



दिल्ली DELHI **BEFORE SHRI SANJAY KUMAR SINGH ARBITRATOR**

H 476704

IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)

IN RE:

**Telenor ASA,
Snaroyvein 30, 1331 Fornebu, Norway**

Through

It's authorized Representative

G. D. Chugh (Advocate)

IPR International Services

Block No. 8, Building No.2, Ground Floor

Rajinder Nagar, New Delhi-110060 INDIA

E-mail: ipris@vsnl.net

COMPLAINANT

Versus

Dr. Prashant Shukla

P.O.Box 8818,

New Delhi-110057

E mail: prashant@vedbhawan.com

RESPONDENT NO.1

Royal Domains

C/o Telenor Technologies

Postfach-3801 CH 4002

E mail: info@rovaldomains.net

RESPONDENT NO.2

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1. THE PARTIES:

The complainant is Telenor ASA Snaroyvein 30, 1331 Fornebu, Norway

(Complainant's authorized representative is G. D. Chugh (Advocate) IPR International Services Block No. 8, Building No.2, Ground Floor Rajinder Nagar, New Delhi-110060 INDIA)

The Respondents no.1 is Dr. Prashant Shukla P.O.Box 8818, New Delhi-110057, E mail: prashant@vedbhawan.com

The Respondents no.2 is Royal Domains C/o Telenor Technologies Postfach-3801 CH 4002, E mail: info@rovaldomains.net

2. DOMAIN NAME AND TRADEMARK IN DISPUTE:

Domain name of the respondent no.2 is "**telenor.in**"

The trademark of the complainant is "**TELENOR**".

The registry is National Internet Exchange of India (NIXI).

3. BRIEF BACKGROUND:

This arbitral proceeding commenced in accordance with IN Dispute Resolution Policy (INDRP) and rules framed there under.

The complainant submitted his complaint in the registry of NIXI. Shri Sanjay Kumar Singh was appointed as Sole Arbitrator in the matter by NIXI.

The complainant has submitted that it is the proprietor of the trademark "TELENOR" vide Trade Mark No. 1426418 vide application dated 3rd March 2006, journal no. supp. 1389-0. The present dispute relates to the Respondent no.2's domain name

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www.telenor.in which is similar to Complainant's trade mark/service mark "Telenor" which is very well known and famous brand in many countries of the world. The complainant has further submitted that its trade mark/service mark "TELENOR" is a well known trade mark within the meaning of Section 2(1) (zg) of the Trade Marks Act, 1999. The complainant has further submitted that the disputed domain name **telenor.in** wholly incorporates the trade mark/service mark "TELENOR" of the Complainant. The suffix ".in" does not distinguish the disputed domain name from the Complainant's trade mark/service mark "TELENOR". The Complainant has established both common law rights and statutory rights in respect of its trade mark/service mark "TELENOR".

It has also been submitted by the complainant that it is the registered proprietor. Complainant is proprietor of trade mark under Trade Mark No.1426418 in classes 9, 16, 35, 36, 37, 38, 41 & 42 in India for goods as mentioned in Para 12 of the complaint.

It has also been submitted by the complainant that has widely used the trade mark/service mark "TELENOR" with and without the Logo openly, continuously, extensively and exclusively in different countries including India and a very valuable goodwill and reputation have been accrued to the trade mark/service mark "TELENOR" with and without the Logo and the members of the public and trade associate the mark "TELENOR" with and without the Logo, with the goods and services of Complainant exclusively. It has been further submitted by the complainant that the Complainant is the registrant of the following domain names containing the said trade mark i.e., www.telenor.com, www.telenor.no, www.telenor.se, www.telenor.com.pk, www.telenor.co.yu, www.telenor.ru, www.telenor.ua, www.telenor.tel etc.. The web site www.telenor.no has also

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been registered since 1999 which provides up to date information about the complainant and its products/services. It has been further submitted by the complainant that use of the aforesaid domain name i.e. www.telenor.in or any other identical or deceptively similar to the trade mark/service mark, trade name and/or domain name, by any other registrant or otherwise is bound to cause confusion and deception in the minds of the public and the members of the trade leading them to falsely believe that such third party had some connection or association with the Complainant. Whoever in the past, tried to adopt or use the trade/service mark/name or domain "TELENOR" in any forms visually or phonetically similar thereto, the complainant took necessary steps to safeguard its rights. Recently, the complainant has also filed a complaint for domain name www.telenor.co.in with NIXI on 27.04.09.

