



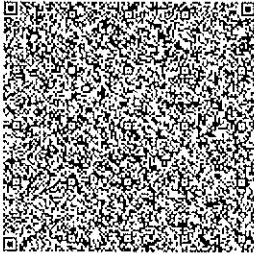
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## INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

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**.IN Registry**  
(NATIONAL INTERNET EXCHANGE OF INDIA)

**COMPLAINANT**  
Reliance Industries Limited

Vs.

**RESPONDENT**  
PK

**ARBITRATION AWARD**

*J.K. Bansal*

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**.IN Registry**  
(NATIONAL INTERNET EXCHANGE OF INDIA)

ADMINISTRATIVE PANEL DECISION  
SOLE ARBITRATOR: SUDARSHAN KUMAR BANSAL

INDRP Case No.904

COMPLAINANT

Reliance Industries Limited  
Maker Chamber IV,  
222 Nariman Point,  
Mumbai – 400 021,  
India

Vs.

RESPONDENT

PK  
Mumbai,  
Maharashtra,  
400 001  
Email: [pk@yaajman.com](mailto:pk@yaajman.com)

**ARBITRATION AWARD**

1. The Complainant is aggrieved by the Respondents registration of the domain name [www.jiodhandhanadhan.in](http://www.jiodhandhanadhan.in) registered through the sponsoring Registrar 'Endurance Domains Technology Pvt. Ltd.' (R173-AFIN) and has accordingly made this Complaint seeking the relief that the domain name [www.jiodhandhanadhan.in](http://www.jiodhandhanadhan.in) (Disputed domain name in short) be either cancelled or transferred to the Complainant with costs.

2. The Complainant has preferred this Complaint on the basis of its claimed proprietorship and ownership rights in the Trade mark JIO word and formative as its essential feature as well as on the basis of its

*J.K. Bansal*

domain names bearing the word/mark JIO as its essential feature which is www.jio.com (collectively referred to as the Trademark/Domain Name JIO).

3. The Complainant claims to be a company incorporated in the year 1973 organized and existing under the laws of India and claims to be the company in the industrial core sectors, textiles, chemicals, mineral exploration and refining, finance and telecommunication.

4. The Complainant further claims that Reliance Jio infocom Limited is the subsidiary and telecom arm of the Complainant which was incorporated on 15.02.2007 and alleges that the 4G telecom services were launched in the name of JIO on 05.09.2016 and within first month it acquired 16 million subscribers. The Complainant claims that JIO services thereafter turn out to be the fastest anywhere in the world and second largest telecom operator in India in respect of its users. The details of the Complainant's popularity of its telecom service under the brand JIO have been pleaded.

5. The Complainant claims to be the prior adopter, user and registered proprietor of the mark JIO and various other JIO formative trademarks which are registered with the Indian Trademark Registry.

6. The Complainant claims its various JIO and JIO formative trade marks to be registered under various numbers and classes under the Trade Marks Act, 1999 in India in its favour. The particulars of such registrations as well as copies of their respective status reports obtained from the e-records of the Trade Marks Registry have been respectively pleaded in and filed along with the Complaint. Consequently, the Complainant claims to have rights in the Trade Mark JIO and JIO

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formative marks. In addition the Complainant also claims that the trademark JIO and various other JIO formative of trademarks are well-known and have extensive goodwill and reputation being used by it in relation to telecom services and which trade marks according to the Complainant identifies and distinguishes the Complainants said service from its source and origin.

7. According to the Complainant, it's said Trade Mark JIO and JIO formative is well known in India since its inception and which trade marks have been well used, well advertised, well established and extremely visible in the market and trade with it in relation to its aforementioned services.

8. The Complainant states that in addition to aforesaid, the word/mark JIO also forms part of the Complainant's domain name [www.jio.com](http://www.jio.com) and that the Complainant itself is the registrant of the said domain name.

9. The Complainant further alleges to have launched its tariff plan for its JIO user under the name "DHAN DHANA DHAN" and pursuant to which the Complainant has registered its trademark with JIO formative which is "JIO DHAN DHANA DHAN" with Indian Trademark Registry under the provisions of Trademark Act 1999. The copy of the status report obtained from the e-records of the Trade Mark Registry pertaining to this registration has been filed alongwith the Complaint.

