

தமிழ்நாடு தமிழ்நாடு TAMILNADU

12766
4 APR 2014

D. SARAVANAN
Advocate & Arbitrator
"Orient Chambers", No. 90 / 73,
4th & 5th Floor, Armenian Street,
Chennai - 600 001.

AU 221950
P.G. SIVASUBRAMANIAM
SIVASUBRAMANIAM
L. S. S. 100 / 98
MIDNIGHT CAMPUS,
CHENNAI - 600 104 (TAMILNADU)

BEFORE THE SOLE ARBITRATOR MR.D.SARAVANAN
IN REGISTRY
NATIONAL INTERNET EXCHANGE OF INDIA

Disputed Domain Name: <www.wellsfargo.co.in>

1. Wells Fargo & Co.,
420 Montgomery St
San Francisco,
California 94104, USA.
And

2. Wells Fargo India Solution Private Limited
Wells Fargo Centre, Building 1-A, Divyasree
Orion (Special Economic Zone)
Sy.No.66/1, Raidurga, Serilingampalli
Hyderabad, India - 500032.

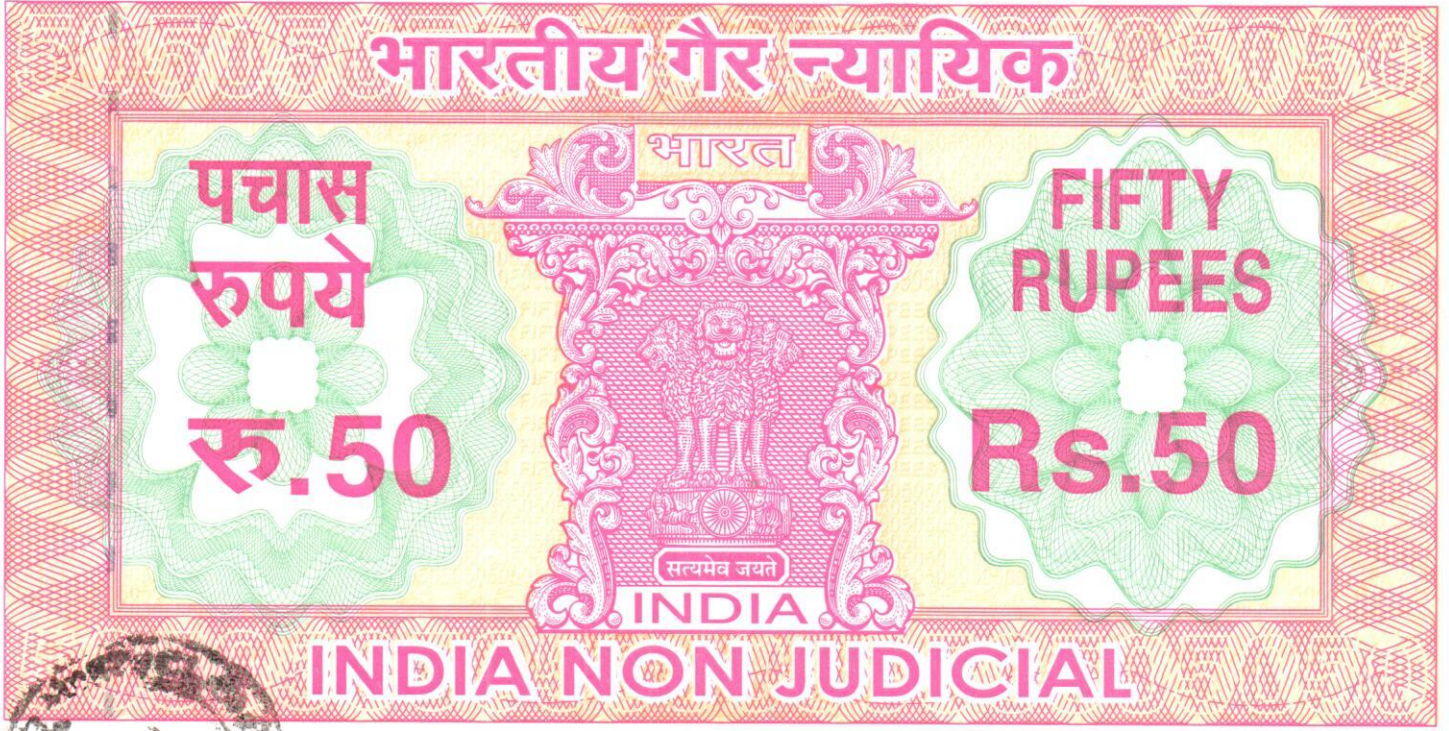
Versus

.. Complainants

Krishna Reddy
110 N Lilley St, apt 301
Moscow, Idaho 83843
USA.

.. Respondent





தமிழ்நாடு தமில்நாடு TAMILNADU

12886
4 APR 2014

D. SARAVANAN
Advocate & Arbitrator
"Orient Chambers", No. 90 / 73,
4th & 5th Floor, Armenian Street,
Chennai - 600 001.

AE 147358
R.S. SHAMUGA SONDARAM
Stamp Vendor,
LINE 14 / 101 / 88
HIGH COURT CAMPUS,
CHENNAI-600 104 (TAMIL NADU)

-2-

1. The Parties:

The 1st Complainant is Wells Fargo & Co., is having its address at 420 Montgomery St, San Francisco, California, 94104, USA and the 2nd Complainant is the Affiliate of the 1st Complainant in India having its address at Wells Fargo Centre, Building 1-A, Divyasree, Orion (Special Economic Zone), Sy.No.66/1, Raidurga, Serilingampalli, Hyderabad, India - 500032.

The Respondent is Krishna Reddy, having his address at 110 N Lilley St, apt 301, Moscow, Idaho 83843, USA.



2. The Domain Name and Registrar:

The disputed domain name : <www.wellsfargo.co.in>

The disputed domain name is registered with National Internet Exchange of India (NIXI) through its Registrar M/s.Sify Technologies Limited.

3. Procedural History:

- February 02, 2014** The .IN REGISTRY appointed D.SARAVANAN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.
- February 02, 2014** Consent of the Arbitrator was given to the .IN REGISTRY according to the INDRP Rules of Procedure.
- March 03, 2014** Notice was sent to the Respondent by e-mail directing him to file his response within 10 days, marking a copy of the same to the Complainants' representative and .IN Registry.
