



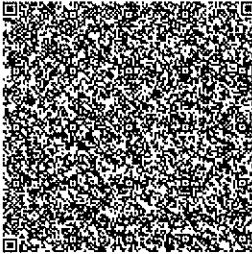
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Unique Doc. Reference : SUBIN-DLDSLHIMP1763671818597983Q
Purchased by : SUDARSHAN KUMAR BANSAL
Description of Document : Article 12 Award
Property Description : Not Applicable
Consideration Price (Rs.) : 0
(Zero)
First Party : SUDARSHAN KUMAR BANSAL
Second Party : Not Applicable
Stamp Duty Paid By : SUDARSHAN KUMAR BANSAL
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IN Registry
(NATIONAL INTERNET EXCHANGE OF INDIA)
ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: SUDARSHAN KUMAR BANSAL

INDRP Case No. 1016

COMPLAINANT
Ziff Davis, LLC,

VERSUS

RESPONDENT
Prabhakar Gupta

ARBITRATION AWARD

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.IN Registry
(NATIONAL INTERNET EXCHANGE OF INDIA)

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: SUDARSHAN KUMAR BANSAL

INDRP Case No. 1016

COMPLAINANT

Ziff Davis, LLC,
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VERSUS

RESPONDENT

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ARBITRATION AWARD

1. The Complainant is aggrieved by the domain name www.ookla.co.in being registered with the sponsoring Registrar Endurance Domains Technology LLP (R173-AFIN) in the name of the Respondent and being so used by the Respondent and has accordingly made this Complaint seeking the relief that this domain name www.ookla.co.in be transferred to it or the same may be cancelled.

2. The Complainant has preferred this Complaint on the basis of its claimed proprietary rights in its trade mark OOKLA word and stylized and

J. H. Bansal

various domains bearing the word/mark OOKLA on the following averments in gist :-

2.1 The Complainant claims to be a corporation organized and existing under the laws of the state of Delaware USA and claims its history to date back to the year 1927. The Complainant claims to be initially in the business of publications and thereafter claims to have forayed into a wide range of different businesses through acquisitions and mergers effected over a period of time and claims to be operating by itself as also through its associated companies and divisions. The Complainant claims to be a leading global digital media operating in three core verticals viz. technology, gaming and shopping.

2.2. One such important business of the Complainant and being the subject matter of the present Complaint, is that of digital media and providing of broad-band and mobile testing services and mobile-applications, mobile-network testing applications, data and analysis of internet access parameters, band-width and latency of a visitors internet connections against one of many geographically dispersed servers located around the world [referred to as the said "services" and/or "business" for the sake of convenience].

2.3. The Complainant claims to be carrying of its said business through its website www.speedtest.net, www.ookla.com and mobile-apps.

2.4. The Complainant in relation to its said business claims to be using its proprietary trademark OOKLA word and stylized and various domains bearing the word/mark OOKLA [referred to for the sake of convenience as the said trademark and/or OOKLA trademark/domains] launched globally in the year 2006.

2.5 The Complainant claims to be the proprietor of its said OOKLA trademark/domains and claims to have built up a globally valuable trade goodwill and reputation there under. According to the Complainant, its said OOKLA trademark/domain duly identifies its said business from its source and origin alone and is a quality identifier of its said business having achieved distinctiveness and secondary significance. The Complainant claims its said OOKLA trademark/domain to be "well-known mark" and of its enjoying global presence and its identity, business, reputation, public identification under its said trademark to be across the globe including in India.

2.6 The Complainant claims its trademark OOKLA word and stylized to be registered in the USA and of it to own several OOKLA formative domains created over a period of time and to be so registered with it.

2.7 The Complainant claims its website is to be very popular amongst internet users which disseminates valuable information and is a source of knowledge of its said business under its said trademark and which websites are a primary source for its global promotion and that its goodwill and reputation under the said OOKLA trademark/domain to pervade both the real world as well as the cyber space. It is further claimed that the website is accessible in India also, and that the Complainant is well recognized and followed on the social networking sites like Facebook Page (with 189,308 Likes) and Twitter profile (with 7,316 followers).

