



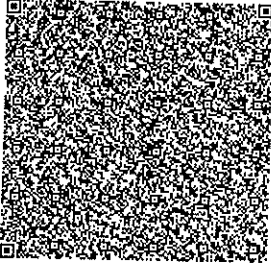
सत्यमेव जयते

INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No.	: IN-DL88181376702787N
Certificate Issued Date	: 02-Dec-2015 12:27 PM
Account Reference	: IMPACC (SH)/ dlshimp17/ HIGH COURT/ DL-DLH
Unique Doc. Reference	: SUBIN-DLDSLHIMP1774419973292724N
Purchased by	: SUDARSHAN KUMAR BANSAL
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: SUDARSHAN KUMAR BANSAL
Second Party	: Not Applicable
Stamp Duty Paid By	: SUDARSHAN KUMAR BANSAL
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



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

IN.Registry
(National Internet Exchange of India)

COMPLAINANT
Girnar Software Pvt. Ltd.,

Vs.

RESPONDENT
Manisha Enterprises

ARBITRATION AWARD

Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shcilestamp.com". Any discrepancy in the details on this Certificate and as available on the website renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

J.K. B...

INDRP ARBITRATION
THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR : SUDARSHAN KUMAR BANSAL

COMPLAINANT

Girnar Software Pvt. Ltd.,
"Girnar", 21 Govind Marg,
Moti Doongari Road
Dharam Singh Circle,
Jaipur – 302 004

Vs.

RESPONDENT

Manisha Enterprises
17 Sunlight,
Irvine, California – 92603,
U.S.A.

Present : Ms. Natasha Bopaiah, Advocate for the Complainant

Mr. Ashok Kumar Singh Sr. Advocate instructed by and with
Mr. Sonal Kumar Singh & Ms. Nikita Batra, Advocates for the
Respondent

ARBITRATION AWARD

The Complainant Girnar Software Pvt. Ltd., is aggrieved by the Respondent's registration of the domain name www.gaadi.in registered through the sponsoring Registrar "IN Registrar d.b.a. inregistrar.com (R123-AFIN)" has accordingly made a complaint before the .IN Registry C/o National Internet Exchange of India in accordance with the .IN Domain Name Dispute Resolution Policy approved by the Internet Corporation for assigned Names and Numbers and .IN Domain Name Dispute Resolution Policy.

J.K. Bansal

1. The case of the Complainant on the basis of which the complaint has been preferred, in gist, is as under :-

1.1 The complainant claims itself to be a Company incorporated under the Companies Act, 1956 and claims proprietary rights in its domain name www.gaadi.com with word "Gaadi" as its important and memorable feature under which it is providing various online services pertaining to the sale and purchase of Cars and information relating thereto encompassing inter alia, a data base of Cars in categories ranging from new launches to upcoming models, from brand names to body types, from price ranges to popular choices, providing visitors with car reviews and e-commerce services to help them reach out to the automobile dealers, and e-store for automobile accessories like car perfumes, sun films, stickers, floor mats, polish, shampoo etc., automobile finance for those who want to buy a car, car insurance and a platform for the sale and purchase of used car, being used by it continuously since October 2008 and claims it's said domain name to be identified with it and its said services.

1.2 According to the complainant, its said website is one of India's leading search and comparison website and is one of the several similar features of the complainant under its various brands/websites bearing the word/trademark viz. – CarDekho; PriceDekho; BikeDekho; and MobileDekho, and claims that its domain name enjoys distinctiveness, popularity, secondary significance, public awareness and goodwill and reputation in the market and trade duly distinguishing the complainant's services with that of the complainant and from the complainant's source and origin alone and which enjoys continuous, commercial use, accessible world over. The claimant claims to have received various prestigious awards and recognitions and to have participated in various events and to have served as many as 165 million visitors over its lifetime and claims to have over 5 lakh registered users till date. The claimant claims to have filed for registrations of its domain name under the Trade Marks Act, 1999.

J. K. Dhanraj

1.3 The claimant claims to have acquired the brand/domain name Gaadi.com on 30th September 2014 from M/s Ibibo and under the brand name CarDekho for a sum of approximately USD 11 million and by virtue of which it is undisputed leader of the Indian automotive portals and which in combination with the business carried out under the domain name CarDekho.com exceeds 15 million monthly visitors.

1.4 According to the complainant, a bare search of the word 'Gaadi' on any popular search engine would inevitably lead to the complainant. Its domain name Gaadi.com has created for its substantial brand value and generated immense goodwill and in which the claimant has rights and interests. According to the complainant any rival use of same/similar domain name by a third party without its permission would invariably dilute or violate the complainant's proprietary rights and distinctive character of its said domain name causing to it immense loss and injury besides causing deception and confusion in the market and trade and all being an actionable wrong.

1.5 The complainant is aggrieved by the respondent's adoption and use of the rival domain name www.gaadi.in, which bears the word/trademark 'Gaadi' as its essential feature and which according to the complainant, the respondent is using for the same/similar services as those of his and that too without its leave and license, and which is in bad faith without justification and thereby not only deception and confusion is being caused in the market and trade, which is being mislead into believing the respondent and its services to be related/associated/affiliated/sponsored with the complainant causing to the complainant loss and injury but also which would invariably tarnish the reputation and good name achieved by the complainant by its hard work and business acumen.

J. K. Sharma

1.6 Being aggrieved by the respondent's adoption and use, the complainant through counsel claims to have served a cease and desist notice dated 17.04.2015 calling upon the respondent to, inter alia, cease and desist from using the impugned domain name which was replied to by the respondent through its counsel's letter dated 14.05.2015. According to the complainant, the said reply contained bald and unsubstantiated allegations and thereafter the respondent with a view to wriggle out of its liability changed the layout and get up of its web pages on its domain name. According to the complainant, nevertheless the respondent's web pages and the layout, get up and structure of its website under the impugned domain name continue to highlight its impugned domain name and prominently the services offered therein.

1.7 The complainant also alleges the traffic on the respondent's website to be extremely low and consequently difficult to track its activities and the respondent to be making all false claims in connection with the extent and quality of its business.

1.8 The complainant claims to have responded by way of reply/response dated 1/07/2015 through its counsel to the respondent's reply dated 14/05/2015 wherein it claims to have refuted the respondent's claims and reiterated its rights, goodwill and popularity including public recognition and valuable trade and extent of its business.

