



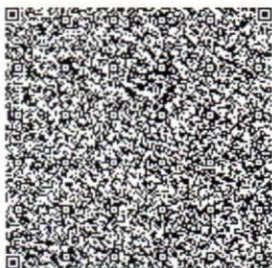
सत्यमेव जयते

## INDIA NON JUDICIAL

### Government of National Capital Territory of Delhi

#### e-Stamp

Certificate No.	: IN-DL85314664187724N
Certificate Issued Date	: 24-Nov-2015 10:02 AM
Account Reference	: IMPACC (SH)/ dlshimp17/ ROHINI/ DL-DLH
Unique Doc. Reference	: SUBIN-DLDSLHIMP1768579531470224N
Purchased by	: JAMES MUKKATTUKAVUNKAL
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: JAMES MUKKATTUKAVUNKAL
Second Party	: Not Applicable
Stamp Duty Paid By	: JAMES MUKKATTUKAVUNKAL
Stamp Duty Amount(Rs.)	: 150 (One Hundred And Fifty only)



#### INDRP ARBITRATION

-----THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]-----

ADMINISTRATIVE PANEL DECISION  
SOLE ARBITRATOR: JAMES MUKKATTUKAVUNKAL

Goods and Service Tax Network

V.

Mr. Ram Samy

ARBITRATION AWARD  
Disputed Domain Name: [www.gst.in](http://www.gst.in)

*James*

#### Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shcilestamp.com". Any discrepancy in the details on this Certificate and as available on the website renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

### **The Parties**

The **Complainant** in this arbitration proceeding is *Goods and Services Tax Network (GSTN)*, is a non-government, private limited company. Its registered office is at Room No. 255, North Block, New Delhi, PIN-110001. The Complainant is represented by its Executive Vice-president (Technology) Mr. Vimal Goel.

The **Respondent** in this arbitration proceeding is *Mr. Ram Samy*, located at 9-8, 1<sup>st</sup> Trust Link Street, Mandaveli, Chennai as per the details given by the Whois database maintained by the National Internet Exchange of India [NIXI].

### **The Domain Name and Registrar**

The disputed domain name is *www.gst.in*. The Registrar with which the disputed domain name is registered is Good Luck Domains [R6-AFIN].

### **Procedural History [Arbitration Proceedings]**

This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy [INDRP], adopted by the National Internet Exchange of India ["NIXI"]. The INDRP Rules of Procedure [the Rules] were approved by NIXI on 28<sup>th</sup> June 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes pursuant to the IN Dispute Resolution Policy and Rules framed there under.

According to the information provided by the National Internet Exchange of India ["NIXI"], the history of this proceeding is as follows:

In accordance with the Rules, 2(a) and 4(a), NIXI formally notified the Respondent of the complaint, and appointed James Muckattukavunkal as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, and the Rules framed there under, .IN Domain Name Dispute Resolution Policy and the Rules framed there under. The Arbitrator submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI.

The request for submission with a complete set of documents was dispatched to the Respondent on October 14<sup>th</sup>, 2015 with the last date of filing of reply by October 29<sup>th</sup>, 2015. Electronic copies of the complete set of documents were also sent to the respondent on the same date. The Respondent replied to the mail through "Goodluck Domains Pvt. Ltd.", which was received by the panel on 27<sup>th</sup> October, 2015, which stated that the legal documents had not been received by the Respondent and requested for documents to be sent again. Vide the same mail, Respondent also requested for some more time for filing of their response. The panel in reply directed the National Internet Exchange of India to send the documents to the Respondent, which was done so on October 28<sup>th</sup>, 2015 and gave the Respondent time till November 10<sup>th</sup>, 2015 to file its reply. The panel received the reply from the Respondent on November 10<sup>th</sup>, 2015 and has taken the reply from the respondent on record.

### **Grounds for the administrative proceedings**

1. The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has statutory/common law rights.





2. The Respondent has no rights or legitimate interests in respect of the disputed domain name.
3. The disputed domain name has been registered or is/are being used in bad faith.

