



தமிழ்நாடு தமில்நாடு TAMILNADU

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BEFORE S SRIDHARAN, SOLE ARBITRATOR

OF NATIONAL INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

DATED: 15th February 2014

Microsoft Corporation, USA

Versus

Complainant

Leonard Syler, Germany

Respondent

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Leonard Syler, Germany	...	Respondent

1. The Parties

- 1.1 The Complainant, Microsoft Corporation is a company organized and existing under the laws of the State of Washington, USA, having its principal office at One Microsoft Way, Redmond, WA 98052-6399, USA represented by Mr.Pravin Anand and Ms Jaya Negi of Anand & Anand, Advocates at First Channel, Plot No.17A, Sector 16A, Film City, Noida, India
- 1.2 Respondent is Leonard Syler, at Feldstr. 53-58 Hamburg, Germany.

The Domain Name and Registrar

- 1.3 The disputed domain name < xboxonegiveaway.in > created on 26.11.2013 is registered with Key-Systems GmbH (R48-AFIN).

2. Procedural History

- 2.1 On 20th January 2014, NIXI asked me about my availability and consent to take up the Complaint for arbitration. On the same day, I informed my availability and consent. I also informed NIXI that I had no conflict of interest with either of the parties and could act independently and impartially.
- 2.2 On 24th January 2014, I received hardcopy of the Complaint.
- 2.3 On 27th January 2014, I issued by email 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 an email about my appointment to arbitrate the complaint to the Complainant and asked the Complainant to send a soft copy of the complaint to me.
- 2.4 On 31st January 2014, NIXI informed me that the complaint copy sent to the Respondent by courier was returned due to incorrect postal address and sought my directions. I directed NIXI to serve by email the soft copy of the complaint along with annexures on the Respondent.
- 2.5 On 3rd February 2014, I received soft copy of the Complaint from the Complainant.
- 2.6 Respondent has not filed any response to the Complaint.

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- 2.7 Email is the medium of communication of this arbitration and each email is copied to all, Complainant, Respondent and NIXI.

3. Factual Background

A Complainant

- 3.1 The Complainant was set up in the year 1975 and is the biggest software publisher for personal and business computing in the world. The Complainant engages in the development, manufacture, licensing, and support of a range of software products for various computing devices. Its software products include operating systems for servers, personal computers (PC), and intelligent devices; server applications for distributed computing environments; information worker productivity applications; and software developments tools. The Complainant also sells video game console (Xbox), video games and engages in online business through various Internet portals (MSN etc.).
- 3.2 The Complainant's popular software products include the most widely used operating system software, MICROSOFT WINDOWS (various versions), and application software such as MICROSOFT OFFICE (various versions) and VISUAL STUDIO (various versions). These software programs are today installed and used on millions of computers all over the world, including India. Other popular software products of Complainant include Microsoft Windows Server System, Microsoft Publisher, Microsoft Visio, Microsoft Project and other stand-alone desktop applications.
- 3.3 Apart from computer software programs, the Complainant also manufactures a large range of computer peripherals (hardware). The Microsoft Hardware group established in 1982 has been an integral part of the Plaintiffs' growth for 27 years. During this period, the Complainant has built its reputation for technological expertise in hardware by developing and launching a series of successful devices including the ergonomically designed Mouse and Keyboard.
- 3.4 The Complainant, Microsoft Corporation, has a current Market Capitalization of 308.12B as on 6th January 2014. This is ahead by leaps and bounds of other well-known and famous trademarks. A copy of the excerpts from www.finance.yahoo.com showing the Complainant's market capitalization as on 6th January 2014 is attached.
- 3.5 The Complainant adopted the trademark "MICROSOFT" in the year 1975 and has used the said trademark continuously and extensively, not only as a trademark but also as a prominent, key, and leading portion of its corporate name. The trademark "MICROSOFT" is one of the most famous and well known trademarks in the world and is exclusively identified and recognized by the purchasing public as relating to the goods and services of the Complainant and no one else.
- 3.6 The Complainant is also the undisputed owner of the world famous mark "XBOX" in connection to the goods and services offered by the Complainant. The Complainant has obtained trademark registrations in over 100 countries across the world, including India, for the "XBOX" mark in several classes of goods and services.
- 3.7 The Complainant has used the XBOX mark for video game entertainment systems, software and accessories in the United States, China and around the world, for more than a decade. The Complainant vide mail dated 12.2.2014 clarified that XBOX mark has been widely used by the Complainant since January 2001 when the advertising campaign for the gaming console was first launched in USA.

