



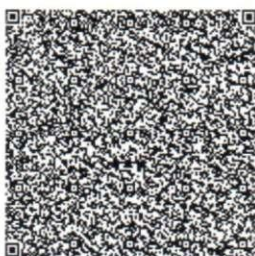
सत्यमेव जयते

INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No.	: IN-DL00126325650403L
Certificate Issued Date	: 08-Apr-2013 11:36 AM
Account Reference	: SHCIL (FI)/ dl-shcil/ HIGH COURT/ DL-DLH
Unique Doc. Reference	: SUBIN-DLDL-SHCIL99702356978910L
Purchased by	: AMARJIT SINGH
Description of Document	: Article 12 Award
Property Description	: NA
Consideration Price (Rs.)	: 0 (Zero)
First Party	: AMARJIT SINGH
Second Party	: NA
Stamp Duty Paid By	: AMARJIT SINGH
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



.....Please write or type below this line.....

ARBITRATION AWARD

.IN REGISTRY - NATIONAL INTERNET EXCHANGE OF INDIA
.IN domain Name Dispute Resolution Policy INDRP Rules of Procedure

IN THE MATTER OF:

Bennett, Coleman & Co. Ltd.
The Times of India Building, No.1
Dr. D. N. Road, Mumbai-400 001

VERSUS

..... Complainant

Mr. Suresh Kumar
Geek IT Solutions Pvt. Ltd.
Flat No. 401, H No: 1-5-980
Shanthi Residency, Chaithanya Puri,
Hyderabad, Andhra Pradesh

..... Respondent

Disputed Domain Name:

<TOM.CO.IN>

ARBITRATION AWARD

.IN REGISTRY - NATIONAL INTERNET EXCHANGE OF INDIA

**.IN domain Name Dispute Resolution Policy INDRP Rules of
Procedure**

IN THE MATTER OF:

Bennett, Coleman & Co. Ltd.
The Times of India Building, No.1
Dr. D. N. Road,
Mumbai-400 001

..... Complainant

VERSUS

Mr. Suresh Kumar
Geek IT Solutions Pvt. Ltd.
Flat No. 401, H No: 1-5-980
Shanthi Residency,
Chaithanya Puri,
Hyderabad,
Andhra Pradesh

..... Respondent

A handwritten signature in black ink, consisting of a large, stylized 'Q' or 'G' shape with a horizontal line extending from the bottom right.

1. **THE PARTIES:**

The Complainant in this administrative proceeding is Bennett, Coleman & Co. Ltd., The Times of India Building, No.1, Dr. D. N. Road, Mumbai-400 001.

The Respondent is Mr.Suresh Kumar Geek IT Solutions Pvt. Ltd., Flat No. 401, H No: 1-5-980 Shanthi Residency, Chaithanya Puri, Hyderabad, Andhra Pradesh.

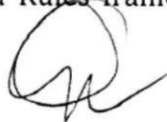
2. **THE DOMAIN NAME AND REGISTRAR**

The disputed domain name <TOM.CO.IN> has been registered by the Respondent. The Registrar with whom the disputed domain is registered is Realtime Registrar BV, Ceinturbaan 32a, 8024 AA Zwolle, THE NETHERLANDS.

3. **PROCEDURAL HISTORY**

3.1 The Complaint was filed with the .In Registry, National Internet Exchange of India (NIXI), against Mr.Suresh Kumar Geek IT Solutions Pvt. Ltd., Flat No. 401, H No: 1-5-980 Shanthi Residency, Chaithanya Puri, Hyderabad, Andhra Pradesh. The NIXI verified that the Complaint together with the annexures to the Complaint and satisfied the formal requirements of the .in Domain Name Dispute Resolution Policy ("The Policy") and the Rules of Procedure ("The Rules").

