



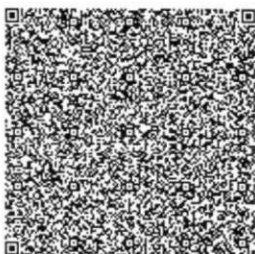
सत्यमेव जयते

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Certificate No. : IN-DL25322670994081M
Certificate Issued Date : 21-Feb-2014 03:08 PM
Account Reference : SHCIL (FI)/ dl-shcil/ HIGH COURT/ DL-DLH
Unique Doc. Reference : SUBIN-DL DL-SHCIL48026730458818M
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
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AMENDED ARBITRATION AWARD

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

Bloomberg Finance L.P.

...Complainant

Versus

Bloomberg Realty (India) Private Limited

...Respondent

018

**AMENDED ARBITRATION AWARD
IN REGISTRY – NATIONAL INTERNET
EXCHANGE OF INDIA**

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

IN THE MATTER OF:

Bloomberg Finance L.P.,
731, Lexington Avenue
New York, New York 10022
U.S.A.

..... Complainant

VERSUS

Bloomberg Realty (India) Private Limited
408-409 DM Tower
21/1 Race Course Road
Indore – 452 001
Madhya Pradesh
India

..... Respondent

1. THE PARTIES:

- 1.1. The Complainant in this administrative proceeding is Bloomberg Finance L.P., 731, Lexington Avenue, New York, New York 10022 U.S.A. represented through Sudhir D. Ahuja (constituted attorney of complainant), D.P. Ahuja & Co., 14/2, Palm Avenue, Calcutta–700019.
- 1.2. The Respondent in this administrative proceeding is Bloomberg Realty (India) Private Limited, 408-409 DM Tower, 21/1 Race Course Road, Indore–452001, Madhya Pradesh initially represented through Rakesh Prabhu, ALMT Legal, 2, Lavelle Road, Bangalore–560001.
- 1.3. The Respondent's attorney Mr. Rakesh Prabhu by his email dated 14.09.2012 intimated the Panel that he will no more represent the respondent in the above matter. By email dated 17.09.2012 M/s.



Vachan & Associates intimated its representation on behalf of the respondent to the Panel.

- 1.4 M/s. Vachan & Associates also intimated the Panel on 05.11.2012 that they will no more represent the respondent in the above matter and the respondent would be taking appropriate steps to present its case before this Panel. The Respondent, thereafter, appointed M/s. Khaitan & Co. as its legal representative on 05.11.2012 to present the case before the Panel.

2. **THE DOMAIN NAME AND REGISTRAR**

The disputed domain name <bloombergreality.in> has been registered by the respondent. The registrar with whom the dispute domain is registered is Transcure Solutions Pvt. Ltd.

3. **PROCEDURAL HISTORY**

- 3.1 The Complaint was filed with the .In Registry, National Internet Exchange of India (NIXI), against Bloomberg Realty (India) Private Limited, 408-409 DM Tower, 21/1 Race Course Road, Indore – 452 001, Madhya Pradesh. The NIXI verified the Complaint and the annexures thereto and was satisfied that the formal requirements of the .in Domain Name Dispute Resolution Policy (“The Policy”) and the Rules of Procedure (“The Rules”) were duly complied with.
- 3.2 The panel submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI to ensure compliance with the Rules (paragraph-6).



- 3.3 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 6th June, 2012.
- 3.4 The parties were first notified about the appointment of an Arbitrator on 6th June, 2012.
- 3.5 In accordance with the rules, paragraph 5(c), the Respondent was notified about the commencement of arbitration proceedings and the due date for filing its response. However, the complainant, on June 7, 2012, intimated that the centre has forwarded wrong complaint to the Panel and has omitted to forward revised complaint dated 11th May 2012 filed against the present Respondent.
- 3.6 The panel notified the centre and required the supply of revised complaint dated 11th May 2012 at the earliest; the panel received the revised complaint from the centre on July 23, 2012. Fresh notice, as per the amended complaint dated 11th May 2012 was issued to the respondent and therefore the Arbitration Proceedings commenced on 23rd July, 2012.
- 3.7 The Respondent was granted an opportunity, by notice dated 23rd July 2012, to file its response, if any, within ten days thereof failing which the respondent was informed that the matter shall be decided by the panel on the basis of the material available on record and in accordance with the provisions of law, as applicable.



- 3.8 The respondent filed his reply on August 3, 2012 through their representative Mr. Rakesh Prabhu, ALMT Legal, Bangalore.
- 3.9 The complainant by its email of August 3, 2012 requested for an opportunity to file rejoinder to the response filed by the respondent. Seven days' time was granted to the respondent to file its rejoinder, which was filed on August 10, 2012.
- 3.10 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 also considered necessary for deciding the Complaint and consequently a personal hearing was granted to the parties on 5th November, 2012. On the basis of the statements and documents submitted on record and taking into consideration the oral submissions made on behalf of the parties, the present award is passed.