2.8 The Complainant claims its company OOKLA was launched globally in April 2006 which currently comprises of highly acclaimed websites that has its alleged reach to over 53 million tech, health, video game and entertainment enthusiasts. The Complainant emphasizes on its claim that OOKLA trade mark is the global leader in fixed broadband and mobile network testing applications, data and analysis. The Complainant claims

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that over ten (10) million tests are initiated by consumers each day with over twenty (20) billion tests completed till date and has been adopted by over 80% of internet service providers and mobile carriers worldwide.

2.9 The Complainant claims to have total of 7,212 global testing servers, with 419 servers in India which are used hundreds of thousands of times daily. Further, it is claimed by the Complainant that they have entered into brand licensing deals with India's largest network operators and Speedtest Customs product is licensed by nearly 1778 Indian clients.

2.10 The Complainant claims that its activities and standing with reference to its OOKLA trade mark/domains have been well reported and commented upon by independent and credible media.

2.11 In gist the Complainant claims to possess statutory rights and common rights in its said OOKLA trademark/domain and of the said OOKLA trademark/domain to be its most valuable intellectual property.



2.12 The Complainant in the Complaint has made numerous pleadings in support of its reach, users, operations, registrations as well as filed documents as **Annexure A to L** and which would be noticed as far as relevant in the course of this Award.

3. According to the Complainant the Respondent, has adopted the impugned domain www.ookla.co.in and has got it registered in its name with sponsoring Registrar as per the WHOIS report attached with the Complaint and is so using the same in relation to the same/similar services and business to that of the Complainant.

3.1 According to the Complainant, the rival disputed and impugned domain name www.ookla.co.in in the name of the Respondent is in violation

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of the Complainants OOKLA trade mark/domains and its rights thereunder and the goodwill and reputation associated therewith being identical with and confusingly similar thereto and whereby consumer deception is being caused and in which impugned domain the Respondent has no rights or legitimate interest and which impugned domain is in bad faith. The Respondent by its impugned domain name and usage is making illegal pecuniary gains to cash upon the goodwill and reputation associated with the Complainant OOKLA trade mark/domains causing loss and injury to the Complainant.

3.2 According to the Complainant, the Respondent on its website available under the impugned domain name is prominently using the Complainants OOKLA trade mark and has adopted a very similar artistic logo  as to that of the Complainant's . The Complainant claims that upon visiting the impugned domain name www.ookla.co.in of the Respondent the home page displays the text 'welcome to OOKLA Telecom' which claims to be a telecom network service provider, providing internet services, consultancy, technology solutions for business, server solutions, bandwidth, broadband, cable TV and is a cable internet operators in addition to providing internet (WiFi) etc. The screenshots of the website accessible through the impugned domain www.ookla.co.in is annexed with the Complaint.

3.3 According to the Complainant, upon receiving the information about the existence of the Respondent with the impugned domain www.ookla.co.in they addressed cease and desist notices dated 12.02.2018 and 16.03.2018 to the Respondent, informing him interalia about their rights associated with the mark 'OOKLA' and even responded vehemently to the replies of the Respondent thereto and despite the same the Respondent has failed to comply with the terms of its said notices. The Complainant alleges the Respondent to have in fact admitted in its replies

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to its notices that it adopted the impugned domain willfully and of his being aware of the Complainants OOKLA trade mark prior thereto. The copies of the cease and desist notices and replies have been filed.

3.4 According to the Complainant the impugned activities of the Respondent including in the adoption and use of the impugned domain is without its leave and license.

4. Vide the present Complaint, the Complainant has sought an order that the disputed domain name www.ookla.co.in be transferred to it.

5. 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 by-laws; rules and guidelines made therein and notified the factum thereof to the Complainant through its attorneys and authorized representatives as well as to the Respondent. The .IN Registry appointed me as the sole Arbitrator of this case on 30.07.2018 and served upon me (the sole Arbitrator) the physical set of the entire Complaint paper book.

5.1 Thereafter, I (sole Arbitrator) issued a notice to the Respondent vide E-mail dated 04.08.2018 with copy of the Complaint and Annexures/documents filed therewith 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 with supporting documents within a period of ten (10) days.

