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TAMILNADU CHAMBERS,
CHENNAI - 600 001.

BEFORE THE SOLE ARBITRATOR MR.D.SARAVANAN
.INREGISTRY
(C/o. NATIONAL INTERNET EXCHANGE OF INDIA)

Disputed Domain Name: www.msn.in

Microsoft Corporation
One Microsoft Way
Redmond
WA 98052-6399, USA

.. Complainant

Vs.

Chun Man Kam
RM1311Wai Yuen House Chuk Yuen
North Estate Kowloon
Hong Kong
H.K.
+582.94196600

Respondent





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6.6.2009

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P. S. SIVANANDAN SIVANANDAN,
STAMP VENDOR,
L. No. 24 / 103 / 85
HIGH COURT CAMPUS,
CHENNAI - 600 001. (KAPIL MADH)

-2-

The Parties:

The Complainant is Microsoft Corporation having its mail address at Microsoft Corporation, One Microsoft Way, Redmond, WA 98052-6399, USA.

1

The Respondent is Chun Man Kam, having its mail address at RM1311Wai Yuen House Chuk Yuen, North Estate Kowloon, Hong Kong, H.K., +582.94196600.

2. The Domain Name and Registrar:

The disputed domain name: www.msn.in. The domain name registered with IN REGISTRY.



such as MICROSOFT OFFICE and VISUAL STUDIO and other popular software products which include Microsoft windows Server System, Microsoft Publisher, Microsoft Visio, Microsoft Project and other stand-alone desktop application. The detailed list of popular software program is marked by Complainant in its complaint as "**Annexure-A**". The Complainant states that they manufacture a large range of computer peripherals also.

4.3 Complainant's Trade Marks and Domain Names:

According to the Complainant, the Complainant adopted the trademark "MICROSOFT" in the year 1975 and has used the said trademark continuously and extensively, not only as a trademark but also as a prominent, key and leading portion of its corporate name. The Complainant further states that they are also the registered proprietor, in India of the trademark "MICROSOFT" and the registration numbers for the said mark are 430449 and 430540 respectively and also states that the said registrations have been duly renewed from time to time and are valid and subsisting under the Trademarks Act, 1999. A photocopy of the said registration certificates are marked by Complainant in its complaint as "**Annexure-B**".

The Complainant states that they own, among other trademarks, the trademark "MSN" and has also obtained trademark registrations in numerous countries for the MSN mark in several classes of goods and services. The Complainant further states that they invested significant time, effort and money advertising and promoting the MSN Mark, the Complainant offers localized versions of its MSN services, including MSN Hotmail and MSN messenger, in eighteen languages to more than thirty countries worldwide and as a result, MSN has become one of the world's most popular Internet Destinations. Complainant has marked some of the Colour Printouts of some of the web pages from the Complainant website<msn.com> as "**Annexure-C**"

The Complainant states that they are the registered proprietor, in India of the trademark "MSN". The Complainant further states that registrations for the said mark are in classes 35, 36, 38, 39, 41,42 respectively and bear the registration number 1236751 and according to them the said registrations have been duly



renewed from time to time and are valid and subsisting under the Trademarks Act, 1999. Complainant has marked copy of the extract obtained from the online Trademark Registry as "**Annexure-D**".

The Complainant further states that they have a huge internet presence including their own website www.msn.com which is a collection of Internet services provider by the Complainant. The Complainant further states that they debuted as an online service and Internet service provider on August 24, 1995, to coincide with the release of the Windows 95 operating system. The Complainant further states that they used the MSN brand name to launch and promote numerous popular web-based services in the late 1990s, most notably Hotmail and Messenger, before reorganizing many of them in 2006 under a new brand name, Windows Live. MSN's Internet portal, MSN.com, still offers a wealth of content and is currently the 6th most visited domain name on the Internet. The Complainant also states that their Microsoft Corporation has collaborated with many other service providers that offers services like MSN shopping, MSN Encarta, MSN space blog, MSN adCenter, MSN Premium that includes MSN Virus Guard and Firewall, etc.

The Complainant refers to some of the decisions passed in favour of the Complainant.