1.9 According to the complainant, the reply of the respondent to its legal notice, in fact, has substantiated the complainant's arguments itself.

1.10 The complainant claims the respondent to have no legitimate right, title and interest in its impugned trade name and which the respondent has malafide adopted to ride upon the complainant's goodwill and reputation. The respondent by its impugned domain name seeks to squat the same for illegal gains.

S.K. Banerjee

1.11 The complainant claims that it has rights, titles and interests in its said domain name even though it may have been acquired by way of assignment/sale/purchase and which does not in any way affect its goodwill, value or market recall.

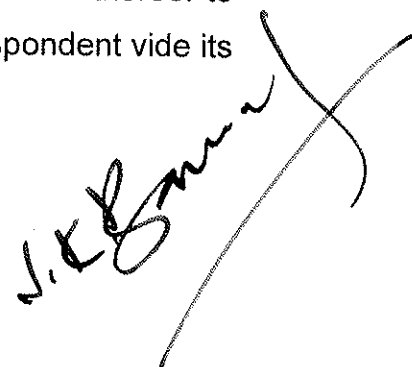
1.12 The complainant claims to have initiated proceedings for protection of its various other domain name and logo viz. www.pricedekho.co.in; www.cardekho.co.in; www.bikedekho.co.in; and www.bikedekho.in against rival confusingly or deceptively similar domain names and which complaints have been upheld by various Arbitrators and whereby the rival respondents have been directed to transfer the rival and disputed names to the complainant.

1.13 The complainant finally claims that the disputed domain name and its adoption and use by the respondent is an actionable wrong, which could be remedied in accordance with the present complaint.

1.14 The complainant has filed the present complaint with the prayer that the impugned domain name registered with the respondent be transferred to the complainant with costs.

1.15 Alongwith the complaint the Complainant has filed the **Exhibits A to P2.**

2. The .IN Registry appointed me as Arbitrator to adjudicate the complaint in accordance with the Arbitration & Conciliation Act, 1996; .IN Domain Name Dispute Resolution Policy; Rules or procedures and/or bye laws Rules and guidelines made therein and notified the factum thereof to the Complainant (through his counsel) as well as to the Respondent vide its email on 21.09.2015.



3. On being put to notice along with the complete set of the complaint paper book vide notice dated 24.09.2015, the respondent contested the complaint by filing its Reply/Written Statement along with documents filed as **Annexures I to 6 (colly)** thereto.

4. In its Reply/Written Statement, the respondent –

4.1 Has claimed its own rights in the disputed domain name viz. www.gaadi.in and claims to have registered and actively used the same since the year 2012 in relation to its following business/services:-

(a) An informative directory and car rental meta-search engine allowing shoppers and travelers to easily find auto providers in India and car rental companies online and which is geared towards the automotive market of empowering consumers looking for car deals to make educated buying decisions through trustworthy merchants and which encompasses providing comparison between services and prices etc. of different car portals to enable the customers to make an informed decision.

4.2 The Respondent set out its career trajectory and background and his involvement with some other car portals and businesses under the name Price.com and BestDeal.com.

4.3 In contest of the Complaint, the Respondent has also raised the following averments:-

(i) That the word/mark "Gaadi" is generic and descriptive and consequently the complainant has no right and claims thereon and consequently no cause of action can be based by the complainant.

J.K. Banerjee

- (ii) That in any case, the complainant has failed to prove or show that the mark gaadi.com has attained any secondary meaning.
- (iii) The respondent's domain name is neither identical, nor confusingly similar to the subject matter name/mark of the complainant as also the respondent's services being different and distinct from those alleged by the complainant to be theirs and that there is no scope of any consumer deception.
- (iv) The complainant has failed to show that the respondent has no rights or legitimate interests in respect of the disputed domain name.
- (v) The respondent's adoption and use is bonafide and preceded with several preparations.
- (vi) The respondent is making a legitimate non-commercial fair use of its domain name without intent for commercial gain or mislead/divert customers or tarnish the trade marks at issue.
- (vii) The respondent's adoption, use and registration is not in bad faith and nor for the purposes of selling, renting or otherwise transferring the domain name or its registration to the complainant.
- (viii) The respondent has neither registered the domain name in order to prevent the owner of the trademark/service mark from reflecting the mark in a corresponding domain name and neither is the respondent engaged in any such conduct.
- (ix) The respondent has not intentionally attempted to attract internet users to its website or other online locations by creating a likelihood of confusion with the complainant's name and the mark as to the

S.K. Bannu

source, sponsorship, affiliation or endorsement with that of the complainant.

- (x) The complainant is guilty of acquiescence and has not approached the Tribunal with clean hands.
- (xi) The trademark registrations filed by the complainant are recent and have not even been advertised in the Trade Marks Journal and mere filing for trademarks do not give any legitimate right to the complainant in the trademarks involved.

5. The complainant was duly notified and serviced with the respondent's reply/written statement and documents vide notice dated 20.10.2015 and wherein the complainant was given an opportunity to file his rejoinder in response to the respondent's reply and documents. Thereafter the complainant filed a rejoinder along with documents being Annexures A to D thereto. In the rejoinder, the complainant disputed the claims, rights and objections raised by the respondent and reiterated its complaint allegations.

6. The Exhibits/documents filed by the parties would be dealt with in the course of the award.

7. Considering the voluminous pleadings, documents, rival contentions and the matter being highly contested and contentious, a hearing was granted to the parties by this Arbitral Tribunal vide notice dated 31.10.2015 served upon both the parties. Under the said notice, the rejoinder along with documents filed by the complainant was also served upon the respondent through counsel. Both the parties availed of the hearing and appeared before this Arbitral Tribunal on 25.11.2015 through their respective counsels and made submissions in support of their respective case and in contest of the others.

J.K. Bhandari

8. Accordingly I proceed to adjudicate this complaint.

9. In order to determine whether the said word/mark gaadi can be a subject of protection it is necessary to determine the placement of the said word/mark on the spectrum of marks viz. whether it is arbitrary or fanciful, generic, descriptive, suggestive and each to be considered in relation to the service/business involved. **[See The Forum Corporation of North America Vs. The Forum, Ltd., 903 F.2D 434 : 14 USPQ.2d 1950]**

9.1 The complainant's nature of business in relation to which it claims to be using its said word/mark has already been noticed above and which is of providing various services relating to motor vehicles on the online market place.

