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ARBITRATION PROCEEDINGS OF DOMAIN NAME
"ushaworld.in"

Before Visheshwar Shrivastav, Arbitrator

IN RE:

Usha International Ltd. ...Complainant

AND

Chinar Trust ...Respondents

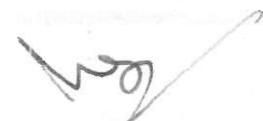
AWARD

1. That the present Arbitral Tribunal was constituted by National Internet eXchange of India hereinafter referred to as NIXI for the disputes pertaining to the allotment of domain name "ushaworld.in" on a complaint filed by M/s Usha International Ltd herein after referred to as complainants. That as per the Rules the Tribunal was required to give its consent by statement of impartiality to NIXI which was carried out.

2. That this Tribunal entered reference and directed the parties to come for a preliminary meeting as the Arbitral Tribunal was not sure as to whether the Respondent Mr. Umesh Gupta of M/s Chinar Trust have

been served with a copy of the complaint and also due to the fact that the complaint of Usha International was not in proper sequence.

3. Due to the above the Arbitral Tribunal called a preliminary meeting on 20th February, 2006 at the office of V. Shrivastav & Co., Enterprise, D-128-129, Okhla Industrial Area, Phase-I at 4:00 pm. On 20th Feb, 2006 both the parties were present/represented. The complainants were represented by their counsels Mr. Vivek Dhokalia and Ms. Shabana Rai of K&S Partners with Mr. Vishal Mittal, Assistant Manager (Legal) of Usha International Ltd and the Respondents were represented through Mr. Ashish Malkotia, Secretary of Chinar Trust.
4. That the complainants were furnished a copy of complaint which was received by the Arbitral Tribunal for inspection and on inspection the complainant's counsel stated that the same requires some reorganization and stated that they will send a reorganized copy within two days. The Tribunal enquired as to whether the Respondents have a copy of the complaint on this, the representative of the Respondent pointed that they do not have a copy of the complaint hence it was directed that the Complainant will also furnish a copy of the complaint to the Respondent within two days. Thereafter, the orders were passed that the Respondents will file their statement of defence / reply to the complaint within 15 days and thereafter the Complainant would file their rejoinder as well their affidavit. The Respondent also undertook to file counter affidavit within one week after being furnished the rejoinder of the Complainant. Thereafter the proceedings were adjourned for 23rd March, 2006. The Respondents were also directed to file a copy of the Registration



Certificate of the Trust and a copy of its bye laws and a letter of the Trust authorizing the person to sign and verify the pleadings on behalf of the Trust. The counsel for the complainant requested that all the relevant records relating to the Domain name, Registration for both the Complainant and the Respondent pertaining to "ushaworld.in" be summoned from the Registrar, NET4 India and NIXI. The Tribunal stated that this can only be done in case there is an application from the side of the complainant to this effect.

5. That the complainants, vide their email dated 20th February, 2006 sent their request for calling of the records pertaining to the application of the parties from Registrar, Net for India.
6. Since no response was received from M/s Chinar Trust to the application of the complainants a hard copy was sent to both the parties as well as to the NIXI.
7. That on 20th February, 2006 an email was received from Mr. Ashish Malkotia from Chinar Trust stating that they do not have any objection to the summoning of records to the Registrar, NET4 India. Thereafter the Tribunal addressed a letter to the National Internet Exchange of India for getting records for the domain name "ushaworld.in" pertaining to the applications filed by Chinar Trust as well as M/s Usha International for NET4 INDIA. That a telephonic response was received by the Tribunal from National Internet Exchange of India hereinafter referred to as NIXI to contact Registrar, NET4 India and their address was also furnished. Accordingly the Tribunal addressed a letter to NET4 INDIA for obtaining the records as per the application of the complainants M/s Usha International Ltd.



8. The Arbitral Tribunal on perusal of the papers found that the Complainants M/s Usha International have filed their reply through their counsel's M/s K & S Partners but did not file any Vakalat papers and POA/Board Resolution of the person signing the pleadings on behalf of the Usha International and also that M/s Chinar Trust have filed a Power of Attorney but had not filed the Vakaltnama of their counsels M/s Anand & Anand.
9. That on 22.3.2006 the Tribunal addressed a notice to the parties stating that the Vakalatnama in favour of Anand & Anand, the counsel for Chinar Trust has not been received and no counter affidavit to the rejoinder affidavit to the Usha International has been received and they were given 3 day's time to comply with the direction. The parties were also called upon to convey whether they would like to advance any oral arguments in support of their contentions before the Tribunal.
10. That the Respondents vide their email dated 23rd March, 2006 conveyed that if permitted they would like to advance oral arguments.
11. That a letter was received on 24th March, 2006 by K&S Partners stating that they would be extremely interested in attending the hearing and wanted some accommodation in the dates.
12. That since the email was not copied/marked to M/s Chinar Trust the Arbitral Tribunal forwarded the mail to Chinar Trust with the comment that the complainant should copy mail to Chinar Trust and NIXI while corresponding with the Arbitral Tribunal.



