



दिल्ली DELHI

G 247926

**VISHESHWAR SHRIVASTAV
SOLE ARBITRATOR
IN**

**ARBITRATION PROCEEDINGS OF DOMAIN NAME
"macmillan.in"**

A W A R D

IN RE :-

H.M. PUBLISHERS HOLDINGS LIMITED, (formerly known as Macmillan Limited), a company incorporated under the laws of United Kingdom and having its registered office at: Brunei Road, Houndmills, Basingstoke, Hampshire, RG 6XS, London, UK

Complainant No. 1

MACMILLAN INDIA LIMITED, a company incorporated under the Companies Act, 1956 having its registered office at: 21 Patullos Road, Chennai 600002 and its Delhi office at: 2/10, Ansari Road, Daryaganj, New Delhi - 110 002

Complainant No. 2

AND

Digitech Software Solutions, SCO 839, NAC, Mani Majra, Chandigarh-160101

Respondent No. 1

Macmillan Insulations India Pvt. Ltd., a company incorporated under the Companies Act, 1956 having its office at SCO No. 90 (2nd Floor), Swastik Vihar, Panchkula - 134 109, Haryana

Respondent No. 2

The Gist of Complaint:

It is the submission of the Complainants that Complainant No. 1 is one of the largest and best known international publishers in the world and is the worldwide proprietor of the trade name and Trade Mark '**MACMILLAN**' and uses the same in relation to academic publishing, publication of scientific, technical and medical journals and reference material, publication of fiction and non-fiction for adults and children, English Language Teaching and general curriculum learning materials for international markets, publishing services like book and journal order fulfilment, warehousing and distribution, information technology enabled services (ITES) like-typesetting and data capture, printing and electronic production, web development and information processing. It is further submitted that Complainant No. 1 operates in over seventy countries on its own and through subsidiary companies. It is stated that Complainant No. 2 is the Indian subsidiary of Complainant No. 1 and is licensed and authorized by Complainant No. 1 to use the '**MACMILLAN**' Trade Mark and trade name. It is submitted that



each Complainant has sufficient common interest in the domain name in question before the present proceedings.

Respondent No. 1 has been made a party to this arbitration proceeding since it is shown as the registrant of the domain macmillan.in in the WHOIS database of .IN Registry.

The Respondent No. 2 has been made a party to this arbitration proceeding since it is running a web site under the domain name macmillan.in. When accessed, the said web site discloses the particulars of Respondent No. 2.

Further, an earlier search of the WHOIS database of .IN Registry showed Respondent No. 2 as the registrant of the domain macmillan.in. The allegation of the complainants are that the two Respondents are acting in concert as revealed by the interchanging of registrant details at the .IN Registry.

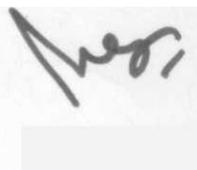
As per the WHOIS database of .IN Registry, the registrar with which the domain name is registered is:

Name: Directi Internet Solutions Pvt. Ltd. d/b/a PublicDomainRegistry.com (R5-AFIN)

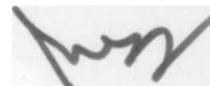
E-mail: http://support.publicdomainregistry.com

CONTENTIONS OF THE COMPLAINANTS:

1. It is the assertion of the complainants that the trade mark **MACMILLAN** is duly registered with the Registrar of Trade Marks, India in class 16 for the category of goods: books and publication, printed matter, periodicals, photographs, transparencies, instructional and teaching materials.. The Registrar of Trade Marks, India has also granted registration, apart from **MACMILLAN**, to the trade marks **emacmillan** (classes 9 and 16), and imacmillan.org (class 9).

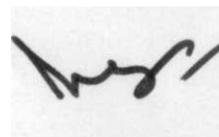


2. Outside India, registrations for the **MACMILLAN** trade mark have been obtained in a large number of countries.
3. The Complainants have also obtained registrations for a large number of domain names incorporating the word **MACMILLAN** or its derivatives.
4. That **MACMILLAN** is not merely a trade mark but is also used as trading/corporate name by a large number of companies owned/controlled by Complainant No. 1. The MACMILLAN group comprises as many as 175 companies all over the world a large number of which use the trade mark MACMILLAN.
5. That complainants have the statutory rights acquired through registration of the Trade Mark **MACMILLAN** and related trade marks in India and other countries, Besides the Complainants also possesses common law rights over the trade mark **MACMILLAN**. These rights have been acquired as a result of uninterrupted use of the said trade mark since 1843.
6. It is submitted that Complainant no 1 was founded in 1843 by Daniel and Alexander Macmillan and ever since then Complainant No. 1 is one of the largest and best known international publishers in the world and has the worldwide proprietorship of the trade mark **MACMILLAN** which it has been using uninterruptedly since then, both as trading name and as trade mark for marketing its goods and services. The Complainant No. 1 and its various group companies including the Complainant No. 2 use the trade mark **MACMILLAN** in relation to academic publishing, publication of scientific, technical and medical journals and reference material, publication of fiction and non-fiction for adults and children, English Language Teaching and general curriculum learning materials for international markets, publishing services like book and journal order