5.2 The Respondent duly responded to the said notice vide its e-mail dated 07.08.2018. In the e-mail the Respondent requested to meet me (Sole Arbitrator) to talk about the complaint. I declined to accede to such a request and instead directed to the Respondent to file its reply/response

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with documents in support of its position and in contest of the Complaint which would be considered as per law. This was vide my E-mail dated 08.08.2018.

6. The Respondent thereafter addressed an e-mail dated 16.08.2018 to this Arbitral Tribunal raising various averments in its defence and in gist as under:

- (a) That it is dealing with internet providing under the impugned domain and that he is a small business and its business is not even 1% of the Complainant.
- (b) That its services under the impugned domain are different to those of the Complainant.
- (c) That the impugned domain was available at cheap price.
- (d) At the time of its registration of the impugned domain it was not registered by anyone and that he was not aware of the fact that domain names cannot be registered if by chance they are same as any other foreign domain name.
- (e) That it registered the impugned domain in complete legal procedure and was not aware that by doing so there could be an infringement of any other parties right.
- (f) That while studying about speed test server it had addressed the Complainant for help and support.
- (g) That its adoption and use of the impugned domain is in good faith without mala fide, without intention to infringe.

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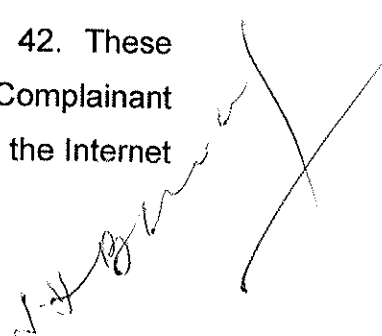
- (h) That being a small company it cannot take away the benefits of the goodwill of the Complainant's domain and that he could display a text on its website homepage in bold letters to the effect that his website is not related to ookla.com in any way.
- (i) That he has been using the impugned domain since the last more than one year and that he would suffer immensely if this domain is denied to him.

7. The said E-mail of the Respondent was considered by me (Arbitral Tribunal) as the Respondents response and thereafter I (Arbitral Tribunal) vide e-mail dated 20.08.2018 sent a notice to the Complainant informing them of the response sent by the Respondent dated 16.08.2018 and Complainant was given a period of ten(10) days to file their rejoinder thereto.

7.1 The Complainant vide its e-mail dated 30.08.2018 filed a Rejoinder to the Respondents aforesaid response refuting the averments of the Respondent and reiterating its Complaint allegations.

8. In the aforesaid facts and circumstances and in light of the pleadings and material on record I now proceed to adjudicate this Complaint.

9. The Complainants trade mark OOKLA word are duly registered in name of the Complainant in the USA under serial No.85015491 filing date 16.04.2010 in classes 38 and 42 ; No.85015486 filing date 16.04.2010 in class 9 ; while the trade mark OOKLA stylized is duly registered under No.87413770 filing date 17.04.2017 in classes 9, 35 and 42. These registrations cover a wide range of goods and services of the Complainant including those pertaining to the field of Internet connections via the Internet

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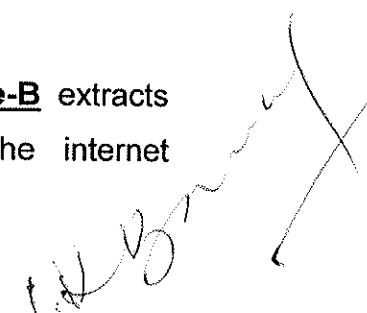
and providing a website featuring technology in the form of non-downloadable software that enables users to monitor, test, analyze, and obtain reports on the speed of Internet connections. The Complainant has placed on record as **Annexure-B** printouts of these registrations obtained from the e-records of the United States Patent and Trade Mark Office. These registrations in the USA do establish the trade mark OOKLA to be in existence and filed for in the year 2010.

10. The Complainant also owns numerous domains bearing the word/mark OOKLA as per the particulars filed as **Annexure-E** to the Complaint. One such domain www.ookla.in is duly registered with the sponsoring Registrar with the creation date of 12.07.2013 in the name of the Complainant. Another such Domain is www.ookla.it which is registered with the sponsoring Registrar with the creation date of 28.01.2014 in the name of the Complainant.