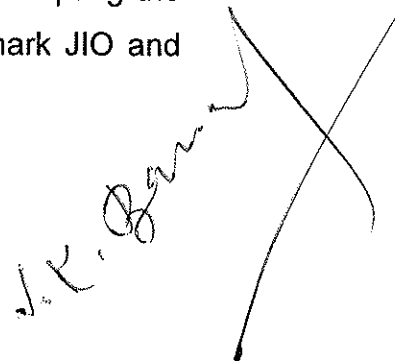
10. The Complainant alleges to be the proprietor of 5000 domain names incorporating the trademark JIO and various other JIO formative trademarks and particulars of some such domains have been filed along with the Complaint.

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11. The Complainant has also pleaded of the nature of business being carried on by it and its group companies, its annual revenues, its business standing and reputation. The Complainant claims that the consumers at large associate the trademark/ domain name JIO and JIO formatives with the Complainant alone.

12. According to the Complainant, the Disputed Domain name www.jiodhandhanadhan.in is identical with and deceptively similar to the Complainant's registered Trade Marks JIO, JIO DHAN DHANA DHAN, other JIO formative trademarks, domain Name www.jio.com and variations/formatives thereof and is in violation of the Complainant's rights therein. The adoption of the disputed domain name (www.jiodhandhanadhan.in) is mala fide and the same is allegedly being used by the Respondent for making illegal gains to trade upon the Complainant's goodwill and reputation attached to the Complainant's said trademarks/domain name JIO and JIO formative trademarks.

13. The Complainant states that Respondent has illegally adopted the Disputed Domain name and is using the Complainant's mark (JIO/ JIO DHAN DHANA DHAN) in full to mislead the online visitors and the general public into believing that the Disputed Domain name is an offshoot of the Complainant or is in some manner legitimately associated with the Complainant, which is not the case. In addition to this, according to the Complainant, the Respondent is also hosting identical content on the disputed domain name with the mala fide intention of disrupting the goodwill and reputation of the Complainant's said trade mark JIO and formatives.



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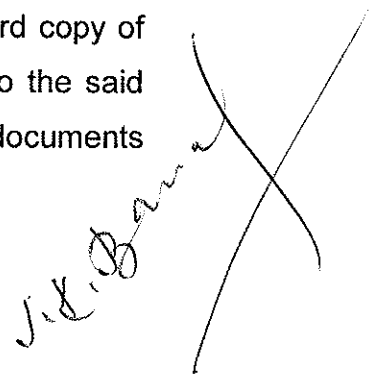
14. The Complainant also claimed in its Complaint that the disputed Domain name to be registered with the sponsoring Registrar and used by the Respondent is malafide and Respondent to have no legitimate rights and interest therein and which has merely been registered to misappropriate the reputation associated with the Complainant's well-known trademarks JIO and JIO DHAN DHANA DHAN and JIO trade mark/domain names.

15. In support of its rights and use the Complainant has made numerous pleadings and filed numerous documents which would be dealt with in so far as they are relevant, in the course of this award.

16. The .IN Registry appointed me as an Arbitrator to adjudicate this Complaint in accordance with the Arbitration and Conciliation Act, 1996; .IN Domain Name Dispute Resolution Policy; Rules of Procedure and/or bye-laws, rules and guidelines made therein and notified the factum thereof to the Complainant through its attorneys and authorized representatives, as well as the Respondent vide its email of 10.07.2017.

17.1 Thereafter, I (Arbitral Tribunal) issued a notice to the Respondent vide email dated 13.07.2017 with a copy of the Complaint and documents wherein the Respondent was notified about my appointment as the Arbitrator and was given an opportunity to submit its written response to the Complaint stating its defense together with documents supporting its position within ten days thereof. The respondent was also directed to provide its complete physical address with phone number to enable National Internet Exchange of India to dispatch the hard copy of the complaint with Annexures to it. No reply was received to the said notice and the Respondent did not submit its response and documents

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and nor furnished its address and phone number within the stipulated time.

17.2 Thereafter in the interest of justice another notice through E-mail dated 24.07.2017 was given to the Respondent giving to it a further period of five (5) days to file its response with documents and furnish its physical address. The respondent did not respond thereto and did not submit any response or documents nor address.