A copy of complaint has already been sent to the respondents by the .In Registry.

The respondent no.1 sent a letter to NIXI stating that he is not the owner. NIXI sent a letter dated 29-06-2009 to complainant stating that WHOIS data reflects only the name of Royal Domains i.e. the respondent no.2. It was further stated in the letter dated 29-06-2009 that it was not desirable to serve notice on respondent no.1.

Upon receipt of the complaint, and considering the letters sent by respondent no.1 and letter sent by NIXI to the complainant and the arbitrator, notice was not issued to respondent no.1.

Upon receipt of the complaint and considering the letters sent by respondent no.1 and letter sent by NIXI to the

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complainant and the arbitrator, notice was only issued to the respondent no.2 on 26-07-2009. Both the letters mentioned above are part of this arbitration proceeding.

The Arbitrator issued notice to respondent no.2 on 26.07.2009 and directed the respondent no.2. to send his defence / counter to the complaint alongwith supportive documents / evidence at his e-mail address within 5 days from receipt. But the respondent did not come forward and send his defence / counter to the complaint.

The respondent no.2 failed to send the defence / counter or supportive documents / evidence to the Arbitrator in compliance of notice dated 26.07.2009.

Notice was again sent to respondent no.2 on 02-08-2009. The respondent no.2 was given another opportunity to send his defence / counter or supportive documents / evidence to the complaint within three days with further notice that in default of non-filing or sending of the defence / counter to the complaint, the matter would be proceeded ex-parte and award would be passed ex-parte on merits of the case and as per law. The Arbitrator gave last and final opportunity to the respondent no.2 making it clear that no further opportunity would be granted.

Inspite of repeated notices, the respondent no.2 has again not come forward and has not sent any reply / defence / counter to the either notice or complaint to the Arbitrator.

The respondent no.2 however sent a letter vide e-mail accusing the Indian legal system. The said letter dated 05-08-2009 is part of this arbitration proceeding. The letter clearly shows that the respondent

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no.2 has no respect for the legal system in India. The respondent no.2 has addressed the arbitrator as complainant. The respondent no.2 instead of addressing the complainant **"Telenor ASA, Snaroyvein 30, 1331 Fornebu, Norway Through It's authorized Representative, G. D. Chugh (Advocate), IPR International Services, Block No. 8, Building No.2, Ground Floor, Rajinder Nagar, New Delhi-110060, INDIA, E-mail: ipris@vsnl.net"** has addressed the arbitrator as complainant. The said letter dated 05-08-2009 is part of this arbitration proceeding and has been considered.

Thereafter a letter was also sent by NIXI to respondent no.2 clearly stating the fact about the appointment of the arbitrator for adjudicating the disputed domain name **"telenor.in"** in the complaint filed by the complainant as mentioned above.

The respondent no.2 has not sent any reply / defence / counter to the complaint despite of notices issued by the arbitrator. This clearly shows the respondent no.2 does not wish to file any proper reply and supportive documents / evidence and he even does not have the honorable intentions to honour the present arbitration proceeding. The respondent no.2 has rather flouted the legal requirements of arbitration proceeding.

Therefore, this matter is being decided on the merits of the case and as per law of the land.

4. PARTIES' CONTENTIONS:

- (i) The complainant has submitted that the use of the aforesaid domain name i.e. www.telenor.in or any other identical or deceptively similar to the trade mark/service mark, trade

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name and/or domain name, by any other registrant or otherwise is bound to cause confusion and deception in the minds of the public and the members of the trade leading them to falsely believe that such third party had some connection or association with the Complainant.

