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H 130065

ARBITRATION CASE NO. 2 OF 2009

IN THE ARBITRATION MATTER OF:

TELENOR ASA

.COMPLAINANT

VERSUS

DOMAIN MANAGEMENT INC.

.RESPONDENT

AWARD:

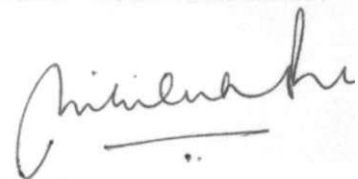
The present dispute has arisen over the registration of the domain name www.telenor.co.in in favour of the Respondent. The Complainant through the instant complaint claims its rights over its registered mark/brand 'Telenor' and questions the bonafide of the Respondent's domain name www.telenor.co.in which is deceptively similar to the complainant's brand name 'Telenor' and its numerous registered domain names associated with the brand name 'Telenor'. The complainant seeks a

transfer of the impugned domain name www.telenor.co.in in favour of the complainant.

The Complainant has filed the present complaint under the .IN Domain Name Resolution Policy of .IN Registry.

The Complainant has contended in its claim that its business activities transcends across various countries of the world, alongwith with its subsidiaries, sister concerns and allied companies, all referred to as "Telenor Group" and that the claimant has registered its mark 'TELENOR' in different countries including Australia, Benelux, Croatia, Denmark, France, Germany, Hongkong, Italy, India, Japan, Switzerland, United Kingdom, United States of America, Malaysia and New Zealand to name a few. The Complainant contends that it is the registrant of the mark 'TELENOR' from 1994 onwards and extending to 2008. A detailed status of the registration of the mark 'TELENOR' by the Complainant with respect to various countries is given under Para 10 of the complaint. From 1994-95 onwards the brand 'telenor' has been in continuous, extensive and exclusive use with respect of the merchandise of the Complainant. Further, its extensive and continuous usage of the marks 'TELENOR' has led to its acquiring a secondary meaning to connote and denote to the relevant section of the public, the merchandise of the Complaint and also tremendous distinctiveness of the same.

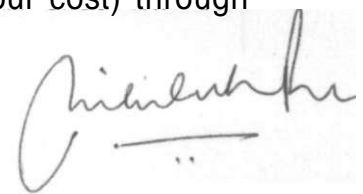
The Complainant has stated that they have made sufficient investment toward the publicity and the promotion pertaining to the mark 'TELENOR'. The Complainant is the registrant of the following domain names containing the said trade mark viz. www.telenor.com, www.telenor.no, www.telenor.se, www.telenor.com.pk, www.telenor.co.vu, www.telenor.ru.



www.telenor.ua, www.telenor.tel. By virtue of its continuous and consistent usage, the Complainant claims to have acquired statutory rights to the exclusive use of the brand name 'TELENOR' and hence challenges the validation of the registration of the domain name www.telenor.co.in in favour of the Respondent, which is deceptively similar to the Complainant's registered domain names. The Complainant has contended that the use of such confusingly similar domain name by the Respondent would create deception in the minds of unwary consumers/ internet users and is bound to divert internet traffic haywire.

In the context the Complainant has relied upon a decision in **Sh Jagdish Purohit vs. Stephen Koeing Dated: July 5, 2006 Decision of INDRP** wherein the issue was the domain name 'Internet.in' vis-a-vis trade mark 'internet'. They were phonetically similar and they both consist of similar 'letters or words' except that in domain name letters, "in", were added. The Complainant has also cited the decision in the case of Satyam Infoway Ltd. Vs. Sifynet Solutions Pvt Ltd., 2004 (28) PTC 566 (SC) wherein it was held that Domain name has all characteristics of trademark. As such principles applicable to trademark are applicable to domain names also. In the said case the words, "Sify" & "Siffy" were held to be phonetically similar and addition of the word 'net' in one of them would not make them dissimilar.

The complainant further stated that the Respondent is not, either as an individual, business or organization, commonly known by the name "TELENOR". The respondent is in no way connected to the Complainant and the registration of the said domain name violates the complainant's statutory rights. The Complainant has also pointed out that the respondent in reply to transfer that domain had demanded charges of USD 100 (US\$ 18 being domain name registration fee and US\$82 for labour cost) through

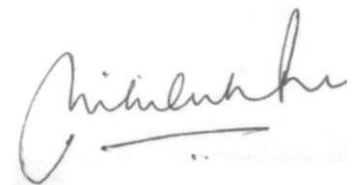
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e-mail dated 06.04.2009 to sell the disputed domain name for USD 400. The Complainant has also mentioned that their domain name www.telenor.pk was also cyber-squatted in similar manner in Pakistan and was awarded in favour of the Complainant after the same was complained with the DNDRC.

The Complainant has also cited similar decisions as held in **Yahoo Inc. vs. Akash Arora, 1999 PTC (19) 201, Montari Overseas vs. Montari Industries Ltd., reported in 1996 PTC 142.** The Complainant asserts that the potential customers would be induced to believe that the Respondent is carrying on activities endorsed by the Complainant. That the Respondent has made false representation to the Registrar that his domain name will not infringe the trade mark rights of any third party.

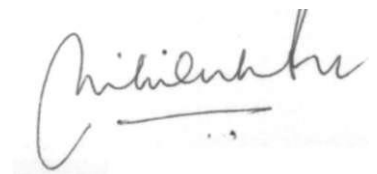
Notice was issued by me on the said complaint to show cause. In response to which, the Respondent has failed to bring forth any reply. In the interest of justice, any further delay in deciding this matter is uncalled for. Hence I choose to proceed with the adjudication of said complaint ex-parte.