4. **FACTUAL BACKGROUND**

- 4.1 The complaint was originally instituted against Mr. Praveen Jain of 'Aries Technology, 201, McSure Plaza, 5-EA Scheme No. 54, Indore – 452 010, Madhya Pradesh, India on 12.04.2012. After the institution of the complaint, the respondent changed the WHOIS record of the impugned domain name <bloombergreality.in> as 'Bloomberg Reality India Private Limited'. The complainant thereafter amended the complaint against current respondent on 11.05.2012.
- 4.2 The complaint is based on the basis of proprietorship claims to the trade / service marks Bloomberg and the registration(s)



thereof. The complainant hold registration of various domains incorporating the mark BLOOMBERG and the first domain, which the complainant and its predecessor in interest have used continuously since the year 1993 is bloomberg.com. Apart from this, the complainant also holds registration of various trade mark(s)/ service mark(s)/ domain names incorporating the mark BLOOMBERG.

- 4.3 The complainant hold registration of the mark BLOOMBERG in India in respect of variety of goods and services falling in classes 9, 16, 35, 38, 41 & 42. The complainant holds registration of several other trade / service mark(s) incorporating the mark BLOOMBERG and its variants in more than 100 countries around the world.
- 4.4 The respondent Bloomberg Reality India Private Limited is engaged in the business of construction of residential and commercial spaces and has been running its business activities in India since the year 2010.
- 4.5 The respondent claims to have amplified into diverse portfolio of business models collectively known as "BLOOMBERG Group" and has obtained registration of domain name bloombergrealty.in.
- 4.6 The complainant is aggrieved by the registration of domain bloombergrealty.in in the name of the respondent and has thus filed the present complaint.



5. **PARTIES CONTENTIONS**

Complainant's case

- 5A. Bloomberg is a multinational financial news corporation and a trusted leader in global business and financial information, founded in 1981. Complainant's predecessor adopted and first used the expression 'BLOOMBERG' in 1987 as its trade mark, trade name, and corporate identity. Bloomberg L.P. currently uses the 'Bloomberg' trade name under license from Complainant. Bloomberg provides influential decision makers worldwide with data, analytics, news, and insight to give them a critical edge. The BLOOMBERG PROFESSIONAL service is now the leading choice of more than 310,000 business and financial professionals globally. Bloomberg's capability in delivering data, news and analytics quickly and accurately through innovative technology has resulted in several award-winning products and solutions. Bloomberg has over 15,000 employees in 192 locations, including 2,300 reporters in 140 news bureaus worldwide.
- 5B In India, Bloomberg has been using the BLOOMBERG trade mark since July, 1996. Bloomberg's subsidiaries operate offices in Mumbai, Bangalore and New Delhi.
- 5C Since inception, Bloomberg has become one of the largest providers of worldwide financial news and information. Bloomberg reaches millions of people worldwide through a variety of international, multi-lingual media outlets, including BLOOMBERG TELEVISION and BLOOMBERG RADIO programming, BLOOMBERG NEWS, and the highly popular website at www.bloomberg.com in India, "Bloomberg UTV" was launched in 2008 as a 24-hour English language business and financial broadcast



news outlet in India, by UTV Software Communications in strategic partnership with Bloomberg Television.

5D The Bloomberg brand is widely advertised in the national and international media. The remarkably rapid growth of bloomberg's operations worldwide has resulted in tremendous popularity and global recognition of the BLOOMBERG mark and name, which has become exclusively associated and identified with Bloomberg and its products and services. Use of the BLOOMBERG trade mark or name by any entity, on any product or related service, would lead people to believe that such product / service either originated from or is somehow associated with Bloomberg. The mark Bloomberg has acquired the status of a well-known trade mark. The mark Bloomberg is not a commonly used Indian name.

5E. This Complaint hold trade mark and service mark registrations for BLOOMBERG in India, listed below along with related goods and services:

- Registration no. 724377 in class 9 dated 26.07.1996;
- Registration no. 724378 in class 16 dated 26.07.1996;
- Registration no. 1282725 in class 35 dated 07.05.2004
- Registration no. 1285577 in class 36 dated 21.05.2004
- Registration no. 1285576 in class 38 dated 21.05.2004;
- Registration no. 1285575 in class 41 dated 21.05.2004;
- Registration no. 1285574 in class 42 dated 21.05.2004

5F. Complainant and its subsidiary / associate companies (collectively described as Bloomberg) also own several other registrations for the mark BLOOMBERG and its variants in over 100 countries of the world. The first registration for the BLOOMBERG trademark was obtained by Bloomberg in the USA in 1990. Complainant and its



subsidiary / associate companies have continually used marks comprising or including the word "BLOOMBERG" in over 100 countries in respect of diverse range of goods and services.

5G Complainant is the owner of the following in domain names:

- (i) bloomberg.co.in
- (ii) bloomberg.in
- (iii) bloomberg.org.in
- (iv) bloomberg.gen.in
- (v) bloombergnews.co.in
- (vi) bloombergtelevision.co
- (vii) bloombergtradeing.co.in &
- (viii) bloombergmedia.in

5H Complainant also holds the registration for <Bloomberg.com>, which complainant and its predecessor in interest have used continuously since its registration in 1993, as well as registrations for <blomberg.net>, <Bloomberg.org>, <Bloomberg.biz>, and <Bloomberg.info>. Complainant and its affiliated companies also own over 1,000 other domain names incorporating the word "bloomberg", including many defensive registrations of marks spelling "bloomberg" incorrectly (collectively, "Complainant's domain names"). The search made on Search Engines to the mark/word Bloomberg also diverts the internet users to the website of the respondent under the confusingly similar domain.