11. As per the WHOIS database, filed as **Annexure-G** by the Complainant, the disputed/impugned domain name www.ookla.co.in in the name of the Respondent was registered with the sponsoring Registrar Endurance Domains Technology LLP (R173-AFIN) with the date of creation of 05.06.2017.

12. This impugned domain registration is much subsequent to the Complainant's aforesaid USA Trade Mark Registrations as per **Annexure-D** as well as the Complainant's adoption of various domains as can be noticed from **Annexure-E**. Thus it is apparent that the Complainant's said OOKLA trade mark/domains are much prior and senior in their factum and existence to the impugned domain.

13. The Complainant has placed on record as **Annexure-B** extracts from leading News Papers and articles published on the internet

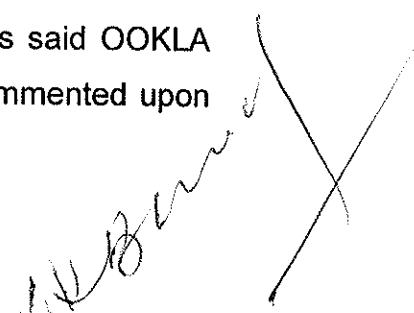


highlighting various aspects of the Complainant's business and activities under the OOKLA trade mark/domain. Some such articles are those published by the DT News network, The Economic Times (Editions Chandigarh, Delhi, Chennai, Kolkata, Ahmedabad, Pune, Mumbai), The Hindu Business Line (Editions Pune, Kochi, Delhi, Mumbai, Kolkata, Bangalore, Chennai, Bhubaneswar), The Indian Express (Editions Kolkata, Ahmedabad, Delhi, Jaipur, Mumbai, Chennai, Bangalore, Pune, Jaipur) ; and the e-newspaper of Business Standard, The Indian Express, Time of India, Financial express etc. These articles have extensively reported upon and analyzed the Complainant business and standing with reference to its OOKLA trade mark/domains.

14. The Complainant has also placed on record as **Annexure-C** the Extracts from various social networking sites like Facebook and Twitter where on the Complainant has been extremely active. The Complainant has received about 189308 likes on its Facebook page while claims to have 7316 followers on its Twitter handle.

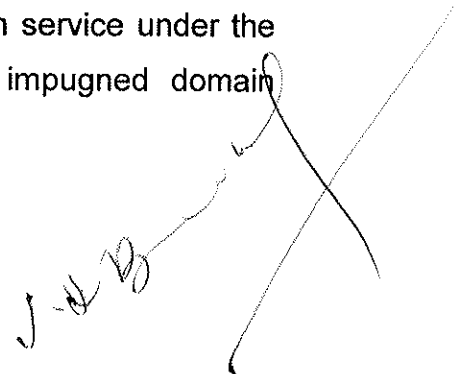
15. According to the Extracts from the Complainant website www.ookla.com filed as **Annexure-F** the Complainant speed test services available under the trade mark OOKLA has been used by over 20 billion times by users across the globe. The Complainant website under its said domain highlights various features and characteristics of the Complainant and its business, standing and stature under the OOKLA trade mark/domains. The internet, social network sites and the Complainant website (**Annexure-B, C & F**) have substantial presence and easy accessibility in India and to the Indian Consumer.

16. Thus the Complainant and its said business under its said OOKLA trade mark/domain have been well reported, written and commented upon by independent media as also by the Complainant itself.



17. In light of the aforesaid, I am of the considered view that the Complainant has been able to establish that it have been in active business under its said OOKLA trade mark/domains in the Indian as well as in the international markets through e-commerce and over the internet enjoying noticeable commercial visibility, market presence and standing in India and Overseas and of the market and trade both in India and Overseas being well aware of the Complainant, the Complaint's said OOKLA trade mark/domain and the Complainants business thereunder. The Complainants said OOKLA trade mark/domain were in existence, in vogue and in use in the market. Consequently, in my view, the Complainants said OOKLA trade mark/domain and the business thereunder also satisfies the territoriality test mandated by the Hon'ble Supreme Court in its decision of Toyota Jidosha Kabushiki Kaisha vs M/S Prius Auto Industries Limited reported in AIR 2018 SC 167.

