



सत्यमेव जयते

INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No. : IN-DL40833672916837T
Certificate Issued Date : 03-Feb-2021 03:24 PM
Account Reference : IMPACC (FR)/ dl916614/ DELHI/ DL-DLH
Unique Doc. Reference : SUBIN-DL91661483840859223995T
Purchased by : BINNY KALRA
Description of Document : Article 12 Award
Property Description : Not Applicable
Consideration Price (Rs.) : 0
(Zero)
First Party : BINNY KALRA
Second Party : Not Applicable
Stamp Duty Paid By : BINNY KALRA
Stamp Duty Amount(Rs.) : 100
(One Hundred only)



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

ARBITRATION AWARD
- IN REGISTRY
BEFORE THE SOLE ARBITRATOR, BINNY KALRA
DISPUTED DOMAIN NAME <www.american tower corporation.in>

Binny Kalra

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.
- 3 In case of any discrepancy please inform the Competent Authority.

**ARBITRATION AWARD
.IN REGISTRY**

(C/O NATIONAL INTERNET EXCHANGE OF India)

Before the Sole Arbitrator, Binny Kalra

Disputed domain name <**www. americantowercorporation.in**>

In the matter of:

ATC IP LLC
116, Huntington Avenue
Boston, Massachusetts 02116
United States of America

Complainant

vs

Pradeep Kumar
Sanjay Place, Agra
Uttar Pradesh 282005, India
Email: americantowercorporation@aaos.in

Respondent

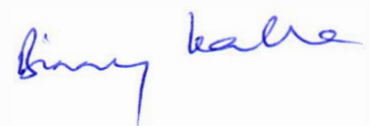
INDRP Case No: 1305

1. The Parties:

The Complainant is ATC IP LLC, which is said to be a part of the American Tower Corporation group of companies ("the ATC Group"), who is represented in these proceedings by M/s Mason & Associates, A-7 LGF, Sarvodaya Enclave, New Delhi 110 17. The Respondent is Pradeep Kumar, who has not made any representation either itself or through counsel during these proceedings.

2. The domain name, Registrar, and Policy:

The present proceedings pertain to a dispute regarding the domain name www.americantowercorporation.in (hereinafter referred to as the "**Disputed Domain Name**"). The Registrar for the Disputed Domain Name is GoDaddy.com LLC, having its address at First floor, 01A167, WeWork Bristol Chowk, Platina Tower, MG Road, Sector 28, Gurgaon, Haryana 122002. The present arbitration is being conducted in



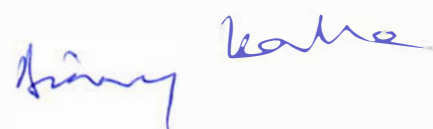
accordance with the Arbitration and Conciliation Act, 1996, the .IN Domain Name Dispute Resolution Policy ("**Policy**") and the INDRP Rules of Procedure ("**Rules**").

3. Procedural history:

- 14 December 2020: Consent of the arbitrator along with a declaration of impartiality and independence was given to the .IN Registry
- 16 December 2020: A notice from the .IN Registry to the parties informing them of the appointment of the arbitrator was sent along with the complete set of papers comprising the Complaint and its annexures.
- 17 December 2020: Notice of commencement of arbitration proceedings was sent to all parties by the arbitrator and a period of 30 days, until 15 January 2021, was given to the Respondent to submit a statement of defence
- 18 January 2021: No communication had been received from the Respondent by the stipulated date and even until 18 January 2021. A notice of forfeiture of the right to file a statement of defence by the Respondent was sent by email by the arbitrator to all concerned parties and the matter was reserved for passing an ex parte award.

4. The Complainant's case:



The Complainant claims to be part of the internationally well renowned ATC Group which started operations in 1995 and provides services of telecom infrastructure, mobile tower installation and related services to the telecom service providers and individual site owners. The Complainant states that the ATC Group has presence in 5 continents and 20 countries and a global portfolio of 181,000 telecom infrastructure and installation sites across the numerous countries. The ATC Group has operations in India through ATC Telecom Infrastructure Pvt. Ltd. ("ATC India") and has over 85000 installation sites in this country.