- (ii) The complainant has submitted that the domain name registered by the Respondents is identical or confusingly similar to the trade/service mark as per Rule 4(a) (i) in which the Complainant has statutory and common law rights. The complainant has relied on a supreme court judgement in case titled as Satyam Infoway Ltd vs. Sifynet Solutions Pvt. Ltd, 2004 (28) PTC 566 (SC). The Supreme Court observed that domain name has all the characteristics of a trademark and an action of Passing off can be found where domain names are involved. As such principles applicable to trademarks are applicable to domain names also. In the said case the words, "Sify" & 'Siffy' were held to be phonetically similar and addition of word 'net' in one of them would not make them dissimilar. A domain name is accessible by all internet users and the need to maintain an exclusive symbol for such access is crucial. Therefore, a deceptively similar domain name may not only lead to a confusion of the source but the receipt of unsought for services. The complainant has annexed the copy of the afore-said decision of Supreme Court.

- (iii) The complainant has further submitted that the Respondents have no legitimate rights or interests in the domain name as the respondents are not a licensee of Complainant, nor have they received any permission or consent to use the trade/service mark, trade name and/or domain name of the Complainant.

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- (iv) The complainant has further submitted that the registration of the said domain name violates statutory and common law rights of the Complainant's trade mark/service mark, trade name and/or domain name. The Complainant has further submitted that it owns all rights including statutory and common law in the trade/service mark, trade name and/or domain name and the Complainant is therefore entitled to protect its rights under the Indian Trade Marks Act 1999. Use of the name either as a trade/service mark, trade name and/or domain name or in any other form constitutes violation of its rights. The Respondents' registration and use of domain name would give rise to a dilution of the Complainant's trade mark/service mark, trade name and/or domain name.
- (v) The complainant has also relied on various decisions in support of his claim.

The complainant has sought the relief of transfer of domain name "**telenor.in**" to him.

5. OPINION/FINDING:

The para no.4 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:-

TYPES OF DISPUTES

Any person who considers that a domain name conflicts with his legitimate rights or interest may file complaint to .IN Registry on following premises:

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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 has no rights or legitimate interests in respect of the domain name and
- iii) The Registrant's domain name has been registered or is being used in bad faith."

The Para no.6 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:

6. EVIDENCE OF REGISTRATION AND USE OF DOMAIN NAME IN BAD FAITH

The provisions of sections 101 to 103 of Indian Evidence Act also show that onus in present proceedings is primarily on complainant. Further if the complainant fails in proving his complaint then he could be made liable for reverse domain hijacking. This also shows that complainant prima facie has to prove the contents of the complaint or else he could face adverse consequences of his failure/false complaint.

The other fact, which is to be dealt with before going into merit is, that, as to whether, the cases decided by WIPO - Administrative Panel could be considered, while deciding the present controversy. Moreover these cases throw light upon various important aspects of controversy. As such they would be considered, while deciding the present controversy, in so far as they do not conflict with INDRP.

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The following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:

- "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 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
- ii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the

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Registrant's website or location or of a product or service on the Registrant's website or location."

The para no.7 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:-

7. REGISTRANT'S RIGHTS TO AND LEGITIMATE INTERESTS IN THE DOMAIN NAME

Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purpose of paragraph 4 (ii):

- "i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstratable preparations to use, the domain name or a name corresponding to the domain name in connection with a bonafide offering of goods or services;
- ii) the Registrants (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 other fact, which is to be dealt with before going into merit is, that, as to whether, the cases decided by WIPO- Administrative Panel could be considered, while deciding the present controversy. Moreover these cases throw light upon various important aspects of controversy. As such they would be considered, while deciding the present controversy, in so far as they do not conflict with INDRP.

8. OPINION AND FINDINGS ON MERITS

A) Whether the domain name is identical or confusingly similar to a trademark in which complainant has right.