9.2 It is well accepted that the word/mark "gaadi" is a word of common usage in the Hindi language meaning and signifying a motor car or a motor vehicle.

9.3 In relation to these services of the complainant the said word/mark gaadi can by no stretch of imagination be considered to be arbitrary or fanciful as arbitrary or fanciful words must have no association or connection with the service or trade involved. **[See McCarthy on Trade Marks and Unfair Competition, 3rd Edition, Vol.1, Chapter 11, Para 11.04].**

9.4 The line dividing generic, descriptive or suggestive marks can be extremely thin and fine. However, it is imperative and that such a demarcation be made as it has crucial bearing on the protection to be accorded to the mark involved and to the nature of evidence required towards the same. This is so as generic trade marks can receive no trade mark protection even if the consumers connect the mark with the product

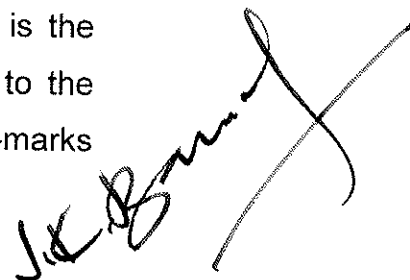
J.K. Bann

and such marks are free for all to use. Descriptive trade marks can be protected only on their acquisition of secondary significance or attained distinctiveness. In contrast suggestive trade marks are accorded the same protection as arbitrary/fanciful trade mark and can be protected even without the necessity of establishing any secondary significance or acquired distinctiveness **[See McCarthy on Trade Marks and Unfair Competition, 3rd Edition, Vol.1, Chapter 11, Para 11.06, Chapter 12, Para 12.05].**

9.5 In my considered view the said word/mark cannot be considered to be generic as the said word/mark does not name the services involved and nor does it serve to denominate a type, kind, genus or a sub category of the services involved **[See Forum Corporation Case, supra].** The complainants services are not referred to or named as "gaadi" or "car" even though they may be related thereto. Consequently it can safely be held that the said word/mark is not generic.

9.6 To be characterized as "descriptive" the word/mark involved must directly give some reasonable accurate or tolerably distinct knowledge or convey information of the characteristic of the service involved. The test to determine whether the words are descriptive has been laid down in **Corpus Juris Se-cundum, Vol. 87 in paras 34 and 35, at page 271,** as follows:-

"The true test in determining whether a particular name or phrase is descriptive is whether, as it is commonly used, it is reasonably indicative and descriptive of the thing intended. In order to be descriptive within the condemnation of the rule, it is sufficient if information is afforded as to the general nature or character of the article and it is not necessary that the words or marks used shall comprise a clear, complete and accurate description. The meaning which should be given is the impression and significance which are conveyed to the public. Whether words or marks claimed as trade-marks



are descriptive or whether they are suggestive or arbitrary and fanciful manner must be decided with respect to the articles to which they are applied and the mark must be considered as a whole.

An exclusive trade-mark must consist of some arbitrary or fanciful term, figure, or device, and words or phrases, in order to constitute a trade-mark, must be used in a purely arbitrary or fanciful when they do not, by their usual and ordinary meaning, denote or describe products to which they are applied, but rather come to indicate their purposes by application and association".

9.7 There can be no doubt on the fact that the services being commercially dealt with by the complainant under the word/mark gaadi pertain to cars and vehicles and services in relation thereto which include data base for cars, new launches, e-commerce services, e-store services, finance insurance, platform for sale and purchase etc., all relating to cars and vehicles. The general nature, character, attributes of the car services is afforded to the consumer and/or is reflected in the consumer mind by the word/mark "gaadi" and/or to avail of these services with reference to the said word/mark and which word/mark enables him to identify these services immediately, forth with, spontaneously with no element of mature thought or following a multi stage reasoning process **[See Rodeo Collection Ltd., Vs. West Seventh, 812 F.2d 1215, 2 USPQ2d 1204].**

9.8 A work/mark is suggestive if it requires imagination, thought, reasoning process and perception to reach a conclusion as to the nature of the services involved while in the case of descriptive trade mark to reach such a conclusion is immediate and instant **[Stix Products, Inc., Vs. United Merchants & Mfrs., Inc., 295 F. Supp. 479 : 160 USPQ 777 (S.D.N.Y. 1968)]**. While the basic difference between a descriptive mark and a generic mark is that a descriptive mark describes the services/goods

J.K. Bhatnagar

while a generic mark names the particular service/goods involved. [See McCarthy on Trade Marks and Unfair Competition, 3rd Edition, Vol.1, Chapter 11, Para 11.21]

9.9 Whether a particular word/mark is distinctive is a question of fact to be determined in the facts and circumstances of each case. The word/mark "Naukri" meaning job in Hindi was held descriptive in relation to employment services, [Info Edge (India) Vs. Shailesh Gupta (ILR (2002) 1 Del 220)]; the word "kabadibazaar" being a combination of two words viz "kabadi" meaning a person who buys second hand goods and "bazaar" meaning a market held descriptive in relation to services for buying and selling of second hand goods – [Manish Vij and Ors., Vs Indra Chugh and Ors – reported in AIR 2002 Delhi 243].

9.10 Consequently I have no hesitation in holding the word/mark gaadi to be descriptive in relation to the services involved and to it being neither arbitrary or fanciful nor generic nor suggestive in relation thereto.

10. It is now settled law that the descriptive words/marks can be protected only on their acquisition of secondary significance for the consuming public [Info Edge (India) case, supra ; Manish Vij case, supra; Yahoo!, Inc., Versus Akash Arora & Anr (1999) 19 PTC 201].

10.1 "Secondary meaning" have been aptly defined in the case of Charcoal Steak House, Inc., Vs. Staley, 263 N.C. 199, 139 S.E.2nd 185, 144 USPQ 241 (1964) as

"When a particular business has used words publici juris for so long or so exclusively or when it has promoted its product to such an extent that the words do not register their literal meaning on the public mind but are instantly associated with

J. L. Bhandari

one enterprise, such words have attained a secondary meaning. That is to say, a secondary meaning exists when in addition to their literal, or dictionary meaning, words connote to the public a product from a *unique source*".