17.3 Thereafter notice through E-mail dated 04.08.2017 was issued by me (Arbitral Tribunal) upon both the Complainant and the Respondent offering a hearing to the parties to clarify on the issue as to whether the Complainant is prior in adoption and/or use of the trade mark/domain name JIO DHAN DHANA DHAN to that of the respondent and if so, to what effect ; and if not so, whether the respondents adoption and/or use of the impugned domain name is in bad faith and devoid of any legitimate interest ? This notice was issued on the basis of the ratio of the decision of the Hon'ble Delhi High Court in the case of Thoughtworks Inc., Vs. Super Software Pvt. Ltd., and Ors reported in 2017 (69) PTC 303. The parties were also directed to appear before this Arbitral Tribunal on 11.08.2017.

17.4 On 11.08.2017 the Complainant appeared through its Ld. Counsels Shri Nishchal Anand and Shri Sanchith Shivakumar, Advocates and addressed on the aforesaid issues raised as also on the issue of the deceptive similarity. No one appeared on behalf of the Respondent. On 11.08.2017 the Ld. Counsel for the Complainant sought to place on record to additional documents and make further submissions. The said request was allowed and the matter was adjourned to 25.08.2017.

*S.K. Bani*

17.5 The Complainant accordingly filed additional documents being Annexures-U to Annexures GG (pages 348 to 390) vide E-mail of 21.08.2017 as also filed the hard copy thereon with this Tribunal on 22.07.2017.

17.6 The factum of the outcome of the hearing of 11.08.2017 was notified to the parties vide my notice through E-mail dated 16.08.2017.

17.7 On 25.08.2017 Shri Nischal Anand, Advocate and Shri Sanchit Shiv Kumar, Advocates appeared before this Tribunal and made their submissions on the issues raised in the notice of 04.08.2017 and on deceptive similarity. They also pointed out that a copy of the additional documents filed by them was sent by them to the Respondent through E-mail and also submitted a delivery report thereof before this Tribunal.

17.8 For good order and in the interest of justice vide notice through E-mail dated 28.08.2017 the additional documents filed by the Complainant were sent by this Tribunal to the Respondent with an opportunity to the Respondent to file any documents in support of its case within a non extendable period of five (5) days thereof and making it clear that no further opportunity would be granted and this Tribunal thereafter would proceed to give its award.

17.9 The respondent did not file any such documents and nor appeared in the hearing of 25.08.2017.

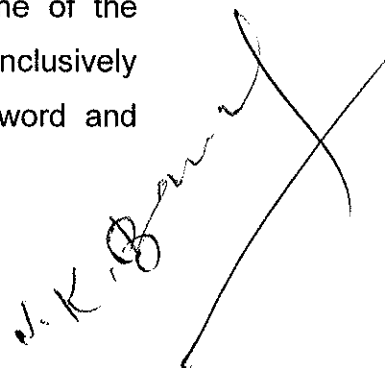
18. Accordingly I now proceed to adjudicate this Complaint on the basis of the arguments advanced by the Ld. Counsel for the Complainant and the material available on record.

J. K. B. [Signature]



19. The Complainant has pleaded one of its company by the name of Reliance Jio Infocom Limited to be incorporated on 15.02.2007 and which Company is its "telecom arm" to provide 4G services to its customers across India. The Complainant has placed on record as **Annexure-C** the extract from the Government of India website [www.mca.gov.in](http://www.mca.gov.in) depicting such incorporation details of this Company. In my view the word/mark JIO does form a prominent and essential feature of this company's trade name. The affairs and activities of this Company in relation to 4G telecom and broadband services have been quoted and reported upon in newspaper, magazines and business journals which have been placed on record by the Complainant as **Annexure-D**. Some such newspapers reports are downloads effected on 05.08.2014 of the newspaper Economic Times and Times of India. This does establish that in the year 2007 the word/mark JIO was in existence ; and was in vogue in the market and in public space as part of the said trade name at least in the year 2014.