18. The knowledge, standing and presence of the Complainant OOKLA trade mark/domain and the Complainants business thereunder in India is even apparent from the fact that the Respondents itself had sought the help and support of the Complainant in relation to a speed test server (as per the Respondents reply dated 16.08.2018) and had used the Complainant speed test custom services to check the network/broadband/speed of the Respondents ISP (borne out from the Respondents letter dated 16.02.2018 addressed to the Complainant and filed on record as part of Annexure-I). This speed test services to check network/broadband/speed is provided by the Complainant under its OOKLA trade mark. Further the Respondent itself had inserted the Complainant's speed test custom service under the trade mark OOKLA on its own website under the impugned domain www.ookla.co.in.

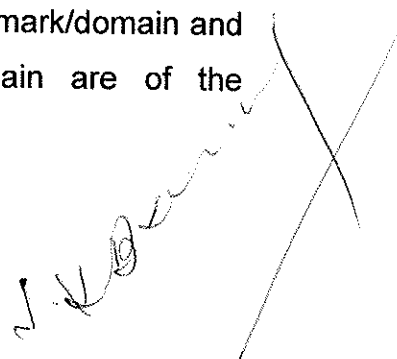


19. In my considered view the word/mark OOKLA is an arbitrary or fanciful mark in relation to the said goods and business of the Complainant, as per para 2.2 above, and has no descriptive or generic connotation thereto and as such the OOKLA trade mark/domains enjoy inherent distinctiveness and are consequently strong trade marks/domains.

20. In view of the aforesaid I am of the considered view that the Complainant has been able to establish its rights and interests in its OOKLA trade marks/domains. This is more so as the Respondent has also not disputed the Complainant's said rights and interests in the OOKLA trade mark/domains in its reply dated 16.08.2018 filed in this Complaint.

21. In my considered view, the disputed domain name is identical with and/or deceptively similar to the Complainant's prior and well established OOKLA trade mark/domain in each and every manner including phonetically, visually, structurally and conceptually. The word/mark OOKLA is an essential dominant and distinguishing feature of the disputed domain name. It is with reference to the word/mark OOKLA that the disputed domain name would be remembered or accessed to by an average consumer **[See B.K. Engineering Company Vs. U.B.H.I. Enterprises AIR 1985 Delhi 210 (DB); Kirorimal Kashiram Mktg & Agencies Pvt.Ltd., Vs Shree Sita Chawal Udyog Mill 2010 (44) PTC 293 (Del) (DB); South India Beverages Pvt. Ltd., vs. General Mills Marketing Inc., 2015 (61) PTC 231 (Del) (DB)].**

22. In my considered view the nature of business and services being provided by the Complainant under its said OOKLA trade mark/domain and those of the Respondents under the disputed domain are of the same/similar nature and description.

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22.1 As per the Respondents website under the impugned domain, extracts of which has been filed as **Annexure-H** to the Complaint, the Respondent claims to be offering services therein in respect of Bandwidth, Broadband, Hardware and Networking Solutions, Internet Service, ISP Network Design and Support, IT Security, Technology Solutions for Business and the like. In its reply dated 16.08.2018 the Respondent claims to be dealing with internet providing under the impugned domain.

22.2 These business and services are extremely close and overlapping to the Complainants goods and services, as per para 2.2 above, which include these Broadband and mobile network testing applications, data analysis being offered through the internet. Both the Complainants and the Respondents business are in the field of internet related services pertaining to broadband and testings and have a close trade connection. The mode of use of the competing services and their class of customers are the same as also the competing services can be used for the same purposes. The rival and competing services and business belong to the same family and same class viewed from a practical business and commercial point of view. **[See Bhagwant Lal Chaman Lal Versus Shulton Inc., reported in 2005 (30) PTC 88 (IPAB)].**

22.3 The Respondent itself has used the Complainants speed test custom service to check the network/broadband speed of its own ISP thus establishing a trade connection between its impugned services with those of the Complainant **[See Corn Products Refining Co., Vs. Shangrila Food Products Ltd., reported in 1960 (1) SCR 968].**

22.4 In any case an average consumer is not expected to know the fine engineering or technical differences between the rival and competing services and businesses. It is the mental perception of such an average consumer that is the relevant test. **[See Mahendra & Mahendra Paper**

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Mills Ltd. vs. Mahindra & Mahindra Ltd. reported in AIR 2002 SC 117 ; Kirloskar Diesel Recon Pvt. Ltd. and Anr. vs. Kirloskar Proprietary Ltd. and Ors. reported in AIR 1996 Bom 149]. To such a consumer the rival and competing services and business would be the same/similar.