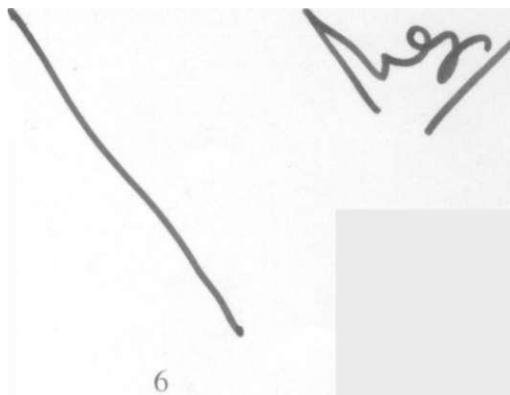
fulfilment, warehousing and distribution, IT enabled services (ITES) like typesetting and data capture, printing and electronic production, web development and information processing, etc.

7. It is contended that the Complainants have been operating in India since 1892. Complainant No. 2 became a corporate entity in 1970. It is amongst the oldest publishing companies in the country and has provided high-quality educational books to generations of Indians. It is now one of the only two publicly listed publishing companies in India. It also has the highest market capitalisation of any publishing house in India. Its turnover was Rs 1,260 million (US\$ 28.64 million) in 2004 and profit after tax Rs 340 million (US\$ 7.73 million). As one of India's foremost publishers, the Complainant No. 2 has to its credit over 2,500 titles in print. Besides this, around 200 new titles are added every year. The Complainant No. 2 Company has always been conscious of its responsibilities in adhering to quality, ensuring ready availability of books and providing excellent customer service. The Complainant No. 2 has a widespread network comprising twenty-two showrooms and branches across major cities in India and sales offices in London and New York. It was chosen by UNICEF to publish books for their project on empowering women. Under the said project entitled "Meena", the Complainant publishes storybooks in all leading Indian languages on awareness-creating themes to empower the disadvantaged girl child. Over the years, books published by the Complainant Company have been winning awards for excellence in publishing. The .complainants no 2 has set up an exclusive typesetting unit in 1976 and an Information Processing Division, a 100% EOU in 2000. The said division is considered to be among the worldwide market leaders in typesetting and data digitisation services for overseas publishers. Recognising the potential the internet offers for online learning, Complainant No. 2 established an e-business division called "e-macmillan" in 2001. The said division has already demonstrated great success at



developing and managing educational portals and providing web solutions and services to overseas customers. Thus, today the activities of Complainant No. 2 are not limited to publishing but also cover other fields like IT, ITES, e-learning, publishing services, educational services, etc. It is noteworthy that all these diverse activities are carried under the **MACMILLAN** trade mark.

8. The complainants by producing and publishing the world's best books for over 150 years and by ensuring the same standard of quality and reliability in their other products and services, the Complainants have painstakingly built for themselves and for the **MACMILLAN** trade mark, an enviable reputation for quality and trust. Besides, the Complainants incur considerable expenditure on advertising and promoting their products and services under the trade mark **MACMILLAN**. As a result, the **MACMILLAN** trade mark has become a household name that enjoys exceptional goodwill, highest customer loyalty and unsurpassed brand equity and high brand recognition, retention and recall..
9. It is stated that the **MACMILLAN** trade mark is exclusively identified by the general public with the products and services produced and marketed by the Complainants. The goodwill enjoyed the **MACMILLAN** trade mark transcends product and service classification and therefore, any unauthorised use of the **MACMILLAN** trade mark is bound to create confusion among customers and the general public even if the trade mark is used in a, trade or business activity **unrelated to the trade and business activities of the Complainants**.

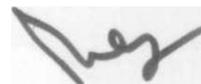


10. This Complainants have raised the following grounds in support of their complaint:

A. The domain name in question is identical and/or confusingly similar to a trademark or service mark in which the Complainants have rights;

This complaint is based on the INDRP Rules, para 3(b)(vi)(1) and it is alleged that trade mark **MACMILLAN** which has been owned and used by the Complainants uninterruptedly since 1843. The proprietary rights and interest of the Complainants in the trade mark **MACMILLAN** have been elaborated in the various documents supplied along with the complaint. It is submitted that the domain name involved in the instant case is **macmillan.in** which, but for the addition of the necessary suffix ".in", is identical to the trade mark **MACMILLAN**. The suffix ".in" is necessary for India-specific top level domains on the Internet and is not to be taken into consideration while comparing the domain name with the Complainant's trade mark. The similarity between the domain name in question i.e. "**macmillan.in**" and the trade mark of the Complainants i.e. **MACMILLAN** is plain and obvious and does not require further elaboration.