13. That the Tribunal thereafter vide its order dated 27.3.2006 had fixed 31.3.2006 as the date of hearing followed by a date of 1.4.2006 which was conveyed to both the parties. In the meanwhile an objection was received from Chinar Trust, objecting to the one side communication addressed to the Arbitrator by the Complainants. The Respondents also took an exception to the email sent by the Tribunal showing March 26 time 2.20 PM when they received it at 10.00 AM. The Tribunal found it proper to send a hard copy of the communication to the parties in which the Tribunal had reminded the Respondents that prior to their objection the Tribunal had itself by the return mail dated 24th March, 2006 taken an exception to the unilateral correspondence with the Tribunal and had directed them to copy their mail to NIXI as well as M/s Chinar Trust. The Tribunal also addressed the Respondents' objection to the Tribunal's mail showing **PM** instead of **AM** and stated that this may be a hardware problem of a particular system and that objection is frivolous as the Tribunal computers shows the sending of the email date as 27-3-06 at 12.51 AM and also reminded the parties that the Tribunal has to complete the Arbitration and publish its award within 60 days which was to expire on 16-4-2006. Thereafter another email was received on March 27, 2005 from K&S Partners apologizing for not copying their request for adjustment of dates to the Respondents and NIXI and again this time requested the hearing to be fixed for 20th of April, 2006.

14. That on 27th March, 2006, itself an email was received from the respondent giving their no objection for the fixing of date for arguments for 20-4-2006 reserving their comments on the complainants not marking a copy of communication addressed to the Arbitrator to them and NIXI.



15. That the Arbitral Tribunal vide its email dated 28th March, 2006 conveyed that the parties have agreed for advancing oral arguments on 20-4-2006 but as per INDRP Rules and Procedures the period of 60 days for the present Arbitration was to expire by 16-04-2005 and this period cannot be extended and from the correspondence of the parties it is not clear as to whether they would like to extend the time as well. Since the Arbitral Tribunal will consider the request for the sitting of **20th April 2006** only if the parties agree for an extension of time otherwise the Tribunal will pass its award without the any hearing on the basis of the pleadings.

16. That the Respondents vide their email dated 29th March, 2006 sent their no objection for extension of time beyond the period of 60 days. The same response was received for extension of time by the Complainants vide their email dated 20th March, 2006.

17. That the Tribunal vide its order dated 29-3-2006 conveyed to the parties that it is extending the time upto 16.5.2006 by another 30 days so as to enable the parties to advance arguments and also enable the Tribunal to pass its award.

18. That the parties were also called upon under Rule 15C of the INDRP Rules to provide for a fee of Rs.5,000/- per hearing.

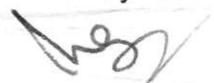
19. The Complainants sent their share of Rs.2500/- as per Rule 15C of INDRP Rules vide their intimation sent by email dt. 10th April, 2006.



20. In the meanwhile the particulars relating to the allotment of the domain name was received from M/s NET4 INDIA. However, due to some hardware problem the same could only be forwarded to the parties on 17.4.2006.

21. That the Respondents vide letter dated 15th April, 2006 addressed to the Tribunal by their Counsel Anand & Anand had due to some confusion sent the cheque of Rs.5,000/- for the ensuing sitting. The Arbitral Tribunal immediately vide its return mail even dated sent back the cheque in original to the counsels for the Respondents stating *inter-alia*, that firstly the fee for the hearing is Rs.5,000/- which is to be shared equally and they were required to send the cheque directly to the NIXI and not to the Tribunal.

22. On 20th April, 2006 the complainant were present with their counsels at 3.00 pm but none was present on behalf of the Respondents. Hence the Tribunal contacted the office of the counsels for the Respondents M/s Anand & Anand. Mr. Azad Virk, the Ld. Counsel for the Respondents promised that they are reaching the venue very shortly hence the arbitration was adjourned so as to enable the Respondents' counsel to come to the venue. The arbitration was resumed at 4.00 pm. wherein the Tribunal queried from the Respondents whether they have received a copy of the sur rejoinder/ affidavit and a document filed by the Complainant pertaining to the domain name - "myushaworld.com". Ld. Counsel for the Respondents objected to the filing of the sur rejoinder on the eve of the hearing when they had come prepared for the arguments and suggested that the Tribunal should not look into the same. The Complainant on the other hand stated that the fate of the sur rejoinder and the **affidavit and the documents with it may be decided by the**



Tribunal using its discretion. The Tribunal stated that it will deal with the sur rejoinder and the documents attached to it at the time of award and stated that it has taken note of the serious objection raised by the Ld. Counsel of the Respondents Mr. N. K. Anand. Thereafter the arguments were addressed by Mr Kenneth D Benjamin Ld Counsel for the complainants.