- March 12, 2014** Respondent sent an email with an informal response.
- March 13, 2014** Respondent sent an email stating that he want the records for his say.
- March 13, 2014** This tribunal sent an email to the .IN Registry to confirm as to whether the respondent has been served with copy of the complaint and supporting documents filed by the complainant.
- March 20, 2014** In reply thereto, the .IN Registry sent an email informing the tribunal that the complaint with annexures was sent to the respondent through courier on 18.02.2014 vide consignment No.9224451530, however, the .IN Registry had received an email from the Blue Dart courier stating that the consignment has been undelivered.
- March 20, 2014** Upon which, this tribunal had directed the .IN Registry to forward a soft copy of the complaint and documents to the respondent.



- March 20th & 21st, 2014** In compliance with the directions of this tribunal, both the complainant and the .IN Registry had forwarded a copy of the complaint with annexures through email respectively, to the respondent.
- April 25, 2014** In spite of lapse of more than a month's time, the respondent has failed to submit his written response. Hence, this tribunal was constrained to send a notice of default intimating the respondent regarding Tribunal's intention to proceed further and decide the dispute on its merits.
- April 26, 2014** Respondent sent a reply requesting the Tribunal to treat his email response dated March 12, 2014 as his official response.
- April 28, 2014** This Tribunal sent an email directing the Complainants to file their re-joinder, if any, to the response of the Respondent.
- April 30, 2014** The Complainants sent their re-joinder marking a copy of the same to the Respondent.
- April 30, 2014** This Tribunal reserved the matter for passing its Award and sent an email to all the concerned.
- April 30, 2014** The respondent sent an email stating that he has some issues with the rejoinder and sought time to address the same. However, the Respondent has not sent any reply to rejoinder till the date of passing of this Award.

