

**BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)
IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)**

Dr. Vedula Gopinath, Sole Arbitrator

Arbitration Award No. INDRP/1340 Dated April 3, 2021

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Dr. Vedula Gopinath
Sole Arbitrator

ARBITRAL TRIBUNAL
Dr. VEDULA GOPINATH
SOLE ARIBITRATOR



ఆంధ్రప్రదేశ్ ఆంధ్ర ప్రదేశ్ ANDHRA PRADESH

SL No. 1472 Date 18-3-2021 Rs. 100/-

Sold To: Dr. Vedula Gopinath

For Whom: Self. S/o: V.K. Chenu (late), VSP.

T. Kiran
CP 357132

Smt. TURAGA KRISHNA VENI
Licensed Stamp Vendor

L.No.03-13-005/2016 R.L.No.03-009/202
26-05, LIG-5, Simlapur Veda Colony
Vepagunta, Gopalapatnam, Visakhapatnam
Cell: 9951030195

BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)
.IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)

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Arbitration Award No. INDRP/1340 Dated April 3, 2021

In the matter of Arbitration Between:

Surya Roshni Limited
Corporate Office: Padma Tower 1
Rajendra Place,
New Delhi-110008. India

... Complainant

AND

Group Surya
Corporate Office: A24 HIG Duplex
Phase 2 Ananta Vihar
Pokhariput Odisha - 751020

... Respondent



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Group Surya
Registered Office
2nd Lane, Gandhi Nagar,
Berhampur
Odisha – 760001

Group Surya
Manufacturing Unit
Plot No.4, Ashok Vihar Phase 3
Gurgaon Haryana 122022

I. THE PARTIES

- a. Complainant Surya Roshni Limited Authorised representative in these administrative proceedings is:

Mr. Shrihar Tripathi Advocate
BOOST IP – Advocate & IP Attorneys,
A – 303, Shikhar Enclave, Sector – 15,
Vasundhra, Ghaziabad,
D E L H I / N C R – 201012
Email: legal@boostip.in

- b. Respondent Group Surya authorised representative in these administrative proceedings is:

Ms. Kangan Roda Advocate (D/1377/2014),
Illumin IP, A – 21, East of Kailash,
New Delhi – 110065.
Email: infor@illuminIP.com
Mobile No. 09711922132

II. DISPUTED DOMAIN NAME & REGISTRY:

The following Domain name is the subject of this Complaint.

www.groupsurya.co.in

The Registry is the National Internet Exchange of India (henceforth referred to as ~~NIXI~~).



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The sponsoring registrar with whom the domain name is registered is indicated as "Endurance Domains Technology LLP".

Web page details of disputed domain name were annexed as Annexure - B of Complaint.

III. PROCEDURAL HISTORY / BACK GROUND:

25-02-2021	The .1N REGISTRY appointed Dr. Vedula Gopinath as Sole Arbitrator from its panel as per paragraph 5 of INDRP Rules of Procedure.
23-02-2021	Consent of the Sole Arbitrator along with declaration was given to the .1N REGISTRY according to the INDRP Rules of Procedure.
25-02-2021	.1N REGISTRY sent an email to all the concerned intimating the appointment of arbitrator. On the same day, the complete set of the soft copy of the Complaint with Annexure was sent to Respondent.
27-02-2021	Notice of Arbitration was sent to all concern by the Sole Arbitrator.
02-03-2021	Notice was sent by Arbitrator to the Respondent by-mail directing him to file his response within 10 days, marking a copy of the same to the Complainant's representative and .1N Registry.
05-03-2021	Time extension for Defence Statement per request from Respondents.
15-03-2021	Defence Statement – Respondent received
20-03-2021	Rejoinder by Complainant. Received
22-03-2021	Addl. Time given to parties for addl. Information
25-03-2021	Both Parties furnished additional information

All communications and pleadings are sent through electronic mail only.



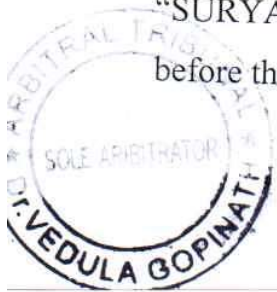

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5. COMPLAINANT ACTIVITIES:

The Complainant Company M/s. Surya Roshni Limited is one of the largest Indian Multinational with a revenue of USD\$840 Million Crores for the year ending 2018-19, which was setup in the year 1973 with a small steel pipe unit. The Complainant began its lighting business in the year 1983 with the setting up its lighting products factory manufacturing facilities. The Complainant Company and their predecessors-in-title have been carrying on the business of manufacturing marketing, Exporting of variety of products such as Heating Products including Water Heaters, Geysers, Immersion Heaters, Room Heaters, Air Heaters and many more tec., and various other Electrical Devices and Equipment's. And also PVC Pipes including CPVC and Fittings, UPVC Pipes, Pressure Pipes and Fittings, Expansion Loop etc., since year 1973 and thereafter. The "SURYA" Brand was claimed to be a Household Mark through its use in almost every home since 5 decades of legacy in the Indian Market. All the said goods and Services of the Complainant are well covered in Trademark Classes from 1 to 42 of the Trade Marks Act, 1999. Over the years and decades, the Complainant has grown into a leading player in the business of Heating Appliances, Lighting and Home Appliances apart from other Sectors. The Complainant not only caters to the Indian Public, but has presence in around 44 Countries.