11. **McCarthy on Trade Marks and Unfair Competition, 3rd Edition, Vol.2, Chapter 15, Para 15.10** has stated that there is no generalized rule as to the amount of distinctiveness necessary to achieve secondary meaning of a mark or by which it can be enunciated or determined where a word acquires distinctiveness and function as a trade mark indicating a particular producer or source of origin. The proof of secondary significance can be established by either direct evidence or circumstantial evidence.

11.1 Direct evidence could include the actual testimony of the consumers as to their state of mind while circumstantial evidence can be established by exclusivity, length and manner of use ; amount and manner of advertising ; amount of sales and number of customers ; established place in the market; proof of intentional copying. The quantum of proof required is not proof beyond reasonable doubt. It is sufficient if there is a pre-ponderance of probabilities **[Ajit Singh Vs. Charan Singh – reported in AIR 1974 P&H 116].**

11.2 Whether a particular descriptive word/mark has attained secondary significance and consequently be protected is a question of fact to be determined from the peculiar facts of the each case and from the relevant evidence probative of probable customer reaction **[See National Shoe Stores Co., Vs. National Shoes of New York, Inc., 113 USPQ 380 (1957)].** The onus and burden of proof being upon the Complaint. **In Info Edge (India) case, supra** the descriptive word/mark "Naukri" was protected having attained secondary significance while in the case of **Manish Vij**

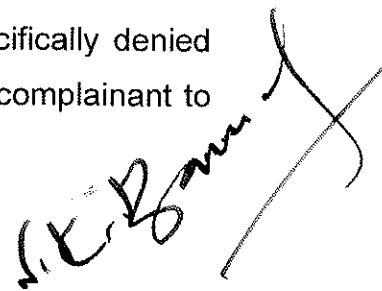
S.K. Bhatnagar

case, supra the descriptive word/mark "Kabadi Bazar" was held to have not attained secondary significance and consequently was not protected.

12. In the light of the aforesaid parameters my analysis of the evidence filed by the complainant and findings thereon is as under :-

12.1 The complainant claims to have been using its said word/mark gaadi.com since the year October, 2008 and to have acquired it in the year September, 2014 for approximately USD 11 million (para 10 and 14 of the complaint). Similar allegations have also been made by it in its cease and desist notice dated 18.04.2015 (filed as **Exhibit K2** by the complainant) served upon the respondent. Neither of these two facts of use since 2008 or of acquisition in 2014 for a sum of USD 11 million have been specifically denied to by the Respondent either in its Reply/Written Statement to the complaint or its reply dated 14.05.2015 (filed as **Exhibit N** by the complainant) to the Legal Notice. All that the respondent has stated in its respective Reply/Written Statement and reply to Legal Notice is that there is a contradiction between the averments made by the complainant of its use since the year 2008 and on its claimed use since 2014 pursuant to the acquisition (Para 10 page 36 of the Reply/Written Statement and para 2 & 3 internal page 3 of the reply dated 14.05.2015 – **Exhibit N**). The complainant in its rejoinder to both the Reply/Written Statement and to the legal notice (**Exhibit P-1** filed by the complainant) has clarified that there is no contradiction the only difference being that since the acquisition the word/mark gaadi.com now belongs to the complainant instead of Ibibo from whom it was acquired and merely because the ownership has changed hands did not effect the value, goodwill or market recall thereof. Thus it can be taken that the complainant has claimed the predecessor ship-in-title involved.

12.2 Despite due opportunity the respondent has not specifically denied the aforesaid two facts and only disputed the claims of the complainant to

Handwritten signature and initials, possibly "S.K. B. B. B.", written in black ink.

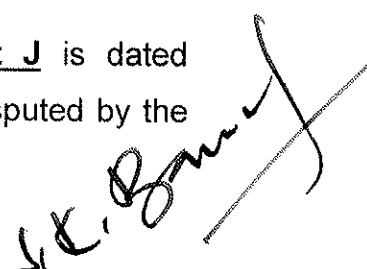
become an undisputed leader of the Indian Automotive Portals by virtue of such acquisition.

12.3 According to the complainant the factum of the acquisition had been widely reported upon by the press and media and the complainant has filed on record as **Exhibit F1 and F2** being internet downloads of the newspaper report on the Time of India newspaper dated 30.09.2014 and from the newspaper Business Standard also dated 30.09.2014.

12.4 Even at the time of arguments the Ld. Counsel for the Respondent did not dispute the complainant's use or factum of acquisition but only disputed its effect. Such non traverse and that to on such an important aspect and despite an opportunity can be held to an admission and can be so acted upon **[Uttam Singh Dugal & Company Limited V/s Union Bank of India & Ors – reported in AIR 2000 SC 2740]**

12.5 The complainant has filed as **Exhibit J** being a screenshot taken from the web page of the respondent itself under the disputed domain name wherein the Respondent itself had placed on its website the complainant's domain name which could be reached to by the consumers from the respondents website itself. The respondents business as per its own allegations is to empower consumers looking for car deals to make educated buying decisions through trust worthy merchants and that the respondent has listed the names and links of the leading car rentals and related services on its website [para 9 page 4 of the respondents reply/written statement]. One such link provided by the respondent is of the complainant itself under the domain name gaadi.com. The factum of the respondents said snapshot has been mentioned/reproduced in the legal notice **[Exhibit K2]** and in the complaint at para 20.

12.6 According to the complainant this snapshot **Exhibit J** is dated 16.04.2015 and the factum of this **Exhibit J** has not been disputed by the



respondent itself. It is the case of the complainant that after the legal notice Exhibit K2 the respondent removed the said snapshot and also changed the lay out and its get up of its web pages.

12.7 Reading the respondents own averments in para 9 of its reply/written statement and Exhibit J clearly shows that the respondent himself had acknowledged and endorsed the complainant's said domain name and the complainants business there under as it is his own case that it provides names and links of "leading" car rental and related service providers on its website. Obviously the complainant must have had some business standing, goodwill and reputation for the respondent to deem it fit to direct its customers to the complainant from its (respondent) own website in the course of its (respondents) own business. The respondent would not like to loose business by directing traffic to an unmeritorious business. The said acts on the part of the respondent itself shows its own state of mind, and as held by Lord Justice Bowen's famous definition that, "The state of a man's mind is as much a fact as the state of his digestion". [Edgerton v. Fitzmaurice, L. Rev. 29 Ch. Div. 459 (Eng. 1885)], and has to be taken against his own stand.