23. At the outset Mr. Benjamin, Ld. Counsel for the complainant stated that the past history relating to the trade mark "USHA and/or USHA SHRIRAM LOGO" should not be considered in the backdrop of the present dispute which is relating to the allocation of the domain name "ushaworld.in" in favour of the Respondent. However in the course of his arguments Mr. Benjamin stated that the complainant have exclusive rights on the trade mark "USHA" and even went on to emphasize that the respondents cannot deny that Usha International has proprietary and statutory rights in the trade mark "USHA" and that their claim on the trade mark "USHA" was prior to that of the Respondent. He stated that the term "USHA" forms a part of the domain name and that the respondents have never used the present domain which is registered as "ushaworld.in". The Ld. Counsel drew the attention to the counter affidavit of the Respondent to para 11.10 wherein the Respondents have submitted that their associate company M/S Usha Shri Ram Enterprises (P) Ltd had registered its domain as 'USHAWORLD.COM' as early as January 2000 and drew the attention of the Tribunal to **Annexure R** filed with the Reply of the Respondents and stated that the said website is only a page and the Respondents company is not interested in running the website and the same has been created to block off the complainants who have been using the term 'Ushaworld' since 2000.



24. It was argued by Mr Kenneth D Benjamin that the Complainant are an associate company of Siddharth Shriram Group which is a reputed business house and has interest over a wide range of areas in the commercial world.

25. The counsel for the Complainants has also stressed that they are the registered owners and proprietors of trade mark "USHA" in various forms. He stated that the complainants are the major share holders of M/s Jay Engineering Works who had taken the registration of trade mark "Usha" as early as 4th of August, 1942 and had been using the same since 1936 and the Complainants who were earlier functioning under the name and style of Agents and Distributors Pvt. Ltd. changed their name to Usha Sales Private Ltd and became a public company and thereafter underwent a change of name to the present name i.e., Usha International Ltd.

26. The Ld counsel for Complainants stated that the Complainants have filed copies of Trade Marks Journals which are given in Annexure 3 to their complaint to show that they are having prior rights to the term 'Usha' as a trade mark.

27. The Ld Counsel stated that their main grievance is that under the Sunrise policy the domain registration for non trade mark category for IN registry had begun and the complainant were interested in the name "ushaworld.in" but they lost out as the Respondents had put in their application prior and hence they were allotted the domain name "ushaworld.in".

28. From the papers received from the Registrar M/s. Net4 INDIA it is noticed that the Complainants submitted their request for the registration of the domain name "ushaworld.in" on 15.1.2005



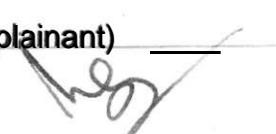
whereas the present registrant i.e., the Respondent submitted their application for the same domain name on 11.1.2005. Since the Sunrise policy of the IN registry for non trade mark category was on the "first come first serve basis" the Respondents were given the domain name "ushaworld.in".

29. That aggrieved by this decision the Complainants wrote representations to National Internet Exchange of India, which are given as **Annex. E** to the complaint due to which the NIXI referred the matter to this Arbitral Tribunal for resolution of the dispute raised by the Complainants.

30. The arguments went on till 6.00 PM. The Arbitral Tribunal thereafter fixed the matter for 24th April, 2006 at 4 pm. at the same venue for the Respondents arguments and clarified that there will be no fee for the second sitting.

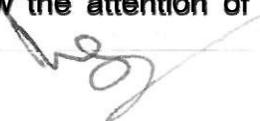
31. Mr. N.K. Anand the Ld. Counsel for the respondents addressed his counter arguments and denied and disputed the contentions of the Complainants. As per the Respondents both the Respondents and the Complainant belong to one identifiable Group of Associated Companies popularly known as Usha Shriram Group and the Group in its entirety has been marketing consumer durable goods under the trade mark "USHA", "USHA SHRIRAM Logo" so on and so forth and the prominent Group entities are as under.

- i. Chinar Trust i.e., Respondents
- ii. M/s Usha Intercontinental India, Proprietor General Sales Ltd.
- iii. Usha Shriram India, Piston & Rings Ltd.
- iv. **Usha International Ltd (the Complainant)** _____



32. The Respondents' counsel drew the attention of the Tribunal to their **Annexure B** which comprise of copies of various pamphlets of their products wherein they have shown that they have been using the trade mark "USHA" or the second Mark "LEXUS" extensively for decades. Interestingly some of the brochures at **page 13 of Annexure B** filed by them has been published by Usha International Ltd. i.e., the Complainant. Besides various caution notices issued from time to time since 1995 cautioning the public against the wrong use of the trade mark "USHA" or "LEXUS" besides press clippings going back to 1991 wherein one clipping which relates to the Complainant i.e., M/s Ushal International **page 201 Annexure B-1**.

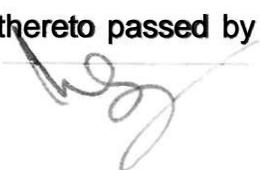
33. The Ld Counsel for the Respondents drew the attention of the Tribunal to **Annexure E** wherein they have annexed mailers sent by the Senior Executive Director of Usha International i.e., the Complainant and their news letters. The Respondents counsel stated that regarding trade mark "USHA" there was a dispute/opposition an opposition raised by M/s Jay Engineering Works (of which the Complainant is the major share holders now) against one Swaran Singh for the use of the trade mark "USHA" and vide order passed by the Registrar of Trade Marks on the opposition filed by Jay Engineering Works were disallowed and the name of "USHA" was registered by Swaran Singh of M/s. Appliances Emporium, Delhi. Thereafter M/s Jay Engineering Works filed a petition in the Hon'ble Delhi High Court against the order of the Assistant Registrar of Trade Marks which bore the **CM(M) No. TM/35 of 1976**. However, the said petition of JEW was dismissed by the Hon'ble Delhi High Court vide its order dt **10th December, 1979**. The Respondents drew the attention of



the Tribunal to the copy of the order of the Hon'ble Delhi High Court i.e. **Annexure C.**