It is submitted that the Complainants' trade mark **MACMILLAN** is not an ordinary trade mark and has been used uninterruptedly since 1843. It is a well-known trade mark within the meaning of Section 2 (1) (zg) of the Trade Marks Act, 1999 and is entitled to be treated differently from ordinary trade marks. It is a trade mark that enjoys great popularity among the general public which associates it solely with the Complainants. The goodwill enjoyed the **MACMILLAN** trade mark transcends product and service classification and therefore, any unauthorised use of the **MACMILLAN** trade mark is bound to create confusion among customers and the general public even if the trade mark is used in a trade or business activity unrelated to the trade and business activities of the Complainants. If the domain registration is allowed to be continued, the public at



large is likely to be deceived and misled into believing that Respondent No.2 or its products/services are associated with or endorsed by the Complainants in some way. The Complainants' trade mark is also likely to suffer loss of goodwill and debasement of brand equity when the public realizes that an exclusive trade mark like **MACMILLAN** which the public associates with activities like education, literature, academics, IT, ITES, e-learning, software, etc. is actually being used for activities of the type that the Respondent No. 2 is dealing in.

B. The Respondents have no rights or legitimate interests in respect of the domain name:

It is submitted that though the WHOIS record of the .IN Registry shows the Respondent No. 1 as the registered owner of the domain name macmillan.in, the Respondent No. 1 is neither known by the name **MACMILLAN** nor carries on any business or trade under that trade mark. Copies of printouts of a few pages from the web site of Respondent No. 1 i.e. www.digitechsoft.com annexed to this Complaint prove this. Respondent No 1 has no rights or legitimate interest in respect of the domain name **macmillan.in** which is identical to and based on the trade mark **MACMILLAN**. Besides when the web site www.macmillan.in is accessed, no particulars of Respondent No. 1 are displayed or available. The web site only shows particulars of Respondent No. 2. Hence, the Respondents are also guilty of providing the .IN Registry with false particulars of registration and ownership. As far as Respondent No. 2 is concerned, it is submitted that the Respondent No. 2 company was incorporated under the name Macmillan Insulations India Pvt. Ltd. without disclosing the true and correct facts to the concerned Registrar of Companies about the ownership of the trade name and trade mark **MACMILLAN**. The Respondent No. 2 company was incorporated under the name Macmillan Insulations India Pvt. Ltd. fraudulently and unlawfully. The Complainants are taking appropriate action under law to seek rectification of the name of Respondent No 2 company and have already brought the matter to the notice of the Department of Company Affairs.



There are historical and factual reasons behind Complainants' use of the **MACMILLAN** trade mark as the business of the Complainants was founded in 1843 by two brothers named Daniel Macmillan and Alexander Macmillan. Ever since then, the surname **MACMILLAN** has served as the business name and trade mark of the Complainants. On the other hand, the Respondent No. 2 has commenced business only recently. None of its products is named **MACMILLAN** as evidenced by the product information available on its web site. To the best of Complainants' knowledge, none of the promoters or directors of the Respondent No. 2 company are named **MACMILLAN**. Hence, neither Respondent No 1 nor Respondent No. 2 has rights or legitimate interest over the trade mark **MACMILLAN** and over the domain name **macmillan.in**.

During April-May, 2007, the Complainant No. 2 had exchanged some e-mails with Respondent No. 2 regarding transfer of the domain name **macmillan.in** to Complainant No. 2. In the course of the exchange, it was admitted by Respondent No. 2 that the Complainants had been using the **MACMILLAN** trade mark since a long time when Respondent No. 2 was nowhere in the picture. This confession by the Respondent No. 2 proves beyond reasonable doubt that the Respondents have no rights or legitimate interest in respect of the domain name **macmillan.in**. Further the complainants rely upon INDRP Rules, para 3(b)(vi)(2).

C. The domain name was registered and is being used in bad faith.

It is submitted that the domain name **macmillan.in** was registered and is being used by the Respondents in bad faith as The Complainants' registration of the **MACMILLAN** trade mark with the Registrar of Trade Marks India dates back to 9 August, 2000. Their actual user of the **MACMILLAN** trade mark goes back to 1843. The **MACMILLAN** trade mark has been used by the Complainants uninterruptedly for over 150 years and has become an extremely popular and



well-known trade mark that everyone recognizes instantly and that everyone associates solely with the Complainants. Even a cursory search about the word **MACMILLAN** over the Internet is sufficient to reveal that the trade mark **MACMILLAN** belongs to the Complainants and is being used by them in a diverse range of activities since long. The Respondents are guilty of committing breach of duty to search and verify the status of **MACMILLAN** trade mark. Proper search and verification of facts regarding the **MACMILLAN** trade mark would have revealed the correct facts to the Respondents. Instead, the Respondents deliberately chose the word **MACMILLAN** for the domain name with the *malafide* intent of deriving undue profits from the goodwill and mass popularity enjoyed by the trade mark **MACMILLAN** as a result of Complainants' relentless efforts of over 150 Years.

It is stated that the Respondent No. 2 was incorporated under the name Macmillan Insulations India Pvt. Ltd. fraudulently and unlawfully, it is submitted that the Respondent No. 2 cannot claim any rights over the domain **macmillan.in** even on the basis that a company has been registered with the Registrar of Companies under the name Macmillan Insulations India Pvt. Ltd. At best, the Respondent No. 2 could have sought registration of domain names like **macmillaninsulations.in** or **macmillan_insulations.in**. etc. It is pertinent to point out that the corporate name of Complainant No. 2 is Macmillan India Ltd. Unlike the corporate name of Respondent No. 2, Complainant No. 1's corporate name is not industry specific nor descriptive of a particular category of goods or services. The fact is that **macmillan.in** has been registered instead of a name like **macmillaninsulations.in** or **macmillan_insulations.in** clearly proves the bad faith registration and user by the Respondents.