1. Microsoft Corporation Vs My Speedy Net Phone (D2003-0359)
2. Microsoft Corporation Vs SysWeb Soft SRL and Martin Caetano (D2003-0528)
3. Microsoft Corporation Vs DOMAeN.com (D2005-0613)
4. Microsoft Corporation Vs Cupcake City (D2000-0818)
5. Microsoft Corporation Vs Stop2Shop a/k/a GeneVozzola (D2004-0510)
6. Microsoft Corporation Vs S.L., Media Web (D2003-0538)
7. Microsoft Corporation Vs Marine Safety Network Weather (FAO603000655480)
8. Microsoft Corporation Vs Serge Kovale (D2005-0584)
9. Microsoft Corporation Vs Timothy Stephenson (D2009-0310)
- 10..Microsoft Corporation Vs Park June (FA0510000585932)

The Complainant further states that they have reputation associated with the Complainant's mark, and the mark MSN is a "well known" mark as understood under Article 6 bis of the Paris Convention. It is further stated that the Complainant's rights in their trade mark, its variations/service names and other



deceptively similar marks have been upheld by the WIPO Board and copy the decisions are marked by the Complainant in its complaint as "**Annexure-E**". The Complainant further states that the Respondent in the present dispute has registered the domain <msn.in> thereby misappropriating illegally and without the trade mark MSN which is exclusive property of the Complainant. The Complainant marked the copy of WHOIS report as "**Annexure-F**".

4.4 Respondent's Identity and activities:

The Respondent is the registrant of the Domain Name <msn.in> which is registered with .IN REGISTRY, National Internet Exchange of India, and New Delhi.

5. Parties contentions:

A. Complainant:

The Contentions of the Complainant are as follows:

(a) The Domain Name is identical or confusingly similar to a Trademark or service mark of the Complainant has Rights:

According to the Complainant, the disputed domain name <msn.in> include the word msn, which is identical and confusingly similar as a whole to the well known and registered trademark msn.com in which the Complainant has statutory rights as well as rights in common law, by virtue of a long and continuous user and being its registered proprietor thereof. And due to this the trademark has acquired distinctiveness and is exclusively identified with the Complainant's goods. And Complainant contends that use of the word msn by the respondent in the domain name would be understood as a reference to the Complainant thus perpetuating confusion among consumers who wish to access the Complainant's web page. The Complainant has also marked the decision rendered by this Sole Arbitrator in the dispute between KFC Corporation Vs. Webmaster Casinos Ltd., (L-2/6/R4) as "**Annexure G**" in support of their contention. According to the Complainant, they have spent substantial time, effort and money advertising and promoting the MSN mark throughout the world. As a result, the MSN mark has become distinctive and well known, and the Complainant has developed an enormous amount of goodwill



registered in bad faith for monetary gains. Registration of a famous trademark without legitimate commercial interests in the same is prima facie evidence that the Respondent was well aware of the reputation and goodwill attached to the Complainant's trademark/name. Thus according to the Complainant the respondent has registered the web site in bad faith. And Complainant has also placed reliance on Rediff.com India Limited Vs Mr. Abhishek Verma and another, where in the disputed domain name rediff.in was ordered to be transferred to the Complainants as the respondent has registered it for monetary gains. Complainant marked the copy of the said Award as "**Annexure-H**". And it also relies on judgments *Mari Clarie Album V. Marie - Claire Apparel Inc(D2003 0767)*, *Veuve Clicquot Ponsardin, Maison Fondée en 1772 V. The Polygenix Group Co, (D2000-0776)*, *Adidas-Salomon AG V. Domain Locations(D20030489)*, wherein it has been held that registration of a well known trademark of which the Respondent must reasonably have been aware is in itself sufficient to amount to bad faith. Complainant marked the copy of the decisions as "**Annexure-I**".