**Background of the Complainant:**

The Complainant in this arbitration proceeding is *Goods and Services Tax Network (GSTN)*, incorporated under the laws of India. The company is a non-government, private limited company. The Government of India along with all state of Indian Union and the empowered committee of State Finance Ministers holds 49% shares and the rest 51% is with non-government finance institutions.

**Statutory rights:**

The Complainant contends that it has rights in the trademark/service mark/trade name "*GST.IN*" and its variants in all forms. The name is related to one of the most important projects/initiatives in relation to indirect tax by the Ministry of Finance, Government of India.

**Respondent**

The Respondent replied to the complaint saying that it has registered the domain name '*gst.in*' for the purpose of creation of a set of email addresses available and usable solely by members of the immediate family of the Respondent.

**Discussion and Findings**

The Respondent does not have any relationship with the business of the Complainant or any legitimate interest in the mark/brand "*GSTN*". Moreover, the Complainant has neither given any license nor authorized the Respondent to use the Complainant's mark. Also it is a well-established principle that once a Complainant makes a prima facie case showing that a Respondent lacks rights to the domain name at issue; the Respondent must come forward with the proof that it has some legitimate interest in the domain name to rebut this presumption. However, the Complainant has not provided for any such evidence regarding registration of "*GST.IN*" or evidence as to acquirement of secondary meaning in the word "*gst.in*". The disputed domain name in question is "*www.gst.in*"

**The Rules of Procedure**

The INDRP Rules of Procedure require under Rule 8(b) that the arbitrator must ensure that each party is given a fair opportunity to present its case. Rule 8(b) reads as follows

*"In all cases, the Arbitrator shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case."*

Rule 11(a) empowers the arbitrator to proceed with an ex parte decision in case any party does not comply with the time limits or fails to reply against the complaint. Rule 11(a) reads as follows:

*"In the event that a Party, in the absence of exceptional circumstances as determined by the Arbitrator in its sole discretion, does not comply with any of the time periods established by these Rules of Procedure or the Arbitrator, the Arbitrator shall proceed to decide the Complaint in accordance with law."*

The Respondent was given notice of this administrative proceeding in accordance with the Rules. The .IN Registry discharged its responsibility under Rules paragraph 2(a) to employ reasonably available means calculated to achieve actual notice to the Respondent of the Complaint.

As previously indicated; the Respondent replied to the Complaint and has sought to answer the Complainant's assertions, evidence or contentions in any manner. The Arbitrator finds that the Respondent has been given a fair opportunity to present his case.

The 'Rules' paragraph 12(a) provides that the Arbitrator shall decide the Complaint on the basis of the statements and documents submitted in accordance with the INDRP and any law that the Arbitrator deems fit to be applicable

### **The issues involved in the dispute**

The Complainant in its complaint has invoked paragraph 4 of the INDRP, which reads:

*"Types of Disputes -*

*Any Person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:*

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

*The Respondent is required to submit to a mandatory Arbitration proceeding in the event that a Complainant files a complaint to the .IN Registry, in compliance with this Policy and Rules there under."*

According to paragraph 4 of the INDRP, there are 3 essential elements of a domain name dispute, which are being discussed hereunder in the light of the facts and circumstances of this case.

### **Parties Contentions**

- I. The Respondent's domain name is identical and confusingly similar to a name, trademark or service in which the Complainant has rights.**

### **Complainant**

The Complainant contends that the domain name 'GST.IN' is of importance to him. The name is also connected to one of the most important projects/initiatives of the Ministry of Finance, Government of India. Also, the company Goods and Services Tax Network (GSTN) has been set up primarily to provide IT infrastructure and services to the central and state government, tax payers and other stakeholders for implementation of Goods and Service Tax (GST).

*Ames*  
*M*



The Complainant submits that as the disputed domain name is 'www.gst.in', it is clearly identical/confusingly similar to the Complainant's trademark in which the Complainant has rights and legitimate interest.

The Complainant also asserts that he is desirous of obtaining "GST.IN" as the name is direct verbatim of the initiative title- "Goods and Service Tax". Secondly, because of its close relation to GST initiative, it can be misused if it falls in the hands of person having wrong intention.