6. COMPLAINANT'S TRADE MARKS & DOMAIN NAMES:

That a Complainant owns and maintenance a Website www.surya.co.in which is the Corporate Website of the Complainant and detailed information about history, activities, products etc., of the Complainant can be obtained there from and the Website acts as Medium of Communication. The Complainant is the Owner and the Registered Proprietor of the well-known Trade Mark "SURYA" and variants thereof, which are registered under different classes before the Trade Mark Registry since as early as the year 1981.



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The Word "Surya" also forms a forepart and is the most distinguishing feature of the Complainants Corporate name and trade style. The trade mark "SURYA" has been registered in India since as early as the year 1981 and has been maintained continuously.

7. THE CONTENTIONS OF THE COMPLAINANT:

- a) The disputed Domain Name www.groupasurya.co.in owned by Surya Group. The Complainant is the owner and the Registered Proprietor of the well-known Trade Mark "SURYA" and variations thereof, which are registered under different classes before the Trade Mark Registry since as early as the year 1981.
- b) The word "SURYA" also forms a forepart and is the most distinguishing feature of the Complainants Corporate name and trading style. The Trade Mark "SAURYA" has been registered in India since as early as the year 1981 and has been maintained continuously since those days by the Complainant.
- c) The Complainant Sales, markets and promotes its wide range of products and related services through a number of Authorized Partners, Dealers, Retailers, both Physical and Online Resellers through Amazon, Flipkart, Snapdeal etc., The Complainant takes care for protecting the Consumers Rights and takes appropriate action for protecting its Brands.
- d) The Complainant is very active and vigilant in enforcing and protecting its rights in its mark "SURYA" & "SURYA ROSHNI" (As per Annexure – D of the Complainant).



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- e) The Complainant has obtained few Arbitral Awards against false domains which were similar / identical to Complaint's Domain. Copies of Awards in INDRP Case No. 1291 & 1294 are Annexed as per Annexure – E of the Complaint.
- f) The Complainant Claims that, their Products and Services Branded under the Trademark "SURYA" are immensely popular amongst the customers.
- g) The Complainant has obtained various Trade Mark SURYA and various SURYA formative marks in various classes viz. Class 09, 11, 20, 35 & 37, details of which were given in the Complaint. Complainant also holds registrations under Copyrights Act .However, copies of Certificates were not furnished due to limit of number of pages as per INDRP Rules.
- h) The Complainant confirms that, the aforesaid registrations for the Trade Mark "SURYA" have been Renewed from time to time and are valid and subsisting.
- i) In view of the various Registrations and Extensive Sales, Publicity and Marketing, its Mark "SURYA" it earned substantial Reputation and Goodwill and Complainant Claims that, Mark "SURYA" has become a well-known mark.
- j) The Complainant came across an imposter website registered under the Impugned domain name with the Respondents, the Complainant noted that, the Respondents has created domain which is infringing upon the registered trademark of the Complainant including inter alia :
 - i) Using the Complaint's Registered Trade Mark and well-known brand "SURYA" as the most prominent part of the impugned domain name.




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- ii) The Complainant alleges that, the Respondent used the Complainant's Registered Trade Mark on the said Website for promoting goods and services, which were identical to the goods and services of the Complainant Company in respect to its Brand "SURYA".
- iii) The Complainant alleges that, the Respondents Domain as "GROUPSURYA.CO.IN" which is prima facie similar / identical to the Complaint's Domain "SURYA.CO.IN" for the identical goods and services.
- k) The Complainant further alleges that, the Disputed Domain Name (www.surya.co.in) having "SURYA" Registered Trade Mark, the Customers and Internet Users may take it as that, the Domain Name belongs to Complainant and believes that, the Respondents Business is closely associated and another vertical of Complainant and also thinks that, the Respondent is providing Quality Products and Services as provided by the Complainant.
- l) The Complainant alleges that; the Respondent has adopted the disputed domain name with mala fide to:
 - i) Impersonate itself as the Complainant;
 - ii) Misrepresent itself and Pass off its unauthorized, spurious and substandard products and services as that of the Complainant; and
 - iii) Misappropriate the Complainant's reputation, goodwill and customer loyalty for its own wrongful profits.
- m) The Complainant alleges that, the Respondent has no right or legitimate interest in respect of the impugned domain name, other than that of reaping undue benefit.
- n) The Complainant impugned domain name is registered under bad faith and prayed the forum to delete or transfer the same to the Complainant.



