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# INDIA NON JUDICIAL

## Government of National Capital Territory of Delhi

### e-Stamp

Certificate No.

Certificate Issued Date

Account Reference

Unique Doc. Reference

Purchased by

Description of Document

Property Description

Consideration Price (Rs.)

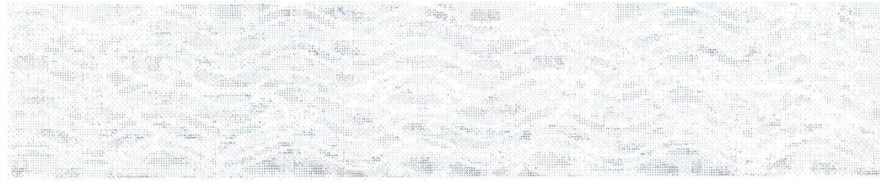
First Party

Second Party

Stamp Duty Paid By

Stamp Duty Amount(Rs.)

: IN-DL41677507606145T  
: 04-Feb-2021 09:05 PM  
: IMPACC (IV)/ dl925103/ DELHI/ DL-DLH  
: SUBIN-DL92510385438340944031T  
: SHEETAL VOHRA  
: Article 12 Award  
: Not Applicable  
: 0  
: (Zero)  
: SHEETAL VOHRA  
: Not Applicable  
: SHEETAL VOHRA  
: 100  
: (One Hundred only)



Please write or type below this line

*Sheetal vohra*

#### Statutory Alert:

1. The authenticity of this Stamp certificate should be verified at 'www.shcilestamp.com' or using e-Stamp Mobile App of Stock Holding. Any discrepancy in the details on this Certificate and as available on the website / Mobile App renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.

**BEFORE THE SOLE ARBITRATOR UNDER THE .IN DOMAIN NAME DISPUTE  
RESOLUTION POLICY  
INDRP ARBITRATION**

**THE NATIONAL INTERNET EXCHANGE OF INDIA  
[NIXI]**

**INDRP Case No: 1298**

**ARBITRAL TRIBUNAL CONSISTING OF  
SOLE ARBITRATOR**

**DR. SHEETAL VOHRA, LLB, LLM, PHD (LAW)  
ADVOCATE, DELHI HIGH COURT**

**IN THE MATTER OF:**

**Nippon Life India Asset Management Limited**

4<sup>th</sup> Floor, Tower A

Peninsula Business Park

Ganapatrao Kadam Marg

Lower Parel [W]

Mumbai – 400 013, Maharashtra

India

anshul.vyas@nipponindiaamc.com

...Complainant

VERSUS

ABC XYZ

ABC XYZ

Mumbai

Mumbai – 400001

India

nipponindiafunds@gmail.com

...Respondent

*Sheetal Vohra*



## ARBITRATION AWARD

### COMPLAINT REGARDING DISPUTED DOMAIN NAME <NIMF.CO.IN>

#### 1. THE PARTIES

The Complainant: Nippon Life India Asset Management Limited [formerly known as Reliance Nippon Life Asset Management Limited], 4<sup>th</sup> Floor, Tower A, Peninsula Business Park, Ganapatrao Kadam Marg, Lower Parel [W], Mumbai – 400 013, Maharashtra India and email: anshul.vyas@nipponindiaamc.com (represented herein by its authorised person Mr. Anshul Vyas).

The Respondent: ABC XYZ, Mumbai, 400001, email id nipponindiafunds@gmail.com.

According to the Whois Database of the **National Internet Exchange of India [NIXI] <www.registry.in>**,. A copy of the printout of the database search conducted for the disputed domain name on 20 November 2020 and the WHOIS details provided by the National Internet Exchange of India [NIXI] was annexed to the Complaint as **Annexure A**.

#### 2. THE DOMAIN NAME AND REGISTRAR:

The disputed domain name : **www.nimf.co.in**

The domain name registered with .IN REGISTRY

#### 3. PROCEDURAL HISTORY:

November 21, 2020: Date of Complaint

December 04, 2020: The .IN REGISTRY appointed Dr. Sheetal Vohra as Sole Arbitrator from its panel as per paragraph 5 (b) of INDRP Rules of Procedure after taking a signed statement of

*Sheetal Vohra*

acceptance and declaration of impartiality and independence.

December 04, 2020

Arbitral proceedings were commenced by sending notice to Respondent through e-mail as per Paragraph 4 (c ) of INDRP Rules of Procedure, marking copy of the same to Complainant's authorized representative and to the .IN REGISTRY to file response within 15 days of receipt of same.

As the Respondent failed to file his response within the stipulated 15 days' time period intimated to all parties, the instant award is being passed.

