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BEFORE THE INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

ARBITRATOR: S.SRIDHARAN

DATED: 17th August 2008

Bombay Stock Exchange Limited ... Complainant

Versus

Jigar Vikamsey ... Respondent

Sridharan

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...

Respondent

1. The Parties

1.1 The Complainant is Bombay Stock Exchange Limited ("BSE"), a company duly incorporated under the Indian Companies Act, 1956, having its registered office at 25th Floor, Phiroze Jeejeebhoy Towers, Dalai Street, Fort, Mumbai -400 001, represented by its counsel, Ms. Marylou Bilawala advocate of Wadia Ghandy & Co., N.M Wadia Buildings, 123, Mahatma Gandhi Road, Mumbai - 400 001.

1.2 Respondent is Mr.Jigar Vikamsey, at 18, Chandravilla, 218, R.A. Kidwai Road, Wadala, Mumbai - 400 031 represented by its counsel Na.Vijayashankar, Ujvala", 37, 20th Main, B.S.K.Stage I, Bangalore 560050.

The Domain Name and Registrar

1.3 The disputed domain name <sensex.in>is registered with Direct Information Pvt Ltd.

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2. Procedural History

- 2.1 On 4th July 2008, the Arbitrator sent an electronic version of the signed Statement of Acceptance and Declaration of Impartiality and Independence. I was informed by the registry that this matter was originally allotted to another arbitrator.
- 2.2 On 8th July 2008, I received hardcopy of the Complaint along with Annexures. I did not receive any other pleadings and I proceeded on the basis that no action was initiated by the earlier arbitrator.
- 2.3 On 8th July 2008, I issued by mail a Notice to the Respondent setting forth the relief claimed in the Complaint and directing him to file his reply to the Complaint within 15 days. I also sent a mail to the Complainant to send an electronic version of the Complaint, preferably as a word document to the Arbitrator at the earliest.
- 2.4 On 9th July 2008, the Complainant sent an electronic version in a word file of the Complaint to the Arbitrator.
- 2.5 On 11th July 2008, Respondent informed the Arbitrator that he had already filed his response to the arbitrator appointed earlier in this matter. Respondent also issued fresh authorization in favour of his counsel to represent his cause further and attached a soft copy of the same.
- 2.6 I discussed with the registry about the Respondent's response to the complaint. On 15th July, I directed the Respondent to send me a soft and

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hard copy of the reply that was submitted to the arbitrator appointed earlier in this matter.

- 2.7 On 20th July 2008, Respondent sent his response to the complaint.
- 2.8 In the meantime, the Complainant made a request for personal hearing. I fixed the hearing on 3rd August 2008 and informed the counsel for both the parties. The parties were further informed that since the matter was pending for long time, there might be only one adjournment and in such an event, the hearing would be held on 9th August 2008. The Complainant made a request to have the hearing on 9th August 2008. The Respondent intimated that he would make arrangements to attend the hearing on 9th August 2008.
- 2.9 The hearing was held on 9th August 2008 at Taj President, Mumbai between 11 AM and 1.30 PM. The Complainant was represented by Mr. Virag Tulzapurkar, Senior Counsel, Bombay High Court, instructed by Wadia Ghandy & Co., Mumbai. He was assisted by Mr. Nikhil, Advocate, Ms. Marylou Bilawala and Ms. Ritambara Baheti, all advocates, Mr. Kunal Vaidya, Article, and Mr. Sunil Kapadia, Mr. Sammit Joshi, Mr. Shailesh Jain all representatives of the Complainant, Bombay Stock Exchange Limited. The Respondent was represented by its counsel Na.Vijayashankar.
- 2.10 An attendance sheet was prepared in triplicate and each copy was signed by Arbitrator, counsel for the Complainant and the counsel for the

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Respondent. One signed copy was given to each party to the dispute and one was retained by the Arbitrator to be sent to NIXI along with the award.

2.11 The Complainant filed certain additional documents during the hearing. The Respondent wanted some time for effectively answering the documents. I considered the request and gave Respondent one week's time to file his response to the additional documents filed by the Complainant. The Complainant also sought time to file written response to the arguments advanced by the Respondent. The Complainant was also asked to submit his written response in a week's time.

2.12 The Complainant and the Respondent submitted their written responses.

3. **Factual Background**

A Complainant

3.1 The Complainant, a public limited company is the oldest stock exchange in Asia with a rich heritage and is popularly known as "BSE". The Complainant was originally established as "The Native Share & Stock Brokers' Association" in 1875 and was an Association of Persons (AOP). In 1957, the name was changed to "The Stock Exchange, Mumbai". In 2002, it was "Bombay Stock Exchange". Effective from 19th August, 2005, the Complainant has come to be known as "Bombay Stock Exchange Limited" by virtue of BSE (Corporatisation and Demutualization) Scheme, 2005 notified by the Securities and Exchange Board of India (SEBI),

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3.2 The Complainant is an affiliate member of FIBV, the International Federation of Stock Exchanges, an organization devoted to demonstrating the crucial financial role that Exchanges play in the world economy and facilitating international initiatives and cross-border co-operation. Information about BSE appears on the FIBV's website. Further, it may be noted that the Complainant is a registered member of the International Organizations such as World Federation of Exchanges (WFE), International Organization of Securities Commission (IOSCO), Founder member of South Asian Federation of Exchanges (SAFE). The Complainant provides an efficient and transparent market for trading in equity, debt instruments and derivatives. It has an international reach including a presence in 417 cities and towns of India.

3.3 In or around 1986, the Complainant coined the word "**SENSEX**" from the words "sensitive index" for use upon and in relation to its publication and reporting of the most traded or sensitive stocks on the Bombay Stock Exchange. The Complainant has been using the name/service mark "**SENSEX**", an index of 30 component stocks, from around 1986, which has become the benchmark index of the Indian Capital Market, and is extensively reported in international print and electronic media. "**SENSEX**" is widely reported in both domestic and international markets through print as well as electronic media. The booms and bust of the Indian equity market can be identified through "**SENSEX**". Due to its wide acceptance amongst the Indian and foreign investors, "**SENSEX**" is

regarded to be the pulse of the Indian Stock Markets and is associated exclusively with the Complainant.

3.4 The services provided by the Complainant under the said trade mark "**SENSEX**" are widely advertised and promoted in the print and electronic media and on the internet, and the Complainant has expended over Rs. 67.35 million on advertising and promotional expenses in respect of the services provided by the Complainant, for the last 3 years. The Complainant has developed an unprecedented level of goodwill and enjoys a very high reputation globally in respect of the services provided under the trade mark "**SENSEX**". The trade mark "**SENSEX**" has been continuously and extensively used on a wide scale since the year of its adoption by the Complainant and is well known globally.

3.5 The Complainant is the registered proprietor of the trade mark / service mark "**SENSEX**" in the United States of America and India.

3.6 The Complainant has got the following US registrations for the mark **SENSEX**. The Complainant has filed copies of US registrations.