34. Mr N.K. Anand, the Ld Counsel for the Respondents pointed out that the Respondents after negotiations with Swaran Singh got a Deed of Assignment in their favor which they have annexed as **Annex. D** and that in view of this the complainant cannot state that they are having prior and exclusive rights on the trade mark "USHA" while contesting for the domain name "ushaworld.in". It was further argued that the Complainant and the Respondents are a part of the same Shriram Group and have shared harmonious business relationship and have been trading in the various products using the word "USHA" and to the exclusion of outsiders and have been as a group of companies participated in various fairs and promoted their products through a unified common platform as can be evidenced from **Annex E**. He stated that the trade Mark "USHA" is actually a House Mark of the Shriram Group.

35. The counsel for Respondents stated that they have also annexed as **Annex F** a copy of the license agreement dt. 25th September, 2001 taken by the Complainants from the Respondents for the use of trade mark "Usha" and "Usha Shriram". The Respondents counsel also pointed out that they have also filed as **Annex G** various registration certificates for the trade mark "USHA" from India and abroad. He stated that both the Respondents and the Complainants have been harmoniously acting together and jointly, along with other group entities fighting for the trade mark "USHA" to the exclusion of others and other for this purpose they have annexed as **Annex H** a copy of suit No.2149 of 1994 filed **before the Delhi High Court and the judgment thereto passed by**



My Lord Justice R. C. Lahoti ,as he then was. wherein the group companies including the Complainants jointly contested as plaintiffs for the trade mark "USHA" against "Usha International Ltd." formerly Usha Rectifier Corporation and Usha Appliances Ltd. He also invited the attention of the Tribunal to **Annexure I** to buttress his argument.

36. Shri NK Anand the Ld Counsel for the respondents stated that of recent some disputes have surfaced among the group entities which includes the Complainant and they have so far unsuccessfully instituted various actions against the Respondents. Some of the instances are given at **Annex J & K** with the reply wherein M/s Shriram Industrial Enterprises Ltd. (SIEL), a group company of the Complainant opposed the issue of the registration of trade mark "Usha Shriram" before the Assistant Director of Intellectual Property, Sri Lanka. Thereafter, another associate company M/s Jay Engineering Works filed bearing suit No.70 of 2002 in the High Court of Kolkata *qua* the name of 'USHA SHRIRAM'(**Annexure L**)

37. That the counsel brought the attention of the Tribunal to **Annexure M** which is an order by the Copy Right Board reported in **2005 (31) PTC 639(CB)**. The counsel stated that this application of JEW was rejected by the Copy Right Board. At this point Mr Kenneth D Benjamin Ld. Counsel for Complainant pointed out that this order of the Copy Right Board is under challenge in the High Court. Mr Anand the Ld Counsel for Respondents also brought to the attention of the Tribunal **Annexure N** which is an order of Registrar Trade Marks wherein even the Registrar has held the all the parties were and are using the name 'USHA' while following the judgment **1996 PTC 610**



passed by Justice Lahoti as he then was. The Respondents counsel stated that they have a genuine and a *bonafide* intention of using the domain name "ushaworld.in" in relation to the goods and services manufactured, marketed under the name of 'USHA' and that in pursuance thereof they as per the sunrise policy being prior were given the trademark "ushaworld.in". The Respondents have annexed print out of the website at **Annex. P** and have also stated that they have registered various domain name using the word "usha" in **Annex. Q**. The Respondents to show the prior use of the word "USHAWORLD" have annexed an **Annex. R** which is report of the domain name "ushaworld.com" which was taken in the year January 2000 prior to the complainants by a sister concern of Respondents Usha Shri Ram Enterprises (P) Ltd which is functioning from the same premises as the Respondents. The Respondents counsel further submitted that the complainant have failed to establish any case for the transfer of the impugned name and have stated that as per INDRP policy the transfer can only be made in case (a) registrant has no rights to legitimate interest of domain name, (b) domain name has been registered or is being used in bad faith. He has also stated that as per Rule 3(B)(c) the Complainants have not been able to substantiate as to why the Respondents should be considered as having no rights or legitimate interest in respect of the domain name and whether the said domain name have been registered by the Respondent to be used in bad faith. He added that the Complainant in order to show their legitimate interest ought to have given cogent and plausible reasons. The Respondents counsel further stated that the complainant is a distributor of the Respondent for household appliances under trade mark "usha" and amongst other a user of trademark in respect of invertors and the Respondents' independent use of trade mark "usha" is limited to fan, sewing

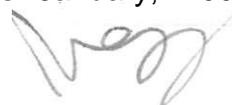


machine etc. He further stated that the complainant and the Respondents have a common ancestor and history being a part of the Usha Shriram Group and the individual entities are the common users of the name USHA within their individual spheres. It is also stated by the Respondents that the various group entities of Usha Shriram Group have registered the trade mark 'USHA' in respect of their products and services and complainant having registered a trade mark USHA does not give it any superior rights to that of the Respondents so as to make them eligible for the domain name "ushaworld.in" . Mr. Anand has stated that Complainants have delayed their action for the domain name by almost a year. The Respondents have further denied that the use of the domain name "ushaworld.in" is likely to cause any confusion or deception in the eyes of the public as the public identifies trade mark "usha" exclusively with that of the Usha Shriram Group.

