



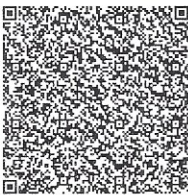
सत्यमेव जयते

## INDIA NON JUDICIAL

### Government of National Capital Territory of Delhi

#### e-Stamp

Certificate No.	: IN-DL46932971074187S
Certificate Issued Date	: 09-Jun-2020 02:34 PM
Account Reference	: IMPACC (IV)/ dl717303/ DELHI/ DL-DLH
Unique Doc. Reference	: SUBIN-DL71730302546924934719S
Purchased by	: V K AGARWAL
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: V K AGARWAL
Second Party	: Not Applicable
Stamp Duty Paid By	: V K AGARWAL
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



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NATIONAL INTERNET EXCHANGE OF INDIA

6C, 6D, 6E, Hansalaya Building,  
15, Barakhamba Road,  
New Delhi – 110 001

**WHAT3WORDS LIMITED v. VINIT SAXENA**

**Case No. 1229/2020**

*Kagani*

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**WHAT3WORDS LIMITED v. VINIT SAXENA**

**Case No. 1229/2020**

**AWARD****1. The Parties**

The Complainant is WHAT3WORDS LIMITED, Studio 301, Great Western Studios, 65, Alfred Road, London W2 5EU. United Kingdom.

The Respondent is Mr. Vinit Saxena, A 23, Konark Towers, Vastrapur, Satellite, Ahmedabad, Gujarat - 380015, India

**2. The Domain Name and Registrar**

The disputed domain name is <www.what3words.in>. The said domain name is registered with the Registrar NameSilo, The details of registration of the disputed domain name, as indicated in WHOIS (Annexure to the Complaint) are as follows:

- |                       |                  |
|-----------------------|------------------|
| (a) Domain ID:        | D9979238 – IN    |
| (b) Registrar:        | NameSilo LLC     |
| (c) Date of creation: | October 23, 2015 |
| (d) Expiry date:      | October 23, 2020 |

**3. Procedural History**

- (a) A Complaint dated March 11, 2020 has been filed with the National Internet Exchange of India. The Complainant has made the registrar verification in connection with the domain name at issue. The print outs so received are attached with the Complaint as an Annexure. It is confirmed that the

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Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the "Policy") and the Rules framed thereunder.

- (b) The Exchange appointed Dr. Vinod K. Agarwal, Advocate and former Law Secretary to the Government of India as the sole arbitrator in this matter. The arbitrator finds that he has been properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.
- (b) In accordance with the Policy and the Rules, a copy of the Complaint was sent to the Respondent on the given address and the same has been served on him.

#### 4. Factual Background

From the Complaint and the various Annexure to it, the Arbitrator has found the following facts:

##### **Complainant's activities**

According to the Complaint, the Complainant, **WHAT3WORDS Limited**, based in the United Kingdom, is engaged in a geolocation business. One of the key features Complainant's activities is creation of unique three word addresses for three meter by three meter "squares" of the earth's surface. Thus, the Complainant creates a precise and easy-to-use alternative to GPS coordinates and traditional zip code and postal code system.

The Complaint indicates that what3words was founded by Chris Sheldrick, Jack Waley-Cohen, Mohan Ganesalingam, and Michael Dent and was launched in July 2013. What3words uses a grid of the world made up of 57 x10 squares of 3 meters by 3 meters. Each square has been given an address composed of three words. The addresses are available in 43 languages according to the what3words online map (as of May 2020), and the addresses are not translations of the same words

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## 5. Parties Contentions

### A. Complainant

The Complainant contends that each of the elements specified in the .IN Domain Name Dispute Resolution Policy is applicable to the present dispute. The said elements are as follows:

- (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's has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and
- (iii) The Registrant's domain name has been registered or is being used in bad faith.

In relation to element (i), the Complainant contends that the Disputed Domain Name is identical with and/or confusingly similar to the Complainant's Mark "WHAT3WORDS". The Disputed Domain Name incorporates the Complainant's trade name and registered trademark in its entirety.

According to the Compliant (Annexure 2), the Complainant is the registered proprietor of the following trademarks:

- (a) UK Trade Mark No. 2656721 for the mark "WHAT3WORDS" filed on 15<sup>th</sup> March 2013 and registered on 05<sup>th</sup> July 2013 for classes 9, 25, 38, 39, 42 and 45;
- (b) EUTM No. 013529111 for the mark "WHAT3WORDS" filed on 04<sup>th</sup> December 2014 and registered on 08<sup>th</sup> April 2015 for classes 9, 25, 38, 39, 42 and 45;

Therefore, the disputed domain name is identical and/or confusingly similar to the registered trademark "WHAT3WORDS" of the Complainant.