It has been held in Indian decision **M/s Satyam Infoway Ltd. Vs. M/s Sifynet Solution (P) Ltd. JT. 2004 (5) SC 541**, that Domain name has all characteristics of trademark. As such principles applicable to trademark are applicable to domain names also. In the said case the words, 'Sify' & 'Siffy' were held to be phonetically similar and addition of work 'net' in one of them would not make them dissimilar.

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It is held in Indian case **JT.2004 (5) SC 541**, that in modern times domain name is accessible by all internet users and thus there is need to maintain it as an exclusive symbol. It is also held that it can lead to confusion of source or it may lead a user to a service, which he is not searching.

Thus conclusion is that domain name and trademark, which may be used in different manner and different business or field, or sphere, can still be confusingly similar or identical.

Thus the conclusion is that the domain name of respondent no.2 is identical and confusingly similar to the trademark of complainant.

Now the other important aspect that needs consideration is, as to whether the complainant has right in the trademark. It is important to mention here that as per the claim of the complainant the respondent no.2 has no trademark right on the said domain name.

This principle is settled in many above Indian cases and referred cases **JT 2004(5) SC 541 and 2004(5) SCC 287**. The complainant has made submission that he has legitimate trademark in India, he is using trademark for many years, his Trade Mark was registered and the registration was issued by the Office of the Trade Mark Registry vide Trade Mark No.668124 dated 05-06-1995 duly issued by the trademark registry at Mumbai and vide Trade Mark No.668125 B dated 05-06-1995 duly issued by the trademark registry at Mumbai.

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Thus the conclusion is that the domain name **telenor.in'** is identical and confusingly similar to the trademark of complainant **telenor.in** and the complainant has established that he has right in the trademark.

B) Whether the respondent has no right or legitimate interest in the domain name got registered by him

It is pertinent to mention here that paragraph 4 (ii) of INDRP is to be read with paragraph no.7.

As already stated that paragraph 4 (ii) and 7 of INDRP are to be read together. Their combined effect is that, onus to prove the ingredients of these paras are prima facie on complainant. The onus is not very weak and prima facie, but it heavily shifts on respondent no.2. Respondent no.2 can discharge the onus by direct cogent and positive evidence which are in his special knowledge and power. The complainant has made positive assertions that respondent no.2 has no legitimate right in domain name and the respondent no.2 has no trademark on the domain name. The complainant has made positive assertions regarding the fact that respondent no.2 has got registered the disputed domain name in the .IN Registry for which the respondent no.2 has no right or trademark. As such in above circumstance it is clear that the

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complainant has prima facie discharged the initial onus cast upon him by virtue of paragraph 4(ii) and 7 of INDRP.

The respondent no.2 on other hand has not come forward inspite of repeated notices to file any reply / counter or to provide any positive, cogent and specific evidence that it is known or recognized by domain name. The respondent has neither put forth and has nor provided such evidence.

Thus the conclusion is that respondent no.2 has no right or legitimate interest in the domain name.

Whether the respondent's domain name has been registered or is being used in bad faith.

It is to be seen as to whether the domain name has been got registered in bad faith. The paragraph no.4 (iii) and 6 are relevant and as already stated; the onus is primarily upon complainant.

Keeping in view above facts and circumstances it is thus clear that the respondent no.2 has registered the disputed domain name and in spite of repeated notices, he has not come forward with reply to the complaint of the complainant and has neither provided any substantial evidence in its support.

Thus the conclusion is that the respondent no.2 has got registered his domain name "**telenor.in**" in bad faith.

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8. CONCLUSION:

The domain name of the respondent no.2 is identical and confusingly similar to trademark of complainant. The respondent no.2 also does not have right or legitimate interest in the domain name. He has got it registered in bad faith; as such he is not entitled to retain the domain name. The complainant is entitled to transfer of domain name "**telenor.in**" to him, as he has established his bonafide rights in trademark as per law discussed above. Hence I direct that the Domain name be transferred to the complainant by registry on payment of requisite fee to the registry.

No order as to costs.

Delhi

Date: 24-08-2009.

Sanjay Kumar Singh
(Sanjay Kumar Singh)

Arbitrator