38. A query was put to the parties which was conveyed in writing as well as by the Arbitral Tribunal stating to reply as to (1) whether either of them are dealing with the same products which compete with the products of one another and (2) Whether the Usha International i.e., Complainant is the agent of Chinar Trust as per the definition of Agent in the Indian Contract Act, 1872.

39. That thereafter it was agreed by the parties to have yet another sitting on 25/04/06 so as to enable them to complete their arguments. It was conveyed by the Tribunal that no fee for hearing is to be paid.

40. On 25/04/06 Mr NK Anand counsel for the Respondents reiterated that the Respondents have with their affidavit filed as **Annexure R** wherein apparently their associate company Usha Shriram Furniture Industries had as early as January, 2000



applied for the registration for ushaworld.com. This was followed by **Annexure T** which is an application with the Trade Mark Registry, New Delhi vide application No. 12237 dt. 26-9-2000. They have also annexed change of the company from Usha Shriram Furniture Industries (Pvt.) Ltd. to Usha Shriram Enterprise (Pvt.) Ltd.

41. Apart from above the Respondents counsel stated as per **Annex. V**, which is a copy of the print out of the domain name USHA-WORLD.IN which is registered by the complainant and stated that the site has not even been created and hence the Complainant's interest is only to litigate in this matter and is not interested in running the website.

42. Thereafter Shri N. K. Anand Ld. Counsel for the Respondents addressed further the arguments for and on behalf of the Respondents. He stated that the complainant is the distributor goods of the Respondent and that Chinar Trust is a family Trust be it the complainant or be it the Respondent they all have common family ties and as a group they all were for decades using the trademark Usha as a single economic entity called the Usha Group and they (the Complainants) are a part of the group.

43. The counsel for the Respondents drew the attention of the Tribunal to **Annexure M pages 370. 371 & 372** of their Reply and particularly to **para (c), (d) & (g)** where in the array of parties i.e. the plaintiffs included respondents and the complainant . The High Court had categorically held that all the Plaintiffs are **exclusive user of trademark USHA as a group.**



44. The counsel for the Respondent also re-emphasized that in the High Court of Delhi a case for trademark USHA was filed against Swaran Singh in January 1996 and the said case CMM-35/1976 went in favour of Swaran Singh and thereafter the Respondents got the mark assigned in their favor from Mr Swaran Singh. It was stressed by the Ld. Counsel of the Respondent that either party was not in competition of one another vis-a-vis any product. This was in answer to the query put by the Tribunal. The second query was as whether the Complainant was agent of the Respondent? The answer to the query was they are not the agent as defined in the Contract Act, 1872.

45. The Ld. Counsel for the Respondents also drew the attention of the Tribunal to **Annexure D page 252-254 and 256** of their reply wherein he stated that the Respondents have also got an assignment for the use of trademark 'Usha' by way of assignment from Swaran Singh.

46. The Respondents' counsel also drew the attention of the Tribunal to **page 404 Annexure I** which is a part of the reported judgment reported in **1996 PTC (16) page 610 Annexure I** wherein many of the Usha Group companies including complainant came to contest the case as Plaintiffs to stop a company called Usha Rectifier Corporation from using the word "USHA". The Ld counsel also relied upon a judgment reported in **2005 (31) PTC 639 (CB) Annexure M.**

47. At this point the Ld counsel for the complainant drew their attention of the Tribunal to page **8 & 9** of their rejoinder affidavit wherein they have stated that order i.e. **Annexure M** is under challenge under **RFA 843 of 2005**. Further the complainants have reproduced some order passed in the said RFA by the Hon'ble

High Court. At this the Ld counsel for the Respondent said that he is citing the judgment only to highlight the facts as given in para 43, which states ***"this is not an ordinary litigation between two competitors or between a wrong doer and victim. It is a matter between persons who at one time were one economic entity having common Directors and who along with three other persons belonging to the Usha group and are entitled to use word "Usha" logo. This fact distinguishes this matter."***

48. Since this judgment is under challenge hence this Tribunal does not feel it proper to go into the contentions raised by the counsel for the Respondents other than his emphasis that the Respondents and the claimants are a part of the single economic entity and have been using the word "USHA" not in competition with each other but as a group. The counsel for the Respondents drew attention of the Tribunal to page 456 which is **Annexure N** which is a decision given by the Assistant Registrar of Trademark which was a matter between Usha Intercontinental Proprietor General Sales Ltd, and JEW wherein the Assistant Registrar of Trademark has relied upon to judgment of Justice RC Lahoti reported in **1996 PTC 610**. Thereafter he drew the attention of the Tribunal to another judgment of reported in **2004 (29) PTC 322** between Chinar Trust and Jay Engineering Works (of whom the Complainants are major share holders) for the use of Mark 'Shriram'. The Ld Counsel for the Respondents drew attention of the Tribunal to para 4 of the judgment.

