

Disputed Domain Name: <SONYZEE.CO.IN>

ARBITRATION AWARD

Dated 26.6.2023

sony Group Corporation;
Sony Pictures Entertainment Inc.;
Sony Corporation of America; and
Culver Max Entertainment India
Private Limited
10202 West Washington Boulevard
Culver City, California 90232
USA

Complainant

Versus

AnghaaUtpad/ AnghaaUtpad
Koon BhowaliNanital

Nainital, Uttarakhand 263132

Respondent

1. The Parties

Complainant

The Complainants in this administrative proceeding are the following entities:

- Sony Group Corporation (also known as Sony Group Kabushiki Kaisha and formerly known as Sony Corporation and Sony Kabushiki Kaisha): a Japanese corporation;
- Sony Pictures Entertainment Inc.: a Delaware (USA) corporation and an indirect subsidiary of Sony Group Corporation;
- Sony Corporation of America: a New York (USA) corporation and a subsidiary of

Alok Kumar Jain

Sony Group Corporation; and

Culver Max Entertainment Private Limited (formerly known as Sony Pictures Networks India Private Limited): an Indian company and a wholly owned indirect subsidiary of Sony Pictures Entertainment Inc., Sony Corporation of America and Sony Group Corporation.

The Complainant's contact details are:

Address: Sony Pictures Entertainment Inc.

10202 West Washington Boulevard
Culver City, California 90232
USA

Telephone: 1-310-244-4000

Fax: 1-310-244-2169

E-mail: Corporate_Legal_Notices@spe.sony.com

The Complainant's authorized representative in this administrative proceeding is:

Douglas M. Isenberg, Esq.
THE GIGA LAW FIRM, DOUGLAS M. ISENBERG, ATTORNEY AT LAW, LLC
One Glenlake Parkway
Suite 650
Atlanta, Georgia 30328
USA
1-404-348-0368 (telephone)
1-678-681-9681 (facsimile)
Doug@Giga.Law

B.

The Respondent

Respondent in these proceedings is AnghaaUtpad/ AnghaaUtpad

Koon BhowaliNanital Nainital, Uttarakhand 263132

Email: jkb1249@yahoo.com

(91)9599912798

Alok Kumar Jain

2. Domain Name and Registrar

<sonyzee.co.in>: Created January 21, 2022
Details of registrar for the Disputed Domain Name is:

GoDaddy.com, LLC

14455 N. Hayden Road, Suite #219

Scottsdale, Arizona 85260

Telephone: 1-480-505-8800

legal@godaddy.com

USA

Procedure History:

3.1. This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (the "Policy") adopted by the National Internet Exchange of India ("NIXI") and the INDRP Rules of Procedure (the "Rules") which were approved in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the Disputed Domain Name with a NIXI accredited Registrar, the Respondent agreed to the resolution of disputes pursuant to the said Policy and the Rules.

As per the information received from NIXI, the history of the proceedings is as follows:

3.2. The Complaint was filed by the Complainant with NIXI against the Respondent . On 1.6.2023 I was appointed as Sole Arbitrator to decide the disputes between the parties. I submitted statement of Acceptance and Declaration of Impartiality and Independence as required by rules to ensure compliance with Paragraph 6 of the Rules.

NIXI notified the Parties of my appointment as Arbitrator via email dated 1.6.2022 and served by email an electronic Copy of

the Complainant with Annexures on the Respondent at the email addresses of the Respondent.

3.3. I issued notice to the parties vide email dated 1.06.2023 directing the Complainant to serve complete set of Complaint on the Respondent in soft copies as well as in physical via courier /Post. The Complainant served Copy of the Complaint with Annexures on the Respondent at its email address. The Respondent was directed to file its response within 10 days from the date of notice. No response was received from the Respondent till 15.06.2023. On 15.6.2023 I granted further time to the Respondent to file reply within 7 days.

A trailing mail was received from the Respondent on 20.6.2023 whereby the Respondent Stated that the Respondent is willing to transfer the disputed domain name to the complainant. Accordingly I informed the parties that now the award will be passed.

3.4 Respondent was duly served and also sent its response showing willingness to transfer the disputed domain to the complainant.