It has to be noted that the paragraph no. 4 of the INDRP policy starts with following words , *"Any person who considers that a registered domain name conflicts with his legitimate rights or interest may files complain to the in registry on follow premises."* This is a positive assertion and sentence. Further paragraph 4(i) also constitutes a positive assertion and sentence. Paragraph 4(iii) and paragraph no.6, which is supplementary/explanation to it; also have positive assertions/sentences. *The above clearly indicates that the onus of proving the contents of Para. no.4 (1) and 4(iii) are upon complainant. To succeed he must prove them.*

Also, the provisions of sections 101 to 103 of Indian Evidence Act also show that onus in present proceedings is primarily on complainant.

The important aspect that needs consideration is, as to whether the Complainant has right in the domain name "GST.IN". The panel notes that there are no proofs given by the Complainant to prove his trademark in the word "GST". An exhaustive search of trademark records does not demonstrate that the Complainant has received any exclusive trademark reservation for this word.

Another important aspect to consider is that even under trademark law, descriptive terms form an absolute bar for registration under Section 9 of the Trademark Act 1999. According to Section 9(b), *"trademarks....which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service.....shall not be registered"*. The very fact is that "Goods and Service Tax" is a generic group of words that the public would associate with the initiative of the government to introduce reform in the arena of indirect tax reform. It would not serve as a source of origin for the rendering of a particular service to any organisation/entity, unless the entity/organisation has acquired distinctiveness or secondary meaning in the aforementioned words that would lead the relevant public to identify the said aforementioned generic words as indicative of the service as originating from the concerned entity/organisation. Merely the fact that the company is the solely authorised entity by the government for the establishment of IT infrastructure for the roll-out of – Goods and Services tax (GST) would not render the word trademark able for the entity in the absence of acquired distinctiveness for the term in this case "GST".

The Complainant is trying to prove his ownership in "GST" which is an abbreviation/acronym. It is a general rule that abbreviations of descriptive terms are in



themselves descriptive if they are or could be used in that way, and the relevant public, whether general or specialised, recognises them as being identical to the full descriptive meaning. [(**Relevant Cases:** *Wieland-Werke AG v OHIM*, T-367/02 to T-369/02; *Audi AG v OHIM*, T-16/02 (appeal C-82/04 P); *Vitaly Lissotschenko and Joachim Hentze v OHIM*, T-311/02)]. The mere fact that the Complainant recognises that the public would identify the words GST as relating to "Goods and Services Tax", would serve as an absolute bar for registration of trademark in the term "GST" unless the relevant public can identify the services that are provided by the Complainant to the word GST. Also, neither the Complainant nor the Ministry of Finance, Government of India made any claim to the word "GST" in the .IN registry from 2005 through 2015.

A domain name performs the same functions online, which a trademark serves in the offline business dealings and transactions. While the trademark is striking graphic signifier of your product or company, the domain name is magnificent navigator to your company on the internet, and the virtual image of your business. The burden is on the Complainant to prove that he/she has legitimate rights in the name. A mere registration of the domain name creates neither an exclusive right to it nor any sui generis protection of the domain name 'as such'.

According to the INDRP paragraph 3, it is the responsibility of the Respondent to find out before registration that the domain name he is going to register does not violate the rights of any proprietor/brand owner.

Paragraph 3 of the INDRP is reproduced below:

*"The Respondent's Representations -*

*By applying to register a domain name, or by asking a Registrar to maintain or renew a domain name registration, the Respondent represents and warrants that:*

- the statements that the Respondent made in the Respondent's Application Form for Registration of Domain Name are complete and accurate;*
- to the Respondent's knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;*
- the Respondent is not registering the domain name for an unlawful purpose; and*
- the Respondent will not knowingly use the domain name in violation of any applicable laws or regulations.*

However, it is the Respondent's responsibility to determine whether the Respondent's domain name registration infringes or violates someone else's rights."

