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ARBITRATION CASE NO. 4/2007

IN THE ARBITRATION MATTER OF:

GENPACT LIMITED

...COMPLAINANT

VERSUS

MANISH GUPTA

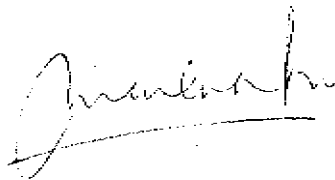
...RESPONDENT

AWARD:

The present dispute has arisen over the registration of the domain name genpact.in, which was registered in favour of the respondent. The Complainant has filed the present complaint seeking the aforesaid domain name genpact.in be transferred in its favour.

The Complainant filed the present complaint under the .IN Domain Name Resolution Policy of .IN Registry.

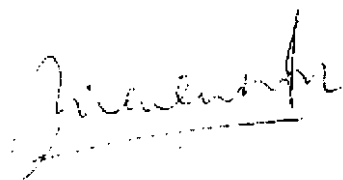
In complaint, the complainant has stated that domain name genpact.in incorporates the trade name of complainant and is also identical to its trade and service mark "GENPACT". According to the complainant the name GENPACT is part of the name of its company which was incorporated on 11th November 2005 as Genpact Global Holdings SICAR sari and thereafter this company assigned its rights and title interest for all the territories of the world to the complainant by a deed of assignment dated 16.07.2007, and that the complainant is a world wide provider of wide range of business process in technology and knowledge services, including Finance and Accounting, Collection and Customer Relations, Insurance, Procurement and Supply Chain, Analytics, Software, IT Infrastructure, Content solutions and Re-engineering. Further the complainant has stated that it has a global network delivery centres in nine countries namely India, China, Hungary, Mexico, Philippines, Netherlands, Romania, Spain and United States. The complainant has also stated that it had adopted the mark "GENPACT" in the year 2005 and is part of the complainant's corporate name and is a service mark used by the complainant for all services provided by it at global level. The complainant has also stated that it has coined the word GENPACT and it has no denotative meaning and the complainant is universally known as the world wide provider of business processes for companies around the world by the said mark, apart from being inherently distinctive, the name has acquired substantial goodwill and a commercial asset of the complainant' company. Furthermore the complainant has also submitted the status report of the registration of trade mark GENPACT in various countries. Some of the said registration is pending and in some cases the registration is complete. Most of them have been initiated in around June 2002 onwards. Intact the first use of mark GENPACT was on 03.03.2005, the date on which domain name Genpact was created.

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The complainant has also contented that the respondent registered or acquired the domain name genpact.in primarily for the purpose of selling, renting or otherwise transferring the domain name for a valuable consideration and that the registration of the said domain name by the respondent creates confusion in the mind of such user that the respondent is connected with the complainant.

In reply to the said complaint, the respondent has stated that it has been using the mark Genpact since 2000 and had got their domain name genpact.in registered their favor in Dec 2005. According to the respondent the word Genpact the combination of the words "Generator" and "Compact", as the respondent is in the field of manufacture of electronic generators also known as inverters. The respondent has taken examples of GENSET, GENPAK, GENPAC, etc were also according to the respondent's are brand names of generators in the market. The respondent has also filed the proof of registration of mark GENPACT which was registered on 17.01.2006 wherein its states that it is a user of said mark since 01.02.2000. The respondent in his reply has denied to have adopted the mark Genpact from the complainant. In support of his claim, the respondent had submitted various invoices showing the mark Genpact in such invoices. The respondent has also filed an affidavit of one Mr. Deen Dayal Kejariwal stated to be the Proprietor of M/s Tirupati electronics deposing that he has been purchasing the products manufactured by the respondent under its mark Genpact.

The complainant in rejoinder to the reply filed by the respondent stated that respondent is a professional cybersquatter and it had been created under fictitious identities to register the said domain name. A detail of WHOIS was filed in support showing the details of domain name Genpact.in and scrap.in wherein the registrant's phone No was same. This was also similar to another domain name registered under the same e.mail id of the registrant by the name of ncr.in. The complainant further stated that the name server of the

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domain name **genpact.in** has been changed time and again which reflected the dishonest intention of the respondent. The complainant has also stated that no evidence regarding the use of genpact since year 2000 has been furnished by the respondent. Furthermore, the complainant has also stated that the respondent never used the mark genpact on a website till date which reflects in the cache memory of the respondent's web site.

Before I decide the complaint, I would like to refer to the provisions of IN Domain Name Dispute Resolution Policy (INDRP).

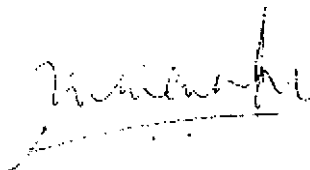
"6. Evidence of Registration and use of Domain Name in Bad Faith

For the purposes of Paragraph 5(iii), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or
- (ii) the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or
- (iii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

7. Registrant's Rights to and Legitimate Interests in the Domain Name

Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence



presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purposes of Paragraph 5 (ii) :

(i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;

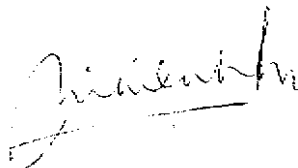
(ii) the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or

(iii) the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

10. Remedies

The remedies available to a Complainant pursuant to any proceeding before an Arbitrator shall be limited to requiring the cancellation of the Registrant's domain name or the transfer of the Registrant's domain name registration to the Complainant. Costs as may be deemed fit may also be awarded by the Arbitrator."