20. The trade mark Jio word and stylized mark is duly registered under the Trade Marks Act, 1999 (Trade Mark Act) under Trade Mark numbers 2247460 in class 9 and under No.2247360 in class 38 both dated 09.12.2011 and under No.3016543 in class 9 as of date 27.07.2015. The copies of the status reports of these registrations obtained from the e-records of the Trade Mark Registry have been placed on record forming part of **Annexure-F (Colly)**. The class 38 services covered by the aforesaid registration are wireless broadband communication services. These registrations are in the name of the Complainant and stand renewed. These registrations conclusively establish the existence and filings for the Trade Mark Jio word and stylized at least in the year 2011.

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21. The Complainant has a number of Jio formative marks and/or marks bearing the word Jio as a prefix being –

(i) Trade Marks Jio RIBBON, Jio DIGITAL LIFE, Jio DIGITAL LIFE (DEVICE OF DOTS), Jio SIMPLE SMART SECURE, Jio CONNECTED INTELLIGENCE apparent from the status reports obtained from the e-records of the Trade Marks Registry and filed as part of Annexure-F (Colly.) showing their registrations and renewals under the Trade Marks Act with the Complainant as under :-

(a) Trade Mark Jio RIBBON under trade Mark Nos.3070712 to 3070724, 3070747 each in class 9 dated 06.10.2015; under Nos.3070727 to 3070741 each in class 38 dated 06.10.2015.

(b) Trade Mark Jio Digital Life under trade mark No.3055803 in class 9 dated 15.09.2015.

(c) Trade Mark Jio DIGITAL LIFE under trade mark No.3139817 in class 38 and 3139821 in class 9 each dated 28.12.2015.

(d) Trade Mark Jio DIGITAL LIFE (DEVICE OF DOTS) under trade Mark No.3139822 in class 9 dated 28.12.2015.

(e) Trade Mark Jio SIMPLE SMART SECURE under trade mark No.3155645 in class 38 dated 11.01.2016.

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- (f) Trade Mark JIO CONNECTED INTELLIGENCE under trade mark No.3155647 in class 42 dated 11.01.2016.

These registrations stretch from the period 06.10.2015 to 11.01.2016.

- (ii) Word/Marks Jio Chat, Jio Money, Jio Mags, Jio TV, JioCinema, JioMusic, JioXpressNews, JioCloud, JioSecurity, JioNewsPaper. Under these marks the Complainant has launched a slew of mobile phone applications providing a variety of different services and which are being advertised on its website [www.jio.com](http://www.jio.com) and print outs whereof have been filed as **Annexure-G** to the Complaint. These word/marks do perform trade mark functions being a source and quality indicator of the said mobile phone applications. The Complainant has filed as **Annexure-FF** downloads of news articles dated 28.03.2016 highlighting the various activities and user of the Complainant under some such JIO formative marks. Thus establishing that some such marks, as mentioned in the news articles are in vogue in the market and public space at least the date from the year March, 2016.

22. The Complainant by itself as also through its various group companies claims to own more than 5000 domain names incorporating the trade mark JIO or its derivative marks. The list of such domains has been filed as **Annexure-J**. The Complainant has filed as **Annexure-EE** particulars of some such domains mentioned in **Annexure-J** obtained from the Whois database available on the INDRP website alongwith the details of their registration with the sponsoring registrar which could be noticed as under:-

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<u>Domains</u>	<u>Date of Registration with sponsoring Registrar</u>
jiolife.com	21.08.2011
jioindia.in	06.01.2012
jiojunction.com	18.03.2013
jiosherpa.com	18.03.2013
jiobeats.in	03.08.2013
jiofm.in	30.09.2013
jio-radio.com	12.10.2013
jiolifeconnected.com	04.07.2014
jioliveeverymoment.com	04.07.2014
jiostudio.net	27.01.2015

These domains and their registrations with their respective sponsoring Registrar are dated from the year 2011 to the year 2015 conclusively establishing such JIO and JIO formative domains to be so registered within this period.

23. The Complainant claims to have conceptualized in the year May, 2016 a tariff plan for the users of its telecom and 4G services under the trade mark Jio under the offer name DHAN DHANA DHAN and thereafter made known the same to advertising agencies for purpose of its advertising campaign around this offer. Print outs from the Complainants website regarding its DHAN DHANA DHAN offer have been filed as Annexure-H. The Complainant claims trade mark rights in the Trade Mark JIO DHAN DHANA DHAN. The Complainants trade mark JIO DHAN DHANA DHAN is registered under the Trade Marks Act under trade mark No.3320801 in class 38 as of 28.07.2016 and the status report of the said registration as obtained from the e-records of the Trade

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Marks Registry is filed forming part of Annexure-F (Colly.). The respondent has not contested the said claims of the Complainant.