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- 3.8 In 2002, the Complainant introduced XBOX LIVE which allows consumers to play XBOX games against other online players, among other benefits. In 2005, the Complainant introduced its second generation gaming console and platform under the trademark "XBOX 360". As of January, 2012, the Complainant had sold more than 66 million XBOX 360 consoles and had nearly 40 million Xbox LIVE members.
- 3.9 The Complainant has invested significant time, effort and money advertising and promoting the XBOX Mark throughout the world and hence has acquired the "well-known" status. The Complainant is also the registered proprietor, in India of the trademark "X BOX". The Complainant's registrations for the said mark are given below :
- (i) Registration No.995765 under class 09
 - (ii) Registration No.1236625 under class 41
 - (iii) Registration No. 918607 under class 09
- 3.10 The said registrations have been duly renewed from time to time and are valid and subsisting under the Trademarks Act, 1999.
- 3.11 The Complainant through its website www.xbox.com provides information about the Xbox Consoles, games and accessories and offers these items for sale. Printout from the Complainant's website is annexed. The Complainant at present owns a number of domain names, the majority of which contain the "XBOX" mark.
- 3.12 It is submitted that the Complainant's rights in the trademark XBOX its variations/ service names and other deceptively similar marks have been upheld before by various panels.
- 3.13 "XBOX" is a "well-known" mark as understood under Article 6 bis of the Paris Convention. Just because some words have been added as prefix or suffix portions it shall not take away the distinctiveness of the said word.
- 3.14 The Respondent in the present dispute has registered the domain <xboxonegiveaway.in> by misappropriating illegally and without authority the trademark XBOX which is the exclusive property of the Complainant.
- 3.15 The Complainant on perusal of the disputed domain name < xboxonegiveaway.in > learnt of the unauthorized and blatant use of its trademark 'X BOX' along with the logo. The Respondents have gone ahead and advertised free distribution of the famous gaming and entertainment console "X Box One" marketed and developed by the Complainants. The impugned website guides the visitor to a three – step process to win a free "X Box One". Moreover, on further inspection, it was revealed that website's first step of the said process involved further advertising of the impugned website on social networking websites such as "Facebook".
- 3.16 The Complainant has filed annexures A to J along with the Complaint.

B Respondent

- 3.17 The Respondent has not filed any reply to the Complainant's Complaint in this arbitration.

4. Parties Contentions

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A Complainant

- 4.1 The disputed domain name < xbxonegiveaway.in > includes the word "xbx", which is identical and confusingly similar as a whole to the well-known and registered trademark XBOX in which the Complainant has statutory rights as well as rights in common law, by virtue of a long and continuous user and being its registered proprietor thereof.
- 4.2 Furthermore due to the above mentioned factors, the trademark 'XBOX' has acquired distinctiveness and is exclusively identified with the Complainant's services. As such the use of the word 'XBOX' in the disputed domain name < xbxonegiveaway.in > would be understood as a reference to the Complainant thus perpetuating confusion among consumers who wish to access the Complainant's web page.
- 4.3 The Complainant has spent substantial time, effort and money advertising and promoting the 'XBOX' mark throughout the world. As a result, the "XBOX" mark has become distinctive and well known, and the complainant has developed an enormous amount of goodwill in the mark, which goodwill has been recognised by UDRP panels.
- 4.4 Since the disputed domain name < xbxonegiveaway.in > comprises of a well-known and famous trademark 'XBOX', it is evident that the Respondent can have no right or legitimate interest in the domain name. Further, it is apparent that the sole purpose of registering the domain name is to misappropriate the reputation associated with the Complainant's famous trademark 'XBOX'.
- 4.5 The disputed domain name < xbxonegiveaway.in > advertises the distribution of the world famous gaming console "X Box One" developed and marketed by the Complainant along with the use of the Complainant's trade mark "XBOX" and their logo, therefore, it is obvious that not only does the Respondent have knowledge of the Complainant's world famous trademark "XBOX" but the only purpose behind registering the disputed domain name < xbxonegiveaway.in > can only be to encash on the goodwill attached to the Complainant's trademark/ name by selling the domain name for profit or in the alternative, preventing the Complainant from registering a domain name in which it has full legal rights or any other malicious intention as displayed by the Respondent.
- 4.6 Further, the Respondent is not commonly known by the domain name nor has he made any demonstrable preparation to use the disputed domain name < xbxonegiveaway.in > name in connection with a commercial or bona fide purpose.
- 4.7 The Respondent has no rights or legitimate interest in the domain name as:
- (a) The Respondent is not a licensee of the Complainant and neither has the Complainant granted any permission or consent to the Respondent to use the trademark 'XBOX' or any variation thereof in any manner or to incorporate the same in a domain name.
 - (b) The Respondent's website is not bona fide as the Respondent has registered the impugned domain name in order to cause initial interest confusion and bait internet users to accessing its website.
 - (c) The Respondent has not shown any demonstrable preparation to use the domain name in connection with a bona fide offering of goods and services.
- 4.8 The Respondent's website is not bona fide since the Respondent is trading on the fame and recognition of the Complainant's well-known trademark in order to cause initial interest confusion and bait internet users to accessing its website is typically the strategy of such