3.2 In accordance with the Rules, Paragraph-2(a) and 4(a), NIXI formally notified the Respondent of the Complaint and appointed me as a Sole Arbitrator for adjudicating upon the dispute in accordance with The Arbitration and Conciliation Act, 1996, Rules framed there under, .In Dispute Resolution Policy and Rules framed there under



on **13th September, 2012**. The parties were notified about the appointment of an Arbitrator on **13th September, 2012**.

- 3.3 The Panel while passing an Award observed that the service of the Respondent by e-mail has been wrongly made, as the e-mail address of the Respondent was wrongly mentioned by the Complainant in his Complaint. The Panel therefore directed the Complainant to forward Soft copy of the Complaint along with all the documents as well as the additional evidence as produced by him to the Respondent and as well as to the National Internet Exchange of India (NIXI) on **January 22, 2013**.
- 3.4 The Respondent was granted an opportunity on **22nd January, 2013**, as aforesaid, to file its response, if any.
- 3.5 The Respondent replied to the notice of this Panel on **January 23, 2013**.
- 3.6 The Panel considers that according to Paragraph-9 of the Rules, the language of the proceedings should be in English. In the facts and circumstances, in-person hearing was not considered necessary for deciding the Complaint and consequently, on the basis of the statements and documents submitted on record, the present award is passed.

4. FACTUAL BACKGROUND

- 4.1 The Complainant belongs to the **"Times Group"** which started 170 years ago with the business of publishing newspapers, journals, magazines and books. Today the **"Times Group"** has emerged as multi-edition, multi-



product organization, and a clear leader in the segment it operates. The "**Times Group**" has more than 45 dailies and periodicals in 3 languages with 108 editions having 11 publishing centers and 15 printing centers across the country providing a combined readership of over 40 Million.

4.2 **Times of Money Ltd (TOM)**, a group company of the Complainant and hence belongs to the "**Times Group**", was incorporated on May 8, 2000 as a Public Limited Company under the Indian Companies Act, 1956 having its registered office at 4th Floor, Times Tower, Kamala Mills Compound, Senapati Bapat Marg, Lower Parel (w), Mumbai - 400.

4.3 TOM's primary business is to serve people of different ethnic and communities residing worldwide to facilitate money transfers to their home country by offering the convenience of using Complainant's internet services. Times of Money started this business by offering online remittance service. Any customer/subscriber who wished to make such payment could use the Times of Money (TOM) websites for online money transfers through various modes. With the advancement and the discovery of World Wide Web and internet the Times of Money/TOM also entered the field of e-commerce. Times of Money (TOM) in the year 2000 entered into the online money transfer business through the internet by adopting the trade mark/domain name **timesofmoney.com** by offering payments industry, **Times of Money** has forayed into online remittances, fortified domestic e-payment mechanisms and facilitated remittance solutions of banks and has been doing the same for more than 11 years.



- 4.4. The respondent has obtained registration of the domain name www.Tom.co.in which is the subject matter of the present proceedings.

5. PARTIES CONTENTIONS

A. COMPLAINANT

5.A.1) The "**Times Group**" comprises of various independent companies, involved in varieties of business such as media and entertainment including radio broadcast, event management, outdoor advertising, motion pictures; television broadcast, financial services, publications of newspapers and magazine, educational services, syndication services, internet services, online remittance etc.

5A.(2)The "**Times Group**" has 100 offices, over 7000 employees, 45 dailies including two of the largest in the country with approx 4.3 million copies circulated daily, 2 lead magazines reaching 2468 cities and towns, 32 Radio Stations, 2 Television News Channel, 1 Television Life Style Channel and Turnover in excess of USD 700 million.

5A(3) The brand, namely **timesofmoney.com**, was registered as a domain name in favour of Times of Money (TOM) on 6th April, 2000. With over 10 years of experience in the payments industry, Times of Money, which is also referred as "**TOM**" abbreviation/short form of 'Times of Money', has forayed into online remittances, fortified domestic e-payment mechanisms and facilitated remittance solutions of banks.

