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Purchased by	: SUDHIR KUMAR SENGAR
Description of Document	: Article 12 Award
Property Description	: Not Applicable
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INDRP ARBTRATION

THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

ADMINISTRATIVE PANEL DECISION

SOLE ARBITRATOR: SUDHIR KUMAR SENGAR

American Petroleum Institute  
Vs

Sakthivel Panneerselvam

## Statutory Alert:

1. The authority of this Stamp certificate is verified at [www.e-stamp.com](http://www.e-stamp.com) or using e-Stamp Mobile App of Stock Holding Corporation of India.
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ARBITRATION AWARD Disputed Domain Name: APIINSTITUTE.IN

*[Signature]*

## 1. The Parties

The Complainant in this administrative proceedings is American Petroleum Institute, 200 Massachusetts Avenue, N.W, Washington DC 20001. The Complainant is represented by its authorized representative Prithvi Singh/Prithvi Gulati , Fidus Law Chamber, F-12,GF Sector 8, NOIDA-2001301, Uttar Pradesh (Email:prithvi@fiduslawchambers.com, prithvi.gulati@fiduslawchambers.com ,Telephone: 91-120-4847550).

The Respondent is Sakthivel Panneerselvam , Balaji Nagar, Baba Street, Chennai - 600032, Tamil Nadu, ( Email: pksakthi.mail@gmail.com, Telephone: +91-73958 07733).

## 2. Domain Name and Registrar

(i) The disputed domain name is < apiinstitute.in >.

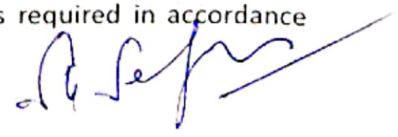
(ii) The Registrar with whom the domain name is registered is Key-Systems GmbH, Im Oberen Werk I, 66386 St. Ingbert, Germany (Phone+49 (0) 68949396850, abuse@key-systems.net)

## 3. Procedural History

The arbitration proceedings is in accordance with the .IN Domain Name Dispute Resolution Policy (the policy) adopted by National Internet Exchange of India ("NIXI") and INDRP Rules of Procedure("the Rules") which were approved on June 28,2005 in accordance with the Indian Arbitration and Conciliation Act,1996. By registering disputed domain name with a NIXI registrar, the respondent agreed to the resolution of disputes pursuant to the Policy and the Rules.

As per the information received from NIXI, the history of the proceedings is as follows:

On Oct 11, 2022, I submitted the statement of Acceptance and Declaration of impartiality and independence, as required by NIXI to ensure compliance with Paragraph 6 of Rules. NIXI notified the parties of my appointment as Arbitrator via email on Oct 11, 2022 and served an electronic copy of the complaint on the Respondent. I informed the Parties about commencement of arbitration proceedings on Oct 11, 2022 and the Respondent was directed to submit a response to the arbitration notice within 7 (seven) days. On 14.10.2022, the Complainant submitted confirmation of delivery of soft copies to the respondent. The Complainant also submitted proof of sending hard copies of the complaint to the respondent on 14.10.2022. The service of notices/summons/complaint through electronic mode such as email is considered valid and sufficient and is an established and acceptable practice in India. The complainant has properly served the copies of the complaint on the respondent by email on pksakthi.mail@gmail.com. The Complainant's submission of proof of delivery of Complaint to the Respondent through email fulfills the conditions required in accordance with INDRP Rules of Procedure Paragraph 3(d).





The Respondent failed to submit reply to the arbitration notice issued on 11.10.2022 within the stipulated time. The Respondent was given another opportunity through email dated 19.10.2022 and was directed to file his response within another 5 days (five days). The Respondent failed to submit any reply within the extended time line. In fact the Respondent has not submitted any response till date.

#### **4. Grounds for Administrative Proceedings**

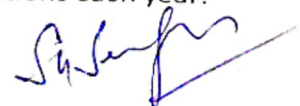
(i) The disputed domain name is identical or confusingly similar to trademark or service mark in which complainant has rights.

(ii) The respondent has no rights or legitimate interests in respect of the domain name.

(iii) The registered domain name has been registered or being used in bad faith.