Sr. No.	Trade Mark	Class	Trade Mark number	Goods/Services
1	SENSEX	16	2981287	Publications regarding the financial and investment industries, namely periodicals, manuals, brochures, pamphlets and books.
2	SENSEX	36	2981287	Securities exchange services;

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				securities brokerage services; providing financial and investment information and securities trading services via telephone wireless communications and the internet.
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3.7 The Complainant has registered its mark **SENSEX** in India under Application No. 1483928 in class 35 in respect of Compilation of mathematical or statistical data services. The said Application was pending at the time of filing of the Complaint and was registered subsequently. The Complainant has filed by way of an affidavit a copy of certificate of registration of the said mark along with a certificate for use in legal proceedings.

3.8 The Complainant has the following applications for the mark **SENSEX**.

Sr. No.	Trade Mark	Class	Trade Mark application number	Services
1	SENSEX	36	1483934	Financial affairs and monetary affairs.
2	SENSEX	41	1483975	Education and training affairs.

3.9 In or around July 2007 the Complainant was shocked to discover that its trade mark "**SENSEX**" is being used and has been registered as a domain name as <sensex.in> by the Respondent. The web site under the disputed domain name <sensex.in> purports to provide information services with respect to the stock markets and current Initial Public Offerings (IPO). The disputed domain name <sensex.in in fact, merely

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provides links to similar other websites. The web site under the disputed domain name <sensex.in> is so designed and contains information about the Complainant, in such a manner as would lead members of public and users of the internet, to believe that the impugned website emanated from the Complainant itself. The Complainant has filed a copy of the home page of the disputed domain name <sensex.in> of the Respondent as on 3rd January, 2008.

- 3.10 On discovery of the Respondent's disputed domain name <sensex.in>, the Complainant through its Attorneys wrote to the Respondent herein vide an e-mail dated 24th July 2007 to cease and desist from using the disputed domain name or any other domain name or variation confusingly and/or deceptively similar to the Complainant's trade mark "**SENSEX**" and to apply to the Registrar Direct Information Private Limited for cancellation of the registration of the impugned domain name or alternatively, to transfer the impugned domain name in favour of the Complainant, within 15 days of receipt of the notice. A reminder letter/e-mail dated 15th November 2007 was also sent by the Complainant through its Attorneys to the Respondent. Thereafter, Respondent's Advocate, Mr. Amit Shroff, through his letter dated 19th November, 2007, asked the Complainant's Attorney to provide him with a copy of the Complainant's Attorney's letter dated 15th November, 2007 as the Respondent was out of station. A copy of the Complainant's Attorney's letter dated 15th November, 2007 was sent to the Respondent's Advocate vide letter dated

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19th November, 2007 of the Complainant's Attorney. Thereafter, the Complainant's Attorney received a letter from one Mr. Sunil Vikamsey, on behalf of the Respondent, on 3rd December, 2007, wherein the said Mr. Sunil Vikamsey acknowledged the receipt of the letter dated 15th November, 2007 of the Complainant's Attorney and sought some time to revert. However, till date the Respondent has not replied to the e-mail dated 24th July 2007, the letter/e-mail dated 15th November 2007 or the letter dated 19th November, 2007 and has failed to indicate how it had any interest or claim to the name/trade mark "**SENSEX**", Further, the Respondent has neither stopped using the the disputed domain name <sensex.in> nor transferred the same to Complainant and still continues to use the disputed domain name <sensex.in>.

- 3.11 The Complainant submits that the Respondent has adopted the disputed domain name <sensex.in> for the purpose of selling, renting or otherwise transferring the same either to the Complainant or to any other person competing with the business of the Complainant, for a valuable consideration, so as to cause loss to the Complainant and/or for the purpose of luring users of Internet to its website under the mistaken impression that the website of the Respondent is in some way connected with the Complainant. The Complainant has filed copies of the aforesaid e-mails / letters dated 24th July 2007, 15th November 2007 and 19th November, 2007 addressed to the Respondent and letters dated 19th

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November 2007 and 3rd December, 2007 addressed to the Complainant's Attorney.

3.12 The adoption of the Complainant's registered trade mark "**SENSEX**" by the Respondent in the disputed domain name <sensex.in> was and is in bad faith and in infringement of the Complainant's rights therein. Respondent by its above mentioned activities has prevented the Complainant from registering the said trade mark as its domain name. The disputed domain name which is being used by the Respondent is identical and/or confusingly and deceptively similar to the Complainant's registered trade mark and is thus affecting the business, reputation and goodwill of the Complainant.

B Respondent

3.13 The Respondent has a Master's Degree in Business Administration with a specialization in Finance. He desired to disseminate information about the investment markets in India through internet and adopted the disputed domain name <sensex.in>.

3.14 The disputed domain name <sensex.in> has been registered in the name of the Respondent since 16th February, 2005. It was argued that the Respondent has not yet started using the disputed domain name <sensex.in> in connection with any goods or services. What are appearing on the web site under the disputed domain name <sensex.in> are the advertisements or links provided by Google. The Respondent,

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however, is planning to offer in the immediate future certain services in the field of capital markets through the disputed domain name <sensex.in .

3.15 The word "sensex" appearing in the disputed domain name <sensex.in is very commonly used by all in connection with capital market transactions, analysis and news. Evidently, no one has any monopoly over the word Sensex and it cannot be used as a trade mark by anyone including the Complainant to the exclusion of others. The Respondent has in good faith and bonafidely adopted the disputed domain name <sensex.in> containing the word Sensex.

4. Parties Contentions

A Complainant

4.1 The Complainant is the registered proprietor of the mark **SENSEX** and has been using the mark "**SENSEX**" since 01.01.1986.

4.2 The Complainant has got Indian and US registrations for the mark **SENSEX** in relation to goods and variety of services falling under classes 16, 35, 36 and 41.

4.3 It was argued that since the disputed domain name <sensex.in is accessible in the United States of America, this would constitute infringement of the Complainant's registered Trade Mark 'SENSEX' in the United States. The INDRP protects not only trade marks registered in India, but all registered trade marks.



- 4.4 The trade mark "**SENSEX**" has acquired distinctiveness by virtue of its long, uninterrupted, continuous, exclusive and extensive use by the Complainant and the trade mark is associated exclusively with the Complainant in relation to the services provided by the Complainant. The mark **SENSEX** is a well known trade mark. The Complainant has statutory as well as overwhelming common law rights in the trade mark "**SENSEX**".
- 4.5 The predominant part of the disputed domain name <sensex.in is "**SENSEX**", the registered trade mark of the Complainant. The presence of the country code top level domain '.in' is insignificant. The disputed domain name <sensex.in> is visually, structurally and phonetically similar to the Complainant's registered mark "**SENSEX**".
- 4.6 The Respondent is not in any way affiliated with the Complainant nor has the Complainant authorized the Respondent to use and register the trade mark "**SENSEX**" or to seek the registration of any domain name incorporating the trade mark "**SENSEX**" or any variation thereof. Neither does the Respondent's corporate name contain either the word "**SENSEX**". The Respondent therefore does not have any logical reason for adopting the word "**SENSEX**" as part of its domain name, except for the purpose of selling, renting or otherwise transferring the domain name to the Complainant or to any other person competing with the business of the Complainant, for a valuable consideration, so as to make a profit at the expense of the Complainant and/or to lure users of Internet to its

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website under the mistaken impression that the website of the Respondent is in some way connected with the Complainant.

