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BEFORE ALOK KUMAR JAIN, SOLE ARBITRATOR
INDRP Case No. 1533

Disputed Domain Name: <XEROXERO.IN>

ARBITRATION AWARD

XEROX CORPORATION

Versus

KUHU LABS PRIVATE LIMITED

Complainant

Respondent

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**BEFORE ALOK KUMAR JAIN, SOLE ARBITRATOR
.IN REGISTRY**

**NATIONAL INTERNET EXCHANGE OF INDIA(NIXI)
INDRP ARBITRATION**

INDRP Case No. 1533

Disputed Domain Name: <XEROXERO.IN>

ARBITRATION AWARD

Dated 28.04.2022

IN THE MATTER OF:

XEROX CORPORATION

45 Glover Avenue, PO Box 450,
Norwalk, Connecticut 06856-4505,
United States of America

Complainant

Versus

KUHU LABS PRIVATE LIMITED

93 Avs Adityapur Jharkhand,
India, 832109

Respondent

1. The Parties

- 1.1 The Complainant in this arbitration proceeding is XEROX CORPORATION ,having address at 45 Glover Avenue, PO Box 450, Norwalk, Connecticut 06856-4505, United States of America

Complainant's Authorised representative are Swetasree Majumdar and Shreya Ganguly having address- Fidus Law Chambers F-12,

Ground Floor, Sector 8, Noida-201301 with emails as shwetasree@fiduslawchambers.com and shreya@fiduslawchambers.com

- 1.2 The Respondent is Admin Kuhulabs, having address as Kuhu Labs Private Limited 93 Avs Adityapur Jharkhand, India, 832109

The disputed domain name is registered in the name of Respondent.

Domain Name and Registrar:-

The Disputed Domain name is <www.XEROXERO.IN>

Registered on 25th February 2020.

The accredited Registrar with whom the Disputed Domain Name is registered is GoDaddy.com, LLC

1 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 29.3.2022 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 29.3.2022 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 01.04.2022 directing the Complainant to serve complete set of Complaint on the Respondent in soft copies as well as in physical via courier /Post. Complainant served the copy of complaint on the Respondent at his email address and also sent copy to Respondent by Courier. The Respondent was directed to file its response within 10 days from the date of notice. No response was received from the Respondent till 11.04.2022. Therefore, on 11.04.2022, I granted further time to Respondent directing the Respondent to file response on or before 18.4.2022 failing which the matter shall be decided on merit. The Respondent did not file any reply till 21.4.2022. On 22.4.2022 I informed the parties that now the matter will be decided on merits of the case. Accordingly now the complaint shall be decided on merit. No personal hearing was requested by any party.

3.4 A Complete set of Complaint was served by NIXI in electronic form by email to the Respondent on 29.03.2022 at the email provided by the Respondent with WHOIS ,while informing the parties about my appointment as Arbitrator. Thereafter I issued notice to the parties through the same trailing mail. Complainant also served copy of Complaint on the Respondent at his email address. All communications were sent to Complainant, Respondent and NIXI by email. Therefore I hold that there is sufficient service on the Respondent through email as per INDRP rules. The Respondent has not filed any response to the Complaint despite two opportunities.

3.5. Clause 8(b) of the INDRP Rules requires that the Arbitrator shall at all times treat the Parties with equality and provide each one of them with a fair opportunity to present their case.

3.6. Clause 12 of INDRP Rules provides that in event any party breaches the provisions of INDRP rules and/or directions of the Arbitrator, the matter can be decided ex-parte by the Arbitrator and such arbitral award shall be binding in accordance to law.

3.7 As stated above, Initially I gave 10 days time to the Respondent to file a Response and additional time to file response on or before 18.4.2022, but the Respondent failed to file any Response to the Complaint despite opportunities and chose not to answer the

Complainant's assertions or controvert the Complaint and the contentions raised. As a result, I find that the Respondent has been given a fair opportunity to present his case but has chosen not to come forward and defend itself.