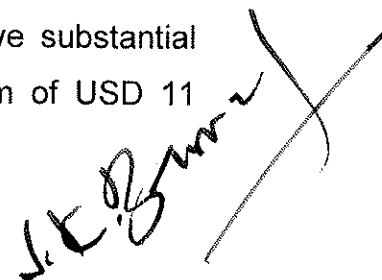
12.8 The complainant in its Exhibit B1 and B2 to the complaint and Annexure-A to its rejoinder has placed on record internet downloads being articles published on the websites www.moneycontrol.com , www.speakbindas.com and http://yourstory.com respectively highlighting the complainants activities under the said domain name as also reporting upon its success and standing. These exhibits are of the year 2013 and 2014 respectively. These articles are with reference to the domain name gaadi.com and with reference to which the online platform for car service has been highlighted. The complainant has placed on record as Exhibit B3 to B9, Exhibit-H being internet downloads taken from its own website bringing out various facets of its said services and on which downloads its domain name has been clearly highlighted. The complainant has placed on

S. K. Bhowmik

record **Exhibit C1 to C4** highlighting the various prestigious awards won by it and events in which it has participated. The said awards and events and as pleaded in the complaint are Limca record (maximum fuel economy in a car in India); Guinness record (longest journey in a single country in same car); Mahindra off-road challenge trophy (winner 2013); Wat Awards for classified site of the year and TharCRDe 4x4 Mahindra Adventure The Great off-road Media Challenge of 2013.

12.9 The complainants documents at **Exhibit D & E** are its analytical data obtained from its own computer system showing it been visited by 165 million visitors and having over 5 lakh registered users respectively. The period covered by this analytical data is January 1, 2008 – July 31, 2013 and August 1, 2013 – August 31, 2015. **Exhibit-I** is the print out of the search report on the search engine 'google' with reference to the word gaadi.

13. All the aforesaid evidence does establish that the complainant and its business under its said domain name was in the commercial and open online market accessible to all and sundry including the peculiar market at hand and had been well reported about and had attracted press and media attention. Undoubtedly the complainant website under its said domain name had worldwide access and reach. The market and trade was aware of the complainant and its activity under its said domain name and did business with the complainant. The press and media had reported widely on the complainant with reference to its domain name. The reports as per **Exhibit B1** and press report as per **Exhibit F1 and F2** have mentioned of the unique position likely to be obtained by the complainant on the acquisition of the domain name in the online market and market share in relation to the services involved and even recommended the complainants businesses. The fact that the complainant had paid USD 11 million for acquiring the domain name does establish the said domain name to have substantial value standing and distinctiveness in the market. The sum of USD 11

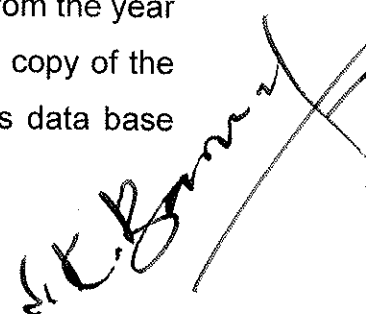


million by no means can be considered to be a small amount. It is preposterous to assume that any business would pay such a heavy amount of money for a mark that was of no and/or of meager value. The fact that the respondent itself have endorsed and acknowledged the complainants business also establishes the goodwill and reputation of the complainant and brings out the respondents own state of mind. The respondent even never disputed the complainant or its predecessor use in the year 2008. The Complainant has substantial traffic (visitors and users) on its website under the said domain name and even if the figures mentioned may not be accurate or demarcated from the Complainant other domains.

13.1 The aforesaid facts clearly show that the word/mark "gaadi" is a source indicator for the complainants services and associated with the complainant and the complainant was referred to and identified by its said domain name. The complainants said domain is identified with its services and has gain public recognition [Carter-Wallace, Inc. Vs. Procter & Gamble Co., 434 F.2d 794, 167 USPQ 713 (9th Cir. 1970)]. The complainant has sufficient market presence and visibility and all the aforesaid factors are a clear attribute of the good name, reputation and connection of a business enjoyed by the complainant [The Commissioner of the Inland Revenue Vs. Miller & Co.'s Margarin'e Ltd., (1901) A.C. 217].

14. Consequently it can be safely held that the complainants said word/mark gaadi.com has achieved secondary significance, goodwill and reputation and duly established by direct as well as circumstantial evidence.

15. The respondent in its Reply/Written Statement at para 1 page 1 itself therein has categorically stated that the domain name www.gaadi.in has been registered and is being actively used by the Respondent from the year 2012. The complainant in its Exhibit A has placed on record a copy of the print out of the data base search from the IN Registry's Whois data base

A handwritten signature, possibly "S.K. Bhandari", is written in the bottom right corner of the page. A large, bold 'X' is drawn over the signature and extends across the right margin.

conducted on 19.08.2015. In view of the respondents categorical statement of claimed use since 2012 the respondents claims have to be adjudicated with reference to such a year.

15.1 The respondent in support of its claimed rights and use and/or preparatory use since the year 2012 filed documents being **Annexure-1 to Annexure-6 Colly**. An analysis of these documents/annexures would show that only one document being **Annexure-1** refers to the respondent under the disputed/impugned domain name gaadi.in. This document is dated 7th and 8th August, 2015 and is only an invite to be a guest of honour and speaker at a conference in Bangalore. None of the other documents even remotely reflect or bring out the respondent's alleged usage of the impugned domain name. **Annexure-2 (colly)** are copies of few designs of .in T-shirts of the respondent ; **Annexure A-3** are screenshots showing the revenue generated by the Respondent from an affiliate network ; **Annexure-4 (colly)** are copies of E-mails exchanged by the respondent with various companies in the automobile sector from the year 2009 ; **Annexure-5** is a copy of a programme of an affiliated business while **Annexure-6 (Colly)** are certain applications filed by the complainant in the Trade Mark Registry. Out of these documents only **Annexure-1** pertains or refers to the disputed domain name. Even this document as noticed above is only an invite and is of the year August, 2015 and that too after the exchange of legal notices between the parties. **Annexure-6 (Colly)** pertains to the complainant itself. In none of the other Annexures being **Annexure 2 to 5 (all Colly)** even remotely have any reference to the impugned domain name. This was also so acknowledged to by the Ld. Counsel for the Respondent at the time of hearing. The complainant on its part had placed on record **Exhibit J** being a snapshot from the web page of the respondent under the impugned domain name. This exhibit is of the year April, 2015 as per the complaint allegations.