#### **5. Background of the Complainant**

The Complainant, American Petroleum Institute, ("API"), is the largest U.S. trade association for the oil and natural gas industry. The Complaint has submitted that API's mission is to promote safety across the industry globally and to influence public policy in support of a strong, viable U.S. oil and natural gas industry. The Complainant further submitted that its chief functions include advocacy, research, standards setting, and certification and additionally, API publishes industry standards, markets training courses on these standards and other industry topics, and offers Individual Certification Programs ("ICP") based on the industry-developed standards. The Complainant submitted that training companies meeting API's requirements may be licensed by API to advertise their courses using its API mark, which is the initialism for 'American Petroleum Institute'. The Complainant further submitted that the Complainant has undertaken various efforts to standardize petroleum field equipment so that interoperability, reliability and safety of equipment is promoted irrespective of the manufacturer and first such standards for petroleum and related industries were published in 1924 and today the Complainant maintains more than 700 standards which cover various facets of petroleum industry and promote use of safe, interchangeable equipment and proven and sound engineering practices (e.g. petroleum pipelines specifications, drill bit specifications). The Complainant further submitted that the Complainant offers these standards to oil and natural gas industry under the trade mark API and the Complainant sells more than 300,000 copies of its publications each year.



The Complainant further submitted that its publications, technical standards, and electronic and online products are designed by our client not only with a view to help users improve the efficiency and cost effectiveness of their operations but also to comply with legislative and regulatory requirements, safeguard health, ensure safety and protect the environment. The Complainant further submitted that the Complainant has used API as a mark to promote its goods and services since at least as early as 1924 in the USA and by virtue of long and continuous use and the exquisite quality of the Complainant's services, the trademarks have come to be associated exclusively with the Complainant. The Complainant further submitted that the Complainant has registered the trade marks in India and collectively these trade mark are referred as API marks. The Complainant further submitted that the Complainant's trademarks are exclusively associated with them on account of innate distinctiveness, their prior, and widespread business activities and as a consequence of the above factors, the said trademarks enjoy a pervasive goodwill and reputation all over the world, including in India, and the Complainant has acquired common law rights to the exclusive use of the said trademarks. The Complainant further submitted that the Complainant promotes and advertises its products and services through its website <https://www.api.org/>. The domain name <https://www.api.org/>, is registered since 1995 and has been used by the Complainant continuously since.

#### **The Respondent**

The Respondent is Sakthivel Panneerselvam , Balaji Nagar, Baba Street, Chennai - 600032, Tamil Nadu, ( Email: pksakthi.mail@gmail.com, Telephone: +91-73958 07733).The Respondent has registered the disputed domain name <apiinstitute.in> in 2020.

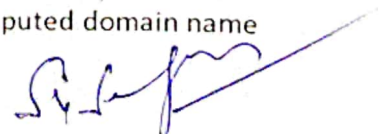
#### **6. Legal Grounds**

A. The domain name registered by the respondent is identical and confusingly similar to trademark or service mark in which the Complainant has rights.

(Policy, Paragraph 4(a); Rules, Paragraphs 4(b)(v-vi))

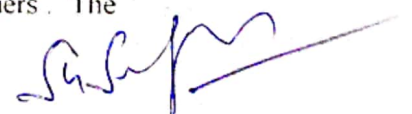
#### **Complainant's Contentions**

The Complainant submitted that the Respondent has registered the disputed domain name





<apiinstitute.in> thereby misappropriating, illegally and unauthorizedly, the Complainant's trademark API. The Complainant further submitted that the disputed domain <apiinstitute.in> wholly contains the Complainant's trademark API and is therefore identical to the Complainant's trademark and trade name. The Complainant further submitted that the Respondent registered the disputed domain name several decades after the Complainant's adoption and use of the trademark API and the trademark API has not been used in connection with the services provided by Complainant by anyone other than the Complainant or those authorised by the Complainant. The Complainant further submitted that the Respondent is not authorised by the Complainant and has adopted the identical trademark with a view to ride upon the goodwill associated with the Complainant's well-known trademark API and pass off its services as those of the Complainant. The Complainant further submitted that due to reputation associated with the trademark API, the first impression in the minds of the consumers shall be that the Respondent's website originates from and is associated with, or is sponsored by, the Complainant. The Complainant contends that the domain name and the contents of the website hosted on the disputed domain name makes it evident that the Respondent is impersonating the Complainant and offering courses related to API's Individual Certification Program to third parties. The Complainant submitted that the offer to provide certifications is fake, illegal and without any permission and/or authorisation of the Complainant. The Complainant further submitted that the Respondent's website also reads as follows: "over 16 years of experience in American Petroleum Institute (API) Individual Certification Programs providing expert Educational [sic]." and such content makes it clear that Respondent is aware of Complainant and is trying to suggest an association or affiliation with Complainant, and thus has registered and is using the Domain Name in bad faith. The Complainant has relied upon Nike Inc. v. Nike Innovative CV Zhaxia (Case No. INDRP/804); Metropolitan Trading Company v. Chandan Chandan (Case No. INDRP/811); Lego Juris A/s v. Robert Martin (Case No. INDRP/125), wherein it has been held that if a disputed domain name completely incorporates the trademark / service mark of a Complainant, then the mere addition of domain codes such as ".in" and/or ".co.in" will not distinguish the disputed domain name. The Complainant contends that in the instant case, the disputed domain name contains the Complainant's trademark API and the descriptive component 'institute'. The Complainant further submitted that the Respondent is attempting to offer services which are identical and/or similar to those of the Complainant; however, their product and service offerings are fake and fraudulent with an intention to deceive third party consumers. The