4.7 The internet users or the general public who do not know that the Complainant and the Respondent have no affiliation with each other or that the Complainant has not licensed or authorized or endorsed the use of its famous and well known trade mark "**SENSEX**" will thus confuse the Respondent's activities as those authorized or endorsed or affiliated with the Complainant which leads to the dilution of the Complainant's well-known and famous trade mark.

4.8 The Respondent has no right or legitimate interest in the disputed domain name <sensex.in> which contains the registered mark "**SENSEX**" of the Complainant in respect of its services.

(a) The Respondent is not nor was it ever commonly known under the name "**SENSEX**" or any other similar name/s or mark/s. The Respondent has no prior interest in the disputed domain name <sensex.in > ;

(b) The sole purpose of the registration of the disputed domain name <sensex.in> is to misappropriate the reputation and goodwill associated with the Complainant's registered trade mark "**SENSEX**". The Complainant has neither authorized nor licensed the Respondent to register or use the impugned domain name incorporating the registered trade mark "**SENSEX**", nor authorized

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or licensed the Respondent to register or use the impugned domain name or any trade mark forming part of it.

- (c) The Respondent has not used nor has it made any demonstrable preparations to use the impugned domain name in connection with any bona fide offering of goods / services by the Respondent. The website to which the disputed domain name <sensex.in> resolves does not offer any services but is being used to direct web traffic and provide links to sponsored web sites and online services. The Complainant has filed a printout of the homepage of the website disputed domain name <sensex.in> as on 3rd January, 2008.
- (d) The Respondent is thus deriving financial benefit from the web traffic that is diverted through the disputed domain name <sensex.in>. The Respondent is thus preventing the Complainant from registering the domain name in its own name and continues to retain such registration for the purpose of selling, renting or otherwise transferring the domain name to the Complainant or to any other person competing with the business of the Complainant, for a valuable consideration, so as to make a profit at the expense of the Complainant and/or to lure users of Internet to its website under the mistaken impression that the website of the Respondent is in some way connected with the Complainant.

The impugned domain name has been registered and adopted by the Respondent in bad faith:



- (a) **The** Respondent is clearly using the goodwill and fame of the Complainant's well known and famous trade mark "**SENSEX**" in bad faith in order to improperly benefit financially, in violation of applicable trade mark laws and the rights of the Complainant. The Respondent has registered and uses the disputed domain name <sensex.in> in an intentional attempt to attract, for unlawful financial gain, internet users to its web site by creating a likelihood of confusion with the Complainant's well-known and famous trade mark "**SENSEX**".
- (b) The Respondent was well aware when it registered the disputed domain name <sensex.in>, that it consisted of the Complainant's trade mark "**SENSEX**" and the Respondent has even made references to the Complainant on its website under the disputed domain name <sensex.in> and the Respondent has no reason to adopt the name '**SENSEX**' other than to ride on the Complainant's reputation.
- (c) it is clear from the disputed domain name <sensex.in> that the Respondent was and is aware of the fact that the Complainant's sensitive stock index "**SENSEX**" possess a strong reputation and is widely used in India and well known (and used) outside India. Considering the popularity and advent of conducting and accessing banking business and/or financial services over the Internet, the Complainant is restricted from using the Internet as a vehicle for



expanding their business possibilities and interaction with the public at large across the world due to the illegitimate adoption of the disputed domain name <sensex.in> by the Respondent.

- (d) The adoption and registration of the disputed domain name <sensex.in> by the Respondent is hampering the potential business and services that the Complainant is likely to and has the capacity to provide on-line, as it is common knowledge that most internet surfers now use the suffix '.in' to track down a business or service. The registration and use of the disputed domain name <sensex.in> by the Respondent is causing detriment and disadvantage to the Complainant, resulting in financial loss to the Complainant.

4.10 It was argued that the use of the disputed domain name <sensex.in> itself constitutes use thereof as a trade mark.

4.11 Since the disputed domain name <sensex.in> is accessible in the United States of America, this would constitute infringement of the Complainant's registered Trade Mark **SENSEX** in the United States. The INDRP protects not only trade marks registered in India, but all registered trade marks.

4.12 In the present Complaint, the Complainant is not claiming any rights over the methodology used by the Complainant to determine the figure which is then provided to its members and public under the Trade Mark **SENSEX**, but is claiming rights over the word / trade Mark **SENSEX**.

4.13 the services provided by the Complainant under the trade mark **SENSEX** are indicative of the 30 selected stocks traded on the Complainant's stock exchange (and no other stock exchange), which 30 stocks (out of a huge number of stocks exceeding 6500 stocks traded on the Complainant's stock exchange) are selected exclusively by the Complainant based on criteria pre-defined by the Complainant, that govern the selection of the stocks. This service provided by the Complainant is provided under the service mark / trade mark **SENSEX**. Because of the high quality of the said Services provided by the Complainant and the extensive advertising and promotion of the trade mark **SENSEX**, the mark **SENSEX** is identified and associated exclusively with the Complainant in respect of its services. Such reputation and goodwill ensures and must ensure for the benefit of the Complainant alone and cannot be usurped by third parties, including the Respondent.

4.14 The Complainant provides the services through its website www.bseindia.com which website was registered by the Complainant in its name on 2nd January, 1997 and the trade marks of the Complainant including **SENSEX** appear on the aforesaid website of the Complainant.

4.15 The domain name www.sensex.co.in was originally registered by one Mr. Manoj Jain in his name but was thereafter transferred in the name of the Complainant after the Complainant objected to the same. Accordingly, the Complainant has been taking steps to protect its ownership rights in the mark **SENSEX** even vis-a-vis its wrongful use by others as a domain



name. In any event non-registration of a trade mark as a domain name by the owner thereof does not permit third parties to adopt such trade marks as part of their domain names and the INDRP recognizes the rights of trade mark owners as against domain name registrants. Further, the Respondent had no other / prior association with **SENSEX** till the registration of the disputed domain name <sensex.in> whereas the Complainant is using the mark **SENSEX** for a very long period of time.

16 The alleged suit referred to by the Respondent filed by one Mr.Mohoni in Pune is completely irrelevant to the present dispute between the Complainant and the Respondent. In any event, the Complainant submits that such suit, if any, shall be defended by the Complainant as the Complainant is the registered proprietor, owner and user of the mark **SENSEX**. The Complainant has separately filed a suit in the Bombay High Court (Suit No. 2483 of 2008) against the said Mr. Mohoni in view of such false claims being made by him. In any event and without prejudice to the above, the mark **SENSEX** is registered in the name of the Complainant both in India and the United States of America and not in the name of the said Mr. Deepak Mohoni.