In these circumstances the Tribunal proceeds to decide the complaint accordingly.

4. Grounds for Arbitration Proceedings.

INDRP Policy para 4. Class of Disputes provides as under:

Any Person who considers that a registered domain name conflicts with his/her legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

(a) the Registrant's domain name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and

(b) the Registrant has no rights or legitimate interests in respect of the domain name; and

(c) the Registrant's domain name has been registered or is being used in bad faith.

5. The Case of the Complainant :-

5.1 Complainant Stated that the Complainant Sony Group Corporation was founded in 1946 and consists of the following major segments: Game & Network Services, Music, Pictures, Entertainment Technology & Services, Imaging & Sensing Solutions, and Financial Services.

Complainant Sony Group Corporation is a public company trading on the Tokyo and New York stock exchanges.

Annex 5 is a copy of Complainant Sony Group Corporation's 2022 corporate report. It is further stated that Complainant Sony Group Corporation had approximately 108,900 employees (as of March 31, 2022) and consolidated sales and operating revenue (fiscal year ended March 31, 2022) of 9,921,500 million yen.

5.2.1 That the Complainant Sony Group Corporation is the owner of the SONY Trademark .Complainant Sony Pictures Entertainment Inc.'s global operations encompass motion picture production, acquisition, and distribution; television production, acquisition, and distribution; television networks; digital content creation and distribution; operation of studio facilities; and development of new entertainment products, services and technologies.

Complainant Culver Max Entertainment India Private Limited (formerly known as Sony Pictures Networks India Private Limited) has several general entertainment channels, film, sports and kids entertainment channels in India, as well as Sony LIV, a digital entertainment video service available over-the-top to viewers in India and international markets. Culver Max Entertainment Private Limited

reaches out to more than 700 million viewers in India and is available in 167 countries.

5.2.2 Complainant Sony Corporation of America is the registrant of the domain name <sony.com>, which was created on July 7, 1989. The whois record for this domain name is attached as Annex 6. A screenshot of the home page of Complainant's website using this domain name is attached as Annex 7. Complainant (or its predecessors or related entities)¹ has prevailed in numerous proceedings under domain name dispute policies, including the INDRP, for domain names that are identical or confusingly similar to the SONY Trademark. Such as *Sony Group Corporation v. Game the Shop*, NIXI Case No. INDRP1593 (transfer of <sonycentral.co.in>); *Sony Corporation v. Deborah R. Heacock*, NIXI Case No. INDRP-669 (transfer of <sonymobileco.in>); *Sony Kabushiki Kaisha also trading as Sony Corporation v. Daniele Melchiori*, NIXI Case No. INDRP-591 (transfer of <sonymusic.in>); *Sony Kabushiki Kaisha also trading as Sony Corporation v. Fujiko Kikuno*, WIPO Case No. D2000-1372 (referring to "Complainant's famous trademark SONY" in decision ordering transfer of <sonysonpo.com>); *Sony Corporation v. Domain Privacy Service and Kitts Registry*, WIPO Case No. D2008-0795 (referring to SONY as "a well-known mark" in decision ordering transfer of <sonytelevision.com>); *Sony Corporation v. Whoisguard Protected, Whoisguard, Inc. / VINCENT, ZESDORN*, WIPO Case No. D2017-1226 (ordering cancellation of <sonyhr.com> where "Complainant's SONY mark is extremely distinctive, widely known and has a strong online visibility"); and *Sony Kabushiki Kaisha, also trading as Sony Corporation v. Richard Mandanice*,

Alok Kumar Jain

WIPO Case No. D2004-1046 (stating that “[t]here is no doubt that the existence of the SONY trademark is well established” in decision ordering transfer of <sony-z5.com>).

5.3 That On December 21, 2021, Complainant and Zee Entertainment Enterprises Limited (“Zee”) of India announced “definitive agreements” for a merger of their companies. Annex 8.

5.4 Complainant further submits that Respondent registered the Disputed Domain Name on January 21, 2022 more than 65 years after Complainant obtained its first registration for the SONY Trademark (as defined below) (ref. Annexes 2-4) and more than 32 years after Complainant registered the domain name <sony.com> (ref. Annex 6). That the Respondent is not using the Disputed Domain Name in connection with an active website. (Ref. Annex 9.)