24. At the time of hearing the Ld. Counsel for the Complainant in support of its rights and claims in the Trade Mark JIO DHAN DHANA DHAN pointed out that the Complainant had successfully impugned three trade mark applications under Nos.3282777 in class 16, 3282778 in class 35 and No.3282779 in class 38 each filed on 10.06.2016 for the trade mark JIO Dhanadhan by one business by the name of Law and Kenneth Saatchi & Saatchi Pvt. Ltd., of Mumbai by protesting to the said business leading to the withdrawal of the said applications. Particulars of such applications and withdrawal letters filed with the Trade Marks Registry have been filed by the Complainant as Annexures-U, V, W, X, Y Z, AA, BB, CC to the Complaint. This fact clearly establishes that the Complainant does claim trade mark rights in its said JIO DHAN DHANA DHAN trade mark and has been enforcing it.

25. As per the search results from the Whois database available with the INDRP website placed on record by the Complainant as Annexure-N the impugned domain jiodhandhanadhan.in with the respondent was registered with the sponsoring registrar only on 01.06.2016.

26. As is apparent from the tradename, trade mark registrations and domains referred to in paras 19, 20, 21 (i) & (ii), 22 and 23 above the trade mark JIO and various JIO formative marks and domains are prior to the registration with the sponsoring registrar of the impugned domain name. The afore referenced company under the trade name Reliance Jio Infocom Limited was incorporated in the year 2007 while the earliest domain name mentioned in para 22 above is of the year 2011 and the

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trade mark registration mentioned in para 20 to 21 (i) stretch from the year 09.12.2011 to 11.01.2016 and all much prior to the registration of the impugned domain name.

27. In my considered view the word/mark JIO is an extremely arbitrary and fanciful trade mark in relation to the telecom and 4G services of the Complainant and has no descriptive suggestive or generic connotation with these goods or services of the Complainant. The word/mark JIO also forms an essential and distinguishing feature of the various JIO formative trade marks and domains set out above and gives to these marks and domains a distinct connotation and identity. As such in my considered view the trade mark JIO as well as the trade marks and domains bearing the word/mark JIO enjoy inherent distinctiveness and can be protected even without establishment of secondary significance and as such they are strong trade marks. Even otherwise the newspaper reports and publications downloaded from the internet, noticed above, does bring out the market activities, presence and visibility of the Complainant under its said JIO and JIO formative trade marks and domains. The respondent has not contested the Complainants claims of rights and use including the Complainants claim of its said trade mark/domain name JIO and JIO formative trade marks to be well known, enjoying noticeable distinctiveness, goodwill, presence and visibility in the commercial market.

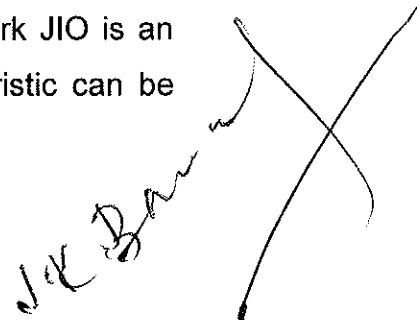
28. Having regard to the aforesaid including the trade mark registrations I am of the considered view that the Complainant has been able to establish its rights, entitlements, legitimate claims and enforceable rights and interest in its trade mark JIO and JIO formative trade marks and domains in relation to its said goods and business. Such rights and specially the rights conferred by Trade Mark