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8. **RESPONDENT's DETAILS:**

- a) The Respondent is an Engineering Procurement and Construction management company dealing installation and maintenance of Solar Power Plants, water plants, construction machinery, water storage plants among others.
- b) The origin of Surya Name, according to the Respondent, emanates from Mr. Surya Nath Singh which is the name of his father. His sons, namely, – Mr. K.K. Singh, Mr. A.K. Singh and Mr. B.K. Singh, respectively and three sons have started their business under the umbrella brand SURYA, namely, SURYA INTERNATIONAL, SURYA INDUSTRIES and SURYA INFRASTRUCTURE (details as per Annexure D of the defence statement)
- c) With the growing popularity of the Respondent's brand GROUP SURYA, the website containing the GROUP SURYA domain name GROUPSURYA.CO.IN was created and launched by the Respondent in the year 2012.
- d) In the year 2016-2019, the Respondent expanded the business in the field of water treatment plant and made expansion of the business. (Details As per Annexure E of the defence statement)
- e) The Respondent claimed to have obtained numerous accreditations/certifications from standard institutions in India including ISO-9001 & 14001, IS-16046 from the Bureau of Indian Standards, Quality Management system. (As per Annexures F and G of the defence statement.)



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- f) The Respondent has taken up various government projects and government of India undertaking projects. The respondent claims to have executed rooftop solar PV System for Railways and other government undertakings. (As per Annexure H of the defence statement).
- g) The Respondent confirms that the respondent is the rightful owner and prior and extensive user of the trade mark “**SURYA INTERNATIONAL (DEVICE)**”, in India in classes 43 and 40 the details of the relevant registrations and pending applications for registration are tabulated herein below:

Trademark	Number	Date	Class	Goods	Status
SURYA INTERNATIONAL	3959293	28-09-2018	43	Services for providing food and drinks, temporary accommodation	Registered
SURYA INTERNATIONAL	3959292	28-09-2018	40	Metal fabrication and finishing services, custom steel rolling and fabrication to the order and specification of others.	Registered

The said trade mark registrations have been renewed from time to time and are valid and subsisting as of this date.




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Pending Applications for registrations.

Trademark	Number	Date	Class	Goods	Status
SURYA INTERNATIONAL	4317754	11-10-2019	09	Lithium-ion Batteries Pending	
SURYA INTERNATIONAL	4323151	17-10-2019	20	Plastic water tanks Pending	

- h) The Respondent claims that they have achieved sales turnover of Rs.150 Crores between the years 2012 and 2020-21.
- i) The Respondent asserts that they have incurred sizeable amount on promotion and advertisement costs the details of which are mentioned in Annexure I to the defence statement.
- j) The Respondent asserts that the respondent has achieved implementation of various solar power projects as per Annexure J of the defence statement, besides products and services under the mark SURYA INTERNATIONAL which were listed on various third party websites like www.indiamart.com and social media websites as per Annexure K of the defence statement.
- k) The Respondent claims that the mark SURYA INTERNATIONAL and its distinctive logo are being relied upon, as a result, the said trademarks and logo have acquired goodwill.


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9. RESPONDENT'S CONTENTIONS:

- I) The respondent alleges that the claim of the Complainant is denied as the complainant has blatantly misrepresented in the Complaint that they are the registered proprietor of the trademark SURYA since the year 1981 and the same is being maintained continuously since then. In this regard, the following information given;
- i) The current status from the Trade Marks registry websites shows the mark SURYA (word) bearing no. 384887 dated January 2, 1982 in class 9 reads as "EXPIRED" on April 1, 1992 and for the mark SURYA (Label) bearing no. 552868 dated June 17, 1991 in class 11 reads as "EXPIRED" and thus it is clear that the present Complaint has been filed with *mala fide* intention.
- ii) The Complainant's contention that the trademarks are valid and subsisting and that the Complainant has exclusive right to use the trademark "SURYA" in relation to the goods for which the trademark has been registered are not true and correct/
- a) Registration bearing number 472227 for the mark SURYA (WORD) in class 9 dated May 14, 1987, claiming use since October 30, 1984 – RECTIFICATION FILED.
- b) Registration bearing number 440572 for the mark SURYA / in class 11 dated May 14, 1985, claiming use since October 30, 1984 – RECTIFICATION FILED