4. Factual Background

4.1 The Complainants:

The 1st Complainant is Wells Fargo & Co., an American Multinational banking and financial services holding company and the 2nd Complainant is the Affiliate of the 1st Complainant and an IT/ITES company registered and incorporated in India to provide back office services to its Affiliates. The authorized representative of the Complainants is M/s Rodney D. Ryder, James M. & Ashwin Madhavan of Scriboard,



Advocates & Legal Consultants, having their office at Level 2, Elegance Towers, Mathura Road, Jasola, New Delhi, 110025, India.

4.2 Complainants' Activities:

(i) The 1st Complainant is considered as one of the top four largest banks in the US by assets and one of the largest banks by market capitalization. It has retail branches and automated teller machines in the US. The 1st Complainant and its Affiliates has presence in many countries, including but not limited to India where, its Affiliate, namely the 2nd Complainant is incorporated and registered as private limited company carrying on business activities of IT and ITES.

4.3 Complainants' Trading Name:

(i) The Complainants have spent a huge amount of money on the promotion and advertisement of its services and products under the trade/service name/mark 'Wells Fargo' since its adoption and use. The Complainant considers their trade/service name/mark as an important and an extremely valuable asset and thus in order to protect the same has secured trade mark registration for the mark 'Wells Fargo' globally including but not limited to India. The copies of the said trade mark registration(s) obtained by the Complainants in India and world over have been annexed with the complaint as "Annexure C". The Complaint states that it is the exclusive owner and proprietor of the trade mark registration(s) and the same is duly valid and subsisting.

(ii) The official website www.wellsfargo.com is a comprehensive, unique and acclaimed introduction to Wells Fargo. A print out of the Home Page of the 1st Complainant is annexed as "Annexure D" to the Complaint. Google Search of the term 'Wells Fargo' throws up a huge number of results of which, each and every one pertains to the Complainant only and a copy of the first page of such search is enclosed as "Annexure E" to the Complaint.



(iii) The profile and popularity of the Complainant under the trade/service mark/mark 'Wells Fargo' has been continuously increasing since the date of adoption and use of the mark. At present, the Complainant's trade name/mark is indentified by the purchasing public exclusively with the Complainant and has acquired an enormous goodwill not only in India but in many countries across the globe.

(iv) As internet has become an essential medium to conduct business, the Complainant in order to expand its presence decided to obtain a domain name registration. The complainant has settled for www.wellsfargo.com [along with many other domain name registrations] as a natural extension of its corporate name for the registration of its domain name and that the complainant then spent considerable amount of money and skill to develop a website on the obtained domain name www.wellsfargo.com.

5. Respondent's Identity and activities:

The Respondent is **Krishna Reddy**, having address at 110 N Lilley St, apt 301, Moscow, Idaho 83843, USA.

6. Dispute:

The dispute arose when the Complainants came to know about unauthorized registration of the domain name www.wellsfargo.co.in through WHOIS database search by the Respondent which is nothing but a duplication of the Complainants' trademark/service mark and cannot have been obtained in good faith.

7. Parties contentions:

A. Complainants:

(1) The Domain Name is confusingly similar to the complainants :

(i) A mere glance at the disputed domain name gives rise to enormous confusion as to its origin as the domain name used by the respondent is identical to the



corporate name of the complainants. The malafide intension of the respondent is evident from the fact that not even a single letter differs between the disputed domain name and the corporate name of the complainants. The respondent has picked up the mark / name of the complainants verbatim without even changing a single letter. Thus, the use of the disputed domain name by the respondent is a *prima facie* case of cyber squatting and trade / service mark / infringement.

(ii) The disputed domain name contains the entirety of the complainants' trademark. It is well established that the specific top level domain, such as ".com", ".in", ".co.in", ".net" or ".travel" does not affect the domain name for the purpose of determining whether it is identical or confusing the similar.

(iii) The term 'Wells Fargo' has been used by the complainants continuously for a number of years, as it is associated exclusively with the complainants. The use by the any other concern of an identical / deceptively similar mark to that of the complainants' mark "Wells Fargo" is bound to lead to confusion and deception and amongst to passing off, and any person or entity using the service mark in any manner is bound to lead customers and users to infer that its product or service has an association or nexus with the complainants.