The Complainant has further made the following relevant factual claims, *inter alia*:

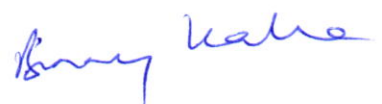
- The Complainant adopted the trade name AMERICAN TOWER CORPORATION at the time of its inception in 1995. It has several trademarks comprising of the words AMERICAN TOWER and/or acronym (which the Panel would characterize correctly as an *abbreviation*) of American Tower Corporation, either alone or in combination with different suffixes that are collectively referred to as the "American Tower Trademarks" in relation to telecom infrastructure and tower installation services.
- The Complainant has received awards and recognition for its consistent standards and excellence in the telecom infrastructure and services industry. Among these are:

- The Complainant is the registered proprietor of the trademarks in class 38 as set out at serial Nos. 1 to 4 in the table at page 6 and copies of the certificates

are filed as Annexure C. Specifically, these marks are  ,  and



- The Complainant is the owner/registrant of the domain names www.americantower.com and www.atctower.in screenshots of which are filed as Annexure D. The website at the domain www.americantower.com has been made available to internet users since October 1995. These web extracts also show the use of the American Tower Trademarks. Apart from these domain names, the Complainant also owns various other domain names comprising of AMERICAN TOWER or ATC with different suffixes. The registration details/WHOIS extracts of the American Tower Domain Names are filed as Annexure E.
- The ATC Group has been continuously using the American Tower Trademarks in India since 2005.
- The Complainant has acquired tremendous goodwill and reputation in the American Tower Trademarks by virtue of use for over two decades. Therefore



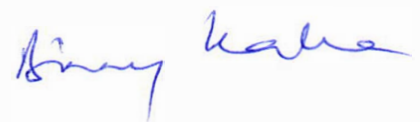
the American Tower Trademarks and the company name American Tower Corporation is exclusively associated with the Complainant and/or the ATC Group.

- The Complainant has instituted a lawsuit in the Delhi High Court regarding the domain name www.atcindiatower.in wherein an interim injunction was granted in its favour blocking the said domain name. A copy of the order is filed as Annexure F. Further, the domain name www.atc-tower.in was ordered to be transferred in the Complainant's favour by the Ld. Arbitrator in INDRP Case No. 1221 and a copy of the decision is filed as Annexure H.
- The Disputed Domain Name was registered by the Respondent on 31 August 2020. The WHOIS extract pertaining to the impugned domain name of the Respondent is filed as Annexure I. The Respondent has copied the American Tower Trademarks and the design and layout of the Complainant's websites at www.americantower.com and www.atctower.in. Screenshots of the Complainant's websites and those of the Respondent's website under the impugned domain name are shown at pages 11 to 17 of the complaint to illustrate the similarities between the two and a comparative chart is also filed as Annexure K.
- The Respondent's website give a near identical corporate address of the Complainant and reproduces its Bangalore office address.
- The Respondent has registered the Disputed Domain Name nearly 25 years after the Complainant's adoption and use of the American Tower Trademarks.

5. Legal grounds:

Under Paragraph 4 of the Policy, the Complainant must establish the following three elements to succeed:

- (a) the Disputed Domain Name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and
- (b) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and



(c) the Disputed Domain Name has been registered or is being used in bad faith.

6. Discussion and findings:

The Respondent has chosen not to participate in the present proceedings and has not filed any statement of defence. Therefore, the claims of fact made by the Complainant as summarized in paragraph 4 of this decision, shall be accepted by the Panel if they are found to be *prima facie* valid. The following discussion therefore proceeds on this basis.