17 The Respondent has himself admitted that he is offering services through the disputed domain name <sensex.in> (See paragraphs 18, 20 and 21 of the Response submitted by the Respondent) Further, the home page of the disputed domain name <sensex.in> displays a chart under the name **SENSEX**, which chart displays the services provided by the Complainant.

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The Complainant accordingly submits that the Respondent is using the disputed domain name <sensex.in> in respect of his services as a trade mark and in a trade mark sense by hijacking the reputation and goodwill of the Complainant in the mark **SENSEX**. The Respondent has, on his own admission on the day of personal hearing, admitted that the Respondent intends to build up a brand value in the disputed domain name <sensex.in> in respect of the services provided by the Respondent through the impugned domain name, which the Respondent is not entitled to do, since the brand value in the trade mark **SENSEX** has been built by the Complainant and can only vest in the Complainant under law. The Complainant further submits that the Respondent has been unable to provide any explanation with respect to the adoption of the word **SENSEX** as part of the disputed domain name <sensex.in> in his Response and at the hearing before the Hon'ble Arbitrator on 9th August 2008.

4.18 As per the Accounting Standards (AS-26), the Complainant is not required to include the mark **SENSEX** in its books of accounts and balance Sheet, since the mark **SENSEX** was not purchased by the Complainant rather the rights of the Complainant in the mark **SENSEX** are established by its prior use and adoption and its registration.

B, **Respondent**

4.19 It was argued primarily that the word **SENSEX** cannot be a trade mark of the Complainant for the following reasons:

- (a) The very adoption of the mark **SENSEX** by the Complainant is not bonafide and dishonest. Information received by the Respondent from the Office of the Trademark authorities in Mumbai under the RTI reveal that there is an opposition filed for the Trademark application made by the Complainant with the person raising the opposition claiming that he was the first person to coin and use the term **SENSEX** (Ref RA-10).
- (b) **SENSEX** is a number reflecting the prices of 30 select shares out of nearly 5000 shares traded on the exchange at any given point of time. The choice of the 30 shares out of the 5000 available shares is a decision based on the well known ABC principle of management since these select shares contribute to the significant part of the market capitalization and for active trading. The methodology and the composition of the index are in the public domain. **SENSEX** can be calculated by any member of the public with reference to the published share price data. **SENSEX** is a factual position of the share trading information created out of the activities of the public in buying or selling shares, using a publicly available formula. The designing of the formula for calculating **SENSEX** is not based on any proprietary intellectual property of the Complainant but on the scientific principles of how market capitalization has to be adjusted through weightages for facts such as the number of shares of a company available for trading at a

point of time compared to a base time. "**SENSEX**" can neither be considered as a "product" or a "service" of the Complainant. **SENSEX** cannot be considered as an indicator of the quality of the service rendered by the Complainant. The continuous use of **SENSEX** by the Complainant is not unique.

The documents of different segments of the media filed by the Respondent indicate that **SENSEX** is seen more as a reflection of the economic factors than the performance of BSE. Hence in public perception **SENSEX** is not a mark that can distinguish any product or service associated with the Complainant and should not be considered as possessing rights associated with a trademark or service mark.

SENSEX is not distinctive to distinguish the services of the Complainant from those of others. The word **SENSEX** is generic to the trade. Every one dealing with Indian capital market must inevitably use the word **SENSEX**. The word **SENSEX** is very commonly used by all in connection with capital market transactions, analysis and news. No one has any monopoly over the word **SENSEX** and it cannot be used as a trade mark by anyone including the Complainant to the exclusion of others. The word **SENSEX** has assumed the specific meaning of an "indicator of stock market status" in general and is no longer considered only to describe the movements of the 30 shares of the Bombay Stock

Exchange used for computing the **SENSEX**. In the specialized segments where the specific reference is required, the term BSE-**SENSEX** is used instead of the mere word **SENSEX** to distinguish between the BSE related index and the reflection of the capital market situation in India

4.20 The Complainant has obtained the trademark registration in US and trying to obtain Trademark registration in India by suppression and misrepresentation of facts and on the basis of products or services which it may be proposing to introduce in future since as is indicated through the media perception **SENSEX** as of now is considered as an "indicator of the status of the Indian Capital Market" and not exclusively connected with the Bombay Stock Exchange. The award of the mark is liable to be set aside upon a proper opposition. The right claimed out of such faulty process should not be the basis for determining the right of the Complainant to snatch the domain name which has already been registered under a widely accepted a "First To market Principle" which is the foundation of the domain name registration system.

4.21 As far as US registrations are concerned, the Complainant has not adduced adequate documentary evidence as to the existence of any product or service under the classification in the exclusive name of "**SENSEX**" either prior to the granting of the trademark or subsequently. The only evidence produced to prove the use of the mark are the third party press reports and the claim is based on the use of the mark to

"Report the summary of the prices of select shares traded in the BSE".

While it is conceded that Complainant has been using the term SENSEX since a long time, it has been used frequently as BSE-SENSEX. Whenever the word is used simply as SENSEX, the objective has been to reflect the general health of the capital market in India.

4.22 Therefore the Complainant has no right on the term SENSEX as either a trademark or a service mark either in US or elsewhere notwithstanding the claimed registration which could be challenged in the appropriate forum.

4.23 The trademark registration in USA was obtained by Bombay Stock Exchange, (Association of Persons) which is an entity different from the current status of the Complainant. In the absence of the recording of the change of ownership with the US Trademark office, the trademark registration in USA is not binding on third parties such as the Respondent and the Complainant does not have any rights which can be rightfully claimed by a registrant of a US Trademark.

4.24 Therefore documents showing registration in the United States of America of trademark submitted by the Complainant cannot be accepted as conclusive proof of the right of the Complainant and the US registrations of the Complainant should not be admitted as evidence in this proceeding. The Complainant does not have any legal right under the US Trademark law to bar the use of **SENSEX** by the Respondent as a part of the disputed domain name < **sensex.in**>.

- 4.25 The Complainant has not placed on record any documentary evidence as to the treatment of **SENSEX** as a trademark in his books since there is no mention about the same either in the balance sheet of 19th August 2005 nor the balance sheet for the year 2006-2007. No income has been shown in the books of Bombay Stock Exchange Ltd under the trademark though it is clear that **SENSEX** was being used by several players in the market to represent the status of the capital markets in India.
- 4.26 As for as Indian Applications are concerned, the Complainant has not provided any evidence to state if the registration has been granted and if so its effective date and if there has been any opposition filed etc.
- 4.27 The Trademark Application in India has been made on 4th September 2006 long after the Respondent has registered the disputed domain name. An opposition has been filed against the registration of the trademark for "SENSEX" by a person by name Deepak Mohoni on February 21, 2007 under various grounds including that the word **SENSEX** was coined by Mr. Deepak Mohoni in 1990. He has also contended that the mark should be considered as fit for absolute refusal under Section 9 (1) (c) of the Indian Trademark Act 1999. The Complainant has withheld this material information from the arbitration complaint and tried to force his non existent right through deceit
- 4.28 Trademark registration in USA was granted on 2nd August 2005. The Indian Applications were made on 4th September 2006. "SUNRISE" policy which was open from 1st January 2005 to February 15 2005 enabling the

trade marks holders to apply for domain name registrations. Complainant made no application during this sunrise period. Registrations were made open on or after 16th February 2006 The Complainant did not make any attempt to file applications even after 16th February 2006. SUNRISE Policy was a unique provision adopted by ICANN to respect the views of the Trademark owners though the domain name system otherwise works on the "First to Market Principle" where the first person to apply for an available name would get the registration. If Trademark owners pass by their rights during the SUNRISE period and then try to snatch the registered domain names, it would lead to defeating the very policy of ICANN and NIXI.