(iv) The mark "Wells Fargo" has been in extensive, continuous and uninterrupted use since the year 1852 in relation to the complainants' business. More specifically, the mark "Wells Fargo" has been in use by the complainants in relation to all its stationary articles including letter heads, visiting cards, order forms, bill books, envelopes, applications forms and in relation to sales promotional material, such as, brochures, catalogues, etc. The mark "Well Fargo" has also been used in relation to advertisement and related business / commercial information disseminated in several print media such as newspapers, magazines etc. both in India as well as abroad. In each of the instances of use, the mark "Wells Fargo" is prominently displayed and has become the focus of the complainants' entire business. The promotional information and brochures are marked as **Annexure F** to the complaint.



(v) In the present case, it is very natural for an internet user, who wished to reach / visit the website of the complainants to type its corporate /commercial name followed by "<.in>" and / or "<.co.in>". This will lead the internet user to believe that the complainant is associated with or owns the website bearing the domain name www.wellsfargo.co.in.

(vi) The impugned domain name is identical to the trade mark "Wells Fargo". As numerous UDRP panels have held in so many decisions that a domain name wholly incorporates a complainants' registered mark may be sufficient to establish identity or confusing similarity, despite the addition of other words to such mark. The complainant has shown that the disputed domain has become a distinctive identifier associated with the complainants or its goods or services.

(2) The respondent has no rights or legitimate interest in respect of domain name:

(i) The respondent has no proprietary or contractual rights in any registered or common law trade mark corresponding in whole or in part to the disputed domain name. Furthermore, the respondent whose name is Mr.Krishna Reddy is not commonly known by the disputed domain name nor does the respondent actually engaged in any business or commerce under the name "Wells Fargo". The respondent has no active business in the name of "Wells Fargo". The respondent is not a licensee of the complainant, nor has the respondent ever been authorized by the complainant to use the complainant's trademarks or registered the disputed domain name. The complainant has no relationship with the respondent.

(ii) The illegality in the registration of the disputed domain name arising from the fact that domain names today are a part and parcel of corporate identity. A domain name acts as the address of the company on the internet and can be termed as a web address or a web mark just like a trademark or service mark. It is also the internet address of the company.



(iii) The respondent cannot have any right or legitimate in the disputed domain name because the disputed domain incorporates the "Wells Fargo" mark in its entirety in which the complainants has the sole and exclusive right and that has become well-known owing to the complainants' efforts.

(3) **The respondent registered in domain name in bad faith:**

(i) The disputed domain name being held by the respondent which is in bad faith and a clear attempt to take advantage of the complainants' goodwill and reputation. This is an attempt to misuse the domain name by the use of the simple domain name extension variant. The mark "Wells Fargo" having been extensively used is understood and associated by consumers in India and throughout the world as the mark of the complainants denoting its services and business. On account of the high degree of inherent and acquired distinctiveness, which mark "Wells Fargo" is possessed of, the use of this mark or any other phonetically, visually or deceptively similar mark, by any other person would result in immense confusion and deception in the trade, leading to passing off. The name / mark "Wells Fargo" has acquired unique important and is associated with the complainants. A mere mention of the said name / mark establishes an identity and connection with the complainants and none else.

(ii) It is inconceivable that the respondent could have registered the disputed domain name without being aware of the complainants' rights. In the light of the respondent's presumed knowledge of the complainants' rights, it is reasonable to infer that the respondent could not have registered the disputed domain name without the intention to target this rights in some manner. Furthermore, it would be extremely difficult, if not impossible, for the respondent to use the disputed domain name as the name of any business, product or service for which it would be commercially useful without violating complainants' rights. Thus, the disputed domain name was registered in bad faith.



B. Respondent:

The Respondent has submitted his response stating that the Article 19 of the Constitution of India guarantees every citizen freedom of speech and believe that his registration of the domain under consideration as purely an exercise of the said freedom.