49. The Ld. Counsel for the Respondents drew the attention of the Tribunal to **Section 33 and 34 of the Trade Mark Act read with Section 144 of the said Act** and stated that for decades both the



parties have been using the term and trademark 'USHA' for their products and hence the complainants cannot state that the Usha is their trademark exclusively. He relied on the Habib Bank Judgment reported in **1982 RPC No.1** in the Supreme Court of Judicature Court of Appeal, England wherein he stated that the complainant is **estopped** from stating that they are having exclusive owners of the trademark "**usha**". The Ld. counsel drew the attention of the Tribunal to **Rule 4 of NIXI** procedure and stated that as per **Rule 4(i)** the dispute can be raised only if the registrant domain name is identical or confusingly similar to the name, trademark or service mark in which the complainants has right and also to Rule 6(i) and (ii) and stated that it is not the case of the complainant that the Respondents is likely to transfer the trademark for sale, renting or otherwise to prevent the owner of the trademark from reflecting the mark in his domain name. He states that the above ingredients are not attracted in this case as their associate had registered another domain name under the name and style of "**USHAWORLD.COM**" much prior to the Complainants. Besides this they have registered domain names as given in **Annexure Q** of their reply.

50. The Ld. Counsel for the Respondents further contended that a complaint was filed by the Complainants for the domain name 'usha appliances'. This matter was also referred in arbitration as per INDRP Policy but the complaint was withdrawn by the complainants they filed the copy of the correspondence which is dated 18th April, 2006 (at the time of the Arguments). The Ld Counsel for the Respondents also stated that they have been using the domain name as can be seen from website created and given as **Annexure P** with their reply. The counsel further drew the attention of the Tribunal to **page 10** of the counter affidavit



which is **Annexure V** which is a print out of the website of the complainant wherein he points out that as on 24/03/04 the Complainants website "usha-world.in" is not even ready, clearly establishes that they are not using the same.

51. Mr. Benjamin, Ld. Counsel for the Complainants in his Rejoinder Arguments *inter alia* stated that there are various applications / registration pending for the trade mark "usha" which have been filed by the complainant. The Ld. Counsel for the Complainant states that they have coined the word USHAWORLD for its sales counters and show rooms in the year 2002. The complainants have drawn the attention of the Tribunal to their **Annexure 3** to establish their use of the word "ushaworld". The counsel further drew to the attention of the Tribunal **Annexure 4** which are clippings of various newspapers for the period from April and May 2003 wherein the use of the word "ushaworld" for Complainants show rooms has been published and he further invited attention to page **34, 35, 37, 39 & 41** of **Annexure 4** to establish the use of "ushaworld".

52. The counsel for the Claimants points out that **Annexure 5** clearly shows that they had acquired the domain name "USHA-WORLD.IN" and further state that the Respondents claiming rights on Usha Shriram and logo is irrelevant to the present proceedings and the Annexures relating to the same does not substantiate their claims.

53. The counsel for the Complainants points out that **Annexure 4** of their affidavit clearly establish that they are using the mark "ushaworld" and hence they ought to be given domain name "ushaworld.in" and that **Annexure 5** of their affidavit is their

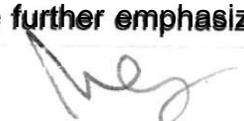


registering the domain name USHA-WORLD.IN on 16th February, 2005 and that the use of "ushaworld.in" by the Respondents is likely to create confusion and has been done with *mala fide* intention and that the Respondents are not making actual use of the said domain name.

54. The Complainants have denied the contention of the Respondents that they have been conspicuously and pervasively using the trade mark "usha" by mutual consent and agreement and they have further denied that the Group constitutes one economic entity for the purpose of proprietorship of the trade mark. The complainant further alleged that the Respondents never used the mark "usha" *per se* and that they have only used the five block logo Usha and Shriram and the matters are subjudice and the Respondents should not try to derive mileage out of matters which are pending before courts.

55. The Complainants' counsels' main stress is that they have been using the term "usha world" since 2002 in respect of their show-rooms. The Complainant have further stated that by a license given to them by the Respondents for the use of trade mark "Usha" and "Usha Shriram" at Annexure F of their reply does not give them the right to apply or to register domain name "ushaworld.in" and the said registration smacks of duplicity and *mala fide* intention.