On the analysis of the document and record submitted by the Complainant, it is seen that the Complainant had registered the trademark "TELENOR" in various countries and it has been in use with respect to the business activities of the Complainant since 1994-1995. The Complainant is also the registrant of the domain names www.telenor.com, www.telenor.no, www.telenor.se, www.telenor.com.pk, www.telenor.co.vu, www.telenor.ru, www.telenor.ua, www.telenor.tel. The connection between trademarks and domain names has been well observed in various national and international cases. Recently, authorities in India (**Yahoo! Inc Vs. Akash Arora**), the U.K. (**Marks & Spencers & Ors Vs. One in a Millions & Ors.**),



Taiwan(fair Trade Committee 89 Gong Zhu Zi No.036), Italy, Germany, and the USA, among other jurisdiction, have ruled that the act of registering a domain name similar to or identical with a famous trade mark is an act of unfair competition whereby the domain name registrant takes unfair advantage of the fame of the trademark to either increase traffic to the domain, or to seize a potential asset of the trademark owner in the hope that the trademark owner will pay the requirement to relinquish the domain name. The continuation of registration and any subsequent use of the impugned identical domain name by the respondent would cause great prejudice and injury to the commercial interests of the Complainant in the mark "TELENOR". In **Satyam Infoway Ltd v. Sifynet Solutions Pvt. Ltd. 2004(28) PTC 566 (SC)** it was observed by the Hon'ble Supreme Court of India that a domain name is accessible by all internet users and the need to maintain an exclusive symbol for such access is crucial. Therefore a deceptively similar domain name may not only lead to confusion of the source but also the receipt of unsought for services. Furthermore, the Respondent has not come forward to justify the bonafide adoption of the impugned identical domain name.

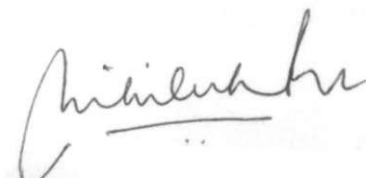
I rely on the findings in the landmark judgment of **Yahoo! Inc. Vs. Akash Arora & Anr.; 78(1999) Delhi Law Times 285**. Also in the judgement of Yahoo judgment, a decision of **Cardservice International Inc Vs. McGee 42 USPQ 2d 1850** was relied, wherein the Hon'ble High Court of Delhi held that the domain name serves the same function as the trademark and is not a mere address and therefore entitled to equal protection as trade mark. In the said case, it was held that, Cardservice international's customers who wish to take advantage of its internet service but do not know its domain name are likely to assume that "cardservice.com" belongs to Cardservice International. However, these

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customers would reach McGee and see a home page for "Cardservice" and thereby assume that they have reached Cardservice International. The Court observed that the services of the plaintiff under the trademark/domain name 'Yahoo!' have been widely publicised and written about globally. In an internet service, a particular internet site could be reached by anyone anywhere in the world who proposes to visit the said internet site.... as a matter of fact in matter where services are rendered through the domain name in the internet, a very alert vigil is necessary and a strict view is to be taken for its easy access and reach by anyone from any corner of the globe....there can be no two opinions that the two marks/domain names 'Yahoo!' of the plaintiff and "Yahooindia" of the defendant are almost similar.... and there is every possibility and likelihood of confusion and deception being caused. The plaintiffs herein were thus granted an interim injunction restraining the defendants from using the domain name 'Yahooindia.com'.

Another similarly decided case is that of **Marks & Spencers & Ors. Vs. One in a Million & Ors**, wherein a British Court ruled that where the value of the domain name consists solely of its resemblance to the trademark of another, the Court could assume likelihood of confusion, and thus find unfair competition. The Court found that the registrant of many domain names similar to famous marks had committed a "deliberate practice....with clear intent to deceive people" as the registrant had no legitimate use for the domain names.

I, therefore, find that the Complainant is the proprietor of several well known domain names, all associated with their registered trade mark "TELENOR" and that these are in long and extensive use thereby acquiring distinctiveness in the merchandise of the complainant. The complainant is the registered proprietor of the marks 'TELENOR' from the year 1994. I find

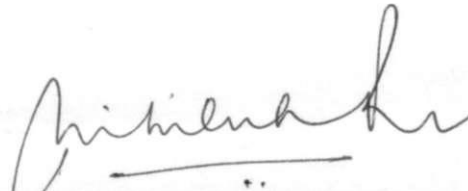
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that the impugned domain name www.telenor.co.in is identical and confusingly similar to the prior registered domain names and registered trade mark of the complainant. Further the respondent has failed to give any reply to the aforesaid complaint of the complainant. The stand of the respondent does not seem bonafide especially in view of the respondent's act of giving an offer to sell the impugned name to the Complainant through an e-mail dated 06.04.2009.

Considering the facts and circumstances of the present matter and taking view of the precedents laid in the context thereof, it is found that the complainant has proprietary right over the mark 'TELENOR' and consequently over the domain name www.telenor.co.in.

Under the facts and circumstances and on perusal of the records, I deem it fit and proper to allow the prayer of the Complainant to the transfer of the said domain name www.telenor.co.in in its favour and the registration of the said domain stands cancelled in their favour.

Parties to bear their costs.



[NIKILESH RAMACHANDRAN]
ARBITRATOR

DATED: 22nd June 2009