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BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD  
INDRP CASE NO. 1125

VOLTAS LIMITED

Complainant

Versus.

HYDERABAD SERVICE ZONE

Respondent

*Harini Narayanswamy*

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KARNATAKA GOVERNMENT OF KARNATAKA

**BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA**

**ARBITRATION AWARD  
INDRP CASE NO. 1125**

**VOLTAS LIMITED**  
Voltas House "A"  
Dr. Babasaheb Ambedkar Road  
Chinchpokli, Mumbai 400033  
India

**Complainant**

**Versus.**

**HYDERABAD SERVICE ZONE**  
Hyderabad  
Telangana 500060  
India

**Respondent**

**1. The Parties**

The Complainant is Voltas Limited of Mumbai India represented in these proceedings by Ira Law of New Delhi, India. The Respondent is Hyderabad Service Zone, Hyderabad, India.

**2. The Domain name, Registrar and Policy**

The present arbitration proceeding pertains to a dispute regarding the domain name <voltasservicecentre.in> (hereinafter referred to as disputed domain name). The registrar for the disputed domain name is Godaddy.com LLC, Scottsdale, AZ United States of America. The disputed domain name was registered on March 3, 2019. The Arbitration proceedings are conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the .IN Domain Name Dispute Resolution Policy (the "INDRP Policy" or "Policy"), and the INDRP Rules of Procedure (the "Rules").

*Hanni Narayana*

### 3. Procedural History

The sole arbitrator appointed in the case is Mrs. Harini Narayanswamy. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, in compliance with the Rules. The Arbitrator received the Complaint and the electronic copy of the case documents from the .IN registry on July 16, 2019 and on July 19, 2019 the Arbitrator transmitted by email a notification of commencement of the arbitration proceedings to the Respondent under the INDRP Rules. Copies of the said notification were sent to other interested parties to the dispute.

### 3. Factual Background

The Complainant is a leading producer of home appliances such as air conditioners and refrigerators. The Complainant also manufactures products for industrial use and undertakes turn-key projects such as engineering procurement constructions (EPC), provides engineering services and electro mechanical works such as Heat Ventilation and Air-conditioning (HVAC), electrical systems for buildings, plumbing, fire-fighting, power and lighting. Its products and services are offered under its trademark VOLTAS.

The Complainant is the registered owner of the VOLTAS trademark for both word and label marks in several classes across many jurisdictions including India, Singapore, Hong Kong, Qatar, Bahrain, Kuwait, China, South Africa and Mozambique. The first trade mark registration in India for the VOLTAS mark dates back to the year 1955. Given here is an illustrative list of the Complainant's Indian trademark registrations for VOLTAS and its formative marks:

Registration Number	Trademark	Date of Application	Class	Goods and Services
169301	VOLTAS (Device mark)	31/05/ 1955	7	Turbines, electric generators engines and motors (none being for land vehicles) washing launder machines, textile

*Harini Narayanswamy*

				<p>machinery, mining machinery, rolling mills, condenser (steam), compressors, machines, spraying machines, presses machines, excavating, lifting and loading machines, concrete mixing and earth working machines, welding machines, machine tools, pumps included in class 7, machine belting, machinery aprons, spindle tapes, agricultural machines, and agricultural implements</p>
169303	VOLTAS (Device mark)	31/05/ 1955	2	Paint driers metal foils for use by painters and decorators.
169304	VOLTAS (Device mark)	31/05/ 1955	3	Perfumery, essential oils for manufacturers of perfumery and soap and non-medicated toilet preparations
169306	VOLTAS (Device mark)	31/05/ 1955	5	Pharmaceutical substances and preparations, biological food products for infants and invalids and antibiotics.
413429	VOLTAS VEELINE (Device mark)	21/11/1983	11	Installations for lighting, heating, steam generating, cooking, refrigerating ventilating, water supply and sanitary purposes.

*Havii Narayana*

4083672	VOLTAS Adjustable Inverter AC	11/02/2019	11	Room Air conditioners
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The Respondent Hyderabad Service Zone, has registered the disputed domain name on March 3, 2019. The Respondent has used the disputed domain name to set up a website that offers services such as air conditioner service, refrigerator service, microwave oven service and washing machine service. The Respondent has advertised and offered door step services in the twin cities of Hyderabad and Secunderabad.