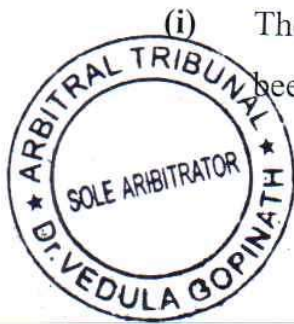

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- c) It was further alleged that the Complainant has suppressed and misrepresented the actually trademark applied for and/or registered. The following are the applications/registrations showing the actual representation of the trademark:

Trademark No.	Date	Trademark misrepresented by the Complainant	Actual Trademark Applied
8945539	07-08-2000	SURYA	
1303269	18-08-2004	SURYA CHALLENGER & DEVICE OF SUN (DEVICE)	

(In this connection, ANNEXURE - "L" of the Defence Statement refers).

- II. The respondent submits that the trademark in question is "SURYA". The word Surya is a generic word which means the Sun, the source of life on the planet and the Hindu deity. It is most humbly submitted that Surya is one of the five basic elements of life in other words Panch Tattva's of life i.e., Fire (Agni), Air (Vayu), Water (Jal), Earth (Prithvi) and Ether (Akash). The word Surya i.e., the sun represents the "Agni" Tattva of life which is one of the basic elements of life. No monopoly can be claimed by the Complainant over the word SURYA as the word SURYA is in the Indian context is so common that it has attained a status of *public juris* in other words "of public right".
- III. The respondent states that the Complainant has chosen to use a name which has been widely used by other manufacturers, as shown below: -



- (i) There exist more than 200 companies wherein the word SURYA has been used. ANNEXURE- "M" of the Defence Statement.

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- (ii) With regard to domain names, the respondent assets that a search conducted for the domain names containing the word SURYA revealed numerous third parties domain names consisting of the word SURYA as follows

Sl. No.	Domain Name	Representation used for the word SURYA	Nature of Business
1	https://www.surya.com/		Home Accessories, table lamps, lamps, lighting, ceiling lights
2	https://www.surya.edu.in/		Education
3	https://surya.ai/		Technology
4	https://groupsurya.in/		Contractors
5	https://suryagroup.edu.in/		Education
6	https://suryagroupindia.in/		Apartments
7	http://www.suryagroup.co.uk		Residential & Commercial Complexes.
8	http://suryagroup.net.in/		Logistics Support & Godown Workstation

ANNEXURE- "N" of the Defence Statement.




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- IV. It is further submitted that a public search conducted on the official website of the Trade Mark Registry for the trade marks containing the word "SURYA" in Classes 9, 11, 20, 35 and 37 revealed the following results:

Class No.	Number of Trademarks containing the word "SURYA"
Class - 09	230
Class - 11	575
Class - 20	47
Class - 35	208
Class - 37	69

- V. In addition to the above, a search was also conducted on the website of World Intellectual Property Organisation (WIPO) on the IP portal, which revealed that more than 1500 trademarks registered/pending registration by various third parties across the world. **ANNEXURE-"O" of the defence statement.**

- VI The respondent makes comparison of its mark with that of Complainant as under:

Complainant's Representation of the word SURYA	Respondent's Representation of the word Suraya
SURYA "Energising lifestyles"	Group Surya "sun" along with waves encircling the letters "S" and "i" along with words "Group Surya"



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From the above, the following points of dissimilarity as claimed by Respondent.:

Sl. No.	Criteria	Respondent	Complainant
1	Logo	unique and distinct logo showing a representation of sun along with waves encircling the letters "S" and "i" along with words "Group Surya"	representation shows use of the word SURYA along with a tagline "Energising Lifestyles"
2	Representation	the colour combination of Black, Orange, Yellow and Blue, which is highly distinctive and unique, thereby making the two rival marks visually, structurally and conceptually different from each other.	use of the colour red to represent the word Surya and black colour to represent the tag line.
3	Font, Colour and Stylization	-	visually, structurally and conceptually different from the Respondent's representation of the word SURYA;
4	Area of Business : Products and Services offered	Solar Pumping Systems, Solar Home Light Systems, Solar Street Light & Pole, Fibre Reinforced plastics, HDPE Pipes, Water Storage Tanks, Lithium Ferro-Phosphate Battery; Water Treatment Plant, High Mast Lighting Pole etc.	lighting, steel pipes & CR strips, PVC pipes, Fans, Home Appliance
5	Business Model		B2C Business to Customers



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VII. The respondent affirms that the Complainant has not been able to establish, that the word SURYA has acquired secondary distinctiveness.