However this panel is of the view that the request to ownership to the same has to be denied on the grounds of no proof of trademark registration for "gst.in" with regard to the same [(**Relevant decisions:** *Jagdish Purohit v. Mr. Stephen Koeing INDRP/6* (July 7, 2006); *Suresh Kumar Sareen v. Jim J INDRP/007* (October 4, 2006); *Pepsico, Inc. v. Bijon Chatterji INDRP/014* (June 24 2006); *Pheonix IT Solutions Ltd. v. Mr. M. Ramesh INDRP/495* (28<sup>TH</sup> September, 2013); *Gokul Kalyansundaram v. Eternal Softwares INDRP/564* (February 2, 2014)]



Furthermore it has been held by the Hon'ble Supreme Court of India that the criteria to be considered while deciding on the similarity/dissimilarity of the marks the following criteria need to be considered; the nature of the marks (i.e.: whether they are word, label or composite marks); the degree of resemblance between the marks; the nature of the goods for which they are used as trademarks; similarities in the nature, character and performance of goods of rival traders; the class of purchasers who are likely to buy goods bearing the marks, the method of purchasing the goods or placing orders; and other circumstances that may be relevant. [(Relevant decision: Cadila Health Care Ltd. V. Cadila Pharmaceuticals Ltd. 2001 (5) SCC 73)]

### **Respondent**

The Respondent mentioned in his reply that he made a full and complete effort to ascertain that the registration of the domain name will not infringe upon or otherwise violate the rights of any third party, which is fully in accordance with Para 3(b) of the INDRP policy. The Respondent has further provided proof in respect of a mail sent to NIXI dated February 15, 2005, which showed it had approached NIXI to ensure that the said domain name had no more restrictions imposed on it other than under the INDRP rules. In the year 2005, the word "GST" would not have referred to the government initiative of "Goods and Services Tax". Also the aforesaid mail clearly states that the domain name is being registered for private use. Therefore the panel finds that the registration was done for non-commercial private family communications and email service with no confusion or complaints from any parties.

The Panel comes to the conclusion that the disputed domain name is not identical or deceptively similar to the Complainants' marks and its business. Accordingly, the Panel concludes that the Complainant has not satisfied the first element required by Paragraph 4 of the INDRP.

### **II. The Respondent has no rights or legitimate interests in respect of the disputed domain name**

#### **Complainant**

The second element that the Complainant needs to prove and as is required by paragraph 4(ii) of the INDRP is that the Respondent has no legitimate right or interests in the disputed domain name.

Once the Complainant makes a prima facie case showing that the Respondent does not have any rights or legitimate interest in the domain name, the evidentiary burden shifts to the Respondent to rebut the contention by providing evidence of its rights or interests in the domain name.

The Complainant asserted that it has legitimate interest in the [www.gst.in](http://www.gst.in) domain name in India, as it has been solely authorized by the government for the establishment of IT infrastructure for the roll out of Goods and Services Tax (GST).

The Complainant has asserted that the Respondent is not known by the disputed domain



name and has no trademark rights in the name. Further the Complainant has not authorized the Respondent to use its mark in any manner. Under paragraph 7 of the Policy, the registrant's rights can be found from the material on record, if (i) before notice of the dispute, the registrant had used or made demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services or (ii) the Registrant (as an individual, business organization) has been commonly known by the domain name, or (iii) The Registrant is making legitimate, non-commercial or fair use of the domain name without intent for commercial gain.

The panel agrees that Respondent is not authorized by the Complainant to use its trademark.. If this was the situation in the present case then in the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated bonafide or legitimate use of the domain name could be claimed by the Respondent. [Relevant Decisions: *Statoil ASA v. Bright, AK, D2014-1463 (WIPO October 14, 2014)* and *Swiss Eco Patent S.A. v. Verdicchio Simon, D2014-1804 (WIPO November 21, 2014)*]. However, the fact remains as discussed above; the Complainant has failed to prove any trademark rights in the word "GST"

In the present case, the Respondent did not need any authorization or license to use the abbreviation "gst" in its domain name. The Complainant has not proved that it holds any trademark rights in the abbreviation "gst" either through registration or by acquiring secondary meaning in the territory of India.