It is submitted that the conduct of the Respondent No. 2 suggests that the domain name **macmillan.in** was registered for selling the registration to the Complainants for valuable consideration in excess of the Respondents' documented out-of-pocket expenses directly related to the domain name. It is



pertinent to refer to the various e-mail communications that the Respondent No. 2 readily had with the Complainant No. 2 regarding transferring the domain name to the Complainant No.2. The communications at once suggest that the Respondents wanted to mint money by selling the domain to the Complainants. When the Complainants suggested a modest but reasonable figure of Rs. 20,000/- (Rupees Twenty Thousand only) as consideration for transferring the domain to Complainant No.2, the Respondent No. 2 backed out and termed the figure quoted by Complainant No. 2 as "embarrassing". This clearly proves bad faith registration and use of the domain name.

The web sites of the Complainants are quite popular and attract a lot of traffic from visitors. The Complainants also run various online educational programmes which contributes to traffic on their web site. Therefore, the Respondents have chosen the domain **macmillan.in** with a view to attracting Internet users to their web site by creating a likelihood of confusion with the Complainants' web sites and the trade mark **MACMILLAN** which is an extremely popular and well-known trade mark. Not every Internet user wanting to access the web sites of the Complainants would know the exact address of the Complainants' web sites. Such users are likely to be deceived by the domain name **macmillan.in** which has been chosen and registered after a lot of thought precisely for this purpose.

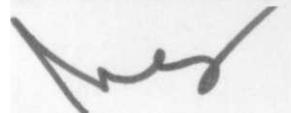
It is submitted that when the Respondent No. 2 came of know about the application filed by Complainant No. 2 under Section 22 of the Companies Act, 1956 before the Department of Company Affairs seeking rectification of company name of Respondent No.2, the registration particulars of the domain **macmillan.in** were deliberately changed in order to create confusion regarding the actual ownership. Whereas on 8 March, 2007, the WHOIS record of .IN Registry showed the Respondent No. 2 as the registrant of the domain name, recent search of the WHOIS record of .IN Registry shows the registrant as Respondent No. 1. It is quite obvious that the two respondents are acting in concert to prevent the Complainants from using the domain name **macmillan.in**.



The Respondents are guilty of submitting false registration particulars to .IN Registry. Therefore, the domain name macmillan.in should be considered as having been registered and used in bad faith by the Respondents. INRDP Rules, para 3(b)(vi)(2).

CONTENTIONS OF RESPONDENT NO. 2:

- A. It is submitted by the Respondents in their Statement of Defence that the Company "Macmillan Insulations India Pvt. Ltd" was incorporated in the year 2005 under the Indian Companies Act, 1956 and the Company is in the business of purchase and sale of insulation material and installation of any work related thereto.
- B. That the name "Macmillan" used as the Company name was inspired from the name of the legendary cricketer of SouthAfrica.
- C. That the domain name Macmillan.in was got registered by the respondent on 30th March 2006. The website of the respondent provides extensive information about the services rendered by the respondent.
- D. That the bare perusal of the respondent's website would show that the respondent is in the business of Insulations, the raw material for which is imported from Tasman, New Zealand, which is a 100% wholly owned company of Fletcher Building Ltd. Australia. That perusal of the complainant's website would reveal to the user the business the complainants, i.e. publishing. The website itself shows that the field of both the parties are different and therefore the classes of consumers are entirely different and distinct.
- E. That they obtained the present registration of domain name formulated policy for registration and administration of .IN domain names. The policy



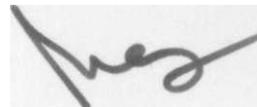
was to take effect from 1st January 2005 and as per the said sunrise policy of the registry, the owners of the registered trademarks or service marks who desire to protect their marks were given an opportunity to apply for .IN domain names before it was open for the general over entities from abroad. The interested owners were to submit applications for registration of .IN domain name beginning from 1st January till 21st January 2005.

- F.** That since the complaint did not apply for the .IN domain within the period specified under the Sunrise Policy, the said domain name was open to the general public thereafter.
- G.** That as aforementioned the respondent and complainant are in business which is totally unrelated to each others business. The website of both the complainant and respondent is being used for promotional activity and not used as online platform for selling the insulation material by the respondent. Thus both the complainant and respondent are in B2B and not in B2C model of business. Both the complainant and respondent users/consumers are different therefore the .IN domain name will not result in causing confusion and or deception to the users/consumers who may subscribe to the services of either complainant or respondent. No user/consumer will assume that the services provided by the respondent is in any case sponsored, affiliated or endorsed by the complainant as the nature and class of users/consumers of complainant and respondent are very different. The user/consumers of the complainant would go to their website to find books as they are primarily in the business of publishing whereas the users/consumers of the respondent will access their website only when they need to insulate the roof of their factory, office, house etc.
- H.** That nature of businesses of both complainant and respondent is so different from each others that the possibility of any user/consumer of being misled is very remote. The complaint in their complaint have not



where highlighted that their existing or prospective users/consumers have been misled by the contents of respondent's website nor have they mentioned as to how much business loss has already happened to complainant or any likelihood of such loss due to diversion of users traffic on the respondent's website.