*M. K. Banerjee*

registrations under the Trade Marks Act or by priority in adoption and use, goodwill, reputation and distinctiveness have to be protected and upheld even if it is against a rival domain bearing the said trade mark JIO as interalia there is a close relationship between trade marks and domain names and as the basic principles of trade mark and passing off laws apply to domain name dispute as well. Trade Mark Registrations have a presumptive validity attached to them and are a presumptive evidence of title in favour of the Registrant/Complainant. The trade mark registrations or common law rights therein or its goodwill or reputation and distinctiveness attached thereto can be violated even against the rival un authorized use thereof as part of a rival domain name. **[See American Home Products Corporation Vs. Mac Laboratories Pvt. Ltd., & Anr. Reported in AIR 1986 SC 137 ; Satyam Infoway Ltd., Vs. Sifynet Solutions Pvt. Ltd., 2004 (28) PTC 566 (SC) ; Bharti Airtel Limited Vs. Rajiv Kumar-2013 (53) PTC 568 (Del) ; B.K. Engineering Co. Vs. U.B.H.I. Enterprises reported in AIR 1985 Delhi 210 ; LT Foods Limited Vs. Sulson Overseas Pvt. Ltd., 2012 (51) PTC 283 (Del)].**

29. The Complainant has been able to establish its ownership in a plurality of JIO formative Trade Marks such as Jio RIBBON, Jio Digital Life, Jio DIGITAL LIFE, Jio DIGITAL LIFE (DEVICE OF DOTS), Jio SIMPLE SMART SECURE and JIO CONNECTED INTELLIGENCE each of which contain the common prefix JIO. The word/mark JIO, in my view, is an essential distinguishing and identifying element in these marks. The word/mark JIO forming the common feature in these marks is a distinctive mark in and of itself as well and strong enough to trigger the identity of these marks from the same source. Consequently, the aforesaid JIO formative Trade Marks of which the word/mark JIO is an essential feature having a recognizable common characteristic can be construed as "Family of Marks".

*J.K. Banerjee*



30. The concept of family of marks has been commented upon in the judgement of J&J Snack Foods Corp. Vs. McDonald's Corp. 932 F.2d 1460, 18 USPQ2d 1889 wherein it has been stated as under :-

"A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. For example, in *AMF, Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 270 (CCPA 1973) the court held that AMF had established a family of marks of "fish" names for sailboats, based on advertising, use, and distinctiveness of the names. In *Motorola, Inc. v. Griffiths Electronics, Inc.*, 317 F.2d 397,399,137 USPQ 551, 553,50 C.C.P.A. 1518 (CCPA 1963) it was held that the use and advertisement of the marks GOLDEN VOICE, GOLDEN BEAM, GOLDEN VIEW, and several other "golden" marks, together with the primary mark MOTOROLA, established a pattern of use and recognition of a family of marks in which "golden" is a dominant feature....."

31. As held above the word/mark JIO is an inherently strong and distinctive Trade Mark being a arbitrary mark in relation to the

*J.K. Datta*



Complainant's goods/services. There has been a pattern of adoption and registrations of such JIO composite marks and domains set out in para 19 to 23 above stretching from the year 2011 to 2016. Such marks of the Complainant have a synergistic recognition with the word/mark JIO. As noticed above the various JIO and JIO formative Trade Marks which, in my view constitute a Family of marks are prior marks to the impugned domain name.

32. The Trade Mark JIO DHAN DHANA DHAN in my considered view can be considered to be part of the Complainant's JIO and JIO Family marks. Even this Trade Mark JIO DHAN DHANA DHAN taken by itself is prior to the respondent's impugned domain. The Complainant's allegations of it conceiving its offer under DHAN DHANA DHAN phrase and launching its campaign with respect to its JIO users in the year May, 2016 and thereafter making it known to advertising agencies and of its having trade mark rights therein has not been rebutted to by the Respondent. The respondent's impugned domain was registered with the sponsoring Registrar only on 01.06.2016 as per the Whois report on record as **Annexure-N**. Even if it was to be taken in the extreme that the respondent's impugned domain was to be prior to the Complainant's said Trade Mark JIO DHAN DHANA DHAN even then the respondent's impugned domain cannot have any superior right to and nor could it defeat the Complainant's rights in the Complainant's said JIO and JIO formative Family marks (para 20 to 22 above) which are all prior to respondent's impugned domain name as it is not necessary that all members of the Family to be in existence at the time of the respondent's impugned entry: the Family cloak will cover other members born after the respondent's intervening use (**see American Standard, Inc. Vs. Scott & Fetzer Co., 200 USPQ 457**). Thus a successful cause on the basis of the Jio Family marks can be based by the Complainant against the rival

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domain name and even on the basis of its Trade Mark JIO DHAN DHANA DHAN or other JIO formative marks that may (assuming) have been created by the Complainant after the impugned domain name like JIO TYPE (registered under trade mark No.3401942 in class 9 dated 04.11.2016).