#### 4. **FACTUAL AND LEGAL BACKGROUND:**

It was submitted that the dispute is properly within the scope of the policy framed by NIXI. The registration agreement, pursuant to which the disputed domain name was registered, incorporates the Policy. Disputes between Registrants, as they relate to domain name registrations, are governed by the Policy. A copy of the Policy was annexed as **"Annexure B"**.

It was further submitted that the Complainant is a listed public limited company incorporated under the Companies Act, 1956 on February 24, 1995. That Originally the Complainant was known as Reliance Nippon Life Asset Management Limited, which was formally changed on January 13, 2020 to Nippon Life India Asset Management Limited. The proof of change of name was enclosed as **Annexure C**.

It was further submitted that the Complainant's name was changed pursuant to Nippon Life Insurance of Japan [NLI Japan] acquiring 74.95% percent stake in the Complainant company from Reliance Capital. By doing so, NLI Japan became the main promoter of the Complainant.

It was further submitted that the NLI Japan is Japan's leading private life insurer and primarily operates in Japan, North America, Europe, Oceania and Asia. It is a 130-year old institution with total assets of over INR 49 Lakh Crores. It is the largest Japanese



insurance company by revenue and currently features at Number 130 in the Fortune Global 500 list as available here: <<https://fortune.com/company/nippon-life-insurance/global500/>>.

It was submitted that Nippon India Mutual Fund [NIMF] was earlier known as Reliance Mutual Fund and that the name was changed from Reliance Mutual Fund to Nippon India Mutual Fund effective September 28, 2019. NIMF is one of India's leading mutual funds, with Average Assets Under Management [AAUM] of INR 200030.43 Crores and 92.73 Lakhs folios.

It was submitted that the Complainant is the Asset Management Company of NIMF since 1995 and that it has also been registered as a Portfolio Manager in India and it also renders advisory services to its offshore clients and an approval to manage and / or advise pooled assets including offshore funds, insurance funds, provident funds, etc. It was further submitted that it is listed on the Bombay Stock Exchange and the National Stock Exchange and has a distribution network of over 76,000 distributors serving over 88 Lakh investor folios; and a widespread presence in India with over 300 offices.

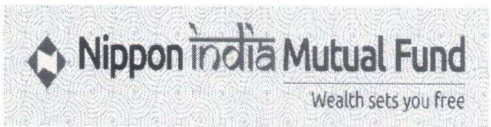

It was submitted that the Complainant's Annual Turnover for the last Financial Year [2019-20] was more than INR Seven Billion and that all recent Annual Returns of the Complainant can be accessed at: <<https://mf.nipponindiaim.com/about-us/financial-reports/>>.

It was submitted that the Complainant has set up various subsidiary companies in India and other countries details of which are available here: <<https://mf.nipponindiaim.com/about-us/company-profile/nippon-life-india-asset-management-limited/>>.




It was submitted that the Expenditure on promoting the brand 'Reliance Nippon' and thereafter 'Nippon India', 'Nippon India Mutual Fund', 'NIMF' and related marks, through the Complainant alone from 2016-17 to 2019-20, as well as the Annual Turnover during this period was provided in the complaint and is being reproduced hereinbelow:

Financial Year	Advertisement and Publicity [INR]	Turnover [INR]
2016-17	57,25,54,276	7,446,465,863
2017-18	86,59,19,352	6,499,802,535
2018-19	20,86,52,621	6,306,160,096
2019-20	22,93,97,456	7,263,444,513

It was submitted that the Complainant considers their corporate name as well trade/service name/mark an important and an extremely valuable asset and thus in order to protect the same, had secured Indian trade mark registrations in multiple classes for the wordmark and device-mark of '**Reliance Nippon Life Asset Management**' before the name change and that subsequently, the Complainant filed for trademarks in India for the following marks in several classes:

S. No.	Mark
1.	Nippon India
2.	
3.	Nippon India Mutual Fund
4.	



5.	
6.	
7.	Nippon Life India Asset Management Ltd
8.	Nippon India ETF
9.	Nippon Life India Asset Management Limited
10.	
11.	Nippon India Alternate Investments
12.	Nippon Life India AIF Alternate Investments

The Registration certificates and the list of the trademark registrations/applications obtained/filed by the Complainant in India was annexed as **Annexure D**.

It was submitted that the profile and popularity of the Complainant under the trademark 'Nippon India', 'NIMF', and 'Nippon India Mutual Fund' had continuously been

increasing since the date of use of the mark. Prior to this, the Complainant enjoyed widespread reputation under the 'Reliance Nippon' mark. The mark 'NIMF' and/or 'Nippon India Mutual Fund' is used as a trademark on all publicity material of the Complainant. It was submitted that at present, the Complainant's trade name/mark is identified by the trading public exclusively with the Complainant and has acquired an enormous goodwill in India.