5A(4) Having commenced its remittance operations under the domain in the year 2000, Times of Money (TOM)



has grown from strength-to-strength since then and has expanded its online remittance business to include remittance services to 23 countries and 9 originating currencies under various brands/domain names. Times of Money (TOM) further expanded its operations in more than 80 countries.

5A(5) The Complainant also provided list of domain name registrations incorporating the mark "TIME" registered by him from the year 2000.

5A(6) Times of Money (TOM) also holds trade mark registrations of the mark **TIMES OF MONEY** for services falling in class 36 in India.

5A(7) Times of Money (TOM) has assigned the above said domain names/ trade mark registrations in favour of the Complainant namely Bennett, Coleman & Co. Ltd. vide deed of assignment dated 29th June, 2012. However, Times of Money (TOM) has continued to carry out its business under the above said domain names as a permitted user/licencee of the Complainant. The Complainant is taking steps to register itself as subsequent proprietor with the trade mark registry and with respective domain name registrars.

5A(8) Times of Money/TOM services under the above said trade names/domain names including **TIMES OF MONEY** in the online remittances have fortified domestic e-payment mechanisms and facilitated remittance solutions of banks and are extensively well known and are used by the relevant category of customers. Hence, by virtue of inherent



distinctiveness, prior, extensive, exclusive, continuous and widespread commercial use worldwide including in India the trade name/domain name **TIMES OF MONEY** or **TOM** has thus become distinctive and indicative of source of services originating from the complainant and none else globally as well as in India. The domain name **TIMES OF MONEY** or **TOM** constitutes a valuable Trade mark and domain name owned by the Complainant, which is entitled to protection in law against misuse and misappropriation.

5.A(9) The popularity of the trade name/domain name/trade mark **TIMES OF MONEY** or **TOM** is also evident from the fact that Complainant's website namely **timesofmoney.com** has been extensively visited by **380,957** worldwide web users and surfers since the year 2000.

5A(10) The above figures are based on the report provided from Google analytics, which shows that since 2009 - 2012, the website **timesofmoney.com** has been extensively visited by 380,957 worldwide web users and surfers.

5A(11) The trade name/domain name/trade mark **TIMES OF MONEY** which is also referred as **TOM** thus come to be inextricably associated with the Times of Money/TOM and connotes and denotes the goods/services originating from the Times of Money/TOM worldwide and none else



5A(12) The trade name/trade mark/domain name **TIMES OF MONEY** has been associated with the Times of Money/TOM for a very long time and has come to be associated with Times of Money/TOM as its trade name/trade mark/brand name and has acquired inherent distinctiveness. **TOM** which is an abbreviation/short form of 'Times of Money' has been used by the Times of Money/TOM on its promotional pamphlets such as cabin stickers, car stickers, internal mailers, Get set elevate posters.

5A(13) The Complainant submits that to its utter surprise and shock, through random search on Whois database, came to know about the domain name <tom.co.in>, which is an abbreviation of the Times of Money/TOM trade name **TIMES OF MONEY**, has been registered in the name of Respondent. As per "Whois" database, the impugned domain name is registered in favour of the Respondent **Suresh Kumar**, Geek IT Solutions Pvt. Ltd. Flat No. : 401, H NO: 1-5-980, Shanthi Residency, Chaithanya Puri, Hyderabad Andhra Pradesh-500075. Therefore, Times of Money/TOM immediately issued a legal notice dated 24th July, 2012 to the Respondent on the said address, seeking transfer of the impugned domain name in its favour. The said legal notice was not replied by the Respondent.

5.A(14) The impugned domain name is registered on **02-May-2012** in bad faith and is confusingly similar to the Times of Money's trade name '**TOM**', which is an abbreviation of the trading name/domain name



TIMES OF MONEY. The respondent has no interest or legitimate right in the impugned domain name.