The Respondent has placed content on the website which refers to the Complainant, for instance in one statement the Respondent has mentioned: "Voltas has its own identity in the global market". The Respondent has displayed the Complainant's trademark on the web pages to which the disputed domain name resolves and has used a similar get-up, trade style and color combination of blue and white that is used by the Complainant.

## **The Parties Contentions**

### **A. The Complainant**

The Complainant states that it was incorporated in the year 1954 and has adopted VOLTAS as its corporate name and trademark about 65 years ago. The mark was coined by combining the names of its two promoters, namely VOLKAT a swiss company and TATAS an Indian group. The Complainant contends that its trademark is an important source identifier for its business and also for its subsidiaries and affiliates.

The Complainant states it has a strong presence in turnkey projects such as engineering procurements and constructions (EPC), electro- mechanical works comprising HVAC, electrical systems for buildings, plumbing, fire-fighting, power and lighting, water management and pollution controls. It also provides engineering services in the areas of water management, pollution control, climate control, electro-mechanical, textile machinery, mining and construction building management systems.

*Hanvi Narayana*

The Complainant states it has ISO 9001-2008 standard certification in its projects businesses and has successfully undertaken and executed prestigious high value projects in Middle East, Far East and South East Asia, CIS countries, Africa and India. The Complainant states its shares are traded on Bombay Stock Exchange and its turnover was INR 6,380.28 crores in 2017-18 and INR 7,084.59 crores in 2018 -19.

The Complainant asserts that its mark is distinctive and has acquired reputation and secondary meaning due to its extensive use, advertisement and publicity and has acquired the status of a well-known mark. As evidence of the mark being well-known, the Complainant has provided a list of awards and recognitions it has received nationally and internationally, newspaper and magazine articles alluding to the goodwill and reputation associated with the VOLTAS mark. The Complainant has also filed copies of orders of the Delhi High Court, the Bombay High Court, and cases filed before the World Intellectual Property Organization (WIPO) where it was declared that the VOLTAS trademark is a well-known mark.

The Complainant has requested for the remedy of transfer of the disputed domain name on the grounds that: (i) that the disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name and (ii) The disputed domain name has been registered or is being used in bad faith by the Respondent.

#### **B. Respondent**

The Respondent did not respond.

#### **4. Discussion and Findings**

Under the INDRP Policy, the Complainant has to establish the following three elements to obtain the remedy of transfer of the disputed domain name:

- (i) The disputed domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights, and

*Hanvi Narayanan*

- (ii) The Respondent lacks rights or legitimate interests in respect of the disputed domain name; and
- (iii) The disputed domain name has been registered or is being used in bad faith.

### **Identical or Confusingly Similar**

The first element requires the Complainant to prove that the disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights.

The Complainant has established its rights in the VOLTAS mark in these proceeding by filing evidence of its trademark registrations. The Complainant has submitted, among others, evidence of trademark registration for the VOLTAS word mark and device marks, such as VOLTAS device mark bearing number 169302 in class 1, dated May 31 1955, VOLTAS device mark bearing number 169301 class 7, dated May 31 1955, VOLTAS device mark bearing number 169303 class 2, dated May 31 1955, VOLTAS device mark bearing number 169304 class 3, dated May 31 1955, VOLTAS device mark bearing number 169306 class 5, dated May 31 1955, VOLTAS VEELINE device mark bearing number 413529 class 11, dated November 21 1983 and VOLTAS BEKO device mark bearing number 3690765 class 99, dated November 30, 2017.

The disputed domain name contains the VOLTAS mark with the terms “service” and “centre”, the misspelling of the word “center”. It is well established that the addition of generic words to a trademark does not prevent a finding confusing similarity between the disputed domain name and the mark. It is clear that the dominant part of the disputed domain name is the VOLTAS trademark. The additional terms with the VOLTAS mark does little to dispel the confusing similarity with the mark. Further the Complainant has provided evidence of trademark registrations for the VOLTAS mark under class 37 services which includes “repair and installation services”. It is likely that an unwary Internet user who comes across the disputed domain name, is likely to be misled or confused that the disputed domain name is somehow connected to the Complainant. In view of these facts and circumstances, it is found that the disputed domain name is confusingly similar to the VOLTAS mark.