5I. The disputed domain name <bloombergrealty.in> was created on 25 June, 2011 and was initially registered in the name of one Pravin Jain of Aries Technologies. On 13 April, 2012, the registrant ID was updated to replace Pravin Jain's contact details with that of Bloomberg Reality (India) Pvt. Ltd. WHOIS database records printed on 29 February and 18 April, 2012 are annexed to the complaint.

- 5J. The case of the complainant is that on account of priority in adoption and use of the trade mark / service mark / domain name consisting of the word Bloomberg and on account of registrations it has acquired a proprietary right therein and the registration of the word BLOOMBERG as part of disputed domain name bloombergrealty.in on the part of the respondent is in bad faith and the said domain name is also confusingly similar to the complainant's marks / domain name. It is, further the case of the complainant that the respondent has no right or legitimate interest in the disputed domain name 'bloombergrealty.in'.
- 5K In January, 2012, the complainant learnt about the formation of the respondent company incorporated on 11.01.2011 under the name Smart Developers Pvt. Ltd. and the name of the company was changed to Bloomberg Reality (India) Pvt. Ltd. on 24.08.2011. It was also found that the owner of respondent company also formed other 18 companies all with the name Bloomberg. On ascertainment of the factual position, the complainant learnt that 18 companies (out of 19 companies) have no commercial activities and exist just on paper. The complainant also discovered that the respondent, through its associate company BLOOMBERG Developers filed number of trade mark applications for registration of the mark Bloomberg. Consequently, a cease and desist letter dated 20.10.2012 was addressed on behalf of the complainant requiring the respondent to desist from using the trade mark / trade name Bloomberg in any manner. Since the complainant did not receive any satisfactory response to its cease and desist letter, the complainant filed opposition to the advertised trade mark application(s) for registration



of mark Bloomberg in the name of Bloomberg Developers Pvt. Ltd. / Smart Developers Pvt. Ltd.

5L. In addition, the complainant also discovered following .com and .in domain names registered in the name of 'Bloomberg' and / or Pravin Jain of Aries Technology.

- bloombergworldwide.com
- bloombergstae.com
- bloomberghotels.com
- bloomberghousing.com
- bloombergairways.com
- bloombergsolar.com
- bloombergglobal.com
- bloombergmedia.in
- bloombergrealty.in

5M Complainant initiated proceedings under UDRP and INDRP against Bloomberg/Pravin Jain, being the registrant of the above domain names. The UDRP complaints were filed on 24th April and 26th April, 2012.

5L The complainant has, therefore, filed the present complaint under INDRP Policy and the Rules and the procedure with a prayer for the transfer of the impugned domain name in its favour.

6. **RESPONDENT'S CASE:**

6A. The respondent's case is that the respondent's group companies are duly registered in India under The Companies Act of 1956.

6B. The respondent is engaged in the business of construction of residential commercial spaces. The projects of the respondent which came up in India are specialized in LEED Certified Green Building world class development standard projects including Integrated

Township, SEZ, Commercial and Residential Spaces, Rainwater Harvesting and recycling of water in every project. The respondent have been in the Reality business under the name and style of Bloomberg Reality India Private Limited in India since 2010 and the website hosted and known as BLOOMBERGREALTY.IN identifies the activities conducted by the respondent in the space of Reality in India.

- 6C Since the year 2011, the respondent company has amplified into a diversified portfolio business model and came to be identified as BLOOMBERG Group.
- 6D. The respondent has put the domain name into fair use without any intent for commercial gain by misleading the customers or to tarnish the trade mark or service mark of the complainant. The respondent is not carrying any content on their websites, which is misleading or providing false information to their customer to lure them and make them believe that services are offered by complainant.
- 6E The respondent has filed applications for registration of the trade mark 'BLOOMBERG' in classes 6, 35, 36, 37, 39, 40, 41, 42, 43 & 44 under various classifications before the Trade Marks Office. The respondent, by filing applications for registration of the trade mark, has demonstrated that they have taken reasonable steps to protect their mark in India. The Respondent is known by the mark and is using the domain name at issue with a bona fide offering of services. The respondent is into varied avenues of realty business and also developing houses, residential townships, hospitals, hotels and various commercial projects in metros and business centres of India.
- 6F At all given times, the respondent has protected and promoted their services with sincerity and integrity. The respondents have never



attempted to either pass-off their services or mislead their customers to lure them to believe that the services are provided by Complainant in India.

- 6G The respondent and the complainant are involved in number of disputes over the right to use the mark BLOOMBERG generally in connection with a broad range of business ventures in India. The dispute over the domain name www.bloombergrealty.in is only one of the trade mark or trademark-related matters pending between the complainant and respondent asserting legitimate right to use that name. Such cases are not within the scope of the .IN Domain Name Dispute Resolution Policy.
- 6H The complainant had filed a complainant against the respondent's other domain name "bloombergworldwide.com" before the National Arbitration Forum. The case was decided by international arbitration panels in favour of respondent by dismissal of the complaint.
- 6I The use of the name Bloomberg is merely a coincidence and is represented along with a flower. Bloomberg means flower or a family of flowers and as such is not confusingly similar to the marks / domain of the complainant.
- 6J The respondent has a legitimate interest in respect of the domain bloomergralty.in and is known by its mark. The domain is used with a bonafide offering of goods / services.
- 6K. The respondent has registered In domain in good faith.
- 6L. The respondent denied other averments made in the complaint in general.