29 Prior to February 16, 2005, the register at .IN registry was not open to the public for registration of a domain name such as < **sensex.in**>. The Respondent therefore had no legal opportunity to register the disputed domain name even if he wanted. Since it was impossible for the Respondent to register the disputed domain name < **sensex.in**> any time earlier and the reason for the same was beyond the control of the Respondent, the principle of natural justice demands that he should not be penalized for not registering the domain name earlier than February 16, 2005.

30 Hence the priority of the domain name registration must be upheld against the later registration of trademark in USA and/or India.

Induvarans

- 4.31 Had the Complainant made an application for the domain name anytime before February 15 2005 even under the non trademark holder category, the registrar would have resolved the dispute before the name was allotted to the Respondent. He has failed to exercise this option and it must be considered as "Abandonment" of his rights if existing or an admission of not having the said right.
- 4.32 The Complainant appears to have not made any attempt to register the name nor raise any objection until around November 2007 when notices were served on the Respondent which was issued outside the INDRP framework. This silence is considered deliberate and an acceptance of the fact that the Respondent had the right to use the disputed domain name < **sensex.in**>. In other words, the Complainant had abandoned whatever right he is now claiming to have on the mark by his deliberate silence.
- 4.33 The current proceedings are therefore considered an attempt to usurp the legitimate value created by the Respondent over the last three years under the pretext of a trademark right.
- 4.34 The Respondent had every right under the constitution of India to set up and carry on the activity of running an information service around the investment scenario in India. Since the Complainant as well as the term **SENSEX** is associated with the investments and sensitive index of share prices, it was imperative that the Respondent had to work around the words BSE, **SENSEX** as well as other related terms. These are

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"legitimate" use of the domain name and the Respondent has every right to continue to use them.

4.35 Under para 10(i) of the Complaint, the Complainant has made a claim that he was constantly eager to protect the mark < sensex.in>. However the Complainant has provided no evidence of such vigil. The acceptance under para 10(j) that the Complainant was not aware of the registration of the disputed domain name <sensex.in> until July 2007 for nearly 30 months when the site was up and running and visible through search engines etc also indicate that the Complainant had no monitoring mechanism to protect what he today claims as a right on which he is highly concerned.

4.36 The wide spread use of the term **SENSEX** in the stock market related news and equity research reports on which the Complainant has shown no evidence of having initiated infringement action as well as the more than 50 websites that exist with the name **SENSEX** built into the name (Ref Annexure RA-5) indicate that the above claim is totally false and misleading.

4.37 Paragraph 10(k) of the Complaint refers to the notices sent earlier in November 2007 to the Respondent and takes objection to not replying for the notices and stopping the use of the disputed domain name oblivious to the fact that these notices were improper notices outside the INDRP and did not deserve any recognition.

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- 4.38 The notices sent by the Complainant in November 2007 were an attempt to intimidate the Respondent with the threat of damages and criminal action on a non-existent right. Since the dispute was falling within the jurisdiction of the INDRP there was no need for the Respondent to take cognizance of the notices
- 4.39 The Respondent has not at any time offered to sell the disputed domain name <sensex.in> to any person or organization more so the competitors of the Complainant.
- 4.40 The term **SENSEX** has been used by every person who deals with the stock market investments and investment reporting in India as long as it has been used by the Complainant himself. If usage alone is the criteria for determination, then economic papers such as Economic Times will have a higher claim on the term than the Complainant. Therefore the length of usage claimed by the Complainant to substantiate its right on the term **SENSEX** is insufficient to claim monopoly rights over the term. In view of the above, the maintenance of the website under the disputed domain name <sensex.in> by the Respondent has in no way caused or is likely to cause any loss to the Complainant nor mislead the members of the public to think that the site has any association with the Complainant. The concerns expressed by the Complainant are therefore not based on facts.
- 4.41 In order to sustain the bad faith component under Rule 6 of INDRP, the Complainant has to provide justification with relevant evidence to prove all

the three aspects specified therein. In the instant case, the Respondent has not made any attempts to sell, rent or otherwise transfer the domain name to the Complainant or any body else. The Respondent has not approached the Complainant with any offer of sale or for demanding any money for transfer of the domain name. **He** has not put up the domain name for auction or otherwise advertised that the domain name is for sale. On the other hand, the Respondent has resisted the demand of the Complainant to get the disputed domain name <sensex.in> transferred to the Complainant since he is using and intending to use the disputed domain name <sensex.in> for legitimate purpose.

4.42 The Respondent has not also engaged in a "pattern of conduct to register disputed domain name <sensex.in> in order to prevent the owner of the trademark/service mark from reflecting the mark in a corresponding domain name. This provision typically applies when a registrant registers multiple domain names aimed at blocking the use of the name by the mark owner in any combination. In the instant case the Respondent has only registered <sensex.in> and <sensex.net.in>. He is using <sensex.in> for information services and intends to use <sensex.net.in> for the other related services he intends to introduce shortly. Hence it cannot be said that the Respondent has registered multiple domain names in such a way as to block the use of the word **SENSEX** in any domain name if the Complainant so desires. The Complainant already holds the domain name <sensex.co.in>. The Complainant was therefore well aware that he had

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access to the use of the domain name **SENSEX** with the TLD extension .co.in and the Respondent had not tried to register multiple names so as to prevent the use of the name **SENSEX** by the Complainant.

4.43 The services rendered by <sensex.in> are not in any way similar to the services rendered by the Complainant. While the Complainant's main service is to provide facilitation of share trading through a set of brokers, the Respondent's service is to provide some investment related information. There is no likelihood of any visitor to the site <sensex.in> considering that it is a site related to the Complainant more than any reader of Economic Times Investment page thinking that the page is part of the publication of Bombay Stock exchange because the page is full of news about **SENSEX**. Therefore, the third element of bad faith is not proved.

4.44 While it is necessary for the Complainant to prove Respondent's lack of "bad faith" on all the three parameters mentioned in INDRP Rule 6, he has failed to neither prove any one of the parameters nor present any evidence to substantiate a reasonable possibility of the existence of "bad faith".