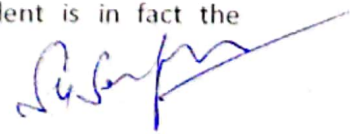


Complainant further submitted that the content of the website hosted on the disputed domain name clearly gives an indication that the Respondent is impersonating the Complainant and thus, there is a strong likelihood of confusion.

B. Respondent has no rights or legitimate interests in respect of the domain name.  
(Policy, Paragraph 4(b), 6; Rules, Paragraph 4(b)(vi))

### **Complainant's Contentions**

The Complainant submitted that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant further submitted that the Respondent has not used, nor made, demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. The Complainant further submitted that the Respondent (as an individual, business, or other organisation) is not commonly known by the disputed domain name and the Respondent has acquired no trademark rights. The Complainant further submitted that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name and is using the domain name to defraud general public; The Complainant submitted that the Respondent has failed to establish the criteria mentioned in paragraph 4(b) that the disputed domain name has not been used in connection with bona fide offering of services by the Respondent. The Complainant contends that the contents of the website hosted on the disputed domain name makes it evident that the Respondent is impersonating Complainant by using its API trademark and offering courses relating to API's Individual Certification Program; The Complainant submitted that the Respondent is not authorised by the Complainant in any manner to use the trademark API and the Respondent has evidently copied the Complainant's trademark API to impersonate the Complainant and defraud the public. The Complainant further submitted that the content of the website hosted on the disputed domain name makes it evident that the same is not for non-commercial or fair use purposes and the Respondent is clearly gaining commercial benefits and unjust enrichment by attempting to offer certification courses to the public (with a view to dupe them) under the trademark API. The Complainant contends that the disputed domain name suggests an affiliation with the Complainant and its API trademark, as the disputed domain name fully incorporates the Complainant's trademark API and the entire website connected to the disputed domain name creates an impression that the Respondent is in fact the



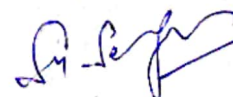


Complainant or one of its affiliates or licensees and that the website on the disputed domain name is the official website of the Complainant or one of its affiliates or licensees. The Complainant further submitted that the Complainant has established a prima facie case that the Respondent has no rights or 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. The Complainant has relied on *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. D2000-0624; *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455). The Complainant further submitted that taking the above into consideration, internet users are clearly misled regarding the relationship between the disputed domain name and the Complainant and will falsely believe that the website connected to the disputed domain name is owned by the Complainant or one of its affiliates or licensees. The Complainant contends that given the business model of the Registrant, he cannot claim to have legitimate interests in the Domain Name. The Complainant contends that as the Respondent has no rights or legitimate interests in relation to the disputed domain name, the second element as referred to in article 4(b) of the Policy has been satisfied.

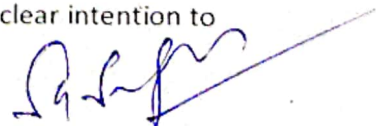
C. The domain name was registered and is being used in bad faith.  
(Policy, Paragraphs 4(c), 7; Rules, Paragraph 4(b)(vi))