23. Having regard to the similarity in the competing and rival trade mark/domains and the close nature of the rival and competing business and services thereunder, in my considered view a mental image would be formed in the minds of the ordinary consumer, market and trade suggesting the Respondents impugned business to be of the Complainant or to be associated, sponsored, affiliated or in some way connected with the Complainant or to be an extension of the Complainants business or to be licensed by it. Thus the consumer, market and trade would be confused into believing the Respondents services and businesses under the impugned domain to be from the source and origin of the Complainant or related thereto and consequently an unjust association would be formed between the Complaint and the Respondent leading to market and consumer deception amounting to misrepresentation whereby loss and injury would be and/or potentially can be caused to the Complainant. **[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]**. The Complainant would have no hold over the Respondent or on the nature of the services being offered by the Respondent and would always suffer by any inferior quality services being offered by the Respondent even if pertaining to the genuine business of the of the Complainant. The Complainant's goodwill and reputation would be at the mercy of the Respondent.

24. A consumer or internet user seeking to access the Complainant or its services by erroneously or inadvertently suffixing the ".co.in" as the ccTLD

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(country code top-level domain) would be misled to the Respondent and consequently would be deceived by reaching somewhere else and not to the Complainant as it had intended.

25. Besides, the Complainant would have no hold on the Respondent's disputed domain name usage and would always suffer by the transfer of traffic to the Respondent's website. Also, since the Respondent is using the trademarks/domains of the Complainant, the Complainant's goodwill and reputation would be left in the hands of the Respondent or a third party over whom the Complainant would have no control. **[See Baker Hughes Limited Vs Hiroo Khushalani 1998 (18) PTC 580 (Del)].**

26. All these violative acts of the Respondent through the disputed domain would perpetually and irreparably not only tarnish the business of the Complainant but also dilute diminish, erode and eclipse the goodwill, reputation and distinctiveness attached to the Complainant's prior adopted and prior in use OOKLA trade mark/domains. Not only that even the consumers would suffer as they would not get what they expected and instead would be deceived.

27. There is a close relationship between Trade Marks and Domain Names. "Trade Marks" are source identifiers of goods or service from a particular source and distinguish them from those of others while "Domain Names" are source identifiers of the business of a particular entity. The basic principles of trade mark and passing off laws apply to domain name disputes **[Satyam Infoway Ltd. Vs. Sifynet Solutions Pvt. Ltd., 2004 (28) PTC 566 (SC)].**

28. The Respondent in its reply dated 16.08.2018 has avered that its adoption and use of the disputed domain is in good faith, without any

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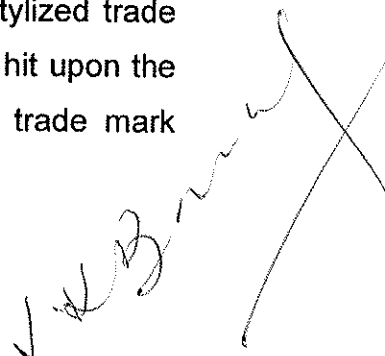
malafide and without any intention to cause any infringement and has been acquired by it at a cheap price.

28.1 In my considered view such a stand is not maintainable and is contrary to law. It has been well settled by the Hon'ble Supreme Court in its celebrated decision of Laxmikant V.Patel vs Chetanbhat Shah & Anr. reported in AIR 2002 SC 275 that the real test is whether by the rival trade mark market confusion or deception would be caused and it is immaterial whether the latter person (the Respondent in this case) does so fraudulently or otherwise. Thus the intention of the latter person in its impugned adoption or alleged use is not the test and that the Respondent can be held liable even if he acts innocently, without malafide or in good faith [See Ruston & Homby Ltd., Vs. Zamindara Engineering Co., reported in 1970 (2) SCR 222].

29. In my considered view even otherwise the very adoption and use of the rival domain is in bad faith and there are no elements of goodfaith or bonafide attached to the impugned domain.