4.45 As regards the common law rights associated with the use of the mark **SENSEX** by the Complainant from an earlier date, it is submitted that it has never been used as a mark "to distinguish" any "goods" or "services" nor to indicate the "quality" of any of the goods and services which are produced or offered by the Complainant. However if any common law

rights are still presumed to exist in favour of the Complainant, we need to examine if his right is any way adversely affected by the Respondent registering the domain name. There is no service which the Respondent is providing which is similar to any service that the Complainant is providing by the same name. For example the Respondent is not creating a share price index called **SENSEX** which is either a composition of a different set of share prices traded in BSE than the one presently used by the Complainant nor a calculation based on a different formula. Since there is no competing business or service between the Complainant and the Respondent there cannot be any "consumer confusion". If there are the visitors to <sensex.in>, it need not mean that there is reduction of visitors to the website of Bombay Stock Exchange. Hence there is no adverse commercial impact on the Complainant by virtue of the Respondent maintaining the website <sensex.in>.

4.46 The "Fairuse" concept of copyright law, the "Compulsory Licensing" of the Patent law and the "Absolute Grounds for Refusal" in the Trademark law are examples of this importance accorded by law to the public interest. It is necessary to consider this aspect also in resolving this dispute.

4.47 The Respondent as a means of abundant expression of good faith has placed prominent disclaimers on his site to indicate that his site or service is in now way connected with the Complainant. This must be considered as a further dilution of the charge of the Complainant that there is any inclination for the Respondent to misuse the name of the Complainant.

4.48 The Complainant's claim of the right on the domain name based on the non-existent trademark rights and reckless charges of bad faith and consumer confusion not founded on any shred of evidence, are an attempt to "Reverse Hijack the domain name" and the Respondent strongly opposes this anti-society move of the Complainant.

4.49 It is possible for both the Complainant and the Respondent to peacefully co-exist in Cyber Space with lookalike disclaimers on each other's sites to inform the visitors to the site that their site is not associated with the other site. The Respondent has already introduced this disclaimer voluntarily and appeals to the good senses of the Complainant to run a similar disclaimer on his website also particularly if he starts using the domain name <sensex.co.in>. The Complainant does not suffer any adverse impact to his business by the Respondent's use of the disputed domain name <sensex.in>.

4.50 The complaint may be dismissed. Respondent be paid a compensation of a sum of Rs 50000/- (Rupees Fifty Thousand only) towards the mental agony and distress caused on the Respondent as well as costs incurred by him as a result of this reckless and unsubstantiated complaint.

5. **Discussion and Findings**

5.1 I will discuss the pleadings and arguments of the Parties to the extent that is required to answer the Complaint.

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5.2 Before going into the merits of the case, I must make myself clear whether I should proceed further to decide the Complaint. It was argued by the Respondent that there was a case pending against the Complainant before a court in Pune filed by one Mr.Mohoni in respect of the Complainant's trade mark **SENSEX**. It may be noted that the said Mr.Mohoni is not a party to the arbitration proceedings. Respondent has not filed any document in support of his allegation. He did not even file a copy of the suit plaint. If the Respondent desired, he could have got himself impleaded as a party in the Pune suit. But till date he has not done so. Therefore, the suit pending before the Pune Court cannot be considered in this arbitration proceeding. Further, Respondent has not initiated on his own any action involving the mark **SENSEX** against the Complainant. No such case is brought to the attention of the arbitrator. Therefore, there is no dispute involving the trade mark **SENSEX** pending between the parties on the date of the personal hearing. In the absence of any dispute pending between the parties on the date of the personal hearing, I proceed to determine this Complaint.

5.3 The Complainant in order to succeed in the Complaint must establish under Paragraph 4 of .IN Domain Name Dispute Resolution Policy (INDRP) the following elements:

- (I) Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;



- (II) Respondent has no rights or legitimate interests in respect of the domain name; and
- (III) Respondent's domain name has been registered or is being used in bad faith.

5.4 Each of the aforesaid three elements must be proved by a Complainant to warrant relief.

Disputed domain name is identical or confusingly similar to a trade mark of the Complainant.

5.5 The Complainant is the oldest stock exchange in Asia. The Complainant provides an efficient and transparent market for trading in equity, debt instruments and derivatives. Complainant coined the word **SENSEX** from the words "sensitive index" for use upon and in relation to its publication and reporting of the most traded or sensitive stocks on the Bombay Stock Exchange.

5.6 But the Respondent raised an objection to the claim of the Complainant that he was the first coiner of the word **SENSEX**. The Respondent argued that the Complainant is not the first person who coined the word **SENSEX**. He related his argument to the information that he received from the trade marks registry in response to Respondent's request dated 11.03.2008 under the Right to Information Act. Respondent filed a copy forwarded by the trade marks registry of the Application No.1483934 in class 36 for the mark **SENSEX** and the letter written by one Mr.Mohoni to the trade marks

registry. The said Mr.Mohoni in his letter claimed inter alia that he was the first person who coined the word **SENSEX** and requested the trade marks registry to refuse the applications of the Complainant. It may be noted that the Trade Marks Act has specific provisions for filing (a) opposition that can be filed after advertisement and before registration of a mark and (b) rectification that can be filed after registration. The said letter forwarded by the trade marks registry to the Respondent was neither an opposition nor a rectification under the provisions of the Act. The letter did not satisfy the conditions prescribed for an opposition such as filing Notice of Opposition in TM-5 within 4 months by paying necessary fee from the date of advertisement of the mark in the official trade marks journal. It did not satisfy the conditions prescribed for rectification such as existence of a registered trade mark and filing an application before the trade marks registry or the Intellectual Property Appellate Board paying necessary fee. The letter was dated 15th February 2007 and was received by the trade marks registry on 21st February 2007. The copy was forwarded to the Respondent under cover of a letter dated 18.03.2008 by the trade marks registry. Notwithstanding the status of the letter, the trade marks registry considered the same and granted registration of the mark **SENSEX** in class 35 under Application No. 1483928, a refusal of which was sought in the letter. So long as the registration remains on the register, the contentions raised in the letter cannot assist the case of the Respondent.

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5.7 The services provided by the Complainant under the mark **SENSEX** are indicative of the 30 selected stocks traded on the Complainant's stock exchange. The Complainant on the basis of pre-defined criteria selects individual stocks out of a huge number of stocks exceeding 6500 traded on the Complainant's stock exchange. No person other than the Complainant has the right to remove or add any stock from or to the 30 stock index. The Complainant has been continuously using the mark **SENSEX** since 1986 and the mark has gained secondary significance by virtue of such long user. The term **SENSEX** is capable of distinguishing the products and services of the Complainant from those of others in the market by virtue of acquired distinctiveness. The mark **SENSEX** can very well function as a trade mark/service mark of the Complainant. Complainant applied for registration in India and US in 2005 after the mark gained substantial amount of user.

5.8 The trade marks under which similar services are provided by the stock exchanges all over the world are registered in the name of the concerned stock exchanges, for example *Dow Jones, Nasdaq, Hangsen*. Use of such marks in descriptive sense by third parties will not make them generic or common to trade. Any use by third parties of such marks will normally be permitted to the extent such use is made in the descriptive sense and any use in trade mark sense will amount to violation of the proprietary rights of the respective owners of the marks.