C. The Supplemental Response filed by the Complainants is as follows:

(i) The Respondent's only contention for proving rights in the disputed domain name is one of Article 19 (Freedom of Speech & Expression] of the Constitution of India. In many cases around the globe it has been held that freedom of speech in the current legal context cannot be a process by which a right is given to a third party in the "possession/goods" of the intellectual property owner. If the three requirements under the policy have been met for declaring that the Respondent has no right in the Disputed Domain Name, then it has been held by various panels the domain name would be transferred to the right holder and even the question of delay [laches] would not be a defense for the Respondent. In the present case, even when there is a right given to the respondent to exercise free speech, such right is not absolute and would be subject to restrictions that come with the exercise of rights of any other person. Therefore, even if the respondent claims protection under Article 19 of the Constitution, he still would be precluded from using a property that someone else has a right in it.

(ii) Courts in India have held that the right to freedom of views, speech and expression through speech under Article 19(1)(a) is not an absolute right; Article 19(2) safeguards against the exploitation or abuse of such right. Any action that may constitute unfair or untrue commercial speech and which may cause injury to the rights holder is an excepted matter under Article 19(2). [Hamdard National Foundation v Dalal (CS(OS) 1225/2013); Bata India Limited v Prakash Jha Productions (2013) 1 SCC 729]. Therefore under the existing law in force, the



Respondent's contention that the disputed domain name usage is protected under Article 19 holds no merit. The respondent has not refuted the claim that the domain name, www.wellsfargo.co.in, is confusingly similar to the complainant's mark "Wells Fargo". The Respondent has no active business in the name of 'Wells Fargo'. The Respondent has not provided any documentation to show whether the registration was done in bad faith or not. The only contention that has been raised is one of Article 19 defense, which lacks any merit in the event of intellectual property infringement.

(iii) By registering the disputed domain name with actual knowledge of the Complainants' trademark, the Respondent has acted in bad faith by breaching its service agreement with the registrar because the Respondent registered a domain name that infringes upon the Intellectual Property rights of another entity, which in the present scenario is the Complainants.

(iv) The Complainants further contend that the Respondent has merely parked the disputed Domain Name in an effort to generate revenue from consumers who mistakenly visit the site, and in such time has not made any legitimate commercial use of the disputed Domain Name. Respondent's failure to use, or to even make preparations to use, the disputed Domain Name in connection with the offering of a legitimate web site constitutes strong evidence of bad faith registration and use. The Respondent has parked the disputed domain name and thus is effectively engaged in "passive holding". The concept of typically implies complete inaction on the part of the Respondent characterized by a failure to direct the domain name under dispute to any active website. In the present case there is a slightly different situation, namely that the Respondent has directed the disputed domain name to a web server-parking page. This is equivalent to "passive holding" because the associated web site is evidently a standard holding page for a third party service. It could not in any sense be described as an active site provided by the Respondent itself.



8. Discussion and Findings:

It has to be asserted as to whether the Constitution of Arbitral Tribunal was proper and whether the Respondent had received the notice of this Arbitral Tribunal?

Having gone through the procedural history, this Tribunal comes to the irresistible conclusion that the Arbitral Tribunal was properly constituted and Respondent had been notified of the complaint of the Complainants.

Under paragraph 4 of the IN Domain Name Dispute Resolution Policy (INDRP), the Complainants must prove each of the following three elements of its case:

- (i) The Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainants has rights;
- (ii) The Respondent has no rights or legitimate interest in respect of the domain name; and
- (iii) The Respondent's domain name has been registered or is being used in bad faith.

(a) Identical or confusing similarity:

(i) The Arbitral Tribunal finds that the trade / service name / mark "Wells Fargo" and the disputed domain name www.wellsfargo.co.in are confusingly similar and identical. The respondent has neither disputed the legal right of the complainants over the trade / service name / mark "Wells Fargo" nor confusing similarity of the disputed domain name. The Complainants have established beyond doubt that it is the lawful owner of the trade / service name / mark "Wells Fargo". The Arbitral Tribunal in its various decisions categorically held that mere addition or substitution of descriptive suffix or prefix like '.com' or '.co' or '.in' does not make a trade mark distinctive.



(ii) The Arbitral Tribunal concludes that the Complainants have established paragraph 4(i) of the IN Domain Name Dispute Resolution Policy.