It was submitted that the popularity of the Complainant's 'NIMF' mark can be further established by the fact that a [www.google.com](http://www.google.com) ["Google"] search of the said term reveals search results, on the first page, almost all of which pertain to the Complainant and its services. Copy of the first page of the search results were annexed as **Annexure E**.

It was submitted that the Complainant's brand has a huge social media presence. All these social media accounts are named 'Nippon India Mutual Fund', which is the expanded form of 'NIMF'. Details of these accounts were produced in the complaint and are given herein below:

Account Name	URL	Subscriber Count
Nippon India Mutual Fund	<a href="https://www.facebook.com/NipponIndiaMF">https://www.facebook.com/NipponIndiaMF</a>	13,85,476
	<a href="https://www.instagram.com/nipponindiamf/">https://www.instagram.com/nipponindiamf/</a>	32,400
	<a href="https://twitter.com/NipponIndiaMF">https://twitter.com/NipponIndiaMF</a>	1,06,800
	<a href="https://www.linkedin.com/company/nipponindiamf/">https://www.linkedin.com/company/nipponindiamf/</a>	3,562
	<a href="https://www.youtube.com/c/NipponIndiaMutualFund">https://www.youtube.com/c/NipponIndiaMutualFund</a>	14,900

It was submitted that additionally, the official mobile application of the Complainant which is used by its customers is titled 'Nippon India Mutual Fund'. On the Google Play store, the app has more than 500,000 installations. Copy of the App page on the Apple App Store and Google Play Store was annexed as **Annexure F**.

It was further submitted that in order to ensure that the Complainant and its revised corporate name and brand name had a proper presence on the internet, the Complainant



blocked several domain names under the '.com' gTLD as well as the .IN ccTLD consisting of the marks 'NIMF', 'Nippon India', 'Nippon India Mutual Fund', etc.

It was submitted that specifically, the Complainant had registered, or rather instructed one of its employees Mr Hiren Shah, the then 'Head – IT Projects and Transformation' of the Complainant to register several such domain names, including the present domain name which is the subject matter of this present complaint. Documents indicating that Mr Shah was an employee of the Complainant from July 24, 2018 to December 19, 2019 were annexed as **Annexure G**.

It was submitted that however, instead of registering the said domain names, including the disputed domain name, on behalf of the Complainant, Mr Shah registered the disputed domain name [and other domains] through his personal account.

It was submitted that in the interest of brevity and to keep the present Complaint within the confines of the word-limit as prescribed under the Rules, the Complainant has taken the liberty of annexing a detailed note [**Annexure H**] describing the malafide and bad-faith activities of Mr Hiren Shah because of which the Complainant had to file the present Complaint, despite the fact that the Complainant was supposed to be the rightful owner of the impugned domain name. The following annexes contain documents and factual information related to the entire incident which is crucial to the present matter:

It was submitted that the above-mentioned annexes [**From H to M**] established the fact that Mr Hiren Shah is the actual Respondent in the present matter; and that he himself and through his associate Mr Abhishek Rai and Amplan India Private Limited is attempting to blackmail the Complainant into paying exorbitant amounts of money in lieu of transferring the impugned domain name to the Complainant.

It is to be noted that while the hosting and control of the content of the website on the said domain name is with the Complainant, the Complainant at this point does not have access to the account associated with the domain name and has thus no control over the domain name.

Additionally, the Complainant recently registered the domain <ni-mf.in> to further secure its rights in the 'NIMF' mark. Whois details of the same are available at: <<https://in.godaddy.com/whois/results.aspx?checkAvail=1&domain=ni-mf.in>>

5. **PARTIES CONTENTIONS:**

A. Complainant

- (a) The Domain Name is identical or confusingly similar to Trademarks of the Complainant
- (b) Respondent has no legitimate interest in the domain name
- (c) Respondent has registered the domain name in bad faith

The Complainant asserts that each of the aforementioned factors are established, as substantiated as substantiated below:

[A] **THE DOMAIN NAME IS IDENTICAL AND/OR CONFUSINGLY SIMILAR TO THE COMPLAINANT'S MARK 'NIMF'**

- It was submitted that the mark 'NIMF' is associated with the Complainant and no one else. The mark 'NIMF' is used by the general public and the Complainant to refer to its mutual fund – that is 'Nippon India Mutual Fund'.
- It was submitted that the Members of the trade and consumers while discussing Systematic Investment Plans [SIPs] refer to the Complainant's mutual fund as 'NIMF'.
- It was submitted that the popularity of the mark 'NIMF' and its clear association with the Complainant and is further established through the following:
  - Google Search results for 'NIMF' pertain to the Complainant and its mutual fund [Please refer to **Annexure E**]
  - Majority of the suggested search terms, as offered by Google at the time of searching for 'NIMF', pertain to the Complainant's mutual fund. This indicates that whenever 'NIMF' is searched on Google, it is typically searched in the



context of the Complainant's services and brand. A copy of the suggested search terms as predicted by Google were annexed as **Annexure N**.