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- 5.9 Therefore, the Respondent's argument that the word **SENSEX** appearing in the disputed domain name <sensex.in> is very commonly used by all in connection with capital market transactions, analysis and news and has become generic cannot be accepted. Any such use described by the Respondent of **SENSEX** by third parties will merely amount to use of **SENSEX** in a descriptive sense. Anyone including the Respondent cannot use the term **SENSEX** in a trade mark sense without the consent of the Complainant.
- 5.10 The Complainant is the registered proprietor of the mark **SENSEX** and has been using the mark "**SENSEX**" since 1986. The Complainant has got Indian and US registrations for the mark **SENSEX** in relation to goods and variety of services falling under classes 16, 35, 36 and 41.
- 5.11 The US Application for **SENSEX** in international classes 16 and 36 was made on 21.05.2001 and the mark was registered on 02.08.2005. The Complainant has claimed user from 02.01.1986. The registration is valid till 21.05.2011. The Application was made in the name of Stock Exchange Mumbai, an association of person and the name had undergone changes subsequently. The Respondent argued that the registration is invalid for non-updation of records of the registration with the present name of the Complainant. It may be noted that the changes that need to be recorded were actuated by operation of law and not by any assignments. Since the registration in US is not necessary for the determination of the complaint, I

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will not go further into the issue of procedural infirmities and its consequences.

5.12 Indian Applications for the mark **SENSEX** under international classes 35, 36 and 41 were made on 04.09.2006. Application No. 1483928 in class 35 in respect of Compilation of mathematical or statistical data services was registered after filing of the Complaint. The Complainant has filed by way of an affidavit a copy of certificate of registration along with a certificate for use in legal proceedings. The Complainant has claimed user from 01.01.1986. The Complainant's applications in other classes are still pending for registration.

5.13 The disputed domain name <sensex.in> was registered on 16th February, 2005. The Complainant is the prior adopter of the mark **SENSEX**. The Respondent did not deny the Complainant's prior adoption and user of the mark **SENSEX**. The above facts have established that the Complaint has both common law and statutory rights in respect of its trade mark **SENSEX**.

5.14 The Complainant's **SENSEX** mark is well known throughout the world including India. It is clearly seen that the disputed domain name <sensex.in> wholly incorporates the mark **SENSEX**. The suffix <.in> does not distinguish the disputed domain name from the Complainant's registered trade mark **SENSEX**.

5.15 I, therefore, find that:



- (a) The Complaint has both common law and statutory rights in respect of its trade mark **SENSEX**.
- (b) The disputed domain name <sensex.in> is visually, structurally and phonetically identical to the Complainant's prior trade mark **SENSEX**.

Respondent has no rights or legitimate interests in respect of the disputed domain name

5.16 It is already seen that the Complainant is the prior adopter and user of the mark **SENSEX**. The Complainant has got registration for the mark **SENSEX** in India. The Complainant's mark **SENSEX** is well known in many countries across the globe including India.

5.17 Now we will see whether the Respondent has established any rights or legitimate interests in the disputed domain name <sensex.in>.

5.18 The first contention of the Respondent is that the word **SENSEX** appearing in the disputed domain name <sensex.in> is a generic word. No one including the Complainant can claim any right over such a generic word. Generic words are common words that describe an entire class of goods or services and no trademarks can be granted for such terms. It is already seen that the indexes of other stock exchanges all over the world are treated as trade marks and are registered as such in the name of respective stock exchanges. Similarly **SENSEX** can function as a trade mark of the Complainant. Any use described by the Respondent of

SENSEX by third parties will merely amount to use of **SENSEX** in a descriptive sense. Anyone including the Respondent cannot use the term **SENSEX** in a trade mark sense without the consent of the Complainant. The Respondent, however, is free to agitate this issue before appropriate forum. Until it is determined by an appropriate authority or court that the Complainant cannot claim any right over such generic word **SENSEX**, the Respondent cannot claim any right or legitimate interest in the disputed domain name <sensex.in>.

5.19 The second contention of the Respondent in essence is that the Complainant failed to apply for the disputed domain name <sensex.in> at the first available opportunity. Before launching of the **.IN** domain names, **.IN** registry gave clear opportunity to the legitimate trade mark holders to come forward and to obtain the domain name for which they have trademarks. The Complainant never came forward and registered the domain till 15th February 2005 after which the domains were made available to general registrants. The disputed domain name <sensex.in> has been registered in the name of the Respondent since 16th February, 2005. Complainant made no application during this sunrise period. Registrations were made open on or after 16th February 2006. The Complainant did not make any attempt to file applications even after 16th February 2006. The Respondent argued that he has not yet started using the disputed domain name <sensex.in> in connection with any goods or services. What are appearing on the web site under the disputed domain

name <sensex.in> are the advertisements or links provided by Google. The Respondent, however, is planning to offer in the immediate future certain services in the field of capital markets through the disputed domain name <sensex.in>. The categorical admission made by the Respondent as to his non use of the disputed domain name <sensex.in> till date of the personal hearing deserves to be noted. In the absence of any use by the Respondent, it is unwarranted to go further into the issue of delay on the part of the Complainant.

5.20 At no point of time the Respondent came forward with the reason for adopting the disputed domain name <sensex.in> except as discussed above.

5.21 Therefore, I conclude that the Respondent has failed to establish any rights or legitimate interests in respect of the disputed domain name <sensex.in>.

Respondent's domain name has been registered or is being used in bad faith.

5.22 Paragraph 6 of .In Domain Name Dispute Resolution Policy (INDRP) enumerates three instances as evidence of registration and use of domain name in bad faith. Respondent argued that the Complaint should establish all the three instances cumulatively to sustain bad faith. A perusal of paragraph 6 of INDRP would show that all the three instances of bad faith need not be cumulatively established to sustain a complaint. Further, paragraph 6 of INDRP permits determination of bad faith on other

instances or factors not illustrated thereunder. It can be inferred from the appearance of ". . . . *in particular but without limitation*" in paragraph 6 as follows

6. *Evidence of Registration and use of Domain Name in Bad Faith*

*For the purposes of Paragraph 5(iii), the following circumstances, **in particular but without limitation**, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:*

5.23 I have visited the web site of World Intellectual Property Organization (WIPO) searching similar provisions that WIPO follows in its domain name disputes resolution policy. Paragraph 4 (b) of Uniform Domain Name Dispute Resolution Policy followed by WIPO cites 4 instances instead of 3 found in paragraph 6 of INDRP as evidence of registration and use in bad faith. Except the presence of one additional instance, Paragraph 6 of INDRP is a replica of paragraph 4(b) of Uniform Domain Name Dispute Resolution Policy followed by WIPO. WIPO decisions also indicate consideration of other factors in determining bad faith element under the heading "other considerations". For example, the following factors among others are considered in arriving at a bad faith decision:

- (a) false contact information
- (b) use of privacy service
- (c) speculation in domain names
- (d) inconceivable legitimate use

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- (e) inactive web sites
- (f) infringement of Complainant's IP rights
- (g) prior knowledge/notice of mark
- (h) disclaimer
- (i) cease and desist letter
- (j) tarnishment
- (k) parking /landing pages

5.24 INDRP permits consideration of factors other than those specified thereunder in arriving at a decision on bad faith element.

