



सत्यमेव जयते

## INDIA NON JUDICIAL

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### e-Stamp

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Certificate Issued Date	: 03-Aug-2019 10:32 AM
Account Reference	: IMPACC (IV)/ dl839103/ DELHI/ DL-DLH
Unique Doc. Reference	: SUBIN-DL83910372090887089715R
Purchased by	: V K AGARWAL
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: V K AGARWAL
Second Party	: Not Applicable
Stamp Duty Paid By	: V K AGARWAL
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



INTERNET EXCHANGE OF INDIA

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15, Barakhamba Road,  
New Delhi – 110 001

Bennett Coleman & Company Ltd., v. Mr. Chintan Mandir

### AWARD

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**Statutory Alert:**

1. The authenticity of this Stamp Certificate should be verified at "www.shcilestamp.com". Any discrepancy in the details on this Certificate and as available on the website renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
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## 1. The Parties

In this case there are two Complainants. They are:

1. **Bennett Coleman & Company Limited,**  
Times of India Building,  
Dr. D. N. Road,  
Mumbai – 400 013

2. **Times Internet Limited,**  
Express Building,  
Bahadurshah Zafar Marg,  
New Delhi 110 002

The Respondent is Mr. Chintan Mandir, Morbi, Gujarat - 363642

## 2. The Domain Name and Registrar

The disputed domain name is <**www.imgujarat.in**>. The said domain name is registered with GoDaddy.com LLC, 14455, North Hayden Rd., Ste. 226, Scottsdale, AZ 85260, United States of America. The details of registration of the disputed domain name, as per Annexure 3 to the Complaint, are as follows:

(a) Domain ID:	D41440000006507792 – AFIN
(b) Registrar:	GDaddy.com LLC
(c) Date of creation:	August 15, 2018
(d) Expiry date:	August 15, 2019

## 3. Procedural History

(a) A Complaint dated July 12, 2019 has been filed with the National Internet Exchange of India. The Complainants have made the registrar verification in connection with the domain name at issue. The print outs so received are

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attached with the Complaint as Annexure 3. It is confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the "Policy") and the Rules framed thereunder.

- (b) The Exchange appointed Dr. Vinod K. Agarwal, Advocate and former Law Secretary to the Government of India as the sole arbitrator in this matter. The arbitrator finds that he has been properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.
- (c) In accordance with the Policy and the Rules, an attempt was made to send a copy of the Complaint to the Respondent on the given address. However, the efforts did not succeed due to incomplete/wrong address. Hence, the present proceedings have to be ex parte.

#### **4. Factual Background**

From the Complaint and the various annexure to it, the Arbitrator has found the following facts:

##### **Complainant's activities**

The Complainant No. 1 is engaged in the business of publishing newspapers, journals, magazines, books and periodicals. Over the years it has forayed into business fields such as television, radio, and digital business, online content publishing and other online services, as well as

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lifestyle and entertainment services.

The Complainant No. 1 entered the field of digital innovation through Complainant No. 2, which is the “digital venture” of the Complainants’ group of companies. The Complainant No. 2, established in the year 1999, has let the internet revolution in India and has emerged as India’s foremost web entity, running diverse portals and websites. The Complainant No. 2’s portfolio has expanded to a wide range of online offerings, spanning news, MVAS, email, blogs, music, video and location based services.

The Complainant No.1’s newspaper, namely, The Times of India is India’s most widely circulated English daily. In addition, the Complainant No. 1 also brings out a large number of newspapers in national and regional languages. It is not possible to give a complete list of such newspapers. However, the names of some of the newspapers by way of illustration are: The Economic Times, The Navbharat Times, The Maharashtra Times, Bangalore Mirror, Hyderabad Mirror, Times Infoline, Times Wellness, Times life, Times Global, Bombay Times, etc. There are an extremely large number of readers of these newspapers.

In the Complaint, it has been rightly observed that with the increase of commercial activity on the internet, a domain name has become a source of business identification. To-day the domain name not only serves as an address for internet communication but also identifies the specific internet site. A domain name is easy to remember and use, and is chosen as an instrument of commercial enterprise not only because it facilitates the ability of consumers to navigate the internet to find the website they are looking for, but also at the same time, serves to identify and distinguish the

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business itself, or its goods or services, and to specify its corresponding online internet location.

### **Respondent's Identity and Activities**

The Respondent's activities are not known.