B. RESPONDENT

5B(1) The Respondent in his reply dated **January 23, 2013** stated that *"if they have the trade mark for the term **TOM** in India, they can take the domain. Well Tom is just my dog name, we thought of putting his site on it. If registry feels like they have proper TM in India, Registry can push the domain to them"*.

6. DISCUSSIONS AND FINDINGS

6.1 The Complainant, while filing the Complaint, submitted to arbitration proceedings in accordance with the .In Dispute Resolution Policy and the Rules framed thereunder in terms of paragraph (3b) of the Rules and Procedure. The Respondent also submitted to the mandatory arbitration proceedings in terms of paragraph 4 of the policy, while seeking registration of the disputed domain name.

6.2 Paragraph 12 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and that there shall be no in-person hearing (including hearing by teleconference video conference, and web conference) unless, the Arbitrator, in his sole discretion and as an exceptional circumstance, otherwise determines that such a hearing is necessary for deciding the Complaint. I do not think that the present case is of exceptional nature where the determination cannot be made on the basis of material on record and without in-person hearing. Sub-Section 3 of Section 19 of The Arbitration & Conciliation Act also empowers the Arbitral Tribunal to conduct the proceedings in the manner it



considers appropriate including the power to determine the admissibility, relevance, materiality and weight of any evidence.

- 6.3 It is therefore, appropriate to examine the issues in the light of statements and documents submitted as evidence as per Policy, Rules and the provisions of the Act.
- 6.4. The award can be pronounced on the basis of the admissions made by the Respondent and also the consent contained in his reply dated 23rd January, 2013 to the transfer of the impugned domain if the Registry feels that complainant have proper TM in India without considering statements or averments made by the Complainant on merit. However, in view of the fact that preliminary onus is on the Complainant to satisfy the existence of all conditions under the policy to obtain the relief's claimed and that the consent of the respondent is not absolute but subject to the complainant having a right in India, the panel feels it appropriate to deal with the averments made by the Complainant in its Complaint in detail and to satisfy itself if the conditions under the policy stand satisfied.
- 6.5. The onus of proof is on the Complainant. As the proceedings are of a civil nature, the standard of proof is on the balance of probabilities. The material facts pleaded in the Complaint concerning the Complainant's legitimate right, interest and title in the trade mark, trade name and domain name <TOM.CO.IN> and the reputation accrued thereto have neither been dealt with nor disputed or specifically denied by the Respondent. The Respondent has not also denied the correctness and genuineness of any of the Annexures/Exhibits filed by the Complainant along with the Complaint.



- 6.6. Under the provisions of Order 8 Rule 5 of the Code of Civil Procedure, 1908 the material facts as are not specifically denied are deemed to be admitted.
- 6.7. The decision of Hon'ble Supreme Court of India in the matter of **Jahuri Sah Vs. Dwarika Prasad** – AIR 1967 SC 109, be referred to. The facts as are admitted expressly or by legal fiction require no formal proof. (See Section 58 of the Indian Evidence Act, 1872).
- 6.8 The Panel therefore accepts the case set up and the evidence filed by the Complainant and concludes that the same stand deemed admitted and proved in accordance with law.
- 6.9 Paragraph 10 of the Policy provides that the remedies available to the Complainant pursuant to any proceedings before an arbitration panel shall be limited to the cancellation or transfer of domain name registration to the Complainant.
- 6.10. Paragraph 4 of the Policy lists three elements that the Complainant must prove to merit a finding that the domain name of the Respondent to be transferred to the Complainant or cancelled.

A. IDENTICAL OR CONFUSINGLY SIMILAR

- 6A.1 The impugned domain name registered on **02-May 2012** is confusingly similar to the Times of Money's trade name '**TOM**', which is an abbreviation of the trading name/domain name **TIMES OF MONEY**;
- 6A.2 The trade name/trade mark **TIMES OF MONEY** and its abbreviation '**TOM**' and the domain name



timesofmoney.com are Complainant's distinctive trade name/trade mark/domain name registered in favour of Times of Money.