(b) Respondent's Right or Legitimate Interest:

(i) The Complainants contend that the Respondent had no legitimate interest in the disputed domain name. Paragraph 7 of the IN Dispute Resolution Policy sets out three elements, any of which shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name for the purposes of paragraph 4(ii) of the Policy. As held by this Tribunal in preceding paragraph, the complainants have established that it is the lawful owner of the trade / service name / mark "Wells Fargo". The respondent's only contention is that Article 19 of the Constitution of India guarantees every citizen freedom of speech and he believe that his registration of the domain in reference is purely an exercise of the said freedom. No doubt, Article 19 protects every citizen's right to freedom of speech and expression. However, such protection or right is subject to Sub-Clause (2) of Article 19 which states that nothing in Sub-Clause (a) of clause (1) shall affect the operation of any existing law. Therefore, the rights protected and Article 19 cannot be said to be an absolute right. In this case, this Tribunal has categorically held in preceding paragraph that the complainant is the lawful owner of the trademark "Wells Fargo" registered under the Indian Trade Marks Act, 1999. Hence, the respondent's unwarranted registration of the impugned domain name with NIXI identical to complainants' Trade Mark is clearly an offense under the Indian Trade Marks Act, 1999. Any action that may cause injury to the rights holder is an excepted matter under Article 19(2) as held in (2013) 1 SCC 729 in the case of Bata India Ltd., -Versus-Prakash Jha Productions. The Complainant has established a strong case of lack of rights and legitimate interest and the Respondent had failed to rebut the presumption of absence of rights or legitimate interests.

(ii) Based on the records filed by the Complainants and the WHOIS Database Search the Arbitral Tribunal is satisfied that the respondent had registered the



domain name without any authorization and also directed the disputed domain name to a web server – parking page.

(iii) The Arbitral Tribunal is satisfied that the Respondent has no rights or legitimate interests in respect of the disputed domain name and, accordingly paragraph 4(ii) of the Policy is satisfied.

(c) Registration and Use in Bad faith:

(i) Paragraph 6 of the Policy provides the circumstances evidencing registration and use of a domain name in bad faith are that, by using the same, the Respondent has engaged in a pattern of such conduct and the Respondent has intentionally attempted to attract, for commercial gain, internet users to the Respondent's web site or other online locations, 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 the Respondent's web site or location. It is the specific case of the Complainant that the respondents' *modus operandi* is by creation of the website www.wellsfargo.co.in under the registered mark with generic/descriptive suffix, is seeking illegal commercial gain through its opportunistic bad faith registration of the disputed domain name.

(ii) The Respondent had registered the domain name which appears to have been selected precisely for the reason that it is identical or confusingly similar to registered trademarks and trade names of the Complainants. The Respondent has no affiliation with the Complainants. Registration of a domain name that is confusingly similar or identical to a famous trademark by any entity, which has no relationship to that mark, is itself sufficient evidence of bad faith registration and use.

(iii) In view of the submitted evidence and in the specific circumstances of this case, this Arbitral Tribunal draws the legal inference that the Respondent's



purpose of registering the domain name was in bad faith within the meaning of the Policy. The Respondent has no legitimate right or interest in the disputed domain name and there was a malafide intent for registering the disputed domain name other than for commercial gains, and that the intention of the Respondent was simply to generate revenue, either by using the domain name for his own commercial purpose or through the sale of the disputed domain name to a competitor or any other person that has the potential to cause damage to the ability of the Complainants to have peaceful usage of the Complainants' legitimate interest in using their own trade names.

In the light of the above, this Arbitral Tribunal finds that the Complainants have established that the disputed domain name was registered and is being used in bad faith.

9. Decision:

For all the foregoing reasons, in accordance with paragraph 10 of the Policy, the Arbitral Tribunal finds that the trade mark "Wells Fargo" constitutes a valuable intellectual property right owned by Complainants, which is entitled to protection in law against misuse, misappropriation as well as dilution and thus orders that the disputed domain name <www.wellsfargo.co.in> be transferred to the Complainants.

Dated at Chennai (India) on this 15th day of May, 2014.


D.SARAVANAN
Sole Arbitrator