

ఆంధ్రప్రదేశ్ రాష్ట్రం ఆంధ్ర ప్రదేశ్ ANDHRA PRADESH

No. 108986, 4/12/2010 100/-  
Sold To... Harini Narayan Swamy  
1/p./W/o./D/O... B. Narayana Swamy 126 Hyd  
To Whom... Self

AM 424066

K. RAMA CHANDRAVATHI  
STAMP VENDOR (L. No:27/08, PL.No.16/2008),  
6-307, Beside Benjara Durbar Hotel, Panjagutta,  
HYDERABAD - 500 082. Phone. No. 23361794

BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA  
ARBITRATION AWARD

In The Matter Between

The McGraw-Hill Companies Inc.

Complainant

Versus.

Corporate Domains, Inc

Respondent

1. The Parties

The Complainant is The McGraw-Hill Companies of New York, United States of America, represented in these proceedings by M/s A L G India Law Offices, New Delhi.

The Respondent is Corporate Domains, Inc. of Shanghai, China.

2. The Domain name, Registrar and Policy

This Arbitration pertains to a dispute regarding the domain name <mcgrawhill.co.in>. The registrar for the disputed domain name is Directi Web Services Pvt. Ltd.

Harini Narayan

The Arbitration Proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the current .IN Domain Name Dispute Resolution Policy (the "INDRP Policy"), and the INDRP Rules of Procedure (the "Rules").

### 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 from the .IN registry and on October 27, 2010 and 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. The Respondent was given twenty-one days time from the date of the notification to file a response. The Respondent did not reply to the notification or filed any response in these proceedings. Based on the material on record the Arbitrator now proceeds to determine the case on its merits.

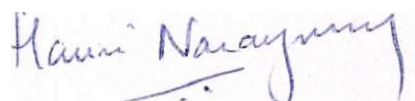
### Factual Background

The Complainant is in the business of publishing and media services and uses the trademark MCGRAW-HILL in connection with its business. It bases its complaint on the following trademarks:

TRADEMARK	REGISTRATION NUMBER	CLASSES	STATUS
MCGRAW-HILL	637512	16	Registered
MCGRAW-HILL	637513	9	Registered
MCGRAW-HILL	1298097	9, 16, 35, 36 38,39, 40 ,41	Pending
The MCGRAW-HILL Companies	1298098	9, 16.35,36 38,39, 40 ,41	Registered

The Respondent registered the disputed domain name <mcgrawhill.co.in> on July 4, 2010.

### 4. Parties contentions

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### A. Complainant's Submissions

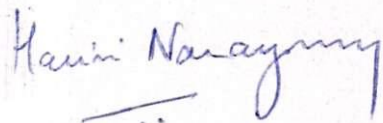
The Complainant states it is a global leader in publishing, education, financial and business media services. It provides information through various media platforms, including books, magazines and online newsletters over the Internet and electronic networks. It also uses television satellite, FM sideband broadcast, software, videotape, facsimile and CD- ROM for its products. Incorporated in 1925, the Complainant states it has grown phenomenally and by the year 2009 it had 21,077 employees in about 400 offices worldwide, generating revenues in excess of 5.95 billion dollars.

The Complainant argues that the disputed domain name is confusingly similar to its registered trademark MCGRAW-HILL. It asserts that its mark is famous in at least 34 countries including major jurisdictions such as USA, EU, U.K. Australia and India. It owns the US trademark No. 1350345 for MCGRAW-HILL, from July 23, 1985, for educational motion pictures, filmstrips, books, pamphlets, brochures and newspapers, with its first use in commerce from 1909. The Complainant has provided trademark registration details in many jurisdictions including USA, EU, UK and Australia. It owns numerous domain names, and some were acquired through UDRP decisions in its favor.

In India, the Complainant states it has acquired good will through long and extensive use of its trademark as a house mark for its joint venture with the Tata group, known as the Tata McGraw Hill Education Private Limited. Presently, Tata McGraw Hill is a market leader in the publishing industry in India that caters to a wide segment of students from Pre-KG to professional studies. It owns a comprehensive range of books, material for many competitive exams and study material, the largest being in the area of Computer Science Engineering. Its education and publishing subsidiaries are Tata McGraw Hill Education Private Limited and Tata McGraw Hill Publishing Company Limited respectively; both were incorporated on March 18, 1970.

The Complainant argues the Respondent has no rights or legitimate interest in the disputed domain name as it has not authorized or licensed the Respondent to use its MCGRAW-HILL mark, nor does it have any past dealings with the Respondent. Further, the Respondent is not known by the disputed domain name and has no trademark rights in the name nor makes legitimate non-commercial fair use of the disputed domain name. The Respondent has parked the domain name with SEDO, and has put it up for sale. The Complainant argues, based on prior case decisions, that SEDO parking is not recognized as a legitimate use of the domain name. The webpage linked to the disputed domain name has sponsored links that redirects Internet users to websites competing with the Complainant. Such use of the disputed domain name for generating Internet traffic is not a *bona fide* use and confers no legitimate rights.