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Accordingly, the first element under paragraph 4 of the Policy has been established by the Complainant, that the disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights.

### **Rights and Legitimate Interests**

The second element requires the Complainant to put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The onus of proving rights or legitimate interest in the disputed domain name lies on the Respondent, but the Complainant has to put forward a *prima facie* case, to prevail under the second element.

The Complainant has argued that the Respondent has no rights or legitimate interests in the disputed domain name. Under the INDRP Policy, a respondent can demonstrate legitimate interests in the disputed domain name if there are circumstances that show (i) that before notice of the dispute, the respondent 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 respondent (as an individual, business organization) has been commonly known by the domain name, or (iii) The respondent is making legitimate, non-commercial or fair use of the domain name without intent for commercial gain.

The Respondent did not respond in these proceedings and from the evidence on record the Respondent is not known by the disputed domain name and is not an authorized reseller of the Complainant's services. Referential use of a mark by an unauthorized service provider could be a basis for legitimate use. However, there are explicit guidelines for such referential use of a mark by an unauthorized service provider or reseller. Legitimate referential use of a trademark is predicated on not misleading Internet users to obtain unjust commercial gain.<sup>1</sup>

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<sup>1</sup> See *Okidata Americas v ASD, Inc.* WIPO Case No 2001-0903 where the following cumulative requirements or guidelines were mentioned for finding legitimate use by a reseller:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder, and

*Harin Narayana*



The Respondent in the present case has not placed a disclaimer and there is no evidence to indicate that the Respondent has used or uses the mark to provide service for only the Complainant's product. However, from the content placed on the webpages, it appears that the Respondent is offering services for other home appliance brands. In particular the Respondent's website states "Voltas Service Center offers best services for Voltas Home appliance Products at customer door step...", and then states "We are highly acclaimed for our experienced and Company trained team of workers ..... they are well trained to handle popular electronic brand like LG." Under these circumstances, the Respondent's use of the mark appears to be a clear case of "bait-and-switch" rather than referential use of the VOLTAS mark. Namely, use of the Complainant's mark to bait customers and then offering services competing with the Complainant. Use of another's trademark to bait customers or to "bait-and-switch" is not considered legitimate use of the domain name under the Policy.

The Respondent furthermore, does not disclose on the website that he is not the owner of the mark but clearly uses the mark to derive mileage from the fame and goodwill associated with the mark with no authorization to use the mark. Such "bait-and switch" use to mislead and attract customers for providing competing services is typically recognized as infringing use. See *Blue Star Limited Vs. Srinivas B*, INDRP Case No. 1089 (<bluestar-service-center.in>). Under the circumstance discussed, the use of the Complainant's mark by the Respondent in the present case is to boost Internet traffic and mislead unwary customers based on the fame associated with the mark, which does not qualify as legitimate use.

Given that the Respondent has not participated in these proceedings and provided any explanation for use of the Complainant's mark and the Complainant has stated that the Respondent has no authorization to use its mark, it is found that the Complainant has successfully made a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain name. The second requirement under paragraph 4 of the Policy has been met by the Complainant.

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(iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

*Hanni Narayana*

services for other brands by the Respondent. Such use of the disputed domain name by the Respondent falls squarely under the bad faith use under the Policy. Inference of bad faith can in addition be drawn from the Respondent providing an incomplete address for the registration records of the disputed domain name and on the "Contact Us" page of the website.

In the light of all that has been discussed, the Arbitrator finds that the Respondent has registered and is using the disputed domain name in bad faith. Accordingly, it is found that the Complainant has established the third element under paragraph 4 of the Policy.

### **Decision**

It is ordered that the disputed domain name <voltasservicecenter.in> be transferred to the Complainant.



**Harini Narayanswamy**

**Arbitrator**

**Date: September 11, 2019**