- 3.8 Further Clause 13(a) of the Rules provides that an Arbitrator shall decide a Complaint on the basis of the pleadings submitted and in accordance with the Arbitration & Conciliation Act, 1996 amended as per the Arbitration and Conciliation (Amendment) Act, 2015 read with the Arbitration & Conciliation Rules, Dispute Resolution Policy, the Rules of Procedure and any by-laws, and guidelines and any law that the Arbitrator deems to be applicable, as amended from time to time.

In these circumstances the Tribunal proceeds to decide the complaint on merit in accordance with said Act, Policy and Rules on Respondent's failure to submit a response despite having been given sufficient opportunity and time to do so.

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:

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(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 :-

The Complainant has filed the present complaint seeking transfer of disputed domain name in its favour. In support of the case the Complainant has stated in the Complaint, inter alia, as under.

5.1. Complainant has averred that the Complainant, Xerox Corporation, is a company organised and existing under the laws of State of New York with its principal place of business at 45 Glover Avenue, PO Box 450, Norwalk, Connecticut 06856-4505345, United States of America.

The Complainant is a technology and services concern and one of the world's leading document management enterprise. Complainant offers one of the world's most widely established, accepted and trusted array of innovative document solutions, services and systems, including colour and

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black and white printers, digital printers, publishing systems, multifunction devices, digital copiers, laser and solid ink network printers serving small and mid-size businesses, large enterprises, governments and graphic communications providers. An extract of the Complainant's corporate profile substantiating the statistics of the Company is annexed as Annexure D with the Complaint. The Complainant is a global leader in administrative, manufacturing, engineering, assembly and customer operations. The Complainant's operations are widespread geographically spanning several countries including India. Extracts of the Complainant's office locations in different countries is enclosed as Annexure E.

- 5.2 The Complainant established its Indian subsidiary in 1983 and has been promoting and selling its goods and services through XEROX India Limited (NIL). The association of the Complainant with the trade and service mark XEROX dates as far back as 1948. The Complainant is also the registered proprietor of the trademark XEROX in respect of goods in various classes in India. An indicative list of some such registrations is as follows:

Trademark	Class	Re •stration No.	Re istration Date
XEROX	01	1 55627	22.09.1952
XEROX	07	217824	18.09.1963
XEROX	09	217825	18.09.1963

XEROX	16	2686386	25.02.2014
XEROX	36, 38	1964325	12.05.2010

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XEROX		1302851	16.08.2004
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Copies of registration certificates of the above marks are enclosed herewith and marked as Annexure G.

It is further stated that the Complainant's trademarks are also an integral and conspicuous part of its trading style, so much so that the Complainant, its business, goods and/or services are themselves readily recognized by mere reference made to them as "XEROX".

5.3. The Complainant has also registered the domain name www.xerox.com since 1986. The Complainant also maintains country specific websites. For instance, for India, the Complainant operates a website www.xerox.in, which is accessible to and indeed targets Indian customers and members of trade. Copies of the Whois records of these websites are enclosed as Annexure H. The Complainant's products and services are readily available on these websites, and anyone can purchase these products through these websites. Few extracts from the Complainant's website where products can be purchased are annexed as Annexure I.

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5.4. The Complainant's trademarks are extremely well regarded and well known in India. Ever since its adoption, the Complainant has been extensively and continuously using the XEROX trademarks throughout the world, including in India. Consequently, the said trademarks have come to acquire immense reputation and goodwill over the years and are one of the most instantly recognizable trademarks in the world today, and equally in India.