7. **COMPLAINANT'S REJOINDER**

- 7A The complainant in its rebuttal submits that respondent is clearly trying to build up its own business on the tremendous reputation, strong brand recall and instant recognition of complainant's BLOOMBERG trade mark and name. There is no other justification why respondent, formed only in 2011, would adopt and use complainant's trade mark and name, which has been known to millions of households in India for years.
- 7B The complainant further submit the respondent has failed to demonstrate that it used the disputed domain name (<bloombergrealty.in>) in the bona fide offering of goods or services over the internet before it received notice from complainant. In fact, the respondent has not furnished any evidence that it provides any goods or services in India.
- 7C The complainant has opposed registration of trade marks filed in the name of Bloomberg Developers Private Limited, that have till now been advertised. Complainant has also filed a cancellation action before the Intellectual Property Appellate Board against a trade mark registration of Bloomberg Developers Private Limited. It is significant and pertinent to point out that the respondent has spelled all its trade mark applications, listed in the table in para b(iii), as BLQMBERG". Such deliberate misspelling of one's own trade marks, in a formal submission, is nothing but a bid to deflect this Tribunal's attention, if that is possible, from the respondent's misappropriation of complainant's BLOOMBERG trade mark.
- 7D The complainant further submits that the present proceeding is only to decide wrongful registration and use of the disputed domain name by respondent. Complainant has, till now, challenged every claim



and allegation of respondent relating to trade mark and / or trade name rights, in other forum. Complainant has approached this tribunal for a determination of its right to prevent abusive registration of domain name that fully includes complainant's prior, registered, and internationally well-known trade mark. The scope of INDRP is not limited to Indian Trade Mark Rights, and the accessibility of .in website address is not limited within India.

- 7E The complainant further submits that in the arbitration proceedings before the National Arbitration Forum in Claim no. FA 1204001439263, the Arbitrator has held that 14 domain names "were registered in bad faith, since they were registered for the purpose of trading globally off complainant's goodwill in its famous BLOOMBERG trade mark..."

8. DISCUSSIONS AND FINDINGS

Under the .IN Policy the Registrant of the domain name is required to submit to a mandatory Arbitration proceeding in the event that a Complainant is filed in the .IN Registry, in compliance with the .IN Policy and the INDRP Rules. The complainant is also required to submit to Arbitration Proceedings if the jurisdiction for Arbitration is sought to be invoked for cancellation or transfer of a disputed domain name. In the present case, both parties have submitted to the jurisdiction of Arbitrator concerning the subject matter of the complaint.

The .IN Policy, paragraph 4 requires the Complainant, to establish three elements, which are:



- (i) The domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights.
- (ii) The Registrant has no rights or legitimate interests in respect of the domain name;
- (iii) The Registrant's domain name has been registered or is being used in bad faith.

8A. The first element under paragraph 4 the Policy requires a Complainant to establish that the domain name is identical or confusingly similar to a trade mark in which it has rights. The complainant's mark BLOOMBERG is registered in India and in many other countries in the world and connected with worldwide financial news and information, which is particularly wide spread through the use of the complainant's website www.bloomberg.com. Copies of the certificates of registration of trade marks in India are filed on record marked as Exhibit 'A'. Copies of certificates of registration in some of the foreign countries are also filed on record as Exhibit 'B'. Copies of WHOis database records evidencing registration(s) of various domains with the word Bloomberg forming essential part thereof in the name of the complainant are filed on record as Exhibit 'C' and Exhibit 'D'. Documents providing complainant company's information, history, activities and range of goods and services and also evidencing complainant's worldwide presence, reputation and popularity is filed on record as Exhibit 'E'.

8B. There is no dispute raised by the respondent as to the authenticity or genuineness of Exhibits 'A' to 'E' filed by the complainant, which prove the prior adoption, use, goodwill, reputation and registration of trade marks / service marks / domain names in the name of the



complainant and its proprietary rights therein and also the fact that the mark Bloomberg has the trappings of a well-known trade mark.

8C The complainant's case is that the domain name bloombergrealty.in is identical and is confusingly similar to complainant's Trade Mark(s) / service mark(s) and domain names BLOOMBERG. The complainant submits that the impugned domain name primarily comprises of complainant's mark(s) BLOOMBERG with reality added as expansion.

8D In the matter of ITC Limited V/s. Travel India case No. L-2/5/R4, it was held that if a well-known trade mark is incorporated in its entirety, it is sufficient to establish that a domain name is identical or confusingly similar to Complainant's registered mark. (relying upon Boehrings Ingelheim Pharma GmbH V. Philana Dhimkana WIPO Case no. 2006-1594, HSBC Holding Plc V. Hooman Esmail Zadeh, Case No. L-2/5/R2 and Allied DOMEQ Spirits and Wine Limited V/s. Roberto Ferrari, INDRP Case No. 071).

8E The ownership concerning the trade mark BLOOMBERG of the complainant has been considered by International Arbitration Panels and decided in favour of complainant. List of cases filed by the Complainant before National Arbitration Forum have been filed on record as Exhibit 'H-1'.

The Arbitration Award passed in the matter of BLOOMBERG Finance L.P.V. Kanha Vijay V; Case No. INDRP/110 is also filed in Exhibit H-2.