29.1 It is beyond doubt that the Respondent was well aware of the Complainant, the Complainants said business and the Complainants said OOKLA trade mark/domain at the time of its impugned adoption and use.

29.2 The Respondent on its impugned website accessible under the impugned domain (extracts of which have been filed as Annexure-H to the Complaint) has incorporated thereon the OOKLA stylized trade mark which is a closely similar/reproduction of the Complainant OOKLA stylized trade mark. It can hardly be believed that a Respondent could have hit upon the substantial reproduction of a stylized/art work attached to a trade mark without any knowledge of the prior existing art work/stylization.

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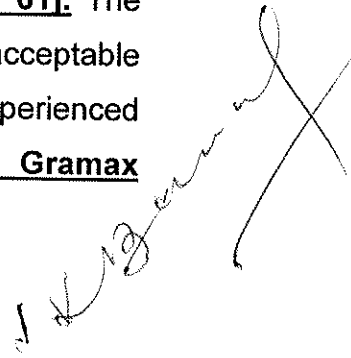
29.3 The Respondent had even provided the link to access speed test custom service of the Complainant on its impugned website accessible under the impugned domain and as admitted by the Respondent in its letter dated 24.02.2018 addressed to the Complainant and filed as part of Annexure-I to the Complaint.

29.4 The Respondents prior knowledge of the Complainant is also borne out from the fact that the Respondent itself had sought help and support from the Complainant in relation to its speed test server and as set out in its reply dated 16.08.2018.

29.5 The Respondent has not contested the Complainants rights in the Complainants said OOKLA trade mark/domains either in its reply filed to this Complaint or even in its response submitted to the Complainants cease and desist letters and filed as Annexure-I to the Complaint.

29.6 Not only that no plausible explanation leave aside a just cogent or credible explanation has been given by the Respondent as to how he came to adopt the disputed domain name bearing an identical word/mark OOKLA and which word/mark otherwise is an extremely arbitrary rare or fancy trade mark not forming part of the ordinary English language or its day to day language usage and which trade mark/domain in the hands of the Complainant enjoys global recognition and business.

29.7 Thus the circumstances attending to the adoption of the impugned domain by the Respondent at the first instance itself is tainted and smacks of dishonesty. [See M/s Hindustan Pencils Pvt. Ltd. v/s M/s India Stationary Products Company & Anr. reported in 1989 PTC 61]. The conduct of the Respondent falls short of the standards of acceptable commercial behavior to be observed by a reasonable and experienced person in the particular area of business at hand [See Gramax



Plasticulture Limited V/s Don & Low Nonwovens Limited 1999 RPC 3671.

30. In my considered view no cause can even be based on the Respondents alleged use of the disputed domain for the last more than one year or of it having built up any public rapport thereunder.

30.1 There is nothing on record to show that the Complainant has actually encouraged the Respondent use of the disputed domain in any form or manner. In fact the Complainant had even addressed cease and desist letters dated 12.02.2018 upon the Respondent impugning its impugned domain and had even vide its letter dated 23.02.2018 disputed the Respondents stand in the Respondents reply dated 16.02.2018 and the copies whereof have been filed as **Annexure-I** to the Complaint. The Complainant had also issued cease and desist letters dated 16.03.2018 through its Attorneys and which was replied to by the Respondent vide its letter of 01.04.2018 and which has been filed as **Annexure-J (Colly)** to the Complaint. The Respondent despite the Complainants said notices has continued with its impugned adoption and use of the disputed domain and has not complied therewith.

30.2 It can be taken that the Respondents impugned adoption and use of the disputed domain is without the leave license and authority of the Complainant.

30.3 As the very adoption of the impugned domain by the Respondent is tainted at inception it can safely be inferred that the Respondent so adopted and allegedly started using the impugned domain to make illegal profits, gains and benefits on the Complainants said OOKLA trade mark/domains and 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 and

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as such its impugned adoption cannot be given any credence even if the Respondent has invested a lot of money in its business. Besides having become aware of the rights and standing of the Complainant from the Complainants cease and desist legal notices dated 12.02.2018 and 16.03.2018 any continued use of the impugned domain would be at the risk and peril of the Respondent itself. **[See Hindustan Pencils Pvt. Ltd., supra].**

31. No benefit can accrue on the impugned domain name upon the Respondent on account of the Respondent being a small company as has been sought to be pleaded by him.