The Complainant further submit as under:

6. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

6.1 It is averred by the Complainant that the Complainant owns thousands of trademark registrations around the world for marks that consist of or contain the coined term “Sony,” the oldest of which were registered in the 1950s. These registrations are referred to herein as the “SONY Trademark.” Complainant’s registrations for the SONY Trademark include the following in India, just to cite a few:

- India App. No. 196,589; application date June 20, 1960
- India App. No. 362,146; application date May 23, 1980
- India App. No. 2,308,689; application date March 30, 2012

Arokh Kumar Jain

Printouts of the above registrations from the website of the Government of India's Controller General of Patents Design & Trade Marks are attached as Annex 2.

Complainant's registrations for the SONY Trademark include the following in Japan, just to cite a few:

- Japan Reg. No. 491,710, registered November 20, 1956
- Japan Reg. No. 500,036, registered April 15, 1957
- Japan Reg. No. 500,037, registered April 15, 1957

Printouts of the above registrations from the website of the Japan Platform for Patent Information are attached hereto as Annex 3.

Complainant's registrations for the SONY Trademark include the following in the United States of America, just to cite a few:

- U.S. Reg. No. 770,275, registered May 26, 1964
- U.S. Reg. No. 801,885, registered January 11, 1966
- U.S. Reg. No. 886,339, registered February 17, 1970

Printouts of the above registrations from the website of the United States Patent and Trademark Office are attached as Annex 4.

6.2 Complainant submits that Previous panels under the INDRP have found that Complainant has rights in and to the SONY Trademark. *Sony Group Corporation v. Game the Shop*, NIXI Case No. INDRP-1593 (transfer of <sonycentral.co.in>); *Sony Corporation v. Deborah R. Heacock*, NIXI Case No. INDRP-669 (transfer of <sonymobileco.in>); and *Sony Kabushiki Kaisha also trading as Sony Corporation v. Daniele Melchiori*, NIXI Case No. INDRP-591 (transfer of <sonymusic.in>). In addition, numerous previous panels under the UDRP have found that Complainant has rights in and to the SONY Trademark. Indeed,

Alok Kumar Jain

previous UDRP panels have said that the SONY Trademark is “famous” (*Sony Kabushiki Kaisha also trading as Sony Corporation v. Fujiko Kikuno*, WIPO Case No. D2000-1372), “well-known” (*Sony Corporation v. Domain Privacy Service and St. Kitts Registry*, WIPO Case No. D2008-0795), “extremely distinctive, widely known and has a strong online visibility” (*Sony Corporation v. Whoisguard Protected, Whoisguard, Inc. / VINCENT, ZESDORN*, WIPO Case No. D2017-1226, and “well established” (*Sony Kabushiki Kaisha, also trading as Sony Corporation v. Richard Mandanice*, WIPO Case No. D2004-1046).

6.3 Complainant contends that the Disputed Domain Name contains the SONY Trademark in its entirety. In addition, the Disputed Domain Name contains a third-party’s trademark (“ZEE”). The ZEE trademark included in the Disputed Domain Name is owned by Zee – which, as stated above, has entered into definitive agreements to merge with Complainant (ref. Annex 8) – and is protected by numerous registrations, including India App. Nos. 3,478,087 (application date February 8, 2017) and 3,478,088 (application date February 8, 2017). Printouts of these registrations from the website of the Government of India’s Controller General of Patents Design & Trade Marks are attached hereto as Annex 10. In addition, the ZEE trademark appears on the list of “well-known marks” from the Government of India’s Controller General of Patents Design & Trade Marks. Annex 11 (No. 93). As set forth in Annex 12 attached hereto, Zee supports the filing of this Complaint by Complainant and consents to transfer of the Disputed Domain Name to Complainant. Section 1.12 of WIPO Overview 3.0 states: “Where the complainant’s trademark is recognizable within the disputed domain name, the addition of other third-party marks (i.e., <mark1+mark2.tld>), is insufficient in itself to avoid a finding of confusing similarity to the complainant’s mark under the first element. The complaint may include

evidence of the third-party mark holder's consent to file the case, and request that any transfer order be issued in favor of the filing complainant only." Accordingly, inclusion of the ZEE trademark in the Disputed Domain Name does nothing to avoid confusing similarity with the SONY Trademark, and the consent from Zee (set forth in Annex 12 attached hereto) makes clear that it is appropriate for Complainant to file this Complaint and for the Panel to order transfer of the Disputed Domain Name to Complainant. Accordingly, the Disputed Domain Name is identical or confusingly similar to the SONY Trademark.