B. Response by the Respondent:

It is the case of the respondent that he registered the domain <MSN.in> solely for an upcoming online project named "Ms.N" and "Ms." is an English honorific used with the last name or full name of a woman, while the "N" stands for people. The disputed domain name <MSN.in> includes the word msn, but in fact the word msn is referring to "Ms.N". Since the respondent unable to register the domain <Ms.N.in> due to the inherent limitation of a domain structure, the respondent therefore omitted the "dot" between Ms and N, and hence registered <MSN.in>. According to the respondent, most of the cases annexed by the Complainant in the Annexure may have bias, because the respondents in such case likely did not file any response to the Panel. According to the respondent, the domain <MSN.in> never resolves to the Complainant's website, and the Complainant statement is false and groundless. The respondent further states that the Complainant submitted the false statement for some improper purposes, so as to harass of the respondent, and Complainant has not filed the complaint in a bonafide manner. The respondent further states that he has deferred the online project "Ms.N" due to the financial crisis, and the respondent is registered the domain in a bonafide manner, although the domain still is not resolved yet.



C. Re-joinder by the Complainant

The Complainant states that the Respondent has registered the domain name <msn.in> thereby - misappropriating illegally and without authorization the trademark MSN which is the exclusive property of the Complainant. And in spite of the contention of the Respondent that he has registered the domain name for the furtherance of an online project named "Ms. N", "Ms" being an honorific English title and "N" referring to a person, the Respondent contends that his domain name <msn.in> really signifies "Ms.N". But according to the Complainant the impugned domain name is phonetically, visually, and structurally identical to Complainant's registered trade mark <msn.in> thereby not only infringing the proprietary rights of the Complainant over the said mark but by doing so also causing a confusion among the general public and the Complainant's mark MSN is registered in numerous countries in several classes of goods and services and the MSN's internet portal <msn.com> is the 6th most visited domain name on the Internet. The Complainant contends that their mark has acquired reputation and goodwill as a result of continuous uninterrupted worldwide use since 1995 and the respondent activity would create confusion to the general public, and consumers would assume some sort of association or affiliation between the Complainant and the Respondent and also no website has been uploaded on the impugned domain name and the same resolves to the Complainant's websites thus perpetuating confusion among the users who wish to access the Complainant's website. As regards the contention that the case law annexed by the Complainant are biased, the Complainant states that the cases are decisions given by the WIPO Arbitration and Mediation Centre and the fact that the decisions were made *ex parte* does not in any manner affect the validity and binding nature of the decisions. The Complainant however states that no false statements or allegations have been made by the Complainant. And it is further contention of the Complainant that it is the Respondent who has infringed the trade mark of the Complainant and necessitated the filing of the present complaint.

6. Discussion and Findings:

It has to be asserted as to whether the Constitution of Arbitral Tribunal was proper? And Whether the Respondent has received the notice of this Arbitral Tribunal?



Having gone through the procedural history, this Tribunal comes to the irresistible conclusion that the Arbitral Tribunal was properly constituted and Respondent has been notified of the complaint of the Complainant. In fact, no parties raised any objection over constitution Tribunal and that both the parties have effectively participated in the process of dispute resolution.

Under paragraph 4 of the IN Domain Name Dispute Resolution Policy (INDRP), the Complainant must prove each of the following three elements of its case:

- (i) The Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) The Respondent has no rights or legitimate interest in respect of the domain name; and
- (iii) The Respondent's domain name has been registered or is being used in bad" faith.

(a) Identical or confusing similarity:

The registered name of the Complainant is Microsoft Corporation. Complainant has furnished a list under "Annexure-A" which include their most widely used operating system software and application software numbering about 278. Complainant has also furnished the Trade Mark Registration Certificate under "Annexure-B" for having the registered trade mark "MICROSOFT" and also <msn.com> under "Annexure-C". Complainant has also furnished the trade mark "MSN" Certificate under "Annexure-D". The main defence of the respondent is that his upcoming online project is named as "Ms.N", out of which "Ms." is an English honorific that used with the last name or full name of a woman and the 'N' stands for people. However, the respondent has not produced any material to support his contention that 'N' stands for people and that the respondent has not shown any connection or resemblance between his upcoming online project and the "Ms.N". In any event, the respondent attempts to educate a reason that due to the inherent limitation of a domain structure, he omitted the "dot" between "Ms and N", and registered <MSN.IN>, which is neither plausible nor permissible in law. Merely because of non-availability of a particular structure in domain name, no one can be



permitted to encroach upon another one's lawful domain. Even the respondent's admission that he has deferred the online project "Ms.N" raises strong suspicious over the respondent's bonafide.