8F. In the said decisions (Exhibit H-1 & H-2) the Arbitration Panel has held the domain Bloomberg.net.in as confusingly similar to the mark Bloomberg of the complainant.



- 8G. The contention of the respondent that the mark BLOOMBERG is represented along with a flower and therefore is not confusingly similar is not tenable in law. The disputed domain name contains the complainant's mark Bloomberg in its totality. Furthermore, the device of flower does not form part of disputed domain name.
- 8H. An internet user would mistakenly believe that a website accessible by the URL <http://www.bloombergrealty.in/> is affiliated with or endorsed by complainant particularly in view of the domains with the mark bloomberg registered in the name of the complainant and as disclosed in Exhibit 'C' and Para 9 of the complaint. The respondent's reference to the BLOOMBERG indicate that the respondent wishes to deceive visitors to his website into believing that the website is affiliated with or managed by the complainant and or enjoys the benefit of complainant's news and information resources. There is strong likelihood that somebody looking for complainant's India-specific services and offers would be mistaken and misled by the domain name BLOOMBERGREALTY.
- 8I. The mark Bloomberg is not a common Indian name. Looking at the distinctiveness of the complainant's mark and its extensive use in commerce; it is likely that the respondent have targeted the complainant's mark in choosing the disputed domain name. Evidence has been provided by the complainant showing recognitions of its mark by the end users of internet in diverse jurisdictions in the world.
- 8J. The test for establishing confusing similarity "is confined to a comparison of the disputed domain name and the trademark alone, independent of the other marketing and use factors usually considered in trade mark infringement or unfair competition cases".



Foundation Le Corbusier v. Monsieur Bernard Weber, Madame Heidi Weber, WIPO Decision D2003-0251. The content of respondent's website, the nature of the services offered by respondent, and education or intelligence level of Complainant's customers are irrelevant in deciding if bloombergrealty is confusingly similar to Bloomberg. The contentions of the respondent that the goods and services of the respective parties are different and fall in different classes of Schedule IV of Trade Marks Rules and as such there is no likelihood of confusion or deception has no legal force, because the content or nature of services offered by the respondent by the use of disputed domain is not a factor relevant in the present proceedings. Even otherwise if a well known mark is sought to be used / misused by any person even in respect of unrelated specification of goods or services, it does not cease to be confusingly similar leading to deception in the mind of end users. The law is pretty well settled on this proposition of law. The reliance placed by the respondent to the judgment of Hon'ble Supreme Court of India in the matter of Vishnudas V/s. Vazir Sultan Tabaco: 1996 PTC 512 is equally misplaced. The Hon'ble Supreme Court in Vazirsultan case was considering the case of rectification of a registered trade mark in respect of specification of goods for which the registered proprietor has made no bonafide use within the meaning of Section 46 of the Trade & Merchandise Marks Act. The Hon'ble Court did not decide the question of deceptive similarity of the competing marks used in respect of different specification of goods / services. The Court made it abundantly clear that the controversy in the case is confined to the propriety and validity of the order of rectification of registration of trade mark in favour of



respondent company and it is not necessary to address the questions of infringement of trade marks or passing off, defensive registration etc. The disputed domain name is confusingly similar to complainant's mark because adding the generic term "reality" to the BLOOMBERG mark creates no distinguishing features to the mark and does not render the mark less recognizable or the disputed domain name less confusingly.

- 8K After considering the facts of the case set up by parties, the Panel finds that the impugned domain name <bloombergreality.in> is identical and or confusingly similar to the mark BLOOMBERG in which complainant has rights and also holds registration(s).

9. **THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN THE DISPUTED DOMAIN NAME**

- 9A The complainant has asserted that the respondent has no right or legitimate interest to disputed domain name for the reason that the mark Bloomberg is a well known and widely used mark of the complainant. Use of another's trade mark in the domain name does not confer right or legitimate interest in favour of the owner of domain name. See America online Inc. v. Xianfeng Fu WIPO Case No. D-2000-1374.
- 9B The Complainant's right in the trade mark / service mark / domain names are much prior to the date of registration of impugned domain name by the respondent. The documentary evidence filed by the complainant marked as Exhibit 'A' to Exhibit G clearly establishes the complainant's prior proprietary rights in the mark Bloomberg. The Evidence on record shows that the mark Bloomberg has widely been used and publicized. The mark Bloomberg is also not a word of ordinary common use. The justification given by the respondent

for the adoption of identical mark bloomberg on the part of its domain name is not found to be satisfactory.

- 9C The owner of Bloomberg Realty, Mr. Prafull Saklecha, formed 18 (eighteen) companies in 2011 alone, all with the name "BLOOMBERG" and changed the name of another company, "Smrat Developers Pvt. Ltd.", Indore, (which he acquired) to Bloomberg Developers Private Limited on 24.08.2011.
- 9D The complainant sent a cease and desist letter to Bloomberg Realty and its associated companies, on 20.01.2012, requiring the companies, inter alia, to stop the use of the trade mark / trade name "Bloomberg" in any manner. Mr. Prafull Saklecha responded by his emails on 06.02.2012 but did not address the material issues. The attorneys of Bloomberg Realty also made no attempt to address the contentions of the cease and desist letter of 20.01.2012 or respond to complainant's specific claims. Instead, they simply stated that they were in the process of receiving detailed instructions from their clients and preparing a detailed reply to legal notice, and that the same would be sent within two weeks.
- 9E The respondent and its associate companies, jointly and / or singly, copied the complainant's trade name, brand name, trade marks, domain names, and even the corporate identity. It appears that the respondent is running a pre-mediated and planned campaign to methodically infringe, usurp and misappropriate Complainant's Intellectual Properties. It is a well settled principle of law that no right can accrue if the very adoption of the trade mark in question is tainted with malafides and obvious dishonesty. The above sequence of events and the dubious action on the part of the respondent, thus,



conclusively establish that the present respondent - registrant has no right or legitimate interest in the subject domain name.