- I. That whenever a search is conducted on the search engine "Google", for the term "Macmillan" the result shows the URL of the complainant. The URL of the respondent is shown when the search is specifically done for "Macmillan".
- J. That the respondent is neither adhering to search engine optimization techniques to improve the traffic and volume of the users/consumers to its website nor the links are providing on any website for linking directly to the respondent's website. As aforesaid the respondent is using the website only for promotional activity for the users/consumers who would be interested in getting their roofs insulated. It cannot be a case of the complainant that users/consumers who are getting their roofs insulated would in all probability be reading books published by Macmillan and vice versa.
- K. That the respondent is catering to the requirements of users/consumers who are industrial houses, where it's difficult to work because of summers as the sun's heat create uncomfortable temperature inside the building. By installing the flamestop under the roof, the inside environment becomes comfortable in summers as well as in winters, therefore the insulation is a necessity.
- L. That the respondent has been using the domain from the date of registration of the domain name and it was never in passive condition. The

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respondent's website has an active content and had legitimate business interest in registering the domain in the .IN registry.

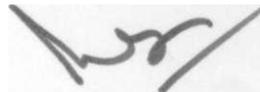
- M.** That the respondent as afore mentioned acquired the .IN domain name to promote its insulation business and did not acquire the domain name with either the malafide intention of reselling, renting or transferring the domain name to the competitor of the complainant of the complainant itself for a valuable consideration or to seek usurp the goodwill attached to the complainant's services of publishing selling of books to derive monetary gains as the respondent is in the business of selling and installation of insulated material.

- N.** That respondent registered the .IN domain name in good faith and is a bonafide user of the domain name. The domain name was not acquired to mislead, divert consumers and or for tarnishing the complainant's reputation amongst its users/consumers.

- O.** That the respondent has invested an enormous amount of money in its promotional activities.

- P.** That the complainant has no where explained in its complaint as to how much monetary loss the registration of .IN domain name by the respondent is causing the complainant and how is it injuring the complainant's reputation and business goodwill relating to selling and publishing of books.

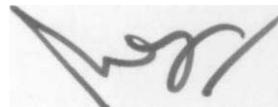
- Q.** That the respondent No. 2 had approached Digitech Software Solutions respondent No. 1 for registering the domain name and developing of their website. On their behalf respondent No. 1 got registered the domain name and maintains the website Macmillan.in. The domain shows as registrant as Digitech Software Solutions, is due to an human error while transferring



it from one reseller panel to other. The domain is currently registered in respondent No. 2's name, as is updated by respondent No. 1 as soon as the mistake was discovered.

CONTENTIONS OF RESPONDENT NO. 1

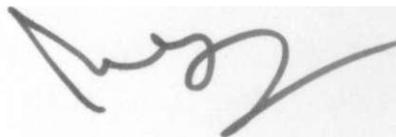
- A.** In their affidavit the Respondent no 2 have stated that they i.e. Digitech Software Solutions is in the business of development and designing of website since a decade. Apart form developing websites for clients the they also register domain name for its clients, thus providing full services to its clients for successful operation and maintenance of the website.
- B.** That the respondent No. 2 had approached them for developing of their website. The deponent got registered the domain name "Macmillan.in" for them.
- C.** That subsequently invoice was raised by them for the services provided to the respondent No. 2.
- D.** That the domain name was registered as "Mamillan.in" by them as the domain name was available with the .IN registry at the time of applying of the said domain name.
- E.** That the domain shows as registrant as deponent's Company Digitech Software Solutions, is due to an human error while transferring it from one reseller panel to other. The domain is currently showing registrant information due to mass transfer of domains from one reseller panel to another in deponent's name, but due to domain lock put by registrar cannot be updated as soon as the mistake was discovered by the Department.

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ORAL ARGUMENTS on 18th December 2008

The arguments were advanced by Shri Mahendra Singh the Ld. Counsel for the complainants, gist of which are as follows:

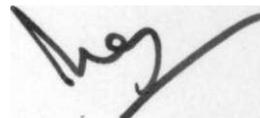
That the present **MACMILLAN** establishment was founded in the year 1843 and was a family business of the **MACMILLAN** family. He drew the attention of this Tribunal to EX-CW 1/14 colly in support of his contention and stated that later on the business was registered as a **Limited Company** under the Companies Act as **MACMILLAN & Company Ltd** in the year 1896 and he has relied upon EX-CW 1/12 and he further stated that in year 1963 the name was changed to **MACMILLAN (Holding) Ltd**. Mr. Singh stated that Macmillan Company of India (P) Ltd was registered under the Indian Companies Act in the year 1970. It is stated that they have been in business in India since the advent of the British. Mr. Singh relied upon a list of the Trade Marks registered in various countries under the name of **MACMILLAN** which is given EX-CW 1/9 colly which is followed by another list of various companies of his clients. Mr. Singh also brought the attention of this Tribunal to EX-CW 1/10 wherein he stated that they have got various domains registered in the name of **MACMILLAN** and also gave a list of companies given in EX-CW 1/11. Mr. Singh stressed that the presence of **MACMILLAN & their Company** is in the entire globe. He also pointed out that Trade Mark given to complainant has been given at page 23/24 of affidavit which is EX-CW 1/8 colly and the application given at page 24 of affidavit says that **"Period of user: since 1898"**.