### **Complainant's Contentions**

The Complainant submitted that the facts and circumstances as set out above cannot lead to any other conclusion than that there has been bad faith on the part of the Respondent. The Complainant further submitted that it is unthinkable that registration was bona fide and/or that the use is taking place in good faith. The Complainant further submitted that due to the fact that the API trademark is well-known in the entire world, is highly distinctive, and given the identity between the said trademark and the disputed domain name, the Respondent must have been aware of the Complainant, the API trademark, the domain names and websites associated with the Complainant and the goodwill associated with it, when the Respondent registered the disputed domain name and this indicates registration in bad faith. The Complainant has relied on *Hodge Jones & Allen LLP v. Koichiro Taneda* WIPO Case No. D2018-1426. The Complainant contends that given the similarities between the disputed domain name and Complainant's trademark and the impersonation



by the Respondent of the Complainant, there is a great risk to third parties as the same is being used for fraudulent activities by the Respondent. The Complainant submitted that there is apprehension that by the Respondent by offering courses and programs under the trademark API, they have already perpetrated fraud on numerous consumers and therefore, it is important to restrain the Respondent from using the disputed domain name at the earliest. The Complainant further submitted that the Respondent's recent registration of the disputed domain name shows that the Respondent's intent to rely on a risk of confusion with the Complainant's activity and trademark as to the source, sponsorship, affiliation or endorsement of the disputed domain name and website associated with it. The Complainant further submitted that such use of the domain name cannot be qualified as a bona fide offering of services. The Complainant has relied on *AT&T Corp. v. Amjad Kausar*, WIPO Case No. D2003-0327. The Complainant further submitted that there is also a risk that the Respondent will make use of the disputed domain name for fraudulent activities such as phishing expeditions and this risk is enhanced by the fact that the Respondent has not only registered the disputed domain name, but also activated email addresses associated with the disputed domain name. The Complainant has relied on WIPO Overview 3.0, section 2.13.1 wherein it is stated that it is well established that "the use of a domain name for illegal activity[,] [such as] phishing, [...] impersonation/passing off, or other types of fraud[,] can never confer rights or legitimate interests on a respondent." The Complainant further submitted that there is great likelihood that actual or potential visitors to the present website of the Respondent will be induced to believe that the Complainant has licensed their trademark API to the Respondent or authorized the Respondent to register the disputed domain name, and further believe that the Complainant has licensed their trademark API to the Respondent or authorized the Respondent to offer courses and advertise services under the trademark API and further believe that the Respondent has some connection with the Complainant in terms of a direct nexus or affiliation with Complainant. The Complainant further submitted that the Respondent has registered the disputed domain name for the purpose of intentionally disrupting the business of the Complainant and by registering the disputed domain name, the Respondent is preventing the Complainant from using the disputed domain name and dislocating and disrupting Complainant's activities and business, with the clear intention to





secure a favourable bargaining position vis-à-vis the Complainant.

### **Respondent's Contentions**

The Respondent has failed to submit any response to arbitration notice issued by this panel to rebut the contentions of the Complainant.

### **7. Discussion and findings**

The Complainant, American Petroleum Institute, ("API"), a U.S. trade association for the oil and natural gas industry, promotes safety across the industry globally. Its main activities are advocacy, research, standards setting, certification and also publishes industry standards. One of the major activity of API is to market training courses on industry standards and also offers Individual Certification Programs ("ICP") based on the industry-developed standards. The Complainant also provides license to companies to conduct industry standards training program. The licensee may use the API mark to advertise their training programs. The Complainant is continuously working since 1924 to standardize petroleum field equipment so that interoperability, reliability and safety of equipment is promoted irrespective of the manufacturer. The Complainant maintains hundreds of such industry standards and publishes industry standard copies. The Complainant also sells a large number of copies to oil and natural gas industries. The Complainant is owner of API mark which is used by the Complainant to promote its goods and services for many decades. The Complainant marks are well known for being in use for a long time. The Complainant has registered the marks in India. The Complainant's trademarks are unique and gathers goodwill in the industry and therefore the Complainant has acquired common law rights to the exclusive use of the said trademarks. The Complainant is owner of domain <api.org> which was registered in 1995 and is used by the Complainant since then. The Complainant promotes and advertises its products and services through its website <api.org>. The contents on disputed domain <apiinstitute.in> indicates that the Respondent was fully aware of the API marks/domain. The Complainant has not given permission/authorization to use the marks of the Complainant.

The Respondent registered the disputed domain name <apiinstitute.in> in 2020 many years



after the registration of marks/domain by the Complainant. The respondent has failed to submit any response to rebut the contentions of the Complainant.

### **Respondent's Default**

The INDRP Rules of Procedure require that Arbitrator must ensure that each party is given fair opportunity to present its case. Rule 8(b) reads as follows;

"In all cases, the arbitrator shall at all times treat the parties with equality and provide each one of them with a fair opportunity to present their case."