N. K. Banerjee

16. Consequently and in light of the aforesaid it can safely be taken that no evidence of any worth has been filed by the Respondent in support of its claimed use or preparatory use since the year 2012 till at least the year mid 2015.

17. In view of the aforesaid it can safely be held that the complainant has proprietary and enforceable rights in its said word/mark and which word/mark has attained distinctiveness, secondary significance, goodwill and reputation with the complainant and of which the complainant is the prior user.

18. In my considered view there is complete identity between the rival and competing domain names viz www.gaadi.com of the complainant and www.gaadi.in of the respondent. The word/mark "gaadi" is the prominent memorable and distinguishable feature in both the rival domains and which would be remembered by an average consumer exercising average caution and with reference to which the average consumer would access the websites of the complainant and the respondent and do business with it. No prefix or suffix is attached to the word/mark gaadi in either of the competing domain names and in which the word/mark gaadi is a standalone constituent.

18.1 The respondent's claims on the nuisances and difference between ccTLD (country code top-level domain) ".in" and gTLD (generic top level domain) ".com" to obviate deceptive similarity is highly misplaced as it cannot be taken for sure that an average internet user of average intelligence seeking to access the rival services would be knowledgeable enough to know such fine and technical nuisances and differences. The internet user seeking to avail the services in question by erroneously or inadvertently typing on the keyboard the ccTLD .in alongwith the "second level" domain name viz. gaadi instead of the gTLD (generic top-level domain) .com would easily be led to the Respondent's website.

J.K. Brown

18.2 The respondents claims of different art works and features attached to the representation of its domain name in its trade literatures and the ability of such art works to distinguish its impugned domain name from that of the complainant is equally misplaced. As noticed above the word/mark "gaadi" is the dominant feature of the competing domains and which would be retained in the public/consumer mind. There is complete similarity between the word/mark gaadi in both the domains. Mere difference in art forms cannot obviate deceptive similarity specially where there is a complete identity in the phonetics, structure, conception and aura of the competing marks [K.R. Chinna Krishna Chettiar Vs. Sri Ambal and Co and Anr. AIR 1970 SC 146 ; Hitachi Ltd., Vs. Ajay Kr. Agarwal & Ors 1996 (16) PTC 262 (Del) (DB) ; Kirorimal Kashiram Marketing & Agencies Pvt. Ltd., Vs. Shree Sita Chawal Udyog Mill Tolly Vill 2010 (44) PTC 293 (Del.) (DB)]. The rival websites would be accessed by simply typing the word/mark gaadi on the keyboard and which would be in the normal font (without art works) available on a normal keyboard. No element of art work would be involved in such typing or access.

19. In my considered view the nature/services being dealt with by the respondent are same/similar/allied to those of the complainant. The services of the complainant pertains to cars and vehicles and services in relation thereto which include data base for cars, new launches, e-commerce services, e-store services, finance insurance, platform for sale and purchase etc., all relating to cars and vehicles. The respondents services in respect of which it claims to be using its disputed domain name are of providing of an informative directory and car rental meta search engine allowing shoppers and travelers to easily find auto providers in India and car rental company online and of empowering consumers looking for car deals to make educated buying decisions through trustworthy merchants and providing comparisons between services and prices etc., of different car portals to make informed decisions. It would immediately be

S. K. Bannu

noticed that both the competing services relate to cars and automobiles and to making intelligent choices in relation thereto.

19.1. The respondent as per its own case also provides links of leading car rental and related service providers on its website. One such link provided by it is of the complainant itself (as per **Exhibit J**). Obviously the complainants services are covered or offered by the Respondent himself. Thus a trade connection exists between the complainant and respondent under the respective services. **[Corn Products Refining Co. Vs. Shangrila Food Products Ltd., AIR 1960 SC 142]**

19.2 An average consumer is not expected to know the fine engineering differences between the rival services involved and the test is the mental perception of the consumer. Consumer deception and confusion can arise even in relation to different and non competing goods and services by use of same/similar marks. **[Mahendra & Mahendra Paper Mills Ltd., Versus Mahindra & Mahindra Ltd., AIR 2002 SC 117].**

20. The complainant has no hold or control over the respondent or over the quality of its services and would always suffer by any inferior services that may be offered by the respondent. Not only that any internet user who may erroneously access the respondent while intending to access the complainant can be led by the respondent to a competitor/rival of the complainant which would invariably cause business and clientele loss to the complainant and more so as the business of the respondent includes providing links on its website to leading businesses in the automobile field and in which field the complainant is in business. Consequently there is a complete chance, reasonable probability or likelihood of consumer deception and injury being caused to the complainant as well as to the public.

S.K. Banerjee

20.1 The Courts in India have repeatedly held that the test is a likelihood of consumer deception and actual consumer deception need not be established. [Ruston & Hornby Ltd., Vs. Zamindara Engineering Co., AIR 1970 SC 1649, Laxmikant V. Patel Vs. Chetanbhat Shah and Another AIR 2002 SC 275] Evidence of actual deception in the facts of this case can even be ruled out as, as noticed above the respondent alleged business since the year 2012 to at least the year mid 2015, when it was put to notice as per Exhibit K2 is not made out.

20.2 Even otherwise where there is a close similarity of the domain names it can also be presumed that the public is likely to be deceived for why else the respondent would choose such a deceptively similar domain name [Marks & Spencer Vs. One-In-A Million reported in 1998 FSR 265 and quoted in Info Edge (India) case, supra].

20.3 With such a high level of likelihood of deception and loss to the complainant the respondent allegations of its not preventing the complaint from using its domain name or attracting its internet users is of no consequence as invariably the complainant is likely to suffer due to the respondents impugned use.

21. In my considered opinion the respondents very adoption and alleged use of the impugned domain name and its registration is in bad faith actuated by malafide and there is no element of good faith or good intention or honesty involved and its claimed use cannot be construed to be fair.