Mr. Singh also stated that page 120 to 125 i.e. EX-CW 1/15 colly depict various awards received by complainants in the recent years and thereafter he drew the attention of this Tribunal to EX-CW 1/17 which he stated that it is an extract derived from the account books of his clients which shows the expenditure on sales promotion of the complainants. Mr. Singh also pointed out by drawing the attention of this Tribunal to EX-CW 1/18 Colly stating that they have moved an application under section 22(1)(ii) of the Companies Act 1956 wherein they are challenging the allotment of name **MACMILLAN INSULATION INDIA (P) LTD** to the respondent before the Regional Director Department of Company Affairs. In the end that Mr. Singh thereafter drew the attention of this Tribunal to EX-CW 1/9 i.e. to pages 146 to 150 and stated that the same should be read in the reverse i.e. from page 150 to 146. Mr. Singh argued that even the respondent have tacitly stated that complainants are in greater need of the domain name **MACMILLAN** than the respondents and he stated that Respondent wanted a price for giving the domain name to them. He submitted that his clients were ready to pay for the expenses incurred by the Respondents for getting the domain name registered. He stated that the Respondents have registered the domain name which is akin to their trade name and mark and are trying to confuse the minds of public showing that they are a part of his clients operations.

ORAL ARGUMENTS on 5th January 2009

On the aforesaid date i.e. Ms Geeta Gulati Ld. Counsel for the Respondents advanced her arguments in support of her contentions given as outlined in her statement of defense and stated that Mr. A.K. Sharma started his firm **Macmillan**

A handwritten signature in black ink, appearing to be 'A.K. Sharma', written over a light-colored background.

Insulation India in year 1992 which is and at that time **MACMILLAN** did not have any Trade Mark registered in India. She drew the attention of the Tribunal towards the various returns and other statements starting from R-1 which she stated that the evidence that the firm was doing business since 1992. She has stated that exhibit R-3 is the printout of the website which is not a portal but a simple page and it shows the various products and services which are given thereto and she relied upon a letter from M/s Rallies India dated 4th of October 1995 and orders from various companies and also relied upon the Income Tax Returns which is dated 1996 and the Balance Sheet of the year 1998 she also stated that the complainant's business differs materially and substantially from the business of the respondent and the respondent website is the mere page. She stated that in a Google search one does not come to the website of her clients but one gets to the website of the complainants. Moreover there is no link or any hyperlink of getting customers. She stated that the respondent are not using the present website in bad faith and she stressed that only if one type **MACMILLAN ".in"** a person can come to her website. As for respondent no.-1 she stated that they are mere Service providers / Resellers and are not Registrants any of the domain **MACMILLAN.IN**.

She has stated that complainants cannot sustain any loss of business in their business ventures due to the presence of the domain of Respondent. She drew the attention of this Tribunal to it customers list provided by her of clients given

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as EX R- 7 and stated that even the clients of the respondents differ materially from that of the complainants.

She has stated that her clients Mr. A.K. Sharma, when he started his business in the year 1992 was impressed by the legendary South African Cricketer Brian McMillan and so he named his business with the name of **MACMILLAN**.

Ms Gulati drew the attention to the advertising expenses given as R-8 and stated that her client is earnestly doing his business and therefore he cannot be labelled as cyber squatter who has created the domain name to derive any monetary benefit. She has stated that the E-mail referred to by Mr. Singh the Ld. Counsel for the complainants will show that actual dialogue was initiated by the complainants and none of the E-mails have been replied to by Mr. A.K. Sharma.

ORAL ARGUMENTS on 10th January 2009

In the 3rd sitting Ld. Counsel Mr. Rahul Beruar represented the complainants as Mr. Mahendra Singh's retainership with the complainants had come to a close. Mr. Rahul Beruar the Ld. Counsel for the complainants at the outset stated that the site has been registered in bad faith as in case the respondent were honest than this ought to have registered the domain name as "Macmillan Insulations" which is their main line of business whereas the domain name is registered as "**MACMILLAN.IN**". The respondents are in clear knowledge of the existence of the complainants and have purposefully taken the domain name which is identical. That he is stated that the contention of the respondent regarding Brian **McMillan** the legendary cricketer the name is spelt as **McMillan** and the



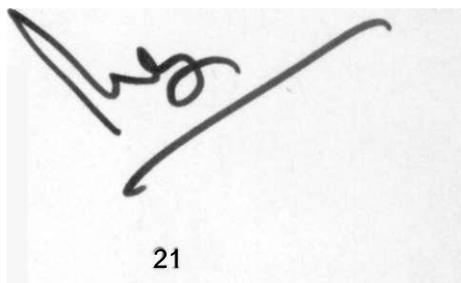
respondent have registered their name by their company and their website and their domain name as **MACMILLAN** he also stated that respondent have not got any Trade Mark or have applied for any Trade Mark. It shows that the name **MACMILLAN** is not precious or dear to them.