Rule 12 empowers arbitrator to proceed with an ex parte decision in case any party does not comply within the time limits or fails to reply against the complaint. Rule 12 reads as follows:

"In the event any party breaches the provisions of INDRP rules and /or the directions of the Arbitrator, the matter can be decided ex parte by the Arbitrator and such arbitral award shall be binding in accordance with the law." The respondent was given notice of administrative proceedings in accordance with Rules. The panel finds that the Respondent has been given fair opportunity to present his case. The Rules paragraph 12(a) provides that the Arbitrator shall decide the complaint on the basis of the Complainant's contention and documents submitted in accordance with Rules and any other law which Arbitrator deems fit to be applicable. In the circumstances, the Arbitrator's decision is based upon the Complainant's assertions, evidence and inferences as the respondent has not replied.

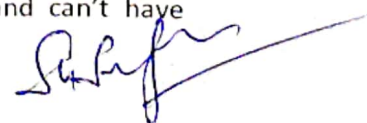
**The domain name <apiinstitute.in> is identical and confusingly to Complainant's trademark or service in which the Complainant has rights.**

The Complainant has been able to prove that it has trademark rights and other rights in marks 'API' by submitting substantial documents. The disputed domain <APIINSTITUTE.IN> is identical to mark 'API' as the disputed domain entirely contains the Complainant's mark "API". Addition of top level domain (CCTLD) extension '.in' is insignificant being country specific. Mere addition of descriptive term 'institute' in domain name does little to make it different. There can't be coincidence that the respondent has chosen domain name similar to the mark of the Complainant. The top level domain <api.org> was registered by the Complainant in 1995 years before registration of disputed domain by the Respondent in 2020. The Respondent has failed to submit any response to rebut the contentions of the Complainant.

Bases on the forgoing analysis, I am of the opinion that the disputed domain name is nearly identical and confusingly similar to the complainant's mark.

**The Respondent has no rights or legitimate interests in respect of the Domain Name.**

The Complainant has been able to prove by submitting evidences that it has legitimate interest in trademark 'API'. The Respondent is not known by the mark and can't have





legitimate interest in the disputed domain. This panel is of the view that mere registration of domain name can't establish rights in disputed domain. According to the Policy that "once the Complainant makes a prima facie showing that the registrant does not have rights or legitimate interests in the domain name, the burden shifts to the registrant to rebut it by providing evidence of its rights or legitimate interests in the domain name". The burden to establish any legitimate interest falls on the Respondent. The Respondent could have invoked legitimate interests in the Disputed Domain Name. The primary objective of the Respondent in registering the disputed domain is definitely to gain from the popularity of the Complainant mark. The Respondent has failed to submit any response to rebut the contentions of the Complainant.

Therefore, in light of complaint and accompanying documents, I am therefore of the opinion that the Respondent has no rights or legitimate interest in the disputed domain name.

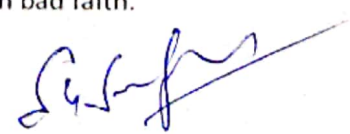
**The Domain Name was registered or is being used in bad faith.**

This can't be a coincidence that the Respondent registered disputed domain name fully incorporating well known mark of the Complainant. The contents hosted on the disputed domain website clearly indicates that the Respondent was fully aware of the goodwill and reputation of the Complainant. The Complainant has been using the mark for several years when the Respondent registered the disputed domain name in 2020. The intent of the Respondent offering similar services to that of the Complainant is definitely a bad faith. The panel finds that the Respondent has registered the domain name to profit from the popularity of the Complainant's mark. The Respondent is impersonating as the Complainant to pass off its services in name of the Complainant. The acts of the Respondent is likely to damage the reputation and business of the Complainant. The respondent has failed to submit any response to arbitration notice issued by this panel to rebut the contentions of the Complainant

In view of the above , I am of the opinion that registration of disputed domain name is in bad faith.

**Decision**

Based on the of contentions of the complainant , the attached documents , cited decisions and in view of the above read with all the facts of the present case, the Complainant's contentions are tenable. The test of prudence demands fairness of actions by the Respondent. The Respondent is involved in impersonating the Complainant aiming to profit from the popularity of the Complainant's marks/domain. In view of the forgoing discussion, I am of the opinion that the disputed domain name is identical and confusingly similar to the Complainant's marks/domain. The Respondent does not have rights or legitimate interest in the disputed domain name and disputed domain name was registered in bad faith.



In accordance with the Policy and Rules I direct that the Disputed Domain name be transferred to the Complainant, with a request to NIXI to monitor the transfer.

The award is being passed within statutory deadline of 60 days from the date of commencement of arbitration proceedings.

No order to costs.

November 3, 2022



Sudhir Kumar Sengar

Sole Arbitrator