- As per Google Trends [trends.google.com], the term 'NIMF' can clearly be seen to be associated with the Complainant. This can be established through the 'Related Topics' section where all topics pertain to financial/investment topics. Similarly, 'Related Queries' specifically relate to 'NIMF Login', which implies that users appear to be trying to search for the Complainant's login page to view their investment details. A copy of the Google Trends report was annexed as **Annexure O**.

- It was submitted that additionally, news articles regularly refer to the Complainant's mutual fund as 'NIMF'. Details of a few such articles were enclosed as **Annexure P**.
- It was submitted that in the past, INDRP Panels have held that Complainant's have rights in their brand names' abbreviations as well. *Mumbai International Airport Limited v Sugra K [INDRP/1223] and Bennett Coleman & Co. Ltd. v Mr Suresh Kumar [INDRP/399]*
- It was submitted that the domain name used by the Respondent is identical to the well-known trademark/service mark of the Complainant. The utmost malafide intention of the Respondent is evident from the fact that the Respondent was an employee of the Complainant and was supposed to register the domain name on behalf of the Complainant.
- It was submitted that in fact, Panels in cases such as *Reuters Ltd. v. Global Net 2000 Inc., D2000-0441; Altavista Company v. Grandtotal Finances Ltd., D2000-0848; Playboy Enterprises v. Movie Name Company, D2001-1201* has held that the mere omission of one letter of a trade mark has no effect on the determination of confusing similarity between a trade mark and a domain name.
- It was submitted that the domain name is identical to the well-known trademark 'NIMF'. As numerous Panels have held in so many decisions [*Farouk Systems,*

*Uthairaj*

*Inc. v. Yishi D2010-0006; Havells India Limited, QRG Enterprises Limited v. Whois Foundation D2016-1775]* that a domain name which wholly incorporates a Complainant's registered mark may be sufficient to establish identicalness or confusing similarity, despite the addition of other words to such marks.

- It was submitted that it was well established that the specific top level domain name extension, such as ".com", ".in", ".co.in" or ".travel", does not affect the domain name for the purpose of determining whether it is identical or confusingly similar. [*Wells Fargo and Company v. Jessica Frankfurter, INDRP/392; Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., D2000-1525*].
- It was submitted that the marks 'NIMF' and 'Nippon India Mutual Fund' have been in extensive, continuous and uninterrupted use. The marks have been used in relation to advertisements and related business information disseminated in print and digital media. It was submitted that each of the instances of use, the marks are prominently displayed and has become the focus of the Complainant's entire business related to a wide range of services. Copies of a few such promotional material and articles were enclosed as **Annexure Q**.
- It was submitted that the 'NIMF' and 'Nippon India Mutual Fund' marks have been used extensively by the Complainant for its business of mutual funds as well as its corporate identity.
- It was submitted that a mark is capable of being a trademark if it has acquired a secondary meaning in the market. The evidence is sufficient to show that Complainant's mark 'NIMF' has acquired secondary meaning through continuous and extensive use by the Complainant. [*Realmark Cape Harbour L.L.C. v. Lawrence S. Lewis, D2000-1435*]. It was submitted that in the present dispute, the Complainant and its group companies are recognised by their mutual fund which is known as 'NIMF' and the mark has thus acquired secondary meaning.
- It was submitted that the profile and popularity of the Complainant under the trade/service name/mark 'NIMF' and 'Nippon India Mutual Fund' has been



continuously increasing since the date of adoption and use of the marks. At present, the Complainant's trade name/mark is a name to reckon with and has acquired enormous goodwill in India due to its extensive use, advertisements, publicity and awareness.