It is evident from above that the Complainant has sufficiently established that it has a right in the said trade mark and the disputed domain is identical or confusingly similar to the trade mark of the Complainant.

6.4 The Complainant states that the Respondent has no rights or legitimate interests in respect of the domain name;

6.5 Complainant averred that the Respondent has no rights or legitimate interests in the Disputed Domain Name. Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the SONY Trademark in any manner. Accordingly, where, as here, "[t]he Respondent is neither a licensee of the Complainant, nor has it otherwise obtained authorization of any kind whatsoever, to use the Complainant's mark," the panel should find a lack of rights or legitimate interests under the INDRP.

Complainant inter alia refers to case of *Accenture Global Services Limited v. Vishal Singh*, NIXI Case No. INDRP-999: wherein it was held that

Given the long and widespread reputation of the Complainant's trademarks, the compelling conclusion is that the Respondent, by choosing to register and use a domain name which is not only

confusingly similar to the Complainant's widely known and distinctive trade mark but identical, intended to ride on the goodwill of the Complainant's trademark in an attempt to exploit, for commercial gain, Internet traffic destined for the Complainant. Potential partners and end users are led to believe that the website is either the Complainant's site, or the site of official authorized partners of the Complainant, while in fact it is neither of these.

As a result, the panel said that the respondent lacks rights or legitimate interests in respect of the disputed domain name.

Further the Respondent has never used, or made preparations to use, the Disputed Domain Name or any name corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services and, therefore, Respondent cannot establish rights or legitimate interests under Paragraph 7(a) of the INDRP. As stated above and as shown in Annex 9, Respondent is not using the Disputed Domain Name in connection with an active website. As numerous panels have repeatedly said, "Passively holding a domain name does not constitute a bona fide offering of goods or services." *Philip Morris USA Inc. v. Gabriel Hall*, WIPO Case No. D2015-1779. See also, e.g., *L'Oréal v. Haya Manami*, WIPO Case No. D2015-0924 ("The Domain Name points to an inactive page. Consequently, Respondent is not using the Domain Name in connection with a bona fide offering of goods or services...").

That to Complainant's knowledge, Respondent has never been commonly known by the Disputed Domain Name and has never acquired any trademark or service mark rights in the Disputed Domain

Abhishek Kumar Jain

Name and, therefore, Respondent has no rights or legitimate interests in the Disputed Domain Name under paragraph 7(b) of the INDRP.

Accordingly, the Complainant has established that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Complainant states that The domain name was registered or is being used in bad faith.

Complainant submits that the SONY Trademark is clearly famous and/or widely known, given that it is protected by thousands of trademark registrations around the world, the oldest of which were registered *more than 60 years ago* (Annexes 2-4). In addition, as set forth above, previous panels have referred to the SONY Trademark as “famous” (*Sony Kabushiki Kaisha also trading as Sony Corporation v. Fujiko Kikuno*, WIPO Case No. D2000-1372), “well-known” (*Sony Corporation v. Domain Privacy Service and St. Kitts Registry*, WIPO Case No.