5.4 The Complainant's rights over and priority in adoption and use of the XEROX trade marks have been upheld by various UDRP panelists in several cases, the particulars of few of such cases are listed below:

I. In Xerox Corporation v, WhoisGuard Protected, WhoisGuard, Inc. /ZULHAM ST / Brave Chaiden, Domain Data Guard / Reza Fahlevi, UNIX Case No. D2019-1278 The Complainant's trademark is widely recognized by consumers around the world. The Domain Names are confusingly similar to the Complainant's trademarks, In particular, since the word XEROX is an arbitrary, coined term and has no generic meaning in any language. The Respondent has merely added the descriptive terms "driver", "drivers", and/or "printer" as well as a hyphen. It only enhances the consumer confusion. Therefore, the domain names < driverfujixerox.net>, <xerox-printerdriver.com>

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and <xerox-printersdriver.com> were transferred to the complainant.

The Complainant's rights in the trademark XEROX have also been upheld in several INDRP proceedings, the particulars of which are listed below:

Case No	Disputed domain name	Date of order
INDRP/475	<u>xerxpoint.in</u>	May 15, 2013
INDRP/474	<u>xerox.net.in</u>	May 21, 2013
INDRP/473	<u>ganeshxerox.in</u>	April 17, 2013
INDRP/472	<u>xeroxshop.in</u>	May 8, 2013
INDRP/471	<u>xerxpark.in</u>	April 6, 2013
INDRP/470	<u>clarityxerox.in</u>	April 29, 2013
INDRP/469	<u>Olympicxerox.in</u>	April 27, 2013

5.5. Complainant states that the Complainant's trademark XEROX has been held as a well-known trademark by the Intellectual Property Appellate Board (IPAB), Chennai in the matter of BV Elango Himachalopathy v. M/S XEROX Corporation & Anr. Dismissing rectification action which were based on genericide of the Complainant's mark XEROX, the IPAB upheld the Complainant's exclusive rights over the trademark XEROX. The IPAB was pleased

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to uphold the validity of Complainant's trademark registrations for XEROX, which were in its opinion, in continuous use since their date of adoption. It rejected the Petitioner's claims of alleged equitable entitlement to the Complainant's trademark by squarely acknowledging "XEROX" as a well known trademark and thereby affirming that it is entitled to the highest degree of protection under Trademarks Law. A copy of the order passed by the IPAB dated 21st September, 2012 is enclosed as Annexure M.

5.6 It is averred in the Complaint that the Respondent in the present dispute has registered the domain name <xeroxero.in> thereby misappropriating illegally and without authority the Complainant's trademark/trade name XEROX, which is the exclusive property of the Complainant. The disputed domain name was registered on February 25th, 2020, several years after the Complainant established its rights in the well-known trademark XEROX. The disputed domain name is parked since its registration and the Respondent has failed to make any bonafide use of the disputed domain name till date. The extracts from the website under the disputed domain has already been enclosed as Annexure C with the Complaint.

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Discussions and findings:

The Complainant has invoked Clause 4 of the Policy to initiate the Arbitration Proceeding.

Clause 4 of the INDRP Policy provides as under:

4.Class of disputes:

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.

Therefore in order to succeed in the Complaint, the Complainant has to satisfy inter alia all the three conditions provided in clauses 4(a),4(b) and 4(c) quoted above.

6.1

Condition 4(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;

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6.1.1

The Complainant has been using the trade mark XEROX for over 70 years which is well prior to February 25, 2020, which is the registration date of the disputed domain. The Complainant has established rights in its trade mark XEROX dating back to 1948.

As per averments made in the Complaint, the disputed domain name xeroxero.in registered by the Respondent incorporates and completely subsumes the Complainant's well known XEROX trademark in their entirety. It is stated that due to the fame of the distinctive and reputation of the trademark XEROX, the first impression in the minds of the consumers shall be that the Respondent's website originates from, is associated with, or is sponsored by the Complainant. Moreover, people accessing the disputed domain name, even without being aware of the content, are likely to think that the disputed domain name is owned by the Complainant or is in some way connected with it.