VIII. The respondent states that the Respondent has taken all the necessary steps to indicate to its consumers very categorically that the origin of the goods is M/s. Surya International, by using the word Surya International in its trademark. It is most humbly submitted that there is nothing to show that the usage of the impugned domain name www.groupasurya.co.in is in any manner dishonest or lacks any *bona fide*.

IX. The respondent vehemently comments that the complainant approached this Forum after almost ten years of the registration of the domain name i.e., in the year 2012 and alleges that Complaint suffers from delay and acquiescence. The respondent relies on the observation made by in (1896) 13 R P C 464, Rowland v. Michell, wherein Romer J. observed that:

"If the plaintiff really does stand by and allow a man to carry on business in the manner complained of to acquire a reputation and to expend money he cannot then after along lapse of time, turn round and say that the business ought to be stopped."

the respondent further comments that the complainant cannot take action against the mark 'Group Surya'.

XI. The respondent challenges the complainant to show any document showing there have been any misappropriation on their reputation goodwill or customer loyalty for any wrongful profits.

Para-wise reply to the Complaint also given by the respondent.



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10. REJOINDER BY COMPLAINANT ON THE DEFENCE STATEMENT:

1. Complainant reiterates their ownership of Trademarks mentioned in Complaint.
2. Complainant alleges Respondent is a Director in few companies which was not disclosed.
3. Complainant alleges that Respondent does not have trade mark for their goods and services under the disputed domain name.
4. Complainant alleges dishonesty on the part of Respondent by adding Group to the complainant's trade mark SURYA. and claims label of respondent is similar to that of Complainants label.
5. Complainant alleges deception on the part of Respondent and relied on INDRP cases INDRP/278 and INDRP/240 saying it is adequate to prove that the disputed domain name is either identical or confusingly similar to the trade mark.
6. Further stated that the domain names www.surya.co.in www.groupasurya.co.in GROUP SURYA INTERNATIONAL bound to create confusion and deception in minds of public and relied on INDRP awards referred aforesaid.
7. Complainant delay of raising complaint explained stating that they had seen the Google ads recently and raised the complaint.




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8. Respondents view that their goods are different from that of Complainants is and referred to INDRP/1291 case, copy of which was attached to Complaint.
9. Complaint denied the contention of Respondent that SURYA is a generic word.
10. It was denied that SURYA name is commonly used by many as corporate name and trademark and comments there was no evidence given.
11. Complaint claims to have fulfilled the conditions of Paragraph 4 of .IN Domain Name Dispute Policy.
12. Further the contents of defence statement are denied and given para-wise comments of defence statement.

11. ADDITIONAL INFORMATION FURNISHED BY THE PARTIES:

Parties were given opportunity to submit additional information. However, parties have furnished information outside the scope of their pleading. Hence, information submitted has been condensed so as to confirm relevancy of the case.

A) COMPLAINANT:

- i) The Complainant reiterates to have enviable goodwill a reputation for their Trade Mark "SURYA" which has become Household name and the Respondent is infringing their Trademark.



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- ii) The Complainant further reiterates that, the disputed domain name is bound to create confusion and deception in the minds of public. That the Respondent has some connection with Complainant Asserts that, they have complied with the three elements of Paragraph 4 of the .IN Domain Name Dispute Resolution Policy (INDRP).
- iii) The Complainant alleges that; the Respondent did false comparison of their goods and services to the goods and services of the Complainant.
- iv) To justify the delay involved in the Complainant, the Complainant says that, they have acted basing on reference on Google Adds by Respondent in December, 2020.
- v) The Complainant reiterates that "SURYA" is an Arbitrary Trademark as per settled law; Arbitrary Mark when applied in an unfamiliar way is entitled for maximum protection.
- vi) The Complainant Asserts that, there is no proofs that Trademark "SURYA" is used by third parties and Complainant is not supposed to chase insignificant strangers and quoted few presidents to support their case.
- vii) The Complainant object that, the Respondent cannot quote or rely upon any case judgments at a later stage, when the same was not mentioned in their Defence Statement.
- viii) The Complainant relies on INDRP Award 1291/2021 submitted along with Complaint (SURYA ROSHNI Vs SURYA EQUIPMENTS Pvt. Ltd.,).





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B) RESPONDENT:

- i) The Respondent says that, the Complainant failed to establish the requirements laid down in Paragraph 4 of .IN Domain Name Dispute Resolution Policy (INDRP).
- ii) The Respondent alleges that, the Complainant does not hold any Trademark Registration in Classes 20, 35 & 37. Further, the word mark SURYA in Class 9 was not renewed and hence the Complainant cannot claim the same now. Further, the Trademark "SURYA" in Clause 9 & 11 have been obtained in respect of goods which are different from the goods and services of the Respondent.
- iii) The Respondent Asserts that, "SURYA" mark is not a well-known mark under Section 2.
- iv) The Respondent is prior adopter of marks "GROUP SURYA / SURYA INTERNATIONAL".
- v) The Respondent reiterates that, "SURYA" word is generic word (Source of Planet) and thus, no monopoly can be claimed.
- vi) The marks and signs of "SURYA" have been differently and dissimilarly represented in the marks. A comparison is to be done to see if the two marks are structurally and visually similar as well as aurally similar and easily give rise to deception and confusion.
- vii) A detailed picture of the products of the Complainant and Respondent have been given by the Respondent to show that, both the goods bear no visual similarity of the products.