- It was submitted that in *Living Media, Limited v. India Services, D2000-0973*, it has been held that “*trademark registration is itself prima facie evidence that the mark is distinctive*”. The Complainant has placed reliance on *eAuto, LLC v. Triple S Auto Parts, D2000-0047*, wherein the Panel decided that when a domain name wholly incorporates a Complainant's registered mark that is sufficient to establish identical or confusing similarity under the Policy. It was submitted that in this case, the Complainant has several trademark applications for ‘Nippon India Mutual Fund’, which is the expanded form of ‘NIMF’ and which are on the verge of registration as they have been duly ‘accepted and advertised’ by the Indian Trade Marks Registry and reference was made to **Annexure D**.
- It was submitted that Panels have also ruled in favour of complainants even where the mark was not registered. *Satyam Computer Service Limited v. Vasudeva Varma Gokharaju, D2000-0835; Express Publications [Madurai] Ltd. v. Murali Ramakrishnan, D2001-0208 and Hindustan Petroleum Corporation Limited v. Neel Punatar, D2004-0351*.
- It was submitted that moreover, in the present case, it is to be noted that the domain name in question was selected by the Complainant specifically for the reason that it could be used in relation to its services. This in itself establishes that the domain name is identical or confusingly similar to the Complainant's mark ‘NIMF’ in which it has both trademark as well as common law rights.

**[B] THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DOMAIN NAME**

- It was submitted that UDRP Panels have repeatedly held that former employees do not have a right to or legitimate interest in domain names incorporating the marks

*Uthairaj Velaz*

of their former employers. The Complainant placed reliance on *GFH Capital Limited v. David Haigh D2014-2148*; *Topcon Positioning Systems, Inc. v. Jason W. Evans D2015-0708*; *Simple Abilities Inc. v. Jeff Hoogveld and Adaptivies Abilities Inc. D2006-0143*; *The Glorya Kaufman Dance Foundation and Glorya Kaufman v. Carolyn B. Baker & Associates and "Glorya Kaufman Dance Foundation," formerly Domains By Proxy, Inc. D2010-0034*; *Savino Del Bene Inc. v. Graziano Innocenti Gennari D2000-1133*.

- The Complainant placed reliance on *Ruby's Diner, Inc. v. Joseph W. Popow, D2001-0868* and submitted that *"an employee or former employee is not a licensee, and thus has no authorization to use a company's trademark or a confusingly similar variation thereof without permission."*
- The Complainant placed reliance on *Piyush Kumar Parekh and Purvi Piyush Parekh v. Avanish Prasad D2017-1252*, and submitted that in this case too the Panel made the following observation on the issue of an employee or former employee registering domain names on behalf of the employer:  
*"....when a respondent, who is a former partner, director, or employee of a business or organization, continues to retain domain names in his personal name after leaving the organization, even if the respondent did not try to sell or rent the domain names, he ceases to have legitimate rights or legitimate interests in the disputed domain name. The basic reasoning in such cases is consistent with the view that, when the domain names are registered under the respondent's own name, he has done so in contemplation of the fact that, when he leaves or resigns from the company or organization, such trademark related rights could be asserted by the owner of the mark. Similarly, in the present case, consistent with the ruling in previous such cases, it is found that the Complainants have successfully established a prima facie case that the Respondent lacks rights and legitimate interests...."*
- It was submitted that the Respondent has no proprietary or contractual rights in any registered or common law trademark corresponding in whole or in part to the disputed domain name.



- It was submitted that the Complainant has specific reasons, as mentioned above, to believe that the Respondent in the present proceeding is Mr Hiren Shah – the former employee of the Complainant.
- The domain name was registered on the instructions of the Complainant and it ideally should have been in the possession of the Complainant. The domain name was never licensed to the Respondent and the Respondent was never permitted to use the domain name for its personal use or to register the domain name through its personal account.
- It was submitted that the Respondent is in no way related to the Complainant or its business, except for the fact that it was a former employee of the Complainant who was tasked with registering the disputed domain name for the Complainant.
- It was submitted that save as mentioned above, the: [1] Respondent has no connection with the Complainant or any company licensed by the Complainant; [2] Respondent is not commonly known by the disputed domain name or the trademark; [3] Respondent was not and is not authorized by the Complainant to register, hold or use the disputed domain name in his personal capacity.
- It was submitted that the very fact that the Respondent has himself and through Amplinno India Private Limited tried to blackmail the Complainant and has demanded an exorbitant amount of money to transfer the domain name establishes that the Respondent does not have any rights or legitimate interests in the domain name. The Complainant referred to and placed reliance on **Annexure M**.
- It was submitted that the Respondent became the registrant of the domain name without Complainant's permission or authorization.
- The Respondent is not, either as an individual, business or other organization, commonly known by the name 'NIMF' or 'Nippon India Mutual Fund'. The Complainant has not licensed or otherwise permitted the Respondent to use its trade/service marks.