D2008-0795), “extremely distinctive, widely known and has a strong online visibility” (*Sony Corporation v. Whoisguard Protected, Whoisguard, Inc. / VINCENT, ZESDORN*, WIPO Case No. D2017-1226), and “well established” (*Sony Kabushiki Kaisha, also trading as Sony Corporation v. Richard Mandanice*, WIPO Case No. D2004-1046). Indeed, “[i]t is implausible that [Respondent] was unaware of the Complainant when [it] registered the Domain Name given the fame of the Trade Mark.” *Six Continents Hotels v. Lin hongyu, Cheng Qi Lin*, WIPO Case No. D2017-2033. Accordingly, “[t]he only explanation of what has happened is that the Respondent’s motive in registering and using the [domain name] seems to be... simply to disrupt the

Complainant's relationship with its customers or potential customers or attempt to attract Internet users for potential gain. These both constitute evidence of registration and use in bad faith: paragraph 4(b)(iii) & (iv) of the Policy." *Pancil, LLC v. Jucco Holdings*, WIPO Case No. D2006-0676. Similarly, given the global reach and popularity of Complainant's services under the SONY Trademark as described above, as well as the strength of the ZEE trademark (Annex 11), "it is inconceivable that Respondent chose the contested domain name without knowledge of Complainant's activities and the name and trademark under which Complainant is doing business." *Pancil LLC v. Domain Deluxe*, WIPO Case No. D2003-1035.

That the Disputed Domain Name is "so obviously connected with" Complainant, Respondent's actions suggest "opportunistic bad faith" in violation of the Policy. *Research In Motion Limited v. Dustin Picov*, WIPO Case No. D2001-0492. In light of the long history of Complainant's trademarks and Complainant's significant presence and brand recognition, "[i]t is likely that the Respondent knew of the Complainant's mark, and has sought to obtain a commercial benefit by attracting Internet users based on that confusion." *Western Union Holdings, Inc. v. Manuel Rodriguez*, WIPO Case No. D2006-0850. See also, e.g., *OSRAM GmbH v. Azarenko Vladimir Alexeevich, Azarenko Group Ltd*, WIPO Case No. D2016-1384 (finding bad faith where "Respondent must have been aware of the Complainant and its said trademark when it registered the disputed domain name" and "the Panel cannot conceive of any use that the Respondent could make of the disputed domain name that would not interfere with the Complainant's long-established trademark rights"); and *Volkswagen AG v. Fawzi*.

Alok Kumar Jain

Sood, WIPO Case No. D2015-1483 (“[g]iven the fame of the Complainant’s marks the Respondent must have known of the Complainant’s rights at point of registration of the Domain Name”).

The Disputed Domain Name was created on January 21, 2022 – shortly after Complainant and Zee announced definitive agreements for a merger of their companies. Annex 8. Such timing is an indication of bad faith. Bad faith also exists under the well-established doctrine of “passive holding” set forth in the landmark case *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003,² given that, as shown in Annex 9, Respondent is not currently using the Disputed Domain Name in connection with an active website. As described by WIPO Overview 3.0, section 3.3:

That previous panels have found bad faith under the passive holding doctrine where a respondent registered a domain name that was confusingly similar to the SONY Trademark. See, e.g., *Sony Corporation v. Whoisguard Protected, Whoisguard, Inc. / VINCENT, ZESDORN*, WIPO Case No. D2017-1226 (“passive holding of the disputed domain name [*<sonyhr.com>*] is further evidence of the Respondent’s bad faith”);

Thus the complainant has shown that the Disputed Domain Name was registered and is being used in bad faith.

In view of above facts, submissions of the Complainant and on perusal of the documents annexed with the Complaint, I find that the Complaint has proved the circumstances referred in Clause 7 of INDRP policy and has established that the registration of disputed domain name is in bad faith.

Alok Kumar Jain

Decision

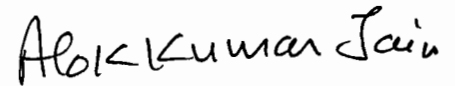
7.1. In view of the foregoing, I hold that the Disputed Domain Name is identical and or confusingly similar to the Complainant's well-known 'SONYZEE' Trademarks and that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Disputed Domain Name was registered in bad faith.

Further the Respondent in all fairness has shown its willingness to transfer the disputed domain to the Complainant.

Thus in view of above discussion and in view of the Consent given by the Respondent for transfer of the disputed domain to the complainant , in accordance with the INDRP Policy and Rules, I direct that the Disputed Domain Name registration be transferred to the Complainant.

Delhi

Dated 26.6.2023



Alok Kumar Jain

Sole Arbitrator