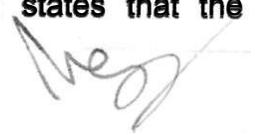
56. The Complainants have further invited the attention of the Tribunal to para **IX(a)** of their Rejoinder and stated that the Respondents' reliance to their proceedings before the Intellectual Property Authority in Sri Lanka *qua* their application was accepted **only after JEW gave its letter of consent. He further emphasized**



that while quoting the orders of Calcutta High Court the Respondent has purposefully suppressed that the order of Calcutta High Court directs the Respondents only to sell products prominently displaying the LEXUS logo for this the counsel drew the attention to para **IX(a)** of their Rejoinder. The Ld counsel for Complainants further states that the Respondent's reliance on the citation at **Annexure M** is bad as this matter is before the Hon'ble Delhi High Court in RFA 843 of 2005 hence the Respondents cannot derive any extra mileage out of the said judgment. He drew the attention of the Tribunal to page **IX(a)** of their rejoinder wherein orders passed by the Hon'ble Delhi High Court have been quoted.

57. That complainants, also drew the attention of the Tribunal to Para 20 (v) page 12 of the Rejoinder and judgment of Hon'ble Supreme Court **1996 PTC 16 SC** *qua* the trade Mark WHIRLPOOL and stated that Respondents are in the habit of improperly registering the Trade Mark of others.

58. The Complainant further invited the attention of the Tribunal to their sur rejoinder wherein have annexed a copy of a WHOIS report which points out that they had registered the domain name **'MYUSHAWORLD.com'** on **09.6.2000**. Apart from the above, the complainants have on 25-4-06 handed over a print out of the web site of "ushaworld.in" which is being run by Chinar Trust and stated that the same is not in use and has not been developed by the Respondents as they have no use for the same. In their arguments the counsel for complainants states that they have been using the term "ushaworld" prior to the Respondents. In **augmentation of his arguments Mr. Benjamin states that the**



registrant i.e., Chinar Trust has never used the word "ushaworld" and even the domain name which is give to them the website is not functioning. The counsel drew the attention of the Tribunal to the counter affidavit of Chinar Trust i.e., Respondent para 11.10 at page 7 wherein the Respondents have falsely stated that the use of the term "USHAWORLD" by the Respondents associate company was prior to that of the complainants.

59. The counsel for the complainant drew the attention to **Annexure T & U** filed by the Respondents in their counter affidavit and pointed out that the same belongs to their associate company Usha Shriram Furniture Industries and there is no acquisition of rights by the Respondents from Usha Shriram Furniture Industries. The counsel for the complainant further, stated that "there is no application or trade mark or copy right for the word "ushaworld" and since there was no trademark hence the Respondents and the Complainants went for the non-trademark category of the .IN Registry.

60. At this juncture the Tribunal places that the Respondents at the close of the arguments have filed a letter dated 26.4.2006 from Usha Shriram Enterprises (Pvt.) Ltd formerly Usha Shriram Furniture Industries (P) Ltd stating that they have no objection if the domain name is used by Chinar Trust.

61. The complainant's counsel pointed out that the present arbitration is regarding "ushaworld.in" only and the present arbitration ought **to revolve around it only and not go into the question of the Trade Mark 'USHA'.**



62. The Complainant's counsel has stated that the Respondents are riding a piggy back on the rights of their so called associate company Usha Shriram Enterprises for the domain name ushaworld.com. The complainants relied on the judgment of Pfizer reported 2006/32 PTC 208 Delhi in support of his contentions.

63. After hearing the arguments and going through the pleadings and the documents filed this Tribunal has come to the following conclusion:

64. Since both the parties have filed documents on the eve / at the time / after the close of the Arguments though this is not a healthy practice but this Tribunal takes the same on record in the interest of justice.

65. That so far as the name or Trade Mark "USHA" is concerned both the parties are using the same for long number of years and they have jointly contested cases against third parties. Since the matter regarding trademark USHA is being contested before various courts it is not within the powers of this Tribunal to give any finding *qua* the ownership rights of "Usha" which as aforestated the parties are keenly contesting against one another in various fora. The scope of this Arbitration is confined to the domain name "ushaworld.in". It is the main stress of the complainants that they have coined the word "USHAWORLD" and using the said term opened show rooms with the said term USHAWORLD displayed prominently on the showrooms. They have also shown that they got the domain name "MYUSHAWORLD.COM" as early as 9th June 2000. They have also annexed as **Annexure 4** to their Rejoinder Affidavit Press



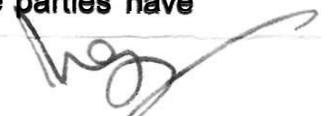
Clippings to show that they are using the term 'USHAWORLD' for their showrooms prior to the use of the term USHAWORLD by the Respondents. If it was so it is to be seen who were prior for the use of the term "USHAWORLD". The Respondents have shown that one of their group companies Usha Shriram Enterprises have got the domain name "ushaworld.com" registered on 24th January 2000 prior to the "coining" the term ushaworld by the Complainants whose **Annexure 4** as given in their Rejoinder relate to a period of year 2003. Not only this that the Respondents have annexed a copy of the retention sheet given at **Annexure T** of the Counter Affidavit wherein there is an application filed for registering "USHAWORLD.COM" with the Trade Marks Registry and the same is dated 26/09/2000. To counter this the Claimants have filed with their sur rejoinder the said registration of the domain name word "MYUSHAWORLD.COM" which is dt. 9-6-2000 whereas as pointed out earlier the Respondents have shown that their sister company Shriram Enterprises had got the domain name "USHAWORLD.COM" as early as 24-1-2000. The Respondents have also filed the letter from the said Usha Shriram Enterprises that they have no objection to Respondents use of domain name "USHAWORLD.COM" as they are their sister concern.