The Complainant asserts the disputed domain name was registered and used in bad faith, as the Respondent had knowledge of the Complainant's prior rights in the trademark, as the Complainant has used it for over a century. Given the fame and goodwill of the mark and the Complainant's use of its mark in several domain names, the Respondent's

  
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registration of the disputed domain name in 2010, the Complainant claims indicates bad faith registration.

The Complainant states bad faith is also implicit from the registration and use of the disputed domain name as the domain name is placed on the SEDO parking site and its sale is advertised. The content of the Respondent's website also shows knowledge of the Complainant's rights and the Respondent's attempts to exploit the fame of the unique mark. Further, the Complainant argues that the Respondent ought to be a cyber squatter, as he has a number of .IN domain names with other famous brands such as <barclaysbank.co.in>, <mlink.in> <rbcroyalbank.in>. Furthermore, the previous registrant of the disputed domain name; "Corporate Domain Portfolios" with the same contact details as the Respondent has been involved in a UDRP case, *Morgan Stanley v. (Corporate Domain Portfolios c/o Ye Genrong*, FA 328821 (Nat.Arb. Forum Jul 25. 2010) concerning the domain name <morhganstanleywm.com> and although the record shows a change of registrant, the Respondent and previous registrant ought to be the same entity.

#### Discussion and Findings

Under the .IN Policy, the registrant of the domain name is required to submit to a mandatory arbitration proceeding in the event that a complaint is filed in the .IN Registry, in compliance with the .IN Policy and the INDRP Rules.

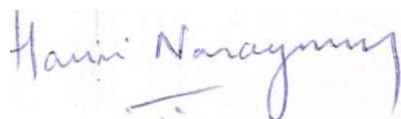
The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:

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

#### Identical or Confusingly Similar

1 The first element requires the Complainant to prove that the domain name registered by the Respondent is identical or confusingly similar to a mark in which it has rights.

The Arbitrator finds that the Complainant has submitted documents showing its registered rights in the trademark M C G R A W - H I L L . In particular, it has submitted copies of its Indian trademark registrations and the details of its international trademark registrations in several major jurisdictions that establish its statutory rights in the M C G R A W - H I L L marks. The Complainant has clearly adopted and used the mark extensively and the Arbitrator is convinced of the distinctive nature of the Complainant's MCGRAW-HILL marks.



The disputed domain name incorporates the Complainant's trademark M C G R A W - H I L L , albeit the hyphen between the words "McGraw" and "Hill". Merely dropping the hyphen does not render the mark different from the domain name. See *The McGraw- Hill v. Yan Wei*, INDRP Case No. 150, September 27, 2010 , pertaining to the domain name <mcgrawhill.in>.

If a trademark is incorporated in its entirety in a domain name, it is sufficient to establish that the domain name is identical or confusingly similar to a complainant's registered mark. See *Allied DOMEQ Spirits and Wine Limited v Roberto Ferrari*, INDRP Case 070, dated September 27, 2008 (<ballantines.in>). A domain name that incorporates a well-known trademark is considered confusingly similar to the trademark. See *Lockheed Martin Corporation v. Dan Parisi*, WIPO Case No. D2000-1015. Accordingly, the Arbitrator finds that the disputed domain name <mcgrawhill.co.in> is confusingly similar to the Complainant's trademark except for the country code top level domain (cc TLD) ".coin " identifier. The ccTLD can be disregarded for purposes of assessing similarity of the domain name to the trademark. See *Morgan Stanley v. Bharat Jain*, INDRP Case No. 156 dated October 27, 2010 (<morganstandleybank.co.in>).

For the reasons discussed, the Arbitrator finds that the Complainant has satisfied the first element under paragraph 4 of the Policy.

#### Rights and Legitimate Interests

The second element requires the Complainant to show that the Respondent has no rights and legitimate interests in the disputed domain name.

The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name, as he has not been given any authorization to use the Complainant's mark. Further, the Respondent is not known by the disputed domain name and has no trademark rights in the name.

Paragraph 7 of the Policy states a Respondent's or a 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 Arbitrator finds there is no evidence on record to show that the Respondent has made preparations to use the disputed domain name for a *bona fide* offering of goods or services or that the Respondent has been commonly known by the disputed domain name or makes legitimate non-commercial fair use of the website linked to the disputed domain name.

