A R D

1. The Parties:

The complainant in this arbitration proceeding is Mahindra India, World Headquarters, Mahindra Towers, Media cube, G.M.Bhosale Marg, Worli, Mumbai 400 018 filed by its authorized representative Nidhish Mehrotra/Rodney D. Ryder, ANM Global, Advocates 4 solicitors, A 6/21 Lower Ground Floor, Vasant Vihar-New Delhi with email address as nidhish.mehrotra@anmglobal.net/Rodney.ryder@Qnmglobal.net

Respondent in this arbitration proceeding is Wangyuan, Milwaukee, WI 53214, USA.
E-mail: ymgroup@msn.com

2. The Domain Name, Registrar & Registrant:

The disputed domain name is www.mahindra.co.in

3. Procedural History:

The complainant, through its authorized representative, filed this complainant to NIXI regarding the disputed domain name www.mahindra.co.in following the clause 4 of the policy of .IN Registry and .IN Registry appointed Mr. Bodhisatva Acharya (The Arbitrator) as Sole Arbitrator under clause 5 of the policy. The Arbitrator submitted his statement of acceptance and declaration of Impartiality and the Independence on December 31st- 2011 and the complaint was produced before the Arbitrator on February 2nd, 2012 and the Arbitrator sent a notice of Arbitration proceeding to Respondent on February 2nd, 2012 through the email of Respondent but Respondent never filed his reply therefore the complaint is being decided as Ex-parte on March 12th, 2012.

4. Factual Background:

- A. Mahindra and Mahindra Limited a company incorporated under the Indian Companies Act, 1913 Founded in 1945 as a Steel Trading Company entered into automotive manufacturing in 1947 to bring the iconic Willys Jeep onto Indian roads. Over the years, Mahindra has diversified into many new businesses in order to better meet the needs of their customers. They follow a unique business model of creating empowered companies that enjoy the best of entrepreneurial independence and Group-wide synergies. This principle has led our growth into a US \$14.4 billion multinational group with more than 144,000 employees in over 100 countries across the globe.

- B. The Complainant is among the top ten industrial houses in India and is the second largest tractor manufacture in the world. The Mahindra Group has a leading presence in key sectors of the Indian economy, including the automotive sector, real estate affairs and building and construction services, financial services, trade and logistics, information technology, infrastructure development, hotel & resort and after-market,



retail trade and also the educational field and is continuing to expand its scope of goods and services every day.

- C. Today, Mahindra operations span 18 key industries that form the foundation of every modern economy- aerospace, aftermarket, agribusiness, automotive, components, construction equipment, finance and insurance, industrial equipment, information technology, leisure and hospitality, logistics, real estate, retail, and two wheelers. Mahindra has grown from a humble local outfit to a US \$14.4 billion corporation employing more than 144,000 people around the world.
- D. The Complainant considers their trade/service name/mark an important and an extremely valuable asset and thus in order to protect the same, has secured trade mark registration for the mark "Mahindra" globally including India. The present official website www.mahindra.com is a comprehensive, unique and acclaimed introduction to Mahindra Limited. That the profile and popularity of the Complainant under the trade/service name/mark "Mahindra" has been continuously increasing since the date of adoption and use of the mark. At present, the Complainant's name/trade is a name to reckon with and has acquired an enormous goodwill not only in India but in many countries across the world.
- E. The Complainant has spent a huge amount of money on the promotion and advertisement of its services and products under the trade/service name/mark "Mahindra" since its adoption and use. The Complainant Sales turnover was into crores of rupees. The complainant states that the gross sales of traded and manufactured goods by the complainant during the Financial year 1st April 2010 to 31st March 2011 was Rs 25895.95.
- F. The Complainant is the registered proprietor/applicant of the mark 'Mahindra'. The Complainant submits that the filings and registration listed for the mark 'Mahindra' are in force, duly valid and subsisting as on date.



Mahindra has been recognized as a "well Known mark" by the Hon'ble Supreme Court and the same has been listed in the well known marks columns in the website of Controller General of Patents Designs and Trademarks.

G. The Complainant in order to expand its *presence* decided to obtain a domain name registration. The Complainant settled for www.mahindrQ.com [along with many other domain name registration of its domain name. The complainant then spent considerable amount of money and skill to develop a website on the obtained domain name <www.mahindra.com>. The complainant also has the following domains registered which are as follows.

1. www.mQhindra.us
2. www.mahindrQ.niz
3. www.mahindrQ.Qu
4. www.mahindrQspQresbusiness.com
5. www.mQhindraintertrQde.com
6. www.mahindrQShubhlQbh.com
7. www.mahindrQworld.com
8. www.mQhindrafinQnce.com
9. www.mQhindrQScorpio.com
10. www.mQhindratrQctors.com
11. www.mQhindrQworldcity.com
12. www.mQhindrQlifespaces.com

H. Recently, the Complainant was in utter surprise and was shocked to know that somebody has obtained a domain name registration for <www.mahindra.co.in>. The Complainant immediately searched the WHOIS database for the disputed domain name and found that the impugned domain name is registered in the name of Mr. Wanyuan. The registrar for the disputed domain name is Direct Interet Solutions Pvt. Ltd. The malafide and devious intention of the Respondent is evident from the glaring fact that the disputed domain name registration is a duplication of the Complainant's trademark/service mark globally including India.

I. Lastly the Complaint was filed for arbitration proceeding to NIXI but Respondent filed no reply and hence is being decided as ex-parte on March 12th - 2012.