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cyber-squatters. Furthermore, an average internet user will be forced to believe that the website < xboxonegiveaway.in > is related to the Complainant thereby furthering the elements of confusion and dilution through the use of the disputed domain name < xboxonegiveaway.in >.

- 4.9 The Respondent has no bona fide intention to use the disputed domain name < xboxonegiveaway.in > and the same has been registered only for the purpose of trafficking and for the sole purpose of causing irreparable damage and injury to the Complainant's goodwill and reputation, resulting in dilution of the Complainant's trademark and/or service mark. The mala fide intentions of the respondent to reap unfair rewards by registering the disputed domain name < xboxonegiveaway.in > are clear from the above stated actions. Hence, the Respondent has no rights or legitimate interest in the domain name.
- 4.10 Due to all the above mentioned factors, the Complainant's 'XBOX' mark is a well known mark and the Respondent is presumed to have had knowledge of Complainant's mark at the time it registered the confusingly similar domain name. This indicates that the Respondent was well aware of the reputation and goodwill attached to the Complainant's trademark/name. Thus this is prima facie evidence of the Respondent's bad faith use and registration. Therefore, the disputed domain name < xboxonegiveaway.in > has only been registered in bad faith for monetary gains. Registration of a famous trademark without legitimate commercial interests in the same is prima facie evidence that the Respondent was well aware of the reputation and goodwill attached to the Complainant's trademark/name. Thus the Respondent has registered the web site in bad faith.
- 4.11 Further, there is a likelihood that an actual or potential visitor to the Respondent's present web page or any future webpage that the subject domain name resolves to, will be induced to:
- (a) Believe that the Complainant has licensed their trademark 'XBOX' to the Respondent or has authorized the Respondent to register the disputed domain name.
 - (b) Believe that the Respondent has some connection with the Complainant in terms of a direct nexus or affiliation with the Complainant or has been authorised by the Complainant.
- 4.12 Thus the disputed domain name <xboxonegiveaway.in> has been registered and is being used in bad faith.

B. Respondent

- 4.13 Respondent has not filed any reply to the Complainant's Complaint in this arbitration.

5. Discussion and Findings

- 5.1 Respondent has not filed his response. I have not received any communication from him until the date of this award. Therefore, I am proceeding to determine this Complaint on the basis of the materials available on record.
- 5.2 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.

5.3. 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.

5.4 The Complainant is the proprietor of the mark XBOX. Complainant has been using XBOX as a trade mark continuously since 2001. The Complainant owns numerous registrations for the trade mark XBOX in many countries around the world including India. In India, the first registration of the Complainant under No.918607 in class 09 dates back to 17.4.2000. The Complainant's domain name www.xbox.com was created on 18.12.1996. The disputed domain name <xboxonegiveaway.in> was created on 26.11.2013. Obviously, the Complainant is the prior adopter of XBOX mark. The above facts have established that the Complainant has statutory and common law rights in respect of its XBOX mark.

5.5 The Complainant's XBOX mark is famous and well known throughout the world including India. It is clearly seen that the disputed domain name <xboxonegiveaway.in> wholly incorporates the prior registered mark XBOX of the Complainant. XBOX is the predominant part of the disputed domain name <xboxonegiveaway.in> and the expression - one give away - is purely descriptive and is not distinguishing part of the domain name. Therefore, this expression - one give away - and the country level suffix ".in" need to be disregarded when determining the similarity or identity with the Complainant's XBOX mark. The disputed domain name <xboxonegiveaway.in> is similar to the Complainant's domain name www.xbox.com.