*Shubra Vohra*

- It was submitted that the Respondent has not provided his correct details in the WHOIS contact information. This clearly indicates the mala fide of the Respondent leading to the conclusion that the Respondent does not have any legitimate interests or rights in the disputed domain name. Moreover, by providing inaccurate and unreliable information, the Respondent has violated Section 2 of the 'Terms and Conditions for Registrants' issued by the .IN Registry. A printout of the said Terms & Conditions as available on the .IN Registry website <www.registry.in> was annexed as **Annexure R**. It is submitted that a similar provision in Paragraph 3[a] of the Policy states that the credentials furnished by the domain name registrant should be complete and accurate. The Respondent has not adhered to this as well.
- It was submitted that it has been established earlier that Mr Hiren Shah and Amplinno are closely associated and that the domain name was registered by Mr Shah. The Complainant referred to and placed reliance on **Annexures K to M**.
- Lastly, the Complainant contends that the Respondent has never been commonly identified with the disputed domain name or any variation thereof prior to Respondent's registration of the disputed domain name. Furthermore, the burden is on the Respondent to prove that it has rights and legitimate interests in the disputed domain name.

**[C] THE RESPONDENT REGISTERED AND/OR IS USING THE DOMAIN NAME IN BAD FAITH**

- The Complainant contended that it strongly believes that the Respondent is Mr Hiren Shah who has registered the domain name on the instructions of the Complainant, but instead of using his official e-mail id, the Respondent used his personal e-mail id <info@hiren.biz> to register the domain name. The Complainant contended that the Respondent must have changed the e-mail id to the present e-mail id as provided in the WHOIS details by NIXI.



- The Complainant contended that additionally, the Respondent has not provided his correct details for the WHOIS data. This action indicates bad faith at the time of registering the domain name as there can be no doubt that the Respondent used his personal e-mail id and incorrect WHOIS details with the intention to deprive the Complainant from using or gaining control of the said domain name.
- The Complainant further contended that when the Complainant asked the Respondent to transfer the domain name to it, the Respondent instead started blackmailing the Complainant is indicative of the Respondent's bad faith use of the domain name. The Respondent is very well aware that the domain name is the rightful property of the Complainant and yet the Respondent with an intention to blackmail the Complainant, did not transfer the domain name to the Complainant and instead sought an exorbitant amount of money in lieu of the domain name. The Complainant relied upon *Havells India Limited, QRG Enterprises Limited v. Whois Foundation D2016-1775; Playboy Enterprises International, Inc. v. Hector Rodriguez D2000-1016; Charles Jourdan Holding AG v. AAIM, D2000-0403*
- It was submitted by the Complainant that since the Respondent was an employee of the Complainant, it is undisputable that the Respondent knew of the Complainant's rights in the domain name and the trademarks 'NIMF' and related variations at the time of registering the disputed domain name. *The Gloria Kaufman Dance Foundation Case [D2010-0034]*.
- It is submitted by the Complainant that panels have repeatedly held that registration of trademark-related domain name by an employee with knowledge of the trademark owner's rights in the mark constitutes bad faith registration and use. The Complainant placed reliance on *Savino Del Bene Inc. v. Graziano Innocenti Gennari D2000-1133; Piyush Kumar Parekh and Purvi Piyush Parekh v. Avnish Prasad D2017-1252*.
- It was submitted that in this specific case bad faith use and registration can be established based on the intention of the Respondent. The Respondent acted in such

a manner, right from the registration of the domain names, including the impugned domain name, which clearly indicates that the Respondent wanted to blackmail the Complainant.

- The Complainant placed reliance on, ***Topcon Positioning Systems, Inc. v. Jason W. Evans D2015-0708***, where the facts were somewhat similar, the Panel held the following:

*"The Respondent's conduct on termination lends credence to the inference that he maintained the Domain Name registrations in his personal name as leverage against his employer. He balked at turning over control of the Domain Names and website (for months, according to the Complaint) and then allowed one of the Domain Names to expire, crashing the Complainant's website. He declined to restore it or transfer the Domain Names unless he was paid more than USD 867,000, a sum that exceeded his salary (according to the Complainant's uncontested allegations) over the period of some seven years that he worked as an employee and had the responsibility for maintaining the Domain Names and website on the Complainant's behalf. The Panel cannot read the Respondent's mind, of course, but this behavior is so extreme that it warrants an inference of planned, bad faith conduct in the registration and use of the Domain Names.."*

- It was submitted that it would be extremely difficult, if not impossible, for the Respondent to use the disputed domain name as the name of any business, product or service for which it would be commercially useful without violating the Complainant's rights. [***The Ritz Carlton Hotel Company LLC v. Nelton! Brands Inc., INDRP/250***]
- It was submitted that the Complainant's trade name/mark is a name to reckon with and has acquired enormous goodwill in India due to its extensive use, advertisements, publicity and awareness throughout the world. Therefore, registration of a domain name identical or confusingly similar to a 'well-known' trademark is a clear indicator of bad faith. The Complainant placed reliance on ***Yahoo! Inc. v. Jorge O. Kirovsky, D2000-0428; Parfums Christian Dior v. Javier***