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- viii) The Respondent further submitted that, various third-party domain names containing the word SURYA are co-existing having a completely different manner of representation of the word SURYA.
- ix) The Respondent quoted few judicial precedents to support their case.
- x) The Respondent submits that, the Complainant has prima facie failed to show that, the Respondent lacks rights or legitimate interest in the Domain Name www.groupsurya.co.in.
- xi) The Respondent reconfirms that, he has adopted and commenced use of brand GROUP SURYA since the year 2012. It is further submitted that, the rationale behind adoption of the mark GROUP SURYA is to represent the group of all the entities under the umbrella brand SURYA, i.e. SURYA INTERNATIONAL, SURYA INDUSTRIES and SURYA INFRASTRUCTURE, which are being managed and operated by three brothers. It is further reiterated that, the Branch "SURYA" has been adopted after their Father's Name i.e., Mr. Surya Nath Singh.
- xii) The Respondent further reiterates that, he is carrying on genuine business by providing goods and services to the Government entities and obtained numerous standard and quality certifications.
- xiii) The Respondent confirms that he is the rightful owner and prior and extensive user of the trade mark "SURYA INTERNATIONAL (DEVICE)", in India in Classes 43 and 40. The said trade mark registrations are valid and subsisting.
- xiv) The Respondent Assets that, their Domain name www.GROUPSURYA.CO.IN has acquired distinctiveness and the Respondent is commonly known by the domain name.




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- xv) The Respondent Domain Name is a unique combination of two word "GROUP" and "SURYA". The combination of the two word together makes the domain name distinctive and therefore, the Respondent has legitimate rights and interests in the Domain Name WWW.GROUPSURYA.CO.IN.
- xvi) The Respondent submits that, the Complainant targets Household goods, whereas, the Respondent targets various Government's Agencies and deals with Industrial Projects, therefore,, under no stretch of imagination there can be any confusions as to the similarity between the rival domain names or as to the origin of the goods.

12. DISCUSSIONS FINDINGS / REASONING

1. In the matter of adjudication of domain name disputes by the Arbitral Tribunal Trade mark law is the enabling Statute in the absence of separate law for Domain Names apart from the. In Domain Dispute Resolution Policy (INDRP) Procedure and Rules and United Name Dispute Resolution Policy
2. In India, business names are emanated mostly from family ancestral personalities, Planets, Deities, nature of activity and such names constitute the factors for christening the business brands, marks, logos, domain names. When a business unit registers a Brand, Mark or Logo the same can be used by their related business units by way of franchise, licence or other internal arrangements. In the Present case the name SURYA gained importance and became the focal point of the case.




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3. The disputed party's business activities and dealings are mostly different in nature with negligible similarities and dealings. While the focus of the business activity of complainant is targeted on Consumer Electronics, house hold electrical equipment and exports to various countries whereas the main thrust of respondent is Rural Electrification, Rural Infrastructure and Water Management amongst others. Thus the respondent organisation is a horizontal segment in nature and not vertical line of business as apprehended by the complainant. The respondent activity appears to be supplementary and complimentary in nature and there appears to be minimal inter-competition and there is a possibility of lack of effective competition.
4. While the Complainant turnover is reported as Rs.6000 crores, the Respondent group turnover comes to Rs.150 crores. Both parties did not submit evidences for the turnover. Also, both parties are having subsidiary companies, joint ventures, associated firms, Related Party business units which aspect is not taken into consideration in the light of the **doctrine of indoor management**. Their disclosures in the pleadings forms the basis for arriving conclusions by the Arbitral Tribunal.
5. It is the matter of gratification to note that both the parties are contributing to the ameliorative action of harnessing natural resources employment generation and contributing to economic development and rural upliftment.



It is observed that the Logos, Marks, Signs, Designs, Devices of both parties are in different way. Some of the marks are represented in


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round shape and the other is in square, or rectangle form and letters SURYA are written in different way, lines drawn to represent Sun rays, apart from colour combinations. Justification for similarity and duplicity of the marks cannot be given or explained from the visual appearance.