6A.3 The Complainant submits that Respondent has recently adopted the impugned domain name in May, 2012 to derive benefit from the goodwill and reputation of the Complainant's brand and mislead members of public into believing that the impugned website belongs to the Complainant or is licensed by the Complainant having same origin and association. There can possibly be no justification for adoption of the impugned domain **tom.co.in** by the Respondent and hence the same is a dishonest, fraudulent and bad faith adoption;

6A.4 The Complainant further submits that the adoption of the impugned domain name amounts to misappropriation of the Complainant's goodwill and reputation and constitutes acts of passing off;

6A.5 As a cumulative result of prior and bona fide use of the trade mark **TIMES OF MONEY/TOM** in relation to the goods/services offered by the Complainant, the extensive and continuous use and the resultant accrual of reputation and goodwill, the Complainant has acquired common law rights in the undisturbed and exclusive use of the said trade mark/domain name. Thus, the adoption of the impugned domain name which is identical to the Complainant's trade mark/domain name **TIMES OF MONEY/TOM** is misappropriation of the Complainant's goodwill and reputation and constitutes acts of misrepresentation



to the members of public at large that the Respondent's business is associated or approved by the Complainant;

6A.6 The Complainant allege that Respondent's unwarranted registration of the impugned domain name with NIXI, being identical to the Complainant's domain name/trade mark **TIMES OF MONEY /TOM** is clearly an offence under the laws of India;

6A.7 The adoption by the Respondent will also inevitably lead to dilution and erosion of the uniqueness and exclusivity associated with the Complainant's trade mark, by reducing its capacity to identify and distinguish the services as originating from a particular source, regardless of the presence or absence of likelihood of confusion, mistake or deception. In other words, the use by the Respondent is bound to result in the whittling away of the selling power, distinctive quality and value of the Complainant's famous trade mark **TIMES OF MONEY/TOM**.

6A.8 The evidence provided by the Complainant in support of his use of the mark 'TOM', which is an abbreviation of his registered trade mark "TIMES OF MONEY" is the advertisements done by the Complainant for the promotion of their mark **TOM** and carrying on activities under the said mark.

The Complainant has also filed on record copies of the agreement entered into with the third parties by the Complainant under the mark **TOM** which

A handwritten signature in black ink, consisting of a stylized, cursive 'G' followed by a horizontal stroke.

predates the adoption of the impugned domain name on the part of the Respondent.

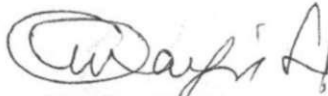
- 6A.9 The Respondent submitted before this Panel that if the Panel is satisfied about the trade mark right of the Complainant, the impugned domain name can be transferred to the Complainant.
- 6A.10 The Panel on the basis of the material available on record is satisfied that the Complainant has been successful in establishing their Common law right in the mark **TOM**, which is abbreviation of their registered trade mark "**TIMES OF MONEY**" and find that the impugned domain name **<TOM.CO.IN>** is identical and/or confusingly similar to the mark of the Complainant.
- 6A.11 In view of the admission made by the respondent and consent for the transfer of impugned domain name and this panel finding the complainant to be the legitimate proprietor of the mark TOM in India, it is not necessary to discuss the other two elements of the policy, i.e. respondent having no interest or legitimate right in the impugned domain name and registration/use in bad faith. Even otherwise the respondent has not disputed, denied or challenged the claim made by the complainant on these aspects of the matter/policy.

7. DECISION

In view of the fact that the Respondent has agreed to voluntarily transfer the impugned domain name **<TOM.CO.IN>** to the Complainant, if the trade mark rights



of the Complainant are established and the said right having been established, it is ordered that the domain <TOM.CO.IN> be transferred to the Complainant.



AMARJIT SINGH
Sole Arbitrator

New Delhi
Dated: 6th April, 2013