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In relation to element (ii), the Complainant contends that the Respondent (as an individual, business, or other organization) has not been commonly known by the mark "WHAT3WORDS". The Respondent does not own any trademark registration as "WHAT3WORDS" or a mark that incorporates the expression "WHAT3WORDS". The Respondent has no license or authorization or permission from the Complainant to either use the mark "WHAT3WORDS" or to register the disputed domain name.

Further, the Respondent does not have any rights or legitimate interest in the Disputed Domain Name. According to the Complainant, as on the date of submission of the present Complaint, there are no goods or services offered on this domain, nor is there any substantive content on the page. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public. The domain is merely a "parking page" with links to other websites including a link stating "*the domain what3words.in may be for sale*". *Click here to inquire about this domain*".

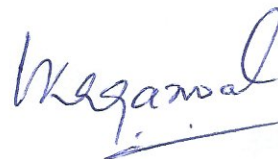
Therefore, the Respondent has no legitimate right, justification or interest in the disputed domain name.

Regarding the element at (iii), the Complainant contends that the Respondent has registered the Disputed Domain Name in bad faith and for its actual use in bad faith.

Further that, absence of use and passive holding of a domain name constitutes bad faith. The Complainant has stated that the use of a domain name that appropriates a well-known trademark to promote competing or infringing products cannot be considered a "*bona fide offering of goods and services*".

## **B. Respondent**

In response to the Complaint, the arbitrator and the National Internet Exchange of India have on May 28, 2020 at 2:45 PM received an e mail from the Respondent. The said e mail states as follows:





Hello Dr. V K Agarwal,

I was not aware of the trademark on this name till I received this notice.

I'm willing to transfer the name to the complainant as per their convenience. Should they have notified me earlier, I would have already done that.

Please ask complainant to provide the details required and I will do the needful at my earliest.

Note: If complainant have account with namesilo.com then I can push the domain to their account within no time.

Thanks & regards.

Vinit

## 6. Discussion and Findings

The Rules instructs this arbitrator as to the principles to be used in rendering its decision. It says that, "a panel shall decide a complaint on the basis of the statements and documents submitted by the parties in accordance with the Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable".

According to the Policy, the Complainant must prove that:

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

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A. *Identical or Confusingly Similar*

The disputed domain name <WHAT3WORDS.IN> was registered by the Respondent on October 23, 2015. The registration of the said disputed domain name will expire on October 23, 2020.

The Complainant is an owner of the registered trademark "WHAT3WORDS". The Complainant is also the owner of a number of domains with the said trademark. Most of these domain names and the trademarks have been created by the Complainant much before the date of creation of the Disputed Domain Name by the Respondent. The disputed domain name is <www.what3words.in>. Thus, the disputed domain name is very much similar to the name and the trademark of the Complainant.

Therefore, I hold that the domain name <www.what3words.in> is phonetically, visually and conceptually identical or confusingly similar to the trademark of the Complainant.

B. *Rights or Legitimate Interests*

The Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Registrant (as an individual, business or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or
- (iii) The Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

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There is no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. The name of the Registrant/Respondent is Mr. Vinit Saxena. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not consented, licensed or otherwise permitted the Respondent to use its name or trademark "what3words" or to apply for or use the domain name incorporating said mark. The domain name bears no relationship with the Respondent/ Registrant. Further that, the Registrant has nothing to do remotely with the business of the Complainant.

I, therefore, find that the Respondent has no rights or legitimate interests in the domain name as per INDRP Policy, Paragraph 4(ii).

*C. Registered and Used in Bad Faith*

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

- (i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the domain name; or
- (ii) the Registrant's has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or
- (iv) by using the domain name, the Registrant has intentionally attempted to attract the internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or

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of a product or service on the Registrant's website or location.

The contention of the Complainant is that the present case is covered by the circumstances mentioned herein above. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark.

The Respondent's registration of the domain name <www.what3words.in> is likely to cause immense confusion and deception and lead the general public into believing that the said domain name enjoys endorsement or authorized by or is in association with and/or originates from the Complainant.

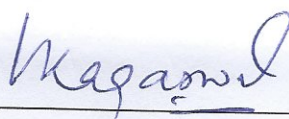
In any case, as has been mentioned above and as mentioned by the Complainant, the Respondent has offered the Disputed Domain Name for sale.

The foregoing circumstances lead to the presumption that the domain name in dispute was registered and used by the Respondent in bad faith.

## 7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to a mark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name, and that the domain name was registered in bad faith and is being used in bad faith, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <WWW.WHAT3WORDS.IN> be transferred to the Complainant.

In any case, the Respondent has in the e mail already stated that "I'm willing to transfer the name to the complainant as per their convenience. Please ask complainant to provide the details required and I will do the needful at my earliest."



Vinod K. Agarwal  
Sole Arbitrator

Date: June 09<sup>th</sup>, 2020