- 9F The complainant's marks are particularly strong and have gained secondary meaning due to their continued use in connection with complainant's financial news and information business. Complainant has not licensed or otherwise permitted Respondent to use complainant's marks, nor has complainant licensed or otherwise permitted respondent to apply for or use any domain name incorporating those marks.
- 9G The respondent does not maintain any website connected to <bloombergrealty.in>. Apart from confusing internet users, looking for complainant's website, respondent's website has no apparent purpose. Respondent's registration and passive holding of the domain name <bloombergrealty.in> fails to show use of the domain name in connection with a bona fide offering of goods or services, or demonstrable preparations to use the disputed domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services by respondent. It has been long held that merely registering the domain name is not sufficient to establish rights or legitimate interests.
- 9H. The respondent managed to update the registrant ID of the disputed ccTLD as well as the gTLDs, to reflect its own name and address, almost about at the same time the complainant filed its complaint in relation to the gTLDs and ccTLDs.
- 9I The respondent has merely held on to the subject domain name since creation, which does not support any website. The respondent cannot be said to be using the domain name for any legitimate, non-commercial or fair use either. Instead, it proves that such domain –



grabbing is just a part of respondent's multi-pronged plan to steal complainant's brand and corporate identity and project itself as "the Bloomberg group". Such willful and malicious act on the part of respondent cannot and does not give the respondent any right or legitimate interest in the disputed domain name.

9J The respondent's contentions that the respondent's group companies are duly registered in India under the Companies Act of 1956 and they have put the domain name into "fair use" without any intent for commercial gain by misleading the customers or to tarnish the trade mark or service mark of the complainant is devoid of any merit in Law. The respondent claims that it is not carrying any content on their websites, which is misleading or providing false information to their customer to lure them and make them believe that services are offered by complainant is also not relevant. The complainant's rights in the mark bloomberg predate the respondent's registration of the domain name by nearly twenty four years. This coupled with the fact that the complainant's mark is well known and is universally recognized; render it doubtful for the respondent to put forth an argument that may establish a right or a legitimate interest in the disputed domain name. See General Electric Company v. La Porte Holding Inc. WIPO case No. 2005-0076.

9K The respondent further submits that it has filed applications for registration of the trade mark 'BLOOMBERG' under various classifications before the Trade Marks Office. The respondent by filing applications for registration of the trade mark has demonstrated that they have taken reasonable steps to protect their mark in India. The Respondent is known by the mark and is using the domain name at issue with a bona fide offering of services. The



respondent is into varied avenues of realty business and also developing houses, residential townships, hospitals, hotels and various commercial projects in metros and business centres of India. The respondent relies upon the decision of EAuto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc. WIPO case no. D2000-0047 and relies upon the proposition that if the respondent establishes that he is known by his mark and using the domain name at issue with a bonafide of offering of goods / services, it is sufficient to demonstrate that the respondent has legitimate interest in his domain.

9L The WIPO Case No. D2000-0047; EAuto L.L.C. v. Triple S. Auto Parts is not applicable in the present case as the respondent in the present case has failed to demonstrate that it used the disputed domain name <bloombergrealty.in> in the bona fide offering of goods or services over the internet before it received notice from complainant. In fact, the respondent has not furnished any evidence that it provides any goods or services in India.

9M The respondent contend that it has filed a trade mark application before the Registrar of Trade Marks Mumbai / Chennai in respect of the mark BLOOMBERG and variants thereof in classes 6, 35, 36, 37, 39, 40, 41, 42, 43 & 44 and at all given times, it has protected and promoted their services with sincerity and integrity. The respondents have never attempted to either pass-off their services or mislead their customers to lure them to believe that the services are provided by Complainant in India. Mere filing of an application for registration or pendency of an application or even advertisement thereof confer no right on the applicant Ref. Metro Playing Card V/s. Wazir Chand : AIR 1972 DELHI 248.



9N The complainant has opposed registration of trade marks filed in the name of Bloomberg Developers Private Limited, that have till now been advertised and opposition proceedings are yet to be decided. Right in a mark is acquired by prior adopter and user of the mark under common law and registration is merely a recordal of such right. Ref. Consolidated Food Corporation V. Brand on AIR 1965 BOM 35. Complainant has also filed a cancellation action before the Intellectual Property Appellate Board against a trade mark registration of Bloomberg Developers Private Limited. It is significant and pertinent to point out that the respondent has spelled all its trade mark applications, as BLOMBERG". Such deliberate misspelling of one's own trade marks, in a formal submission, is nothing but a bid to deflect this Tribunal's attention, if that is possible, from the respondent's misappropriation of complainant's BLOOMBERG trade mark.