*Garcia Quintas and Christiandior.net, D2000-0226; Nike, Inc. v. B. B. de Boer, D2000-1397.*

- It was submitted that the at present, the domain name is being held by the Respondent. This is in bad faith and a clear attempt to take advantage of the Complainant's goodwill and reputation.
- It was submitted that the Respondent has provided incomplete WHOIS contact details. As per Section 2 of the 'Terms & Conditions for Registrants', domain name registrants are mandated to provide complete and accurate contact details. Additionally, Section 3 prohibits use of any Proxy/Privacy services to conceal WHOIS data. A similar provision in Paragraph 3[a] of the Policy also states that the credentials furnished by the domain name registrant should be complete and accurate. Thus, the blatant disregard and violation of these provisions by the Respondent constitutes strong evidence of bad faith.
- It was submitted that any use of the impugned domain name by the Respondent would necessarily be in bad faith. The Complainant placed reliance on *Xpedia Travel.com, D2000-0137 and Goodfoodguide.net, D2000-0019*.
- It was submitted that the domain name is being used to blackmail the Complainant. The Respondent is attempting to extract huge sums of money from the Complainant who have rights and legitimate interests in the said domain name. Moreover, it has come to the Complainant's attention that the Respondent had defrauded it through various other activities as well during his employment with the Complainant.
- It was submitted that the Respondent can transfer or sell the domain name to some competing interest of the Complainant. This will seriously affect the Complainant as the domain name is a direct reproduction of the Complainant's mark 'NIMF'.
- It was submitted that based on the above, it is apparent that the Respondent registered or acquired the impugned domain name primarily for the purpose of selling the domain name to the Complainant at an exorbitant price.

- It was submitted that the Respondent's registration and use of the domain name meets the bad faith elements set forth in the INDRP. Since the Respondent was an employee of the Complainant and was tasked with registering the domain name, the Respondent had actual knowledge of the trademark prior to registering the disputed domain name. By registering the disputed domain name, in his personal capacity, with actual knowledge of the Complainant's trademarks, the Respondent has acted in bad faith by breaching its service agreement with the Registrar because it registered the domain name that infringes upon the Intellectual Property rights of another entity, that is the Complainant.
- It was submitted that the additionally, the Respondent has breached all of its Representations as provided in Paragraph 3 of the Policy.

Thus, it was argued and submitted that from the above mentioned facts, it was evident that the Respondent is not making any legitimate non-commercial or fair use of the domain name. Since the Complainant has business and customers across several sectors including the banking and financial sector, automotive, travel and transport worldwide any link / information provided by the Respondent using the disputed domain name will lead internet users to believe that such information is endorsed by the Complainant. It was submitted that use of the disputed domain name by the Respondent is only to create an impression of association between the Respondent and the Complainant.

It was further submitted that infact, the Respondent has registered the disputed domain name with the sole purpose of selling the disputed domain name as is evident from the corresponding website. It is obvious that the Respondent is not using the disputed domain name in connection with bonafide offering of goods or services.

Further, it was submitted that to the best of the Complainant's knowledge (a) the Respondent is not conducting any business under the acronym or any name to warrant registration of the disputed domain name viz [www.nimf.co.in](http://www.nimf.co.in) in his name; (b) the Respondent is not known by the disputed domain name; and (c) the Respondent does



not have any trademark or service mark rights in the expression www.nimf.co.in or any part of the same or expanded version of the said acronym.

**THE DOMAIN NAME WAS REGISTERED OR IS BEING USED IN BAD FAITH**

It was submitted that the Domain Name was registered *and* is being used in bad faith for following reasons:

**REGISTRATION IN BAD FAITH**

It was submitted that it is inconceivable for the Respondent to state that he did not have knowledge of the Complainant's prior owned and registered trade mark and acronym at the time of registration of the Domain Name, particularly as the Complainant's trade mark rights predate the registration date of the Domain Name by many years.

**USE IN BAD FAITH**

It was submitted that the Domain Name is not resolving to an active website. However, it is a well-established principle that it is not necessary for a disputed domain name to be associated with an active website for a finding of bad faith to be made under the Policy. That though it was fairly submitted that to the best of the Complainant's knowledge, the Respondent has never actively used the Domain Name, I hold that such passive holding of the Domain Name would not preclude a finding of bad faith given the overall circumstances of the case.

**6. DISCUSSION AND FINDINGS:**

I have given considerable thought to the totality of the circumstances in this case and considered all relevant factors in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated

good-faith use and (iii) the implausibility of any good faith use to which the domain name may be put. I thereafter have no hesitation to hold that in the present case, all factors are satisfied.