5.25 The Complainant is the prior adopter and user of the mark **SENSEX** and has been using the mark **SENSEX** from 1986. The mark **SENSEX** has gained secondary significance in respect of goods/services of the Complainant by virtue of such long continuous use. The disputed domain name <sensex.in> wholly incorporates the mark **SENSEX** of the Complainant. The Complainant has Indian registration for the mark **SENSEX** and such registration is in force today.

5.26 Respondent himself admitted that the Complainant has been using the mark **SENSEX** for a long time. The mark **SENEX** was being used by the Complainant when the Respondent registered the disputed domain name <sensex.in>. Respondent is not an illiterate but has a master's degree in business administration with a specialization in Finance. He desired to disseminate information about the investment markets in India through

internet and adopted the disputed domain name <sensex.in>. When the Respondent adopted the disputed domain name <sensex.in>, the mark **SENSEX** of the Complainant is well known in the financial markets in India and abroad. Though the Respondent has advanced arguments negating the contentions of the Complainant, he has not come up with any affirmative reason for adopting the disputed domain name <sensex.in>. Respondent put strong reliance on certain disputes raised by third parties against the Complainant involving the mark **SENSEX**. Such disputes are either irrelevant to the current proceedings or decided in favour of the Complainant. The Respondent has no reason to adopt the disputed domain name <sensex.in>. The very adoption by Respondent of the disputed domain name <sensex.in> is malafide and dishonest.

5.27 The Respondent seeks that the dispute resolution should recognize the constitutional right of a citizen in India to carry on a vocation or business of his choice without transgressing the law of the land. But he had chosen not to respond to the notices sent by the Complainant. On discovery of the Respondent's disputed domain name <sensex.in>, the Complainant through its attorneys wrote to the Respondent herein vide an e-mail dated 24th July 2007 to cease and desist from using the disputed domain name or any other domain name or variation confusingly and/or deceptively similar to the Complainant's trade mark "**SENSEX**" and to apply to the Registrar Direct Information Private Limited for cancellation of the registration of the impugned domain name or alternatively, to transfer



the impugned domain name in favour of the Complainant, within 15 days of receipt of the notice. A reminder letter/e-mail dated 15th November 2007 was also sent by the Complainant through its Attorneys to the Respondent. Thereafter, Respondent's Advocate, Mr. Amit Shroff, through his letter dated 19th November, 2007, asked the Complainant's Attorney to provide him with a copy of the Complainant's Attorney's letter dated 15th November, 2007 as the Respondent was out of station. A copy of the Complainant's Attorney's letter dated 15th November, 2007 was sent to the Respondent's Advocate vide letter dated 19th November, 2007 of the Complainant's Attorney. Thereafter, the Complainant's Attorney received a letter from one Mr. Sunil Vikamsey, on behalf of the Respondent, on 3rd December, 2007, wherein the said Mr. Sunil Vikamsey acknowledged the receipt of the letter dated 15th November, 2007 of the Complainant's Attorney and sought some time to revert. However, till date the Respondent has not replied to the e-mail dated 24th July 2007, the letter/e-mail dated 15th November 2007 or the letter dated 19th November, 2007. The conduct of the Respondent clearly shows that the Respondent has nothing on merits to answer the Complainant's mails/notices. Respondent's contention that the mails/notices of the Complainant were an attempt to intimidate the Respondent with the threat of damages and criminal action on a non-existent right is clearly an afterthought, without any substance and cannot be accepted.



5.28 The Respondent argued that as a means of abundant expression of good faith he has placed prominent disclaimers on his site to indicate that his site or service is in now way connected with the Complainant. I have visited the site of the Respondent. There is no disclaimer prominently on the home page or first page of the site. A click on the disclaimer button at the bottom of the page leads to the following disclaimer on a separate page:

Sensex.in is run independently of Bombay Stock Exchange (BSE) and it has no connection with the BSE or its affiliates whatsoever.

5.29 It may be noted that the Respondent had the knowledge that the well known mark SENSEX was being used by the Complainant for decades when he adopted the disputed domain name <sensex.in>. Respondent has not yet started using the disputed domain name <sensex.in>. The above facts have established malafide and dishonest adoption of the disputed domain name <sensex.in> by the Respondent. A disclaimer will not cure a malafide and dishonest adoption. Therefore, the disclaimer irrespective of the location where it is displayed will not help the case of the Respondent.

5.30 The Respondent argued the Respondent has registered only the disputed domain name <sensex.in> and <sensex.net.in>. The Complainant already holds the domain name <sensex.co.in>. The Complainant was therefore well aware that he had access to the use of the domain name "Sensex" with the TLD extension .co.in and the Respondent had not tried

to register multiple names so as to prevent the use of the name "Sensex" by the Complainant. The presence of other domain names in the name of the Complainant will not entitle the Respondent to adopt the disputed domain name <sensex.in> incorporating the registered trade mark of the Complainant. Further the Respondent cannot rely on the alleged adoption and or use of marks similar to the registered mark **SENSEX** of the Complainant by others. Adoption and or use by others will not cure the dishonest and malafide adoption of the disputed domain name <sensex.in> by Respondent.

5.31 The above discussions have clearly established bad faith element in favour of the complaint as follows:

- (a) The adoption of the disputed domain name <sensex.in> by Respondent is dishonest and malafide. It is for unlawful financial gain to attract internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's registered trade mark **SENSEX** as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.
- (b) The adoption and registration of the disputed domain name <sensex.in> by the Respondent is hampering the potential business and services that the Complainant is likely to and has the capacity to provide on-line, as it is common knowledge that most internet surfers now use the suffix **'.in'** to track down a business or service. The registration and use of the disputed domain name



<sensex.in> by the Respondent is causing detriment and disadvantage to the Complainant, resulting in financial loss to the Complainant.

- (c) Considering the popularity and advent of conducting and accessing banking business and/or financial services over the internet, the Complainant is restricted from using the internet as a vehicle for expanding their business possibilities and interaction with the public at large across the world due to the illegitimate adoption of the disputed domain name <sensex.in> by the Respondent.

5.32 The above facts and circumstances have necessitated me to award costs of the Complaint to and in favour of the Complainant. I will normally award costs in the range of Rs.5 lacs. But in this case, the Respondent has all along conducted himself in a very cooperative and constructive manner. Therefore, I fix Rs.2,00,000/- (Rupees two lakh only) as costs and the Complainant and the Respondent shall equally bear the costs. Therefore, I order Respondent to pay Rs.1,00,000/- (Rupees one lakh only) towards costs to the Complainant.

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6. Decision

6.1 For all the foregoing reasons, the Complaint is allowed as prayed for in the Complaint.

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

6.3 Respondent is ordered to pay the Complainant a sum of Rs. 1,00,000/- (Rupees one lakh only) towards costs of the proceedings.



S.Sridharan

Arbitrator