66. The above throws to light that the Respondents' associates though are not party to this arbitration were prior to the use of "ushaworld". Not only this even the advertisement given for the show rooms are for the year 2003. The Respondents have stated that they have coined the word "ushaworld" for their show rooms but the coining of the term is in the year 2003 whereas amongst various documents filed by the Respondents particularly their **Annexure R, T & U** shows that the Respondent's associate



company M/s Usha Shriram Enterprise had decided to use the term as early as January 2000, much prior to the Complainants. The complainants counsels contention was that the Respondents are using registration of another company would not be allowed to 'ride piggy back on the rights belonging to another entity'. However, this Tribunal finds that even the complainants have claimed exclusive rights to the 'USHA' based trade mark of their associate company Jay Engineering Works and hence they cannot take this stand to exclude Respondents from establishing their contentions based on the Registration of their associate company, This leads the Tribunal to make a hypothetical scenario in its mind in which it is supposed that instead of Chinar Trust the complainants would have got the registration for domain name "ushaworld.in" what would have happened. The answer is clear that the Registrant of USHAWORLD.COM i.e. M/S Shri Ram Enterprises would have raised the dispute. One cannot loose right of such a probability. Apart from above, the complainants have relied upon a judgment of Hon'ble Delhi High Court reported as 2006 (32) PTC 208(Del) titled Pfizer Products Inc. vs Altamash Khan & Anr. The case of Pfizer Products was a case where a cyber squatter ie the defendant had *malafidely* without having any interest in VIAGRA registered a domain name viagra.in under the sunrise policy which was on first come first serve basis . The Plaintiff company i.e., Pfizer had registered trademark of "VIAGRA" in 147 countries and in such a background the Hon'ble Court had held the Defendant does not have any interest in the domain name "viagra.in" apart from putting it up for sale.

67. Unfortunately this judgment does not come to the aid of the complainants as in the present Arbitration both the parties have



shown the use of the trademark "usha" which they have been using as a group for many years and apparently now there are some legal battles between the parties.

68. From the above it is clear that the Respondents and their associate companies have also been prior in the use of the word "ushaworld" and have also been prior in registering the domain name "ushaworld.in". The Pfizer case is not attracted here as the Respondents have shown that they have put the web site in operation and on the contrary have also shown that the web site USHA-WORLD.IN registered by the Claimants is still inactive .

69. The parties attentions were drawn to a judgment of Hon'ble S.C. **2004(5) Co. Law Journal 1 S C** wherein again it was made clear that the domain names were being given on "first come first serve basis" and the Respondents' application was admittedly prior to that of the complainants. Moreover the Respondents have an interest in the word "Ushaworld" be it for themselves be it for their sister concern as they are part of a large group and are using the "House Mark" "USHA" for decades.

70. That there is nothing in the Complainant or the evidence annexed there to show that the Respondents are cyber squatters and have taken this domain name which is confusingly similar to the name of the complainant. As seen above both are trading and marketing goods under the brand name and trademark "usha" and they have already stated that they are not selling goods in competition with one another. In fact the complainants are distributors and marketing agents of the Respondents' products hence it cannot be also said that the domain name has been acquired in bad faith.

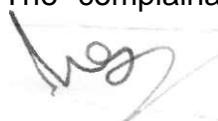


71. In view of the above, on "first come first serves" basis the domain name registered by Chinar Trust "ushaworld.in" was prior as per sunrise policy and it was in a open category and not in a trademark category hence and both the parties and their associates have been using the House Mark "USHA" and hence the complainants cannot lay and claim of the exclusivity on the count of "USHA".

72. This Tribunal is also at a loss to find answers to the following questions (1) why the Complainant did not initiate any opposition in the year 2000 when the associate company of the Respondents had taken the domain name "USHAWORLD.COM" (2) why the complainants thereafter subsequently contended themselves with the domain name "MYUSHAWORLD.COM".

73. Logically they should have in the year 2000 raised a dispute but they did not do so. It is also not clear as to why the Complainants withdrew the second dispute which they raised qua domain name "Usha Appliances".

74. Keeping in view of the above it is clear that the claimants have not been able to establish any long use or exclusive use of the word "USHAWORLD" which they have stated that they have coined for their show rooms. In view of above this Tribunal , awards that Respondents are entitled to retain the domain name "ushaworld.in" which they have got registered prior to the complainants in the open category under the sunrise policy. The complainant's have not been able to show that they were prior in use of the term "ushaworld" or have been exclusively using the term "ushaworld". The complainants have not been able to



establish any bad faith on the part of the Respondents and also that the Respondents want to sell away or trade this website for a monetary consideration to any third party. The domain name hence will stay with the Respondents.

It is awarded accordingly.

Place: New Delhi
Date : 13/05/06

A handwritten signature in black ink, appearing to read 'V. Shrivastav', is written over a set of three thin, parallel lines that form a shallow V-shape.

V. Shrivastav
Arbitrator