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Manoj K. Singh v. Shailendra Singh

AWARD

1. The Parties

The Complainant is Manoj K. Singh Advocate, DBA M/s Singh & Associates, N- 30, Malviya Nagar, New Delhi - 110 017

The Respondent is Shailendra Singh, C - 46-A, Street No. 6, Jyoti Colony, Shahdara, Delhi - 110 032.

2. The Domain Name and Registrar

The disputed domain name <singhandassociates.in> is registered with Rediff.Com India Limited.

3. Procedural History

The Complaint was filed with the National Internet Exchange of India in December 2008. The Complainant has made the registrar

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verification in connection with the domain name at issue. The print out so received are attached with the Complaint. It is confirmed that the Respondent is listed as the registrant and the contact details for the administrative, billing, and technical contact for the disputed domain name are that of the Respondent. 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.

The Exchange appointed Dr. Vinod K. Agarwal, Advocate, Solicitor of the Supreme Court of England and Wales and Former Law Secretary to the Government of India as the sole arbitrator. The arbitrator finds that he was properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.

In accordance with the Rules, Arbitrator through a registered letter dated 29th December 2008 formally notified the Respondent of the Complaint. The Respondent was required to submit his defence within 15 days from the date of the receipt of the notification, that is, 20th January 2009. The Respondent was informed that if his response was not received by that date, he would be considered in default. The Arbitrator would still proceed to review the facts of the dispute and to decide the case. The Respondent did not submit any response.

4. Factual Background

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

Complainant's activities

The Complainant Mr. Manoj K. Singh is an Advocate by profession. The Complainant is providing various legal services to both corporate houses and individuals. The name of his legal firm is M/s Singh & Associates which started in 2002. The Complainant contends that M/s Singh & Associates has published many articles in various national and international legal journals. Further that, it has also participated in a large number of national and international legal conferences. The Complainant was also nominated as one of the "Best Deal Law Firm of the Year 2008" by Asian Legal Business.

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Respondent's Identity and Activities

The Respondent did not reply to the Complainant's contentions. Hence, the Respondent's activities are not known.

5. Parties Contentions

A. Complainant

The Complainant contends that each of the elements specified in the Policy are applicable to this dispute.

In relation to element (i), that is, the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, the Complainant contends that "Singh and Associate" is the name of its legal firm and its service mark. The disputed domain name <singhandassociates.in> is identical to the Complainant's service mark. Thus, the domain name <singhandassociates.in> is confusingly similar to the Complainant's service mark.

In relation to element (ii), that is, the Respondent has no rights or legitimate interests in respect of the domain name, the Complainant contends that the Respondent has never registered service mark as Singh and Associates or any similar mark. The Respondent (as an individual, business, or other organization) has not been commonly known by the domain name <singhandassociates.in>. Further, the Respondent is not making a legitimate or fair use of the said domain name for offering goods and services. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public and the customers of the Complainant.

Thus, it is contended that there were no legitimate rights or interests of the Respondent in the domain name "singhandassociates".

Regarding the element at (iii), that is, the domain name has been registered and is being used in bad faith, the Complainant contends that the main object of registering the domain name <singhandassociates.in> by the Respondent is to mislead the general public and the customers of the Complainant. The Complainant has contended that the use of a domain name that appropriates a well-known service mark and the name of a law firm to promote

competing or infringing products cannot be considered a "bona fide offering of goods and services".

Thus, it is contended that the Respondent has registered the disputed domain name and the same is being used in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

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 in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

According to the Policy, the Complainant must prove that:

- (i) The 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 interests in respect of the domain name;
- (iii) The domain name has been registered and is being used in bad faith; and
- (iv) The domain name is registered only for the purpose of trafficking.

A. Identical or Confusingly Similar

The Complainant is carrying on a legal firm by the name of M/s Singh & Associates. The disputed domain name is <singhandassociates.in>. Thus, it is apparent that the disputed domain name is very much similar to the service name or the name of the legal firm of the Complainant. The addition of the word "and" in place of the word "&" will not make the name different. Both words have the same pronunciation and meaning. In *Lilly ICOS LLC v. John Hopking / Neo net Ltd.*, WIPO Case No. D2005-0694, the arbitrator has held that, "generally, a user of a mark may not avoid likely confusion by appropriating another's entire mark and adding descriptive or non-distinctive matter to it".

The Complainant has submitted that it has preferred a trademark application to register the mark SINGH AND ASSOCIATES. The Complainant also has a website by the name of <singhassociates.in>.

Therefore, I hold that the domain name <singhandassociates.in> is identical and confusingly similar to the Complainant's mark.

B. Rights or Legitimate Interests

According to 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 Respondent of the dispute, the Respondent'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 Respondent (as an individual, business or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent 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 has not filed any response in this case. There is no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. Based on the default and 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. SINGH AND ASSOCIATES is the name and mark of the Complainant. It is evident that the Respondent can have no legitimate interest in the domain name. Further, the Complainant has not licensed or otherwise permitted the Respondent to use its name or mark or to apply for or use the domain name incorporating said name

I, therefore, find that the Respondent has no rights or legitimate interests in the domain names.

C. Registered and Used in Bad Faith

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:

- (i) Circumstances indicating that the Respondent 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 is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of documented out of pocket costs directly related to the domain name; or
- (ii) The Respondent 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 it has engaged in a pattern of such conduct; or
- (iii) The Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to its website or other on-line location, 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 its website or location.

The contention of the Complainant is that the present case is covered by the above circumstances. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web sites, by creating a likelihood of confusion with the Complainant's mark as to the

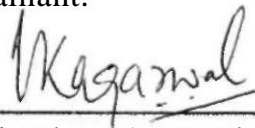
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source, sponsorship, affiliation or endorsement of its web sites.

The foregoing circumstances lead to the presumption that the domain name in dispute was registered and used by the Respondent in bad faith. As the Respondent has failed to rebut this presumption, I conclude that the domain name was registered and used in bad faith.

Decision

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



Vinod K. Agarwal
Sole Arbitrator

Date: February 23, 2009