7. There have been quite number of domain names including the name SURYA in their business domain names in various segments such as Education, Real Estate, Housing Manufacturing etc. Recently the Arbitral Tribunal came across a domain name www.m.suryaa.com operating a Telugu daily Newspaper including electronic edition claiming large readership in Andhra and Telangana States apart from Telugu people in other parts of the World over. Since the Registering Authorities shall approve and allot the domain name on FIRST COME FSIRST SERVE basis, it is for the applicant to choose the domain name to suit the business requirements. In case of dispute, the validity of the domain name shall stand to test and survive basing on their Trae marks registration background if available. Further there are number of companies incorporated in India with SURYA name as per the information of Ministry of Corporate Affairs, Government of India.


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8. The aforesaid background made the Arbitral Tribunal to believe that SURYA name is a generic and general usage name and one cannot claim any monopoly or exclusive ownership on the same. Subsequently this view is authenticated by judicial pronouncement and reviews.
9. Both parties levelled allegations and counters on each other saying that certain Trade Marks are not valid and subsisting and non-renewal or pending with Trade Mark authorities' queries. The Arbitral Tribunal made an independent search of the Trade Mark Registry trademarks and come to the conclusion that both parties are having valid Trade Names, devices, logos with SURYA name and also the details are unable to be published here in view of disclaimer of NO LEGAL use by the authorities. Some of the Trade Mark Applications of both parties are pending for registration. Also the Arbitral Tribunal gone through the well-known trade mark list of Registry 97 well-known trademarks list and the SURYA name is isolated from this list and thus it can be concluded that the mark SURYA is not a well-known trade mark. In the alternative SURYA name can be termed as a generic name.
10. Respondent registered the domain name [www: groupasurya.co.in](http://www.groupasurya.co.in) in 2012. Complainant registered domain name www.surya.co.in much earlier to 2012. Both parties are carrying on their own businesses independently without any Inter-connection or mutual relationship.
11. The Arbitral Tribunal has observed that the Complainant complied with the first element of Paragraph 4(a) of the .INDRP policy to a




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reasonable extent. It was further observed that the Respondent is having legitimate rights on the disputed name as owner and holder of valid Trade Mark registrations and pending Trade Mark applications.

12. a). Claimant furnished award copy 1291 of INDRP Surya Roshni Ltd. Vs Roshni equipment Pvt.Ltd. and other. While the award is commendable as it is published with cogent reasons, the Arbitral Tribunal opines that this award does not find it applicable to the present case. It may be noted that the Respondent in the quoted award does not have Trademarks or even applied for Trade Marks. Further, lack of legitimate rights and bad faith were proved. In the present case the Respondent possesses valid and subsisting trademarks and pending trade mark applications apart from having legitimate rights in the domain name and bad faith was not proved at all.
- b) Also, another quoted award dated 14- 01-2021 Surya Roshni Limited vs Surya Electro Controls was not taken into account for the present case as the award was decided ex-party basis and there is no opposition or reply from the Respondent in the case.
13. It is to be noted that whether the domain name under reference and respondent's trademarks have been registered way back in 2012. The complainant has now came up with this complaint after lapse of 9^{1/2} years for which time limitation for the claim need also to be examined under The Limitations Act, 1963.



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14. .IN Dispute Resolution Policy:

Paragraph 4 of the Policy lists three elements that the Complainant must prove to merit a finding that the domain name of the Respondent to be transferred to the Complainant or cancelled:

- i) The domain names are identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and
- ii) The Respondent has no rights or legitimate interests in respect of the domain names; and
- iii) The domain names have been registered and are being used in bad faith.

While the Complainant is able to prove party 4 a of the policy, Complainant was unable to prove the second and third elements of paragraph 4.

From the available records, documents and other information produced before this Forum, the Arbitral Tribunal believes and confirm that the Registrant is having legitimate rights and interests in respect of the domain name www.groupsure.co.in and there is no proof to establish that the domain name has been used in bad faith.

15. As per Para 6 of INDRP Policy, circumstances have been prescribed to be found by the Arbitrator to be present, to prove the use of domain name in bad faith. The Claimant was unable to prove the circumstances against the Respondent to prove bad faith.



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16. Registrant's rights and legitimate interests in the Domain Name. As per Para 7 of INDRP Policy, for the purposes of Clause 4(iii), the certain circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purpose of Paragraph 4(iii) (supra)
17. As per available records and evidence produced, the Respondent is found to be bona fide user of domain name and offering goods and services. Thus the Respondent is having legitimate interest and rights in the disputed domain name.

13. JUDICIAL REVIEW AND PRECEDENTS:

The Arbitral Tribunal relied on the following judicial precedents in the case.

1. The Hon'ble Supreme Court in the case of Reliance Industries Ltd., Vs. Reliance Polycrrete Ltd., 1997 PTC (17) 581 Excerpt from the Judgement

Quote.