A. Whether the Disputed Domain Name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights

The Disputed Domain Name is www.americantowercorporation.in. The Complainant has claimed statutory and common law rights in the marks AMERICAN TOWER and ATC by themselves and or with different suffixes. The evaluation of Issue A shall therefore be twofold:

a. Whether the Complainant has rights in the mark American Tower Trademarks

The Panel notes the following factors that are most relevant to establish that the Complainant has rights in the American Tower Trademarks:

- Indian trademark registration Nos. 1406882 and 1406881 for the marks



and



,

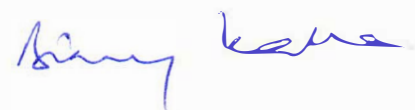
respectively, in class 38. While the said registrations do not give the Complainant a right to the exclusive use of the word "American" per se, the combination of the words "American Tower Corporation" in the manner represented has clearly been granted protection. Pertinently, Section 28 of the Trademark Act 1999 confers on the registered proprietor the exclusive right to the use of the mark for the goods and services for which it is registered. The Hon'ble Supreme Court in *Satyam Infoway Ltd. v. Sifynet Solutions (P) Ltd.* [(2004) 6 SCC 145] has held that, in relation to commercial activity on the internet, domain names are used as business

Romy Lake

identifiers and that where domain names are used in connection with a business, the value of maintaining exclusivity becomes critical;

- The domain name www.americantower.com was registered as far back as 17 October 1995 by the Complainant and the Complainant owns and operates *inter alia* websites at the domain www.americantower.com and www.atctowerindia.in;
- The ATC group is an established provider of telecom infrastructure, mobile tower installation services and related services and has been carrying on its business under the American Tower Trademarks for around 25 years. The Panel viewed the website and the history of the Complainant at <https://americantower.com/company/history.html>, and found this claim to be reasonably substantiated;
- The Complainant started operations in India in 2007 (Annexure-D at page 45).
- The Complainant has a valuable goodwill and reputation under the American Tower Trademarks and these marks are exclusively associated with the Complainant and or the ATC Group and its services arising from long and continuous use, active presence in over 20 countries and 181,000 telecom infrastructure and installation sites worldwide. There are 75000 installation sites in India, as per the extracts of the Complainant's website filed as Annexure-D (at page 45). Validation from the industry of the Complainant's standards of quality and services also bears out the goodwill and reputation of the American Tower Trademarks; and
- The Complainant has enforced their trademark rights against third parties using infringing domain names, including:
 - i. Before the Hon'ble High Court of Delhi, in CS (Comm.) 246 of 2019, securing an interim order of injunction against the infringing domain names www.atcindiatower.in and www.atctower.in.net.
 - ii. Before the .IN Registry, in INDRP/1221, against the infringing domain name www.atc-tower.in.

The Panel finds each of these claims to be *prima facie* valid, based on the documents placed on record as Annexures B to K to the Complaint. It is noted that the details of the Registrant are masked in the Whois record for the domain name



www.atctower.in (Annexure-E to the Complaint) however the claim made by the Complainant as to its ownership of the various domains *inter alia* comprising the mark 'American Tower' is accepted. In view of the above noted factors, the Panel finds that the Complainant has statutory and common law rights in India, together with widespread goodwill and reputation in the American Tower Trademarks, which entitle it to claim protection for a domain name incorporating its trademarks.

b. Whether the Disputed Domain Name is identical and/or confusingly similar to the American Tower Trademarks

As the result of independent analysis, the Panel finds that the Disputed Domain Name is confusingly similar to the American Tower Trademarks and agrees with the claims made by the Complainant for the following reasons:

- The Disputed Domain Name www.americantowercorporation.in wholly contains the words "American Tower Corporation", which is protected under trademark registration No. 1406681 in favour of the Complainant. The Disputed Domain Name also wholly incorporates the words "American Tower" which are subject matter of the Complainant's trademark registration No. 1406682;
- The Panel accepts that the American Tower Trademarks are exclusively associated with the Complainant and it is likely that consumers who access the website corresponding to the Disputed Domain Name will associate it with the Complainant or believe it to be that of the Complainant.
- The Complainant's claim insofar as it relies on the similarity in the lay out /look and feel between the websites corresponding to the Disputed Domain Name and the Complainant's website www.americantower.com, though not relevant to the analysis of whether the Disputed Domain Name itself is identical or confusingly similar to the Complainant's mark, is relevant for the purpose of analysing whether the Disputed Domain Name has been registered or is being used in bad faith by the Respondent, as discussed below.

For the above reasons, the Panel finds that the Disputed Domain Name is confusingly similar to the American Tower Trademarks in which the Complainant has rights.