It is further averred that the Addition of "ero" to the Complainant's trade mark XEROX does not affect the overall impression of the dominant part of the disputed domain name. In fact, such use gives the impression that the disputed domain is the Complainant's India specific extension and hence increases confusion that the Respondent's domain is associated with the Complainant.

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Complainant relies upon the following decisions:

In *Ducati Motor Holding s.p.A vs- Abhishek Chordia* (INDRP case No. 834) it was held that a domain name that entirely incorporates a Complainant's mark is sufficient to establish the confusing similarity of the disputed domain name with the mark.

Nike Inc. V Nike Innovative CV Zhaxia (Case No. INDRP/804); *Metropolitan Trading Company v. Chandan Chandan* (Case No. INDRP/811); *Lego Juris A/s v. Robert Martin* (Case No. INDRP/125), where it was held that if a Disputed domain name completely incorporates the trademark / service mark of the Complainant, then the mere addition of domain codes such as ".in" and/or ".co.in" will not distinguish the Respondent's Disputed domain name.

I have gone through the complaint and perused all the documents annexed with the Complaint.

From above submissions it is evident that the Complainant has acquired rights in the trade mark **XEROX** by way of trademark registrations, and by virtue of use as part of their company and domain names since much prior to the date on which the Respondent created the impugned domain **<XEROXERO.IN>** incorporating the

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Complainant's identical company name, trade mark and trade name **XEROX** in toto. This evident identity between the Respondent's domain name and the Complainant's marks, domain names and company name incorporating **XEROX** is likely to mislead, confuse and deceive the Complainant's customers as well as the general public as to the source, sponsorship, affiliation or endorsement of the Respondent's domain name. The Complainant's rights over the marks **XEROX** predate the Respondent's registration of the impugned domain < **XEROXERO.IN**> by almost 70 years, which as per the WHOIS records, was only registered/created on **25 February, 2020**.

The Respondent has not filed any response to the complaint as such all the averments of the complainant has remained unrebutted.

It is evident from above submissions and documents annexed with the complaint that the complainant has sufficiently established its rights in and to the ownership of the **XEROX** Trademarks.

A mere perusal of the disputed domain name **XEROXERO.IN** of the Registrant/Respondent shows that the Respondent has used the Complainant's trading mark '**XEROX** in its entirety. it is well established that the mere addition of the Country Code Top Level Domain '.in' does not add any distinctive or distinguishing

element. Further Addition of "ero" to the Complainant's trade mark XEROX does not affect the overall impression of the dominant part of the disputed domain name

In view of the above facts and submissions of the complainant, and on perusal of the documents annexed with the Complaint, I hold that the Disputed Domain Name <XEROXERO.IN> of the Registrant is identical or confusingly similar to the trademark XEROX of the Complainant and the domain name www.XEROX.IN.

Condition no.4 (b) the Registrant has no rights or legitimate interests in respect of the domain name;

The Complainant stated in the complaint that the Respondent has no legitimate interest in the domain name <XEROXERO.IN>. It is further stated that the Complainant has not authorized the Respondent at any point of time to register the impugned domain name. Further, the Respondent cannot assert that it is using the domain name in connection with a *bona fide offering of goods and services* in accordance with Paragraph 6(a) of the .IN Policy, as it is. Thus the Respondent has no rights or legitimate interests in respect of the impugned domain name.

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The Respondent has not filed any response as such the facts stated in the complaint had remained unrebutted. Further the Respondent has failed to satisfy the conditions contained in clause 6(a),(b) and 6(c) of INDRP Policy.

On the contrary the Complainant has established that the Registrant has no rights or legitimate interest in respect of the Disputed Domain Name and has never been identified with the Disputed Domain Name or any variation thereof. The Registrant's use of the Disputed Domain Name will inevitably create a false association and affiliation with Complainant and its well-known trade mark XEROX.

Therefore, in view of the submissions made in the complaint and on perusal of the accompanying documents, I am of the opinion that the Respondent has no rights or legitimate interests in respect of the domain name;

Accordingly I hold that the Registrant has no rights or legitimate interests in respect of the Disputed Domain Name.