9O The respondent further submits that both the complainant and the respondent are involved in a number of disputes over the right to use the name BLOOMBERG generally in connection with a broad range of business ventures in India. The dispute over the domain name www.bloombergrealty.in is only one of the trade mark or trademark-related matters pending between the complainant and respondent asserting legitimate right to use that name. Such cases are not within the scope of the .IN Domain Name Dispute Resolution Policy.

The respondent relies upon the decision of national arbitration forum in commercial publishing company Vs. Earth Publishing Company Inc FAO 95013 and relies upon the preposition.

"The adopted policy establishes a streamlined, inexpensive administrative dispute resolution procedure intended only for the



relatively narrow class of cases of “abusive registrations”. Thus, the fact that the policy’s administrative dispute – resolution procedure does not extend to cases where a registered domain name is subject to a legitimate dispute is a feature of the policy, not a flaw. The policy relegates all “legitimate disputes” to the courts. Only cases of abusive registrations are intended to be subject to the streamline administrative dispute-resolution procedure.”

The respondent further relies upon National Arbitration Forum decision in the matter of Abbott Labs. V/s. Patel, FA 740337 and relies upon the proposition that “assertions of trade mark infringement are “entirely misplaced and totally inappropriate for resolution” in a domain name dispute proceeding because the UDRP Policy applies only to abusive cybersquatting and nothing else.”

The respondent further relies upon the National Arbitration Forum decision in Stevenson Indus., Inc. v. CPAP-PRO Online, FA 105778 having proposition that “if the existence of [rights or legitimate interest] turns on resolution of a legitimate trade mark dispute, then respondent must prevail, because such disputes are beyond the scope of this proceeding.”

9P The reliance placed by the respondent in the matter of Commercial Publishing Company Inc V/s. EarthComm. Inc. is misplaced as in the said case the panel concluded that the complainant was not entitled to relief under Section 4(a) of the policy, not because of pending legal proceedings between the parties, but on the ground that the complainant had failed to establish any rights in the trade mark included in the disputed domain name.

9Q In the matter of Abbott Laboratories v. Kumar Patel the panel did not dismiss the complainant but decided it in favour of the

complainant. The Panel held "Before addressing the substantive questions posed by the parties' contentions, we first note that respondent contends that complainant's contentions consist of what is essentially a complaint for trade mark infringement which ought to be decided in the appropriate national courts. It is of course true that the Policy's dispute resolution procedure is intended solely to address a narrow class of abusive domain name registrations, and necessarily relegates all other disputes between the parties to the Courts. It is also true that some of the language used by the complainant in its submissions in this proceeding is reminiscent of that commonly found in trademark infringement cases. The panel will, however, limit its consideration of the allegations of the complaint to those directly pertinent to issues properly considered under the policy."

9R In the matter of Stevenson Industries, Inc. v. CPCP-PRO Online. The complaint was dismissed because all of the three required elements had not been satisfied, and not because the parties were involved in other trade mark related disputes.

9S In the matter of Bloomberg Finance L.P. V. Bloomberg (Pravin Jain) the complainant filed against Pravin Jain / Bloomberg (the original registrant of the disputed domain name) was "dismissed without prejudice" as the Arbitrator found it beyond the scope of a domain name dispute resolution proceeding to sort through the various trade mark and trade name disputes between the parties. However, the decision in Claim No. FA1204001439263 is **against Bloomberg Realty (India) Pvt. Ltd.**, the present registrant of the disputed domain name and the respondent herein, in which transfer of 14 domain names to complainant was ordered by the Panel.



Complainant in the present proceeding does not seek any relief other than transfer of the disputed domain name, having resulted from a glaring example of "abusive registration."

9T In numerous decisions / awards rendered by different Arbitrators in the complaints filed by the complainant, the disputed domains are either cancelled or transferred to the complainant, list of such cases form part of the record. It is thus also established that in none of the earlier decisions against numerous persons using bloomberg as part of their domain names the arbitrator(s) found any right or legitimate interest in the registration of the basis of complainant's right therein.

9U The Panel, after considering all the submissions by the Parties concludes that respondent has no rights or legitimate interest in the impugned domain name.

10. RESPONDENT REGISTERED THE DOMAIN NAME IN BAD FAITH

10A The complainant has to establish that the domain name was registered and used in bad faith. Bloomberg has a strong reputation and a high profile presence in the financial sector, and is the subject of substantial consumer recognition and goodwill. Complainant's mark BLOOMBERG was first registered in India on 26.07.1996. The Domain <Bloomberg.com> was registered by Bloomberg on 29.09.1993 and has been in continuous use since 1993. The Promoter – director of Bloomberg Reality (India) Private Limited, by its own admission, is a Chartered Accountant by profession and therefore, familiar with Bloomberg and its services and products. Such facts firmly lead to the conclusion that respondent was aware



of complainant's mark before registering the <bloombergreality.in> domain name.