The Ld. Counsel for the complainant stated that they have a right in a trade name/mark even if they got a Trade Mark registered in the year 2000 besides they have common law rights and can prevent anyone from using their Trade Mark. He drew the attention of the Tribunal to section 22 of the Trade Mark Act, 1999 and stated that the respondent cannot take shelter *qua non* registration of the Trade Mark by the complainants till the year 2000.

He stated if someone wants to see that complainant no.2 i.e. MacMillan India he will use "in" for India and will come to the website of the respondent.

He alleged that the registration of Domain name by Respondents is clearly a case of "Passing off"

Mr. Beruar also stated that the respondent contention with regards to their naming their business on the name of the Cricketer Brian **McMillan** even if taken on its face value one can get on website registered by using the word '**McMillan**' like one of their competitors M/s McGraw Hill have got a domain registered in their name however the respondent have used **MACMILLAN** purposefully and in bad faith.



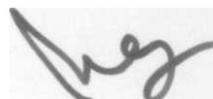
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Mr. Singh also stated that in case someone wants to visit the website of the complainants of India 'in' case be types in for India he will get to the website of the Respondent No. 2 and will get the impression that Respondent No. 2 is a part of the complainants group and that **MACMILLAN** Group has diversified in insulations services as well.

He drew the attention of this Tribunal to the e-mails given as Ex 1/19 and particularly to page-149 which says that the e-mail is from "GM India Operations" and hastened to add that the respondent do not have any over sea operation and by use of such designations the respondent are trying to give themselves an image as if they are a Multinational Organization affiliated to the **MACMILLAN** Group. The counsel also stated that as per the goods traded by the Respondent No. 2 as given at R-3 and R-7 none carry the name **MACMILLAN**.

Miss Geeta Gulati interjected stated that the respondent are trading in the goods manufactured by M/s Tasman, New Zealand having the name 'Harvey Foil/Flamestop'

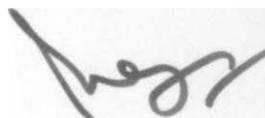
The Ld. Counsel for complainants drew attention to R-3 and stated that Respondent No.-2 are using the e-mail id macmillaninsulations@gmail.com and whereas they are using the domain name and website title "www.macmillan.in". It means the respondents are consciously using the trade name and Trade Mark of the complainants in bad faith. The Ld. Counsel of the complainants also stated that they entered into a dialogue for the transfer of the said domain name in order to avoid litigation. The counsel for the complainants also stated that respondent has registered the domain name in order to prevent



the complainant from protecting their Trade Mark in the form of their domain name **MACMILLAN**.

To the contention and the argument advanced by Ms Geeta Gulati Ld. Counsel for the respondent stressing that the their website is only a page and not a portal for this the Ld. Counsel of complainants rejoined and stated that website can be converted into a portal within 2 hours. The Ld. Counsel also stated that such a domain name undermines the efficacy of the complainants registered Trade Mark which they are having in India since 2000 and when the Respondents' website was put into effect in the year 2006. He reiterated that complainant has a statutory as well as common law rights due to continuous use of the Trade Mark since 1898 in India as per EXCW 1/8 colly. Ms Geeta Gulati stated that in her 'sur' rejoining that they have not published the website in bad faith and they are regular users of the said name **MACMILLAN** since 1992 and it is not a case that their company **MACMILLAN INSULATION INDIA PVT. LTD.** is the only company which is registered under name of **MACMILLAN** to buttress her contentions she drew the attention of the Tribunal Ex R-17 which is their reply to the complaint of the complainants before the Regional Director Department the Company Affairs Govt, of India u/s 22 of the Companies Act. Mr. Rahul Beruar thanked Ms Gulati for having got this fact to their notice as they would be shortly draw up action under the relevant provision of the Indian Companies Act.

This Tribunal notes that Ms Geeta Gulati also pointed out that the complainants did not take the advantage of Sunrise Policy (Ex R-4) brought out for protection of the people with the Trade Mark and hence not having done so they cannot



state that her Registration is in bad faith. Ms Gulati placed decisions of WIPO Arbitration and Mediation Center in the case of -

ITI Manufacturing Enterprises Inc., ITI Corporation v. Douglas Nicoll, Differential Pressure Instrument, Inc.

2007 (35) PTC 971 (WIPO) Sanofi- Aventis, Aventis Inc v. Searchology, Domain Registered

2008 (37) PTC 624 (WIPO) Viking Range Corporation v. Domain By Proxy

2006 (33) PTC 597 (NIXI) Sony Ericsson Mobile Communications AB V. Chen Shenglu

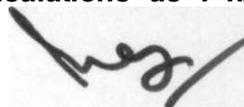
This Tribunal too relies upon a recent judgment of the Hon'ble Delhi High Court reported at 156 (2009) DLT 83.