33. The Family of marks – series of marks doctrine has been recognized, applied and enforced by the Hon'ble Delhi High Court in its celebrated decision of **Modi-Mundipharma Pvt. Limited Vs. Preet International Pvt. Ltd. & Anr., 2010 (42) PTC 690 (Del.)** wherein the Hon'ble High Court held the plaintiffs numerous trade marks like CONTINUS, AMBROCONTIN, ANGICONTIN, GLIPICONTIN, INDICONTIN, ISOCONTIN, METOCONTIN, MORCONTIN, NAPROCONTIN, NITROCONTIN, PYRICONTIN, SALCONTIN, THEOCONTIN, TRD-CONTIN, UNICONTIN, VASCONTIN each bearing the word/mark CONTIN in relation to pharma products to constitute a family of marks and accordingly restrained the rival defendant from using the trade mark FEMICONTIN amounting to interalia passing off.

34. In my considered opinion the rival impugned domain is identical with and confusingly similar to the Complainant's said JIO and JIO formative Family marks including to the Complainant's Trade Mark JIO DHAN DHANA DHAN. The impugned domain bears the Complainants registered trade mark JIO as well as JIO DHAN DHANA DHAN. The word/mark JIO forms an essential material, distinguishing and memorable feature of the rival domain name. The effect and significance of the word/mark JIO is not offset nor diminished by the add on suffix DHAN DHANA DHAN thereto in the impugned domain. The individuality of the word/mark JIO stands out prominently in the Complainant's said family marks as well as the impugned domain name. The word/mark JIO

*J.K. Bhowmik*

being the common part is more emphatic and is firmly fixed in the mind of customers as it enjoys strong distinctiveness. It is with reference to the word/mark JIO as well as JIO DHAN DHANA DHAN that the disputed domain name would be remembered by the general internet users who would access the internet services being offered by the respondent. As held above Trade Mark JIO by itself and in itself is an extremely strong and inherently distinctive Trade Mark being an arbitrary mark. Having regard to the various Family marks of the Complainant each bearing the common prominent prefix JIO the market and trade would definitely take and construe the rival domain to be an extension or part of the Complainant's JIO & JIO Family marks or in some way related, sponsored, affiliated, associated or connected thereto. Consequently, I am of the considered view that by the impugned domain and its use whether present or prospective an unjust association would be formed between the Complainant and the Respondent leading to market and consumer deception. [See Montari Overseas Ltd., Vs. Montari Industries Ltd., 1996 (16) PTC 142 Del (DB) ; Ravenhead Brick Company Ltd., Vs. Ruaborn Brick & Tera Cotta Co. Ltd., (1937) 54 RPC 341 (Ch.D) ; Semigres TM (1979) RPC 330].

35.1 A consumer or internet user seeking to access the Complainant or its 4G telecom services would not only be misled with reference to the trade mark JIO or JIO DHAN DHANA DHAN in case they come across the Respondent's website by erroneously or inadvertently suffixing the "second level" domain name i.e., JIO DHAN DHANA DHAN with the ccTLD (country code top-level domain) .in or of gTLD (generic top-level domain) .com or the gTLD (generic top-level domain) .co.in. The said internet user/consumer would be deceived by being led to somewhere else or in not reaching the Complainant.

*S.K. Banerjee*

35.2 On reaching the Respondent **such consumer** would find no actual content on the Respondent's impugned website parked on the disputed domain which, as per Annexure-M of the Complaint, is merely a landing page for click to advertisement. Such a consumer would not get what he intended and instead would be deceived and would adversely relate the impugned website and its landing page to the Complainant. Such an act/activity would inevitably tarnish the image and standing of the Complainant in the eyes of such a consumer causing to the Complainant as well as to the Complainants said JIO and JIO formative trade marks and domains loss and injury.

35.3 Besides the Complainant would have no hold on the respondent or its licensee/assignee impugned domain name usage and would always suffer by any inferior quality of services being rendered by it thereunder. The Complainants goodwill and reputation would be left in the hands of the Respondent or a third party over whom the Complainant may have no control. [See Baker Hughes Limited Versus Hiroo Khushalani 1998 (18) PTC 580 (Del)].