21.1 The respondent claims itself to have an extra ordinary career trajectory and reputed background and recognized entrepreneurship exposition worldwide in the services being conducted by him. The respondents claims to be a global business and to have participated in noteworthy trade shows and to be a major proponent of the growing in space in the USA at Top level domain shows and to have founded and use

the domain name Price.com in the year 1998 being a first comparison shopping site and to have achieved immense popularity and market space thereunder. The respondent as per its own Annexure-3 & 4 Colly claims to have achieved revenue of the value of USD 6.8 million from one of its affiliate network and to have been in repeated correspondence with various companies in the automobile sector since 2009. The respondent has further claimed to have personally worked with automobile companies to promote their services.

21.2 The respondent himself provided a link to the consuming public to the complainant on its (respondent) own website under the impugned domain name as per Exhibit J. The link was provided with reference to the complainants subject matter domain name. The respondent has not even disputed the complainants acquisition for a sum of USD 11 million approx. and nor the complainants use through predecessors since 2008.

21.3 In such circumstances and with such experience, expertise and standing in the automobile sector it is inconceivable for the respondent to be not aware of the complainant or the complainant's predecessor, the complainant's usage and activities under the complainants said domain name or of the various press and media reports on the internet and other media pertaining to the complainant and its domain. Despite so the respondent deliberately adopted and allegedly started using the impugned identical with and deceptively similar domain name for the same/similar business as that of the complainant. On being put to notice by the complainant (Exhibit K2) the respondent removed Exhibit J from its website and instead uploaded a modified version which did not contain the complainants domain name or link to it and as per Exhibit O of the complaint. If indeed the respondent had any such bonafide rights or claims there would have been no occasion for it to have removed Exhibit J from its website. Obviously it was to the respondents own understanding that he was committing a wrong or a potential wrong. While considering the

J.K. Bann

concept of malafide the Hon'ble Supreme Court in its celebrated case of **Parbodh Sagar v/s The Punjab State Electricity Board and Ors reported in 2000 (5) JT 378 has held – "...** that the expression "malafide" is not a meaningless Jargon and it has its proper connotation. Malice or malafide can only be appreciated from the records of the case in the facts of each case. There cannot possibly be any set of guidelines in regard to the proof of malafides. Malafides, where it is alleged, depends upon its own facts and circumstances". "Intention" cannot be proved by direct evidence. It has to be inferred from the conduct and act of parties and the surrounding circumstances of the case **[Ajit Singh case, supra]**. In light of the aforesaid pronouncements it can be safely held that the concept of or what amounts to bad faith, malafide or dishonesty is not one that lends itself to a exhaustive definition and for the determination of which there can be no rigid strait jacket formula and nor prescribed hard and fast rules or set guidelines. They have to be judged with reference to the facts and circumstances of each case.

22. The respondent has not furnished any cogent explanation on its adoption of an identical prior trade mark/domain name. The respondents impugned conduct speaks for itself (res ipsa loquitur) and falls short of the standards of acceptable behavior. Obviously the motive of the respondent was to derive some benefit from the complainant's domain and the complainants business thereunder. Otherwise there would have been no occasion for the respondent to have not used the impugned domain name from the year 2012 when it claimed to have commenced its use till about the year mid – 2015 when it was put to legal notice.

23. The Hon'ble Delhi High Court in its celebrated decision of **M/s Hindustan Pencils Pvt. Ltd. v/s M/s India Stationary Products Company & Anr. Reported in 1989 PTC 61** affirmed the observation of Romer J, in the matter of an application brought by **J.R. Parkington and Coy. Ltd., 63 R.P.C. 171 at page 181** that "in my judgment, the

J.R. Parkington

circumstances which attend the adoption of a trademark in the first instance are of considerable importance when one comes to consider whether the use of that mark has or has not been a honest user. If the user in its inception was tainted it would be difficult in most cases to purify it subsequently". In the same judgment the Hon'ble High Court has held that if a party for no or apparent or valid reason adopts the mark of another business it can be assumed that such an adoption was not honest and the Court would be justified in concluding that the defendant/Respondent by such an act wanted to cash upon the name and reputation of the Complainant and which was the sole primary and real motive of the defendant/Respondent in so adopting such a mark. In the same judgment the Hon'ble Court further held that the violator business who uses or adopts someone else marks must be aware of the consequence which must follow. The Respondent cannot derive any benefit from its own wrongs.

24. Even otherwise lack of fraudulent intent or bonafide good faith **[Ruston Case, supra and Laxmikanth V. Patel case, supra]** is immaterial and that the respondent can be held liable despite it.

25. Consequently it can safely be held that the respondent has no rights or legitimate interest in the disputed domain name and which has been registered and/or is being used or intended to be so used in bad faith. In the absence of any honesty the respondent cannot even be entitled to the benefit of an honest concurrent use.

26. I now deal with the following submissions made by the Ld. Counsel for the respondent –

26.1 The Ld. Counsel for the respondents submitted that the policy .IN Domain Name Dispute Resolution Policy (INDRP) is a complete Policy which has to be stricto sensu construed and the case of the respective parties has to be mandatorily adjudicated within the four corners of this

S.K. Banerjee

Policy only. According to the Ld. Counsel for the Respondent it is mandatory for the complainant to establish all the three premises set out in Rule 4 of the Policy and the issue of use and bad faith has to be construed within the strict limit and parameters of Rule 6 of the Policy while the respondent can escape liability if it can be shown that his case satisfies any of the conditions set out in Rule 7 whereof. According to the Ld. Counsel for the respondent the onus and burden of proof to establish the conditions set out in Rules 4, 6 & 7 of the Policy is strictly upon the complainant and not upon the respondent and which burden/onus the complainant has failed to establish.

In my opinion the submissions of the Ld. Counsel for the respondent are not maintainable for the following important reasons:-

- (i) The Hon'ble Supreme Court of India in its decision of **Satyam Infoway Ltd., Vs. Sifynet Solutions 2004 (6) SCC 145** has declared the basic principles of Trade Mark law and the laws of passing off to be applied to disputes in respect of internet domain name. Thus while adjudicating the present dispute these principles cannot be overlooked and have to be applied. To do so would amount to nullifying the law declared by the Hon'ble Supreme Court.
- (ii) A bare reading of Rules 6 & 7 of the Policy indicates that the condition and circumstances enumerated therein are "in particular but without limitation" and thereby providing a sufficient elasticity and flexibility to adjudicate the complaint with reference to applicable existing laws. In the said Rules only some such circumstances have been identified for the purpose of adjudication of the complaint. The premises and circumstances enumerated in Rules 4, 6 & 7, which are to be read conjointly, are neither rigid, exhaustive and nor straight jacket formula of inflexible application.