DECISION OF THIS ARBITRAL TRIBUNAL

1. The complainants have established that this are leading publication house and part of a large group which has presence in many countries and have got the Trade Mark **MACMILLAN** Registered in various countries including India and have domain names registered world wide. This fact is also conceded to by Respondent No. 2 in their email reference CW 1/19 page-147 of complainants affidavit wherein the respondent have stated the following.

"E-mail dated 12, May 2007 which sent by Mr. Chandar M. Thakur.

"I personally feel that Macmillan as publishing Company need the said domain more than Macmillan Insulations as I know when I was



studying I was reading books published by Macmillan where as I think our Macmillan was no where in the picture. With the same concept I would try to convince my CEO".

2. The genuineness of the said documents is not in dispute even though the respondent have not been able to show their link to word **MACMILLAN** and even if the contention of the Respondent's Counsel is taken on the face value that Mr. A.K. Sharma the CEO of her clients who had started the business of "**MACMILLAN INSULATIONS**" had named his business after Brian **McMillan** the legendary cricketer, he ought to have used **McMillan** as a name of his business. Even otherwise this Tribunal feels that this contention is too spacious and farfetched to be accepted.

3. That the company of the respondent is in the business of providing insulation services and for the purpose they have got the company registered under the Companies Act as **MACMILLAN INSULATION INDIA PVT. LTD.** hence in all probabilities they ought to have got the domain name registered as **McMillan Insulations** as one of their E-mail ID as Ex R-3 depicts. Moreover their contention that the respondents are only in insulation business and riot in a business akin to that of complainants does not hold much ground as the as a main purpose of referring a dispute to *fora* is for finally adjudication of a controversy and the adjudicating body ought to make sincere efforts to end a controversy



finally. It is emphatically pointed out by the Ld. Counsel for the respondents Ms Gulati that her clients business is growing and they are investing in publicity and promotion and company name however there is neither any binding or a guarantee that they will not enter into of the businesses of the complainants and same is the case as vice versa as the word of business is the world of opportunities and the both complainants and the respondents are 'entrepreneurs' and it is not known in future which way they decide to turn. Hence even if this Tribunal wishes away the possibility of each of the parties entering into others business in the uncertain future the present controversy can again raise its head and legal battles may ensue. There is no doubt that the domain name of the Respondents name is not only similar but confusingly similar to the name of the complainants and Trade Mark. This Tribunal is does not agree with the arguments of the Ld. Counsel for the respondent which states that the respondents started their business in 1992 and at that time there was no Trade Mark of the complainants. In the light of fact that the complainants have indubitably displayed that they are in the business 150 years and are using the name **MACMILLAN** for more than a century their claim to the domain name, in question gets further strengthened. The respondents on the other hand not been able to show their any direct link with name **MACMILLAN** qua their director(s), Principals or Associates or any family surname by the name 'Macmillan'.

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4. As a hypothetical argument for example it is known that Amitabh Bachchan is a renowned actor, however, in someone other than him or duly authorized / licensed by him hosts a website under the name **www.amitabhbachchan.in** and starts business of say selling ice creams or potato wafers, the public at large is bound to get attracted and they will in all probability assume and even carry a confusion in their minds that the actor Amitabh Bachchan is behind the same.

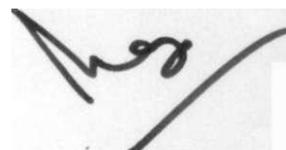


5. As aforesaid this Tribunal relies upon a recent judgment of the Hon'ble Delhi High Court reported at 156 (2009) DLT 83 in support of its conclusions.



6. This Tribunal refrains from making any comments on the petition/application filed by the complainants under section 22 of the Companies Act which is pending before the Regional Director, Department of Companies Affairs and is being adjudicated upon by said authority and nothing in this award shall prejudice the rights and contention of the respondent and the complainants in the said legal battle.

7. So far as the dispute pending before this Tribunal is concerned the domain name '**www.macmillan.in**' is undoubtedly confusingly similar to the trade name and Trade Mark of the complainants and their company

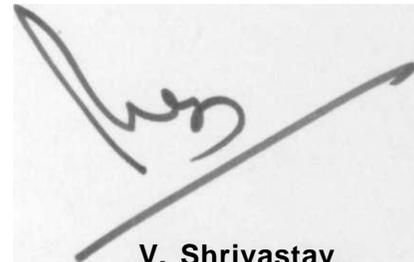


and hence this Tribunal directs that the said domain name be registered in favour of the complainants without any further delay.

8. This Tribunal expresses its sincere gratitude for the cooperation extended by the counsels for the parties i.e. Ms Geeta Gulati Ld. Counsel for the Respondents, Mr. Rahul Beruar Ld. Counsel of the Complainants and last and certainly not the least to the assistance given by Mr. Mahendra Singh the former Ld. Counsel of the Complainants.



NEW DELHI
DATE: 24/01/2009



V. Shrivastav
Arbitrator