36. All these violative acts of the Respondent would perpetually and irreparably not only tarnish the business of the Complainant but also diminish, erode and eclipse the distinctiveness attached to the Complainants registered and prior adopted trade mark JIO and JIO formative and JIO DHAN DHANA DHAN.

37. All the aforesaid acts of the Respondent, in my considered view clearly establish the Respondent's very adoption of the disputed domain name and its registration with the sponsoring Registrar to be actuated in bad faith, malafide and fraud and that the Respondent has no legitimate

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right or interest in the disputed domain name. This in addition is also apparent from the following :-

- (a) The Respondent has not furnished any explanation on its adoption of an identical prior Trade Mark JIO and JIO DHAN DHANA DHAN belonging to the Complainant. This is more so as the Complainants said JIO and JIO formative trade marks including the trade mark JIO DHAN DHANA DHAN is duly registered on the Indian Trade Mark Register as also are an extremely arbitrary and fanciful trade mark in relation to the nature of the goods/services being dealt with in the course of trade by the Complainant and such JIO and JIO formative marks and domains are all prior to the Respondents impugned domain.
- (b) The Respondent was well aware of or ought to have been aware of the Complainant's said JIO and JIO formative Trade Marks and domains before its alleged adoption and registration of the disputed domain name using a deceptively similar mark, as is the case. The Respondent must have possessed prior knowledge and interest in the internet and awareness of the concepts of E-commerce and online markets actuated through the internet medium triggered through domain names. The Complainant and its said JIO and JIO formative trade marks and domains including the trade mark JIO DHAN DHANA DHAN and the business thereunder has been reported and written upon and has been widely and substantially existing and dominating over the internet and currently the Complainant and its group companies own more than 5000 domain name consisting of JIO as prominent part of the said domain names. The Complainant boasts itself to be India's largest private sector enterprise with businesses in the oil and gas

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exploration and production, petroleum refining and marketing, petro chemicals, retail and tele communications. The Complainant and its group companies claim to have an annual revenue in excess of USD 66 billion and the Complainant being a Fortune 500 company. The Complainant and its activities have been well reported upon in every conceivable media. It is inconceivable for the respondent not to have been aware of the Complainant or its business and standing.

- (c) The Respondent's impugned conduct speaks for itself (*res ipsa loquitur*) and falls short of the standards of acceptable commercial behavior. Accordingly, it can be concluded that the motive of the Respondent was to derive unjust benefit from the Complainant's said JIO and JIO formative trade marks and domains including Trade Mark JIO / JIO DHAN DHANA DHAN.
- (d) The Respondents impugned adoption and registration with the sponsoring Registrar and alleged use of the impugned domain is tainted at inception as it has been deliberately done by it having regard to its prior knowledge and existence of the Complainants said JIO and JIO formative trade marks and domains. That being so the Respondent must be held to be aware of the consequences which would ensue from such a malafide and bad faith adoption and/or use. A presumption/assumption of wrong doing and dishonesty to encash upon the goodwill and reputation of the Complainants said JIO and JIO formative trade marks and domains can be drawn against it **[See Hindustan Pencils Pvt. Ltd., Versus India Stationary Products Company & Anr. 1989 PTC 61].**

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38. In my considered view the Complainant has discharged its onus/burden of proof and has established its proprietary and enforceable rights in its JIO, JIO DHAN DHANA DHAN and various other JIO formative trademarks and domains. The wrongs of the Respondents are also apparent from the fact that it has not traversed nor challenged the Complaint facts against him. Such a non-traverse has to be taken against the Respondent (Uttam Singh Dugal & Company Limited V/s Union Bank of India & Ors – reported in AIR 2000 SC 2740).

39. Trade Marks have been accepted to be valuable business assets to be protected against their wrongful adoption and use even as part of a rival domain name and such violations have to be removed in the interest of the right holder as also of the consumers.

40. In the aforesaid view of the matter I have no reservation against holding that the Complaint must be allowed.

Accordingly it is decided that the disputed domain name www.jiodhandhanadhan.in be transferred to the Complainant.

Signed at New Delhi, India on this 5<sup>th</sup> day of September, 2017.

  
Sudarshan Kumar Bansal  
Sole Arbitrator