5.6 I, therefore, find that:

- (a) The Complaint has common law and statutory rights in respect of its XBOX mark.
- (b) The disputed domain name <xboxonegiveaway.in> is:
 - (i) Similar to the Complainant's prior registered trade mark XBOX, and
 - (ii) Similar to the Complainant's domain name www.xbox.com.

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

5.7 It is already seen that:

- (a) The Complainant is the prior adopter and user of the XBOX mark. The Complainant's XBOX mark is well known in many countries across the globe including India.
- (b) The Complainant's XBOX mark was adopted in the year 2001. The first Indian registrations for the mark XBOX was obtained in 2000. The Complainant's domain name www.xbox.com was created on 18.12.1996. The disputed domain name <xboxonegiveaway.in> was created on 26.11.2013.

5.8 Respondent did not register the disputed domain name until 26.11.2013. Complainant has adopted and used the mark XBOX and a domain name containing the mark XBOX before Respondent registered the disputed domain name <xboxonegiveaway.in>. It is unlikely

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that the Respondent was unaware of existence of Complainant's trademark and domain name rights before registering the disputed domain name <xboxonegiveaway.in>.

5.9 I have visited the web site of the Respondent under the disputed domain name <xboxonegiveaway.in>. It has led to a web page containing the notice:-

*This account has been suspended.
Either the domain has been overused, or the reseller ran out of resources.*

It is obvious from the above notice that the Respondent never intended to use the disputed domain name <xboxonegiveaway.in> in connection with a bona fide offering of goods or services.

5.10 In the absence of any reply from the Respondent, I agree with the contentions of the Complainant:

- (a) The Respondent is not commonly known by the disputed domain name <xboxonegiveaway.in> nor has he made any demonstrable preparation to use the disputed domain name <xboxonegiveaway.in> in connection with a commercial or bona fide purpose.
- (b) The Respondent is not a licensee of the Complainant and neither has the Complainant granted any permission or consent to the Respondent to use the trademark 'XBOX' or any variation thereof in any manner or to incorporate the same in a domain name.
- (c) The Respondent's website is not bona fide since the Respondent is trading on the fame and recognition of the Complainant's well-known trademark in order to cause initial interest confusion and bait internet users to accessing its website is typically the strategy of such cyber-squatters. Furthermore, an average internet user will be forced to believe that the website <xboxonegiveaway.in> is related to the Complainant thereby furthering the elements of confusion and dilution through the use of the disputed domain name.

5.11 Therefore, I have no hesitation to hold, for the above reason that the Respondent has no right or legitimate interest in respect of the disputed domain name <xboxonegiveaway.in>.

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

5.12 The Complainant is the proprietor of the mark XBOX. Complainant has been using XBOX as a trade mark continuously since 2001. The first Indian registrations for the mark XBOX was obtained in 2000. The Complainant's domain name www.xbox.com was created on 18.12.1996. The disputed domain name <xboxonegiveaway.in> was created on 26.11.2013. Obviously, Complainant's rights in the XBOX mark pre-date Respondent's registration of the disputed domain name <xboxonegiveaway.in>. The Respondent could not have ignored, rather actually influenced by, the well-known XBOX mark of the Complainant at the time he acquired the disputed domain name <xboxonegiveaway.in>.

5.13 As seen above, Respondent is currently not using the disputed domain name <xboxonegiveaway.in> in any manner. The Respondent is no way connected with the Complainant. Respondent's adoption of the disputed domain name <xboxonegiveaway.in> is nothing but an unjust exploitation of the well-known reputation of the Complainant's prior registered XBOX mark.

5.14 Respondent's lack of response to the Complaint indicates that the Respondent has no reason and/or justification for the adoption of the Complainant's XBOX mark.

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- 5.15 Thus it is clearly established that Respondent registered the disputed domain name <[xboxonegiveaway.in](#)> in bad faith.
- 5.16 The actions of the Respondent should not be encouraged and should not be allowed to continue. Respondent never intended to put the disputed domain name <[xboxonegiveaway.in](#)> into any fair/useful purpose. Respondent not even considered it worth responding the complaint of the Complainant. Respondent did not file any response. The conduct of the Respondent has necessitated me to award costs of the Complaint to and in favour of the Complainant.

6. Decision

- 6.1 For all the foregoing reasons, the Complaint is allowed as below.
- 6.2 It is hereby ordered that the disputed domain name <[xboxonegiveaway.in](#)> be transferred to the Complainant.
- 6.3 Respondent is ordered to pay the Complainant a sum of Rs.10,00,000/-(Rupees ten lakh only) towards costs of the proceedings.


S. Sridharan
Arbitrator