It also seems that the Respondent has not used the disputed domain name, [www.gst.in](http://www.gst.in), for commercial gain or for the purpose of disrupting the business of the Complainant. As the matter stands of now the Respondent does not seem to be carrying out any commercial activity through the disputed domain name in India.

The panel cannot agree with the contention of the Complainant that the Respondent's intentionally created the website for commercial gain and mislead the customers or cause harm to the Respondent.

#### **Respondent**

The Respondent has argued that he uses the disputed domain name as a non-commercial, for more than ten years, private family communications and email service with no confusion or complaints from any parties. The very admission of the Complainant that the website is unmapped lends credence to the Respondent's claim that the same is being used for private, non-commercial use. As further proof the Respondent has provided evidence by way of e-mail dated February 14, 2005 in his response to the complaint.

For these reasons, the Panel holds that the Complainant has not proved that the Respondent does not have any rights or legitimate interests or is infringing the mark of the Complainant in the disputed domain name.

#### **III. The disputed domain name has been registered or is being used in bad faith.**



## Complainant

It has been contended by the Complainant that the Respondent has registered the disputed domain name in bad faith. The language of the INDRP paragraph 4(iii) is clear enough, and requires that either bad faith registration or use of bad faith has to be proved.

Paragraph 6 of the INDRP provides that the following circumstances are deemed to be evidence that a Respondent has registered and used a domain name in bad faith:

*"Circumstances indicating that the Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or*

*the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or*

*by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its Website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its Website or location or of a product or service on its Website or location."*

From the circumstances of the case and from the evidences put before the Panel by the Complainant, the Panel is of the opinion that the Complainant had no previous connection with the disputed domain name and any use of the disputed domain name by the Respondent, and the use of the same would not result in confusion and deception of the trade, consumers and public, who would assume a connection or association between the Complainant and the Respondent.

On the perusal of the disputed domain name the panel found that the Respondent has not used the disputed domain name to intentionally attract internet website users to its website or the on-line location by creating a likelihood of confusion with the Complainant's marks as to source, sponsorship or affiliation or endorsement of an unmapped website [www.gst.in](http://www.gst.in). Therefore the assumption that the Respondent is deriving a financial benefit and an unfair profit from the goodwill of the Complainants brand is not proved.

The only way that bad faith could have been proved is by registering the disputed domain name with actual knowledge of the Complainant's mark. Furthermore the Respondent could have been said to have acted in bad faith is by breaching its service agreement with the registrar on the ground that the Respondent registered a domain name that infringes upon the Intellectual Property rights of another entity, which in the present scenario is the Complainant. **[Relevant Decision: Swarovski Aktiengesellschaft v. WhoisGuard, Inc. / Person, Johnny D., D2013-1450, (WIPO October 2, 2013); zingametall BVBA v. Mister Alexey Navalny INDRP/639(January 21, 2015)]**

The Respondent's registration of the domain name does not meet the bad faith elements set forth in the INDRP. Therefore the panel comes to the conclusion that the registration is not in bad faith.

### **Respondent**

The Respondent contends that during the time of ownership from 2005-present, the Respondent has used the 'gst.in' domain name solely for non-commercial, private and familial purposes, with no complaints, objections or concerns raised by any member of the public, civil society, government agencies or academic institutions.

Consequently it is established that the disputed domain name was not registered in bad faith or used in bad faith.

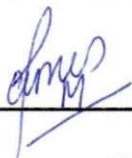
### **Decision**

The following circumstances are material to the issue in present case:

- i. There is no trademark registration of the domain name by any of the parties.
- ii. The Respondent though have registered the domain name but has not provided any evidence whatsoever of any actual or contemplated good faith use of the disputed domain name.

The domain name of the respondent is not identical and confusingly similar to trademark of Complainant. The Complainant also does not have any right or legitimate interest in the domain name. The Complainant is also not entitled to transfer of domain name to him, as he has also not established his bonafide rights in trademark as per law discussed above. Also it is pertinent to note that since there is no trademark registration related to "gst.in" therefore, no one can be stopped from registering the domain name.

Hence it is the decision of the panel that the complaint should be dismissed.



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**JAMES M.**  
**Sole Arbitrator**  
**Date: November 21, 2015**