The complainant has referred to a case decided by WIPO Arbitration and Mediation Center in the case of Telstra Corporation Limited v. Nuclear Marshmallows (Case No. D2000-0003) on February 18, 2000. The facts in the said case was that the Complainant, a largest company listed on the Australian stock exchange and the largest provider of telecommunications and information services in Australia,, was the registrant of the following domain names containing the word <TELSTRA alongwith telstra.com, telstra.net, telstra.com.au, telstra-inc.com, telstrainc.com. The Complainant's main activities, each of which is carried out under or by reference to the <TELSTRA> mark, are the provision of a fixed telephony network to residences and businesses across Australia; the provision of local, long distance domestic and international telephone call services to over 7 million residential and business customers in Australia; the provision of 78,000 public payphones in Australia; the operation of mobile telecommunications services

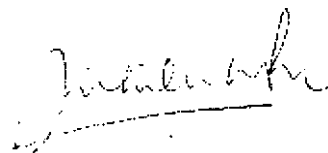


to 3.4 million customers; the provision of a range of data, Internet and on-line services (including the largest Internet Service Provider in Australia); the provision of wholesale services to other telecommunications carriers and service providers; the provision of directory information and connection services to over 520 million calls per annum; the publication and distribution of white pages and yellow pages directories in hard-copy, CD-ROM and on-line formats; and the operation of over 80 retail outlets throughout Australia.

Respondent was the registrant of the domain name <telstra.org>, the Registrar of which is Network Solutions, Inc. It was found that the domain name did not resolve to a web site or other on-line presence.

The Administrative Panel found that this part of the domain name was identical to the numerous trademark registrations of the word <TELSTRA> held by the Complainant. In addition, the Administrative Panel found that the whole of the domain name was confusingly similar to those trademark registrations made by the complainant and therefore the Respondent had no rights or legitimate interests in the domain name. The relevant portion of the decision is quoted hereinbelow:

"7.10 This understanding of paragraph 4(a)(iii) is supported by the actual provisions of the Uniform Policy. Paragraph 4(b) of the Uniform Policy identifies, without limitation, circumstances that "shall be evidence of the registration and use of a domain name in bad faith", for the purposes of paragraph 4(a)(iii). Only one of these circumstances (paragraph 4(b)(iv)), by necessity, involves a positive action post-registration undertaken in relation to the domain name (using the name to attract custom to a web site or other on-line location). The other three circumstances contemplate either a positive action or inaction in relation to the domain name. That is to say, the circumstances identified in paragraphs 4(b)(1), (ii) and (iii) can be found in a situation involving a passive holding of the domain name registration. Of course, these three paragraphs require additional facts (an intention to sell, rent or transfer the registration, for paragraph 4(b)(i); a pattern of conduct preventing a trade mark owner's use of the registration, for paragraph 4(b)(ii); the primary purpose of disrupting the business of a competitor, for paragraph 4(b)(iii)). Nevertheless, the point is that paragraph 4(b) recognises that inaction (eg. passive holding) in relation to a domain name registration

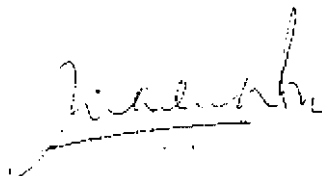


can, in certain circumstances, constitute a domain name being used in bad faith. Furthermore, it must be recalled that the circumstances identified in paragraph 4(b) are "without limitation" - that is, paragraph 4(b) expressly recognises that *other* circumstances can be evidence that a domain name was registered and is being used in bad faith. (Emphasis supplied)

On the analysis on the document and record submitted by both parties it is seen that although respondent claims that it had registered the trademark prior to complainant in December 2005, after coining the said ma'k Genpact by combining words "Generator" and "Compact". This is much later to the complainant registering its mark GENPACT globally after March 2005 in various countries, which is supported by the fact that the complainant has listed the various registration of its mark in countries where it carries out its operation. In some cases the registration has been carried out in Jun 2005 and in some cases they are still pending. However, in India the registration of the said mark Genpact by the complainant is still pending since 18.08.2005, which again is in much prior to the registration of the domain name gen_pact_in on 12.12.2005 by the respondent.

The respondent in support has not given much evidence in support of its claim that it is a user since 2000. He has only provided copies of invoices starting from 2006 where again only word Genpact trademark reflects in the lower half of the column description alongwith another mark as icon in certain cases. No other proof regarding the use of the trademark genpact or any brochure relating the mark with its products has been placed. Eventhough the mark has been registered as on 17.01.2006 with the declaration that he is a user since the year 2000, but it is unbelievable that a mark that was been used by the respondent had no connection with or identifiable with the goods which purpose it was registered for.

The Complainant has proprietary right over the said name and the same cannot be taken away if some one registers it earlier under a policy. The Law



is very clear on the issue of proprietary rights over names of a registered user. The respondent on the other had has failed to place any evidence whatsoever of any actual or contemplated good faith use by it of the domain name. Hence this is a clear case of cyber squatting done by the Respondent herein. The Respondent has not been able to show that he had created the website with the intention to use for his purpose or for his goods that was being manufactured and that he has a proprietary right over the said domain name. Therefore the Respondent has not proved that the registration was not done in bad faith.

Considering all facts and circumstances and on perusal of the records, I deem it fit and proper to allow the prayer of the Complainant to the transfer of the said domain name genpact.in in its favour.



NIKILESH RAMACHANDRAN
ARBITRATOR

DATED : 28th January 2008 In view of the above