## **5. Parties Contentions**

### **A. Complainant**

The Complainants contend that each of the elements specified in the .IN Domain Name Dispute Resolution Policy are applicable to the present dispute. The said elements are as follows:

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

In relation to element (i), the Complainants contend that the Complainant No. 1 with the objective to target specific section of readers belonging to the State of Gujarat, adopted a suggestive mark "I AM GUJARAT" and got the domain name **iamgujarat.com** registered on September 01, 2016. The Complainant No. 1 is also the registrant of the domain name **iamgujarat.in** since September 01, 2016. The said trademark is registered in English as well as in Gujarati language.

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The Complainants commenced the use of the trademark/ domain name I AM GUJARAT/**iamgujarat.com** from March 03, 2017 through their online publication website [www.iamgujarat.com](http://www.iamgujarat.com). Thus, the Complainant No. 1 is the owner of the trademark/domain name I AM GUJARAT/**iamgujarat.com** where as the Complainant No. 2 translates the contents and uploads the same on the website.


According to the Complaint, the said trademark has acquired enormous goodwill and reputation and high degree of distinctiveness, distinguishing and signifying the source of the services as originating from the Complainants and/or their group company.

The Complainant No. 1 has also applied for registration of the said trademark and such applications are pending registration. So far as the trademark "I AM GUJARAT" is concerned, the applications for its registration in English and Gujarati languages in Classes 41 and 42 have been submitted on July 17, 2017 and the same are pending registration. Copies of the applications are available at Annexure 10 to the Complaint.

The Complainant No. 1 is also the registrant and proprietor of various domain name registrations. Some such illustrations are as follows:

<[www.timesofindia.indiatimes.com](http://www.timesofindia.indiatimes.com)>;                      <[www.worldwidemedia.in](http://www.worldwidemedia.in)>;  
<[www.economictimes.indiatimes.com](http://www.economictimes.indiatimes.com)>;                      <[www.timesascent.com](http://www.timesascent.com)>;  
<[www.navbharattimes.indiatimes.com](http://www.navbharattimes.indiatimes.com)>, etc.

The Complainants contend that the disputed domain name contains the trademark of the Complainant No. 1, that is, I AM GUJARAT. The removal of the word "a" from the word "am" in a domain name is insignificant. It does not lead to any distinctiveness or reduce the similarity





to the trademark "I AM GUJARAT" of the Complainant. It will not be perceived by the relevant public as a different, eligible to distinguish the Respondent or the services offered under the disputed domain name from the Complainant. Further that, they do not help in distinguishing the disputed domain name from the Complainant's trademark. On the contrary, the disputed domain name leads the public to believe that it relates to the services rendered by the Complainant.

Therefore, the disputed domain name is identical and/or confusingly similar to the trademark 'iamgujarat' of the Complainants.

In relation to element (ii), the Complainants contend that the Respondent (as an individual, business, or other organization) has not been commonly known by the trademark or the expression "I AM GUJARAT". The Respondent does not own any trademark registration as "I AM GUJARAT/iamgujarat" or a mark that incorporates the expression "I AM GUJARAT". The Respondent has no license or authorization or permission from the Complainants to either use the designation "I AM GUJARAT" or to register the disputed domain name with the said words.

Further, the Respondent is not making a legitimate or fair use of the said domain name for offering goods and services. The Respondent has registered the domain name for the sole purpose of harping upon the goodwill and reputation of the Complainants in the trademark domain name I AM GUJARAT/iamgujarat and for creating confusion and misleading the general public.

Therefore, the Respondent has no legitimate justification or interest in the disputed domain name.

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It has been held in the World Intellectual Property Organization (Arbitration & Mediation Centre) Case No. D2000-0055 that *"...in the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated bona fide or legitimate use of the domain name could be claimed by the Respondent"*.

Regarding the element at (iii), the Complainant contends that the Respondent has registered the disputed domain name in bad faith and for its actual use in bad faith. The main object of registering the domain name <www.imgujarat.in> by the Respondent is to mislead the customers of the Complainant and internet users and the general public

Further that, the Respondent is in the business similar to the Complainants, that is, online publication of news. The disputed website under the impugned domain name <www.imgujarat.in> is an interactive website which invites public for subscription and is targeting customers in India. The consumers are visiting the disputed website under the belief that either the said website belongs to the Complainants or there is an association or endorsement of the disputed domain by the Complainants which is not the case.

The Respondent has not demonstrated any preparations to use the domain name or a name corresponding to the domain name in connection with any bona fide offering of goods or services.