I have gone through all the case laws cited by the Complainant as well as the Annexures filed with the Complaint.

I note that inspite of the Complainant's efforts to contact the Respondent prior to submitting the present Complaint, the Respondent has failed to engage with the Complainant or otherwise come forward with any actual or contemplated good-faith use of the Domain Name the Respondent 'knew or should have known' of the registration and use of the Complainant's well known trademarks and acronyms of the same prior to registering the disputed domain name [www.nimf.co.in](http://www.nimf.co.in). The Complainant has been known by the name and acronym globally and in India.

I hold that the registration by the Respondent of the of the disputed domain name [www.nimf.co.in](http://www.nimf.co.in) is dishonest and misleading.

I further hold that, the Respondent's registration of the disputed domain name ([www.nimf.co.in](http://www.nimf.co.in)) is contrary to and is in violation of paragraph 4 of the INDRP Policy.

I have specifically perused Annexure-D and Complainant's trademarks. On going through the E-Register of Indian Trade Marks, Registry I have noted that a few of Complainant's marks specifically "NIPPON INDIA MUTUAL FUND" were at advertisement stage on the date of filing the instant Complaint. However, some of these advertised marks have now got registered for example Complainant's trademark under number 4436914 and 4437915 both for "NIPPON INDIA MUTUAL FUND" are now registered trademarks. Clearly, NIMF is an acronym for "NIPPON INDIA MUTUAL FUND".

Similarly, I have perused Annexure-H being detailed note describing *malafide* and bad faith activities of Mr. Hiren Shah. It is well-settled legal principle that an ex-employee cannot register a trademark and / or a domain name in his own name and if he does so,



it is clearly *malafide* and dishonest. Further the Complainant's advocates have vide their email dated 19/12/2020 brought to my knowledge that the Respondent could not be served as per Rule 3 (d) and forwarded the courier tracking which clearly states that the Respondent could not be served due to "ADDRESS INCOMPLETE OR WRONG". This again is *malafide* and dishonest act on part of the Respondent. This shows that the Respondent has provided incomplete WHOIS contact details. As per Section 2 of the "Terms and conditions for the Registrants", domain name registrants are mandated to provide complete and accurate contact details.

In view of all the above facts and well known legal propositions and legal precedents I find and hold as under:

- that that the Respondent's domain name is misleading to the acronym of the trademark in which the Complainant has rights.
- that the disputed domain name [www.nimf.co.in](http://www.nimf.co.in) is registered by the Respondent incorporates the acronym of Complainant's registered trademarks NIPPON INDIA MUTUAL FUND.
- that due to the fame of the distinctive and reputation of the trademarks/ acronym of the Complainant, the first impression in the minds of the users shall be that the Respondent's website originates from, is associated with, or is sponsored by the Complainant.
- that the Respondent has no rights or legitimate interests in respect of the domain name.
- that none of the exemptions provided under paragraph 7 of the .IN Domain Dispute Resolution Policy (INDRP) apply in the present circumstances.
- that Complainant has not authorised, licensed, or permitted the Respondent to register or use the Domain Name [www.nimf.co.in](http://www.nimf.co.in).
- that the Complainant has prior rights in the trademark / acronym which precedes the registration of the disputed domain name by the Respondent.
- that the Complainant has therefore established a *prima facie* case that the Respondent have no rights and legitimate interests in the disputed domain name and thereby the burden of proof shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Domain Name.

- that the disputed domain name has been registered in bad faith
- that the disputed domain name is identical to the acronym of the Complainant's registered trademark in their entirety, in which the Respondent cannot have any rights or legitimate interest.

That I received no Response / Reply to the Complaint on behalf of the Respondent though proper service was effected to the Respondent's email addresses provided and I am satisfied that the Respondent has received the copy of the Complaint as well as the Order and direction of this Tribunal to submit his reply within 15 days of receipt of the Complaint and the email of the Tribunal. I have therefore proceeded only on the basis of available documents and assertions on the law and facts made before me.

### **DECISION**

- a) In view of the above facts and circumstances, it is clear that the Complainant has succeeded in its complaint.
- b) That the .IN Registry of NIXI is hereby directed to transfer the domain name/URL of the Respondent "[www.nimf.co.in](http://www.nimf.co.in)" to the Complainant;
- c) In the facts and circumstances of the case no cost or penalty is imposed upon the Respondent. The Award is accordingly passed on this 31<sup>st</sup> January 2021 .

Place: Delhi

Date: 31.01.2021



Dr. Sheetal Vohra

(PHD Law)

Sole Arbitrator

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