- 10B In the matter of Northwest Airlines, Inc. v. Mario Koch NAF Case "it was held that bad faith is found if it is unlikely that the registrant would have selected the domain name without knowing the reputation of the well known trade mark in question".
- 10C In the matter of Educational Testing Service v. Atak Teknoloji Ltd. Sti, WIPO Case No. D.2010-0479, "the Panel also recognized the notoriety of the complainant's trademarks and it believed that Respondent must have known of the complainant's trade mark TOEFL when registering the disputed domain names". The complainant has established substantial reputation in the mark BLOOMBERG and as such the consumers and public in general is invariably likely to associate the use and application of the word Bloomberg with complainant's corporate identity, business and various financial services.
- 10D In the matter of ITC Ltd. V. Travel India Case No. L-2/5/R4 it was held that "Registration of a domain name with actual knowledge of a trade mark holder's rights in a mark is strong evidence that the domain name was registered in bad faith".
- 10E The respondent is not using the domain name <Bloomreality.in> for any apparent purpose. It is, therefore, inconceivable that respondent would adopt the expression Bloomberg for any purpose other than to steal complainants identify and earn illegal benefits from the tremendous reputation and goodwill of complainant worldwide. In HSBC Holdings plc v. Hooman Esmail Zadeh Case No. L-2/5/R2, it was held that "non-use and passive holding are evidence of bad-faith registration".



- 10F In light of the international fame and wide use of complainant's mark BLOOMBERG, it is hard to believe that respondent did not know about the complainant's mark, brand name and its substantial accompanying goodwill. In *Barney's Inc. v. B N Y Bulletin Board*, WIPO Case No.D-2000/0059, and it was held that "the registration of a domain name containing a famous mark is strong evidence of bad faith."
- 10G The disputed domain name was created on 25.06.2011. The complainant assertion that respondent had acquired and held the domain name by proxy and has not, to date, made any meaningful use of the same has not been rebutted by the respondent by any evidence. If respondent had a bona fide reason or intention for registering the said domain name, he would have proceeded to host a proper and relevant website with the domain name. the fact that respondent has chosen not to do so proves respondent's wrongful intention to misappropriate complainant's trade mark and brand for fraudulent purposes.
- 10H The respondent's bad faith in obtaining registration of several Bloomberg domain names, for no apparent purpose, is clear indication that respondent is harbouring plans for illegal gains, either from complainant or its competitors.
- 10I The respondents contend that they have not registered the domain names in bad faith. The respondents have been actively conducting the business using the website of the domain names since 2010. As a result of respondent's hard work and intelligence, the business conducted by the respondents under the name Bloomberg has been successful. For the said reasons, it cannot be concluded that the respondent's domain names were registered in bad faith and to take



advantage of name and reputation enjoyed by the complainant by using the mark 'Bloomberg'. The respondent has a legitimate interest over the name Bloomberg for conducting business and also developing houses, residential townships, hospitals, hotels and various commercial projects in metros and business centres in India.

- 10J The respondents acknowledged the fact that the complainant is a huge business establishment providing varied service for their offices worldwide. Any user / customer of the complainant can contact or avail these services from any of the complainant's office located globally. On the other hand the respondents have clearly identified themselves as one of the service providers who are into different avenues of realty business and also developing house, residential townships, hospitals, hotels and various commercial projects in metros and business centres of India. The contention of the respondents that they and complainant deal with completely different type of goods and services and thus eliminating any possibilities of confusion amongst current and prospective customers or in the minds of the public is equally untenable in law. The goods or services being different are not the criteria to decide the question of Bad Faith. A well known mark, if adopted by a rival trader in respect of different description of goods or services, is not an answer to the question as to how such person hit upon the well known mark particularly when such mark is not a commonly used mark or word in ordinary parlance. The adoptions of such mark by a rival trader is dishonest and in bad faith at the inception itself. Ref. Whirlpool Corp. V. N.R. Dongre 1998 PTC 77. The contact details provided by the respondents on their website, mentioning the address of the respondents, contact numbers of the respondents in India, contact



email address, being different from that of complainants is also no legal consequences so far the issue of Bad faith is concerned.

- 10K The respondent's contentions that there is no evidence that it registered the disputed domain name in bad faith because there is no "history or pattern of misuse of any domain names by respondent is equally devoid of any merit. In fact, respondent has shown such a pattern by registering several domain names using complainant's registered and well-known trade mark. In the matter of BIC Deutschland GmbH & Co. KG v. Paul Tweed, WIPO Decision D2000-0418 it was held that "Multiple registrations coupled with the non-use of domain names is sufficient evidence of bad faith."
- 10L The proposition relied upon by the respondent, in the matter of Physik Instrumente GmbH & Co. v. Stefan Kerner and Magic Moments Design Ltd. (WIPO Decision D2000-1001) for the proposition that "the geographical area and the field of services play a major role in determining the bad faith" is also misplaced. The Physik Instrumente panel held that the British Respondent could not have engaged in bad faith because, prior to purchasing the disputed domain name, it had never heard of the complainant which was a small German measurement equipment company. In the present proceeding, respondent has not alleged that, when it formed its company in 2010, it was unaware of complainant's mark and, instead, acknowledges complainant's domain market position.
- 10M The Panel concludes that since the respondent has not placed on record any document to show that the respondent has been carrying on its business activities before he has been actual put on notice by the complainant for infringement and passing off its trade mark



BLOOMBERG, the plaintiff is successful in proving the third element of INDRP.

11. **DECISION:**

For the forgoing reasons, the impugned domain name <Bloombergreality.in> is ordered to be transferred to the complainant in terms of the prayer made in the complaint.



AMARJIT SINGH
Sole Arbitrator

Dated: 20th February, 2014