The Complainants have stated that the use of a domain name that appropriates a well-known trademark to promote competing or infringing

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products cannot be considered a “*bona fide offering of goods and services*”.

In support of their contentions, the Claimants have relied on the decision in the case of *Yahoo Holdings, Inc., v. Harry G*, WIPO Case No. D2017 – 2232 wherein it has been held that, “*where a domain name incorporates a sufficiently well-known trademark, and the Respondent knew, or ought to have known, of the trademark’s existence, and the Respondent had no legitimate rights or interests in it, the domain name is considered to have been registered in bad faith*”.

## **B. Respondent**

The Respondent did not submit any evidence or argument indicating his relation with the disputed domain name <www.imgujarat.in> or any trademark right, domain name right or contractual right.

## **6. Discussion and Findings**

The Rules instructs this Arbitrator as to the principles to be used in rendering its decision. It says that, “a panel shall decide a complaint on the basis of the statements and documents submitted by the parties in accordance with the .IN Domain Name Dispute Resolution Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable”.

As has been stated above, according to Clause 4 of the said Policy, the Complainant must prove that:

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

A. *Identical or Confusingly Similar*

The disputed domain name <www.imgujarat.in> was registered by the Respondent on August 15, 2018. The registration of the said disputed domain name is due to expire on August 15, 2019.

The disputed domain name <www.imgujarat.in> gives rise to the confusion and deception *qua* its origin because the disputed domain name is phonetically, structurally and deceptively similar to the Complainant's trademark/ domain names "I AM GUJARAT/ iamgujarat.in/ iamgujarat.com". These domain names are instantaneously associated with the Complainants.

The Complainant No. 1 is also the owner of a number of domains with the trademark I AM GUJARAT as stated above and referred to in the Complaint. Most of these domain names and the trademarks have been created by the Complainants much before the date of creation of the disputed domain name by the Respondent. Thus, the disputed domain name is very much similar to the name and the trademark of the Complainant No.1.

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The pronunciation of both the words 'am' and 'm' is phonetically similar and identically. Therefore, the removal of the alphabet 'a' from the word 'am' does not change the proposition and phonetically the disputed domain name is identical to the trademarks and the domain names of the Complainants.

Further, a possibility that an internet user who wishes to visit the Complainant's website for news gathering, is likely to be taken to the Respondent's website cannot be ruled out. Thus, the internet user may see inaccurate news contents. It may be detrimental to the Complainant's earned goodwill and reputation.

Therefore, I hold that the domain name <www.imgujarat.in> is phonetically, visually and conceptually identical or confusingly similar to the trademark of the Complainant.

#### *B. Rights or Legitimate Interests*

According to Clause 7 of the Policy, the Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Registrant (as an individual, business or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or

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- (iii) The Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent's response is not available in this case. There is no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. The name of the Registrant/Respondent by which the disputed domain name is registered is Mr. Chintan Mandir. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.

Further, the Complainants have not consented, licensed or otherwise permitted the Respondent to use its name or trademark "I AM GUJARAT/iamgujarat" or to apply for or use the domain name incorporating said mark. The domain name bears no relationship with the Registrant/Respondent. Further that, the Registrant/Respondent has nothing to do remotely with the business of the Complainants.

I, therefore, find that the Respondent has no rights or legitimate interests in the domain name under INDRP Policy. Clause 4(ii) and Clause 7.

C. *Registered and Used in Bad Faith*

According to Clause 6 of the Policy, any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

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- (i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the domain name; or
- (ii) the Registrant's has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or
- (iii) by using the domain name, the Registrant has intentionally attempted to attract the internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

The contention of the Complainant is that the present case is covered by the circumstances mentioned herein above. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark. It may also lead to deceiving and confusing the trade and the public.

The Respondent's registration of the domain name <www.imgujarat.in> is likely to cause immense confusion and deception and lead the general public into believing that the said domain name enjoys endorsement or authorized by or is in association with and/or originates from the Complainant.

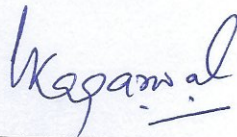
The foregoing circumstances lead to the presumption that the domain name

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in dispute was registered and used by the Respondent in bad faith.

### 7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to a mark in which the Complainants have rights, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered in bad faith and is being used in bad faith, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <www.imgujarat.in> be transferred to the Complainant.



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Vinod K. Agarwal  
Sole Arbitrator  
Date: 05<sup>th</sup> August 2019