It is observed that, in may prima facie views, it does appear to be a case of too much self-importance given to themselves by the Appellants. Fact that so many Joint Stock Companies and Firms, having word "Reliance" as their Corporate Firm name exists belies case that public / common man associates the word only with the Appellants or their group Companies, no matter what the field of activity".

Unquote




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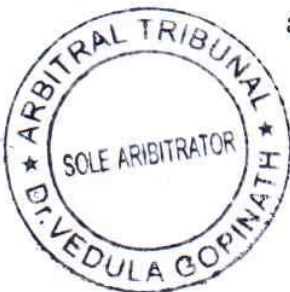
2. The Delhi High Court in the case of Bigtree Entertainment Pvt. Ltd., Brain Seed Sportainment Pvt. Ltd., decided on 13 December, 2017, It was held Turning to the present case, Plaintiff's Domain Name www.bookmyshow.com and Defendant's Domain Name iswww.bookmysport.com are not the sole users of the prefix "BOOKMY". In the written statement learned counsel fee the Defendant has submitted several pages of domain names, beginning with "BOOKMY" that have existed both before and subsequent to the Plaintiff's Website. This gives the first indication that the prefix is a descriptive one. The appeal was dismissed.

3. N. Dinesh Kumar Vs. Shweta Khandelwal, Miscellaneous First Appeal No. 780/2021, decided on 15.03.2021). Karnataka High Court

The Court observed that, as per Section 2 (1) (zb) of the Trade Marks Act, 1999, the Trademark is totally different from the trade name. There may be cases where trade name is also the trade mark but in very many cases it may not be so.

The Court further observed that in the present case there cannot be any dispute that trade names are only a part of the composite whole of the trade mark. The Court while deciding such cases should have in mind the 'quintessential common man' who goes to the neighbourhood shop with the idea of purchasing product of his liking.

The Court thus held that, the "impugned order is totally bereft of any discussion of the same. Absent of such discussion, weight of authorities dictate that, the impugned order be characterized as perverse and resultantly it is liable to be set aside".




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4. Madras High Court Radisav and M/s.Aachi Masala Foods Pvt. Ltd. vs Achi Cargo Channels Pvt. Ltd. . Dismissed the infringement suit for usage of term "AACHI" (meaning grandmother in local language) as the same is a Generic use.

In view of the aforesaid judicial review by Higher Courts, the Arbitral Tribunal strongly believes that usage of generic name and terms appears to be common and cannot be a matter of monopoly on the part of any particular person.

Comparing the focal point of SURYA name in the present case with that of words Reliance, Bookmyshow, Aachi (ref. decided cases) it is proved that the name SURYA cannot be claimed by any person exclusively.

6. Section 9(1)(b) of the Trade Marks Act, 1999:

The Trademark law stipulates that a trademark which has secured a secondary meaning or secondary significance shall not be refused registration even if it falls under the categories under Section 9. It is well settled law that common language words or descriptive words or common words and names cannot be trademarked by any trader unless and until such trade names have acquired such a great reputation and goodwill in the market that the common language word has assumed secondary significance.

Supreme Court Godfrey Philips India Ltd. vs Ginner Food and Beverages Pt. Ltd. (2005) 123 Comp Cas 334 (SC) Bombay High Court J.L. Mehta vs Registrar of Trademarks AIR 1962 Bom 82 Ishi Khosla vs Anil Aggarwal Delhi High Court ITC limited vs Britannia Industries.



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These aforesaid case laws settled the principle of acquired distinctiveness. The goods associated with a trade mark do not have to be in the market for a certain number of years for the trade mark to have acquired distinctiveness. A trade mark can acquire distinctiveness even overnight and therefore it depends on case to case. There is no fixed time frame for a trademark to have acquired distinctiveness.

14.CONCLUSIONS

1. The Arbitral Tribunal concludes that the Complainant has established clause 4(i) of the .IN Domain Name Dispute Resolution Policy to a reasonable extent.
2. However, the Complainant failed to establish the fact of legitimate rights under clause 4(ii) of the INDRP Policy.
3. Also, the Complainant failed to prove the 'bad faith' component under clause 4(iii) of the INDRP Policy. To be successful, the complainant is required to prove all three elements of the Policy.

The alleged, impersonation, misrepresentation, pass-off, misappropriation of Complainant's reputation, goodwill, etc were not proved and no such evidence was provided. The comments and allegations levelled by Complainant against the Respondent proved to be illusory, capricious, and far from truth.

15.DECISION

For the aforesaid reasons, the Complaint is Denied. Both Parties bear their own costs.

Visakhapatnam
April 3, 2021



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