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The Respondent who is not connected with the Complainant or its business uses the Complainant's trademark in the disputed domain name. In the Arbitrator's view, the use of the Complainant's mark in the disputed domain name and the sponsored links on the Respondent's website are likely to mislead the public and Internet users that the disputed domain name refers to the Complainant. It is likely to cause confusion to users, who may falsely believe that the Respondent's domain name and website are being operated or endorsed by the Complainant. Such activity does not constitute a *bona fide* offering of goods and services under the INDRP Policy. A website and a domain name that gives a false impression to users and misleads users does not confer legitimate rights. See for instance. *Pfizer Inc. v. Schreiner /Schreiner & Co.*, WIPO Case No.D2004-0731.

The Complainant has made a *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name and has satisfied the second element under paragraph 4 of the Policy,

#### Bad Faith

Under the INDRP Policy the Complainant is required to prove that the domain name was registered or is being used in bad faith.

The Complainant has put forward the following arguments that the Respondent has registered and used the disputed domain name in bad faith. First, the Complainant has prior rights in the trademark and has used it for over a century. Second, the Respondent has parked the disputed domain name on the SEDO parking portal and advertised its sale. Third, the Respondent has registered a number of domain names that use other famous marks and the prior registrant, with the same contact details as the Respondent, was involved in a UDRP case. All these circumstances according to the Complainant, lead to the inference that the Respondent is a cyber squatter.

The Arbitrator finds these arguments of the Complainant are persuasive, as the Complainant has filed credible evidence to support its contentions. The Complainant has filed documents that establish it has adopted and used the mark from the year 1909. Given the long use of the mark by the Complainant, it is highly unlikely that the Respondent was unaware of the Complainant's mark, and indeed it suggests the Respondent must have known of the mark and most likely had the Complainant's unique mark in mind while registering the disputed domain name.

Under Paragraph 6 (iii) of the Policy, if the registrant of the domain name in dispute, has used the domain name to intentionally attract Internet users to the Registrant's website or other online location by creating a likelihood of confusion with the trademark of another, it is considered evidence of bad faith. Exploiting the fame of a trademark with an intention of attracting Internet users constitutes bad faith registration; See for instance *Ferrari S.p.A v. American Entertainment Group, Inc.*, WIPO Case No.D2004-0673,

The Complainant has submitted evidence that the Respondent's website has featured links that compete with its business. The use of sponsored links that compete with the

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Complainant's business, suggests that the Respondent has registered the disputed domain name with the intention of attracting Internet users to its website based on the fame of the Complainant's mark and divert confused users for its commercial gain . Using the domain name for displaying links for commercial gain under the circumstances discussed is evidence of bad faith use. See *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, WIPO Case No.D2006-0062.

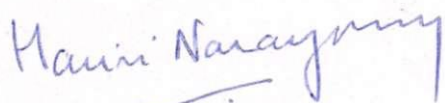
Given the fame of the Complainant's mark and the material on record the Arbitrator is of the view that there is merit in the Complainant's arguments that the Respondent has registered the disputed domain name for its trademark value, to generate Internet traffic and to derive income or commercial gain by using the trademark. As the Respondent has no legitimate rights in the trademark the registration and use of the domain name is in bad faith.

The Policy makes reference to circumstances indicating bad faith registration and use of a domain name where the respondent engages in a pattern of registration of domain names to prevent the owner of the trademark from reflecting its mark in a corresponding domain name. The Arbitrator finds the evidence on record shows the Respondent has registered other domain names bearing the famous trademarks. Further the fact that the previous registrant had the same address, suggests cyber-flight, given the prior registrant's history of the being involved in a UDRP dispute. This is also indicative of a pattern of such behavior on the part of the Respondent that is recognized as indicating bad faith. *Sony Ericsson Mobile Limited v. Salvatore Morelli*, INDRP Case 030, dated January 20, 2007 (<sony-ericsson.in>) and *Taco Bell Corporation v. Webmasters Casino*. INDRP Case 067, "dated May 29, 2008(<tacobell.co.in>)

Further, the Respondent has parked the disputed domain name on the SEDO parking site with an advertisement for its sale. Parking of a domain name that uses a well-known trademark constitutes bad faith registration and use. The registration of a well-known mark itself is evidence of bad faith registration. See *Genpact Limited v. Manish Gupta*. INDRP/056, exploiting the fame of a well-known mark constitutes bad faith registration. See *Lego Juris v. Robert Martin*, INDRP /125, Feb 14, 2010. The Arbitrator finds the disputed domain name has been registered and used in bad faith under paragraphs 4 and 6 the Policy.

### Decision

For all the reasons discussed above the Arbitrator orders that the domain name <mcgrawhill.co.in> be transferred to the Complainant.



**Harini Narayanswamy (Arbitrator)**

**Date: November 30, 2010**