5. Parties Contentions:

(a) Complainant contends that

- (i) The Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (ii) The Registrant has no rights or legitimate interests in respect of the domain name; and
- (iii) The Registrant's domain name has been registered or is being used in bad faith, and the domain name be transferred to the Complainant.

(b) Respondent contends that

The respondent never filed his reply properly.

6. Discussion A Findings:

Under the Paragraph 4 of the Policy (INDRP) Any Person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

- (i) The Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has right.
- (ii) The Registrant has no rights or legitimate interests in respect of the domain name; and
- (iii) The Registrant's domain name has been registered or is being used with bad faith

After having gone through the records, documents, produced by the Complainant, Arbitrator's findings are:

- (i) That the disputed domain name gives rise to enormous confusion as to its origin as the domain name used by the Respondent is identical to the corporate name of the Complainant in and unto which the complainant otherwise have



and assert statutory and common law proprietary rights. The Complainant has undertaken tremendous efforts in terms of publicity and marketing activities, not only within India but also across the world. The utmost malafide intention of the respondent is evident from the fact that not even a single letter differs between the disputed domain name and the corporate name of the Complainant. WIPO /ARBITRATION AND Mediation Center in cases such as Reuters Ltd. v. Global Net 2000 Inc. has held that the mere omission of one letter of a trade mark has no effect on the determination of confusing similarity between a trade mark and a domain name. The present case is on an even higher footing as the Respondent has picked up the mark/name of the Complainant verbatim without even changing a single letter. Thus, the use of the disputed domain name by the Respondent is a prima facie case of cyber squatting and trade/services mark/name infringement.

The disputed domain name contains the entirety of the Complainant's trademark. It is well established that the specific top level domain, such as ".com", ".in", ".net" or ".travel", does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

The mark "Mahindra" has been in extensive, continuous and uninterrupted use since the year 1945 in relation to the Complainant's business. In Mahendra & Mahendra Paper Mills Ltd. versus Mahindra Ltd. (2002)2 SCC 147] the Hon'ble Supreme Court of India has observed that Mahindra name has acquired distinctiveness and a Secondary meaning in the business or trade. People have come to associate the name "Mahindra" with a certain standard of goods and services. Any attempt by another person to use the name in business and trade acts is likely to and is probability will create an impression of a connection with the Complainant's group of companies.

The domain name <www.Mahindra.co.in> is identical to the trademark "Mahindra". As numerous UDRP panels have held in so many decisions [See Farouk Systems, Inc. v. Yishi case No. D2010-0006] that a domain name wholly incorporates a



complainant's registered mark may be sufficient to establish identity or confusing similarity, despite the addition of other words to such marks.

- (ii) The Respondent in this administrative proceeding has no rights or legitimate interests whatsoever in the disputed domain name and more particularly those giving rise to the circumstances prevailing in paragraph 4 (c) of the policy. It is submitted that there is no bona fide offering of goods or services under the disputed domain name by the Respondent.

The Respondent has no proprietary or contractual rights in any registered or common law trade mark corresponding in whole or in part to the disputed domain name.

The Complainant submits: [1] Respondent has no connection with the Complainant or any company licensed by Complainant; [2] Respondent is not commonly known by the disputed domain name or the trademark; [3] Respondent was not and is not authorized by Complainant to register, hold or use the disputed domain name.

- (iii) The Complainant's "Mahindra" trademark is globally well known as they have continuously been used since 1945. Further, the Marks have received extensive unsolicited media attention, having been prominently featured in numerous publications with local, national and international audiences. The Complainant submits that the brand of the complainant has become so valuable that it represents the amount by which the brand is likely to enhance the company's future cash flows.

The disputed domain name <www.Mahindra.co.in> is being held by the Respondent. This is in bad faith and a clear attempt to take advantage of the Complainant's goodwill and reputation. The name/mark "Mahindra" has acquired important and is associated with the Complainant and the said name/mark establishes an identity and connection with the complainant and none else.




- (iv) The Complainant thus has satisfied the Arbitrator on all the parameters as mentioned in the Paragraph 4 of the Policy (INDRP).

7. Decision:

Hence the Arbitrator decides, the Disputed Domain Name www.mahindra.co.in is identical or confusingly similar to registered trademark of the Complainant and Respondent has no right to use the disputed domain name and the Respondent domain name has been registered in bad faith.

The Arbitrator further decides and orders that the domain name www.mahindra.co.in shall be transferred to the Complainant with immediate effect.


BODHISATVA ACHARYA
SOLE ARBITRATOR
NIXI 12/03/2012

DATED: March 12th, 2012,
PLACE: NEW DELHI,
INDIA.

Bodhisatva Acharya
LL.M., PGDM.
Arbitrator
NTXI
INDIA

Postal Address: Director,
Translam College of Law, Mawana
Road, Meerat-250001, INDIA
Contact No. +91 90125 92222
Email: a_s_bharvi215Aahoo.com

Ref. No. invS/arb/pro/11-12

Dated: March 12th, 2012


To,
Mr. Rajiv Kumar
1.O.
NIXI,
INDIA.

Dear Sir,

I have sent you the AWARD in the disputed Domain Name www.mahindra.co.in and you are kindly requested to send my arbitrator fees Rs.9000/- for arbitration proceeding at your earliest disposal.

With my best regards

Yours truly,


BODHISATVA ACHARYA
Arbitrator
NIXI
INDIA
12/03/2012