J.K. Bann

26.2 The Ld. Counsel for the Respondent submitted that the complainant has abandoned his claims in the domain name gaadi.in and has acquiescence to the respondents adoption and use in as much as prior to the year 2008 the complainant never sought any registration for the domain name gaadi.in (with the country top level domain) when it was available for him to do so while he only obtained registration and use for the domain name gaadi.com (with the generic top level domain) and that after the year 2012 the complainant has never interfered with the respondents use amounting to an acquiescence.

In my considered opinion the aforesaid submissions is clearly erroneous for the following reasons :-

- (i) The respondents plea of an abandonment is misplaced as the concept of abandonment is related to an existing known-right which the right holder can intentionally relinquish or give up and that too without creating any proprietary rights therein in another person **(Kanhiya Shanker Vs. Mohabata Sedhu AIR 1960 Punjab 494).** Prior to 2008 the complainant itself had no rights or claims and consequently could not have abandoned and nor could have created any proprietary therein in favour of the respondent. The rights of the complainant can only arise in the Trade Mark after it has been adopted and so used and exploited by it creating a right in its favour and to enforce it against a violative wrong.
- (ii) The respondents allegations of acquiescence by the complainant is also not maintainable. What constitutes acquiescence has been commented on by the Hon'ble Supreme Court in **M/s Power Control Appliances Vs. Sumeet Machines Pvt. Ltd., (1994) 2 SCC 448: 1995 (15) PTC 165 (SC).** The Court observed that :-

J.K. Bawa

"Acquiescence is sitting by, when another is invading the rights and spending money on it. It is a course of conduct inconsistent with the claim for exclusive rights in a trade mark, trade name etc. It implies positive acts not merely silence or inaction such as is involved in laches It is important to distinguish mere negligence and acquiescence. Acquiescence is one facet of delay. If the plaintiff stood by knowingly and let the defendants built up an important trade until it had become necessary to crush it, then the plaintiffs would be stopped by their acquiescence. If the acquiescence in the infringement amounts to consent, it will be a complete defence The acquiescence must be such as to lead to the interference of a licence sufficient to create a new right in the defendant".

The Hon'ble Supreme Court in the very same judgement in respect of acquiescence quoted Cotton, LJ in Proctor V. Bannis (1887) 36 Ch. D740 as under :-

"It is necessary that the person who alleges this lying by should have been acting in ignorance of the title of the other man, and that the other man should have known that ignorance and not mentioned his own title".

None of the conditions set out in the aforesaid stand established. The respondent himself has placed no evidence on record showing any user leave aside credible user between claimed year of 2012 till mid 2015. In the absence of any such use the issue of the complainant standing by or encouraging the respondent by active steps cannot arise. In fact the complainant had put the respondent to notice (Exhibit K2) and whereafter the respondent even removed Exhibit J and as per Exhibit O filed by the respondent. Had there

SK Bannis

been any such acquiescence by the complainant there would have been no occasion for the respondent to do so.

26.3 The Ld. Counsel for the respondent has further submitted that the complaint ought to be rejected at its threshold as the complainant is guilty of making false statements in pleadings to the effect that its trade marks for the word/mark gaadi.com (as per the particulars furnished in **Exhibit G** of the complainant) are duly registered under the Trade Marks Act, 1999 and that these trade marks have received favorable acceptance orders from the Registrar of Trade Marks while in fact that is not so and a fact not disputed to by the Ld. Counsel for the complainant during the course of the hearing.

In my understanding the said submission is without cause for the following reasons :-

- (a) That the issue of trade mark registrations or favourable orders by the Trade Marks Registry are not material nor relevant for the adjudication of this dispute. It is settled law that action based on passing off are independent to and based on distinct and different causes of action to those of based on infringement arising from violation of registered trade marks. The present action is being decided on facts and materials other than that of registered trade marks which are governed by different laws and consideration [Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, reported in AIR 1965 SC 980, Wander Ltd., Vs. Antox India (P) Ltd., reported in 1990 (2) Arb. L. R399 (SC)]. Wrong statements and suppressions and such like wrongs must be material and relevant to the dispute in order to penalize the person guilty thereof. [S.J.S. Business Enterprises (P) Ltd., Vs. State of Bihar, (2004) 7 SCC 166 SC]

S.K. Banna

- (b) Even otherwise the concept of *falsus in uno falsus in omnibus* has been rejected by the Indian courts [Rizan Vs. The State of Chhattisgarh (2003) 2 SCC 661]. Just because one statement is found to be wrong would not vitiate the effect of numerous other independent, credible and reliable evidence and findings in favour of the complainant and against the respondent's wrong or in support of the complainants cause of action. The findings returned herein in this award are independent of and not dependant upon any trade mark registrations or findings by the Trade Marks Registry.

27. In my considered view the Complainant has discharged his onus/burden of proof. The present complaint is maintainable and stands established even if it was to be considered within the strict parameters of the INDRP policy.

28. Honesty and fair play are, and ought to be, the basic policies in the world of business [Laxmikanth V. Patel case, supra] and further considering that domain names are business identifiers, serving to identify and distinguish itself or its services and to specify its corresponding online location. Domain names have attained legal sanctity and the services rendered over the internet are important for any business. The domain name is a valuable corporate asset entitled to protection [Satyam Infoway Ltd., v. Sifynet Solutions 2004 (6) SCC 145 ; Yahoo Inc., v. Akash Arora 2999 PTC 201; Rediff. Communication Limited v. Cyberbooth, AIR 2000 Bom.27].

In the aforesaid view of the matter I am of the confirmed view that the complaint must be allowed.

Accordingly it is decided that the disputed domain name www.gaadi.in be transferred to the Complainant.

J.L. Bawa

Signed at New Delhi on this 2nd day of December, 2015.


Sudarshan Kumar Bansal
Sole Arbitrator