31.1 The Respondent as per present may be a small company but in times to come it may grow in size and business by using the Complainants OOKLA trade mark/domain and its goodwill. All this would cause huge damage to the Complainant at a future point of time even if it was to be taken for the sake of argument that for the moment there may be no immediate harm to the Complainant. It is legitimate for a Court of Law or Tribunal to consider as to how a business may be carried on in the future and not limit itself to the situation that may exist at the date of the proceedings at hand **[See Laxmikant V. Patel supra].**

32. In my considered view the Respondents offer to incorporate a disclaimer on its impugned website to the effect that it is not related to the Complainants domain ookla.com in any way in bold letters cannot be acceded to.

32.1 Such a disclaimer would be of no effect and nor would it remedy any wrong as the consumers or internet users stand deceived at the threshold of logging/entering into the website of the Respondent by using the impugned domain name itself. Such a usage of the disputed domain has

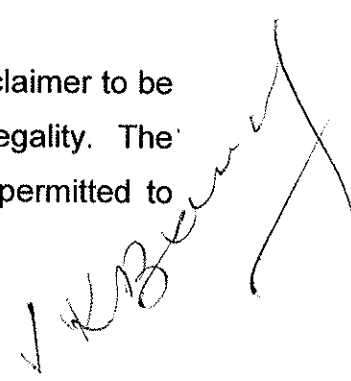
J. K. Bhatnagar

been effected by the internet user/consumer under the impression that the impugned domain belongs to or is associated with the Complainant. By not reaching the Complainant and instead reaching the Respondent by such a use the consumer stands deceived at the very inception as he has reached a destination where he did not intend to reach at the first instance.

32.2 In this regard the observations made in the judgment of **Bosewell-Wilkie Circus (Pty) Ltd., Versus Brian Boswell Circus (Pty.) Ltd., reported in 1985 Fleet Street Report 434** can be safely relied upon. In this case the Respondent sought to allay all likelihood of confusion by maintaining that its ring master in its circus prior to the commencement of each performance announces that it has "nothing to do with any other circus which is currently touring South Africa". The court rejected such a disclaimer by holding that the spectators at a particular session have already bought their tickets and are seated after all by the time they hear the announcement and consequently the confusion would therefore already have taken place.

32.3 The grant, use or conferment of disclaimers, whether voluntary or by court/judicial orders, can never be as a matter of right and nor in the usual course. To do so would amount to negation of the scheme and intent of the trade mark/domain laws which are in gist to protect Trade Mark/Domain name, the public and promote fair dealings. To permit disclaimers as a matter of right or as a matter of course would give a license to any violator to freely use a violative mark/domain by simply incorporating a disclaimer. This would be against the very mandate of law. Under the guise of disclaimer a violative use cannot be protected.

32.4 In the present facts and circumstances, permitting a disclaimer to be incorporated would in gist amount to perpetuating an illegality. The Respondent under the guise of such disclaimers cannot be permitted to

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carry on its impugned violative use and especially as its own conduct is tainted and smacks of malafide. There are no equities with the Respondent to be balanced with the Complainant's rights. Permitting such a disclaimer or any other disclaimer would amount to giving the respondent the benefit of its own wrong.

32.5 In my considered view the Complainant has been able to discharge its onus/burden and has established its proprietary and enforceable rights in the OOKLA trade mark/domain. The Respondent has no legitimate rights or claims on the disputed domain name which is a bad faith domain and by which the rights and standing of the Complainants OOKLA trade mark/domain are being violated and consumer and market deception ensuing or likely to so ensue.

33. Trade Marks, trade names and domains have been accepted to be valuable business assets to be protected against their wrongful adoption and use as rival domains and such violations have to be removed in the interest of the right holder and consumers swiftly and effectively.

34. I have no reservation in holding that the Complaint must be allowed.

Accordingly, it is decided that the disputed domain name **www.ookla.co.in** be transferred to the Complainant.

Signed at New Delhi, India on this 22nd day of September, 2018.


Sudarshan Kumar Bansal
Sole Arbitrator