6.3

Condition 4(C): the Registrant's domain name has been registered or is being used in bad faith

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Clause 7 of INDRP Policy provides as under:

Clause 7. Evidence of Registration and use of Domain Name in Bad Faith

For the purposes of Clause 4(c), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (a) 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
- (b) the Registrant 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
- (c) by using the domain name, the Registrant has intentionally attempted to attract 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 of a product or service on the Registrant's website or location.

36.

Complainant has placed reliance on a decision of prior Panel in *M/s Merck KGaA v Zeng Wei INDRP/323* wherein it was stated that:

"The choice of the domain name does not appear to be a mere coincidence, but a deliberate use of a well-recognized mark... such registration of a domain name, based on awareness of a trademark is indicative of bad faith registration."

The Respondent had no reason to adopt an identical name/ mark with respect to the impugned domain name except to create a deliberate and false impression in the minds of consumers that the Respondent is somehow associated with or endorsed by the Complainant, with the sole intention to ride on the massive goodwill and reputation associated with the Complainant and to unjustly gain enrichment from the same.

It is relevant to mention the following cases:

i. in *Flipkart Online Services Private Limited v. Azeem Ahmed Khan* wherein it was held that *parking of domain names incorporating someone else's trademark constitutes bad faith.*

ii. *IN Instagram, LLC v. Contact Privacy Inc. / Sercan Lider (WIPO Case No. D2019-0419)* wherein it was held that *"passive holding can be sufficient to find bad faith use".*

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iii. In *Johnson & Johnson v. Daniel Wistbacka* (WIPO Case No. D2017-0709) while discussing the elements constituting bad faith with respect to passive holding of respondent's domain name as noted in the landmark case of *Telstra Corporation Limited v. Nuclear Marshmallows* (WIPO Case No. D2000-0003), it was held that, *...In particular it seems that the fifth element (i.e., impossibility to conceive of any plausible active use) is actually a conclusion which was made on the base of the preceding four elements and that this fifth element plays a decisive role in determining whether any particular passive holding can be regarded as a "bad faith" use of a domain name in dispute.*

In the present case like in the above cited case, the Panel cannot conceive of any plausible use of the disputed domain name that would be legitimate, absent an authorization from the Complainant. As the disputed domain name is strictly identical to the Complainant's distinctive mark, consumers would certainly mistakenly assume that an active website connected to the disputed domain name is operated or endorsed by the Complainant, when such is not the case. The Panel accordingly reaches the conclusion that the passive holding of the disputed domain name amounts to use in bad faith given the circumstances of the case.

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The facts and contentions enumerated in the complaint establish that Respondent's domain name registration for <XEROXERO.IN> is clearly contrary to the provisions of paragraph 4(c) of the INDRP and is in bad faith.

It is shown by the complainant that the Complainant is a well known reputed and global entity with extensive operations around the world. The Registrant was most certainly aware of the repute and goodwill of the Complainant. Therefore adoption of the substantially identical Disputed Domain Name by the Registrant in 2020 is with the sole intention to trade upon and derive unlawful benefits from the goodwill accruing to the Complainant. The Registrant has in fact knowingly adopted the Disputed Domain Name which wholly contains the Complainant's prior trademark XEROX to attract customers to the Disputed Domain Name by creating confusion with the Complainant's reputed trademark XEROX and corresponding domain name.

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(a)(b) and (c) of INDRP policy and has established that the registration of disputed domain name is in bad faith.

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Accordingly I hold that the Registrant's Domain Name has been registered in bad faith.

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 'XEROX' 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.

7.2 In accordance with the INDRP Policy and Rules, I direct that the Disputed Domain Name registration be transferred to the Complainant.

Delhi
Dated 28.04.2022

Alok Kumar Jain
Alok Kumar Jain
Sole Arbitrator