B. Whether the Respondent has any rights or legitimate interests in respect of the Disputed Domain Name

As stated earlier, the Respondent has not submitted its defence or responded to the Notice of Arbitration.

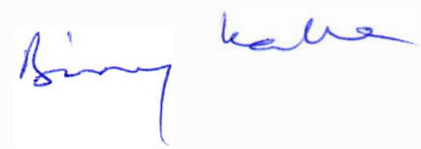
From a neutral viewpoint, it appears unlikely that the Respondent came up with the unusual combination of the words 'American' and 'Tower' without any knowledge of the Complainant's prior use of and rights in the said mark in respect of telecom infrastructure and mobile tower installation, especially since the Respondent is using the Disputed Domain Name for a website that offers wireless communications infrastructure, and the Respondent has copied the Complainant's addresses on its website. Moreover, the Respondent is not known by the name 'American Tower'. The reasoning in *Nationwide Mutual Insurance Company v. WhoisGuard, Inc. / Onofeghara Wisdom, Onofegharawisdom Company lmt, Case No. D2019-0748* seems apt for the facts of this case.

From the documents on record it does not appear that the Respondent is making a legitimate non-commercial or fair use of the domain name, rather its use appears to be with intent for commercial gain by misleading and diverting consumers to itself by the use of the trademark at issue.


Taking into account the uncontroverted claims in the complaint and the documents placed on record by the Complainant at Annexures B to K, and absent any contradiction by the Respondent, the Panel *prima facie* finds a lack of any rights or legitimate interest in the Disputed Domain Name by the Respondent.

It would be reasonably expected of any entity who claims any rights or interest in any asset such as a domain name to defend such right or interest, when challenged. Therefore, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

C. Whether the Disputed Domain Name has been registered or is being used in bad faith

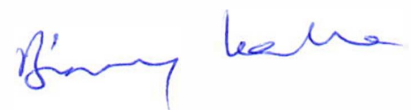


A perusal of Annexure K to the complaint, consisting of webpage extracts from the website corresponding to the Disputed Domain Name, unequivocally demonstrates that the Disputed Domain Name is used in relation to a website which:

- Prominently features on the home page the marks  AMERICAN TOWER / 'American Tower Corporation' which are identical to the Complainant's marks;
- Makes a contrived representation on the 'About Us' page that "American Tower Corporation, is a leading Service Provider for the Erection, Commissioning, and Installation of the Telecom Towers and Allied Infrastructure in India since 2007";
- Gives an identical Gurgaon address as that of the Complainant on the 'Contact' page. Under the city name mis-titled 'Delhi', the Respondent also gives an identical address of Bangalore as that of the Complainant.
- Offers financial benefits and high returns on investment to customers while misrepresenting itself as being associated with or part of the Complainant's business;

The above observations demonstrate that the Respondent's use of the Disputed Domain Name appears to be in bad faith and even the website at the Disputed Domain Name appears to have several elements that are deceptively similar to those of the Complainant's website www.americantower.com. Given the extent of copying from the Complainant's website on the Respondent's website, including the prominent use of the American Tower Trademarks, the Respondent's actions seem to be deliberately designed to create confusion.

Based on this conclusion and considering the confusing similarity between the Complainant's American Tower Trademarks and the Disputed Domain Name, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith.



7. Decision: For the reasons discussed above, the Panel finds that the Complainant has satisfied all three elements required under Paragraph 4 of the Policy to obtain the remedy of transfer of the Disputed Domain Name.

Therefore, the Panel orders that the Disputed Domain Name <**www.americantowercorporation.in**> be transferred to the Complainant.

Further, in view of the egregious copying by the Respondent which makes it clear that it has actively sought to cause confusion and gain financially by the use of the Disputed Domain Name, and given the potential of significant harm to customers who may be misled by the Respondent's misrepresentations, the Panel deems this a fit case to impose costs on the Respondent. Accordingly, it is hereby ordered that the Respondent shall pay to the Complainant the cost of filing the complaint in the sum of Rs. 30,000.

Signed:



Ms. Binny Kalra

Arbitrator

Date: 3 February, 2021