(i) Admittedly, the disputed domain name <msn.in> include the word msn, which is identical .and confusingly similar as a whole to the well known and registered trademark msn.com in which the Complainant has statutory rights as well as rights in common law, by virtue of a long and continuous user and being its registered proprietor thereof. The respondent's domain name <msn.in>, consists of entirely Complainant's trade mark, except ccLTD. Thus, this Arbitral Tribunal comes to the irresistible conclusion that the disputed domain name <www.msn.in> is confusingly similar or identical to the Complainant's marks. Thus respondent's domain name is likely to cause confusion, mistake and deception, and hence constitutes infringement of Complainant's domain name and trademark, as well as constituting unfair competition.

(ii) The Arbitral Tribunal concludes that the Complainant has established paragraph 4(i) of the IN Domain Name Dispute Resolution Policy.

(b) Respondent's Rights or Legitimate Interests:

i) The Complainant contends that the Respondent has no legitimate interest in the disputed domain name. There is no materials exhibited on the part of the respondent that he is prior user of the impugned domain name and also the respondent is not commonly called by the domain name. The respondent's domain name will misleadingly divert customers or tarnish the trademark of the Complainant.

ii) From the materials exhibited, the Respondent does not have rights or legitimate interests in the disputed domain name as the Respondent's current use is neither an example of a bona fide offering of goods or services as required under paragraph 7 (i) of the policy nor is there any legitimate non-commercial or fair use of the disputed domain name as such there is no evidence that Paragraphs 7(ii) or 7(iii) of the policy apply. The Complainant asserts that they have not licensed or otherwise authorized the Respondent to use their trademark.



iii) The Arbitral Tribunal is satisfied that the Respondent has no rights or legitimate interests in respect of the disputed domain name and, accordingly paragraph 4(ii) of the Policy is satisfied.

(c) Registration and Use in Bad faith:

i) Paragraph 6 of the Policy provides the circumstances evidencing registration and use of a domain name in bad faith are that, by using the same, the Respondent has engaged in the similar business competing with the Complainant and the Respondent has intentionally attempted to attract, for commercial gain, internet users to the Respondent's web site or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's web site or location.

ii) The Respondent has registered the domain name which appears to have been selected precisely for the reason that it is identical or confusingly similar to registered trademarks, trade names and corporate name of the Complainant. The Respondent has no affiliation with the Complainant. Registration of a domain name that is confusingly similar or identical to a famous trademark by any entity, which has no relationship to that mark, is itself sufficient evidence of bad faith registration and use.

iii) In view of the submitted evidence and in the specific circumstances of this case, this Arbitral Tribunal draws the legal inference that Respondent's purpose of registering the domain name was in bad faith within the meaning of the Policy. The Respondent has no legitimate rights or interests in the disputed domain name and there was no real purpose for registering the disputed domain name other than for commercial gains, and that the intention of the Respondent was simply to generate revenue, either by using the domain name for its own commercial purpose or through the sale of the disputed domain name to the Complainant itself or any other person that has the potential to cause damage to the ability of the Complainant to have peaceful usage of the Complainant's legitimate interest in using their own trade names and the registration has intentionally attempted to attract Internet users to its website for commercial gain, by intentionally creating a likelihood of confusion with the Complainant's mark, thus misleading consumers.



In the light of the above, this Arbitral Tribunal finds that the Complainant has established that the disputed domain name was registered and is being used in bad faith.

7. Decision:

For all the foregoing reasons, in accordance with Rule 3(b) (vii) of the INDRP rules, the Arbitral Tribunal orders that the disputed domain name <www.msn.in> be transferred to the Complainant.

Dated at Chennai (India) on this 11th day of November, 2009.


(D.SARAVANAN)
Sole Arbitrator