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BEFORE SHRI SANJAY KUMAR SINGH  
ARBITRATOR

IN DOMAIN NAME DISPUTE RESOLUTION  
POLICY (INDRP)

**IN RE:**

**Suresh Kumar Sareen,**  
16/2, Mathura Road,  
Faridabad- 121 002

**.Complainant**

Versus

*Jim J*  
Gustav- Heinemann-Str. 15a  
Street 1:8205 Wanstraw Way  
City: Apex  
State/Province: NC  
Postal Code: 27539  
Country: United States of America

**..Respondent**

**THE PARTIES:**

The complainant is Suresh Kumar Sareen, R/o 16/2  
Mathura Road, Faridabad- 121 002.

*Sanjay Kumar Singh*

The Respondent is Mr. Jim J of Gustav- Heinemann-Str. 15a, Street 1:8205 Wanstraw Way, City: Apex, State/Province: NC, Postal Code No.27539. United States of America.

**2. DOMAIN NAME AND TRADEMARK IN DISPUTE:**

Domain name of the respondent is isp.in

The trademark of the complainant is "ISP". The registry is National Internet Exchange of India (NIXI).

**3. BRIEF BACKGROUND:**

This arbitral proceeding commenced in accordance with IN Dispute Resolution Policy (INDRP) and rules framed thereunder.

The complainant submitted his complaint in the registry of NIXI on 31.01.2006. Shri Sanjay Kumar Singh was appointed as Sole Arbitrator in the matter by NIXI.

It is alleged by the complainant that he is registered owner of the trademark "ISP" vide Registration date 26.12.1975 and certificate no. 133406 has been duly issued by the trademark registry at Mumbai. He has further alleged that the trademark has been issued in respect of the Wiper (screen) for motor car included in the class-12. It is further alleged by the complainant that he has been using this logo

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trademark for many years and the same is also published in the journal.

A copy of complaint has already been sent to the respondent by the .In Registry through e-mail. Upon receipt of the complaint, the Arbitrator sent a notice dated 10.04.2006 to the respondent to send his defence/ counter to the complaint alongwith supportive documents/evidence at his e-mail address within 10 days from receipt. But the respondent did not come forward and send his defence/ counter to the complaint.

Failing to send the defence/ counter by the respondent, the Arbitrator again sent a notice dated 19-07-2006 by giving another opportunity to the respondent to send his defence/ counter to the complaint with further notice that in default of non-filing or sending of the defence/ counter to the complaint, the matter would be proceeded ex-parte.

Failing to send the defence / counter by the respondent, the Arbitrator again sent a notice dated 24-08-2006 by giving last and final opportunity to the respondent to send his defence / counter to the complaint with further notice that in default of non-filing or sending of the defence / counter to the complaint, the matter would be proceeded ex-parte. It was also stated in the notice that it was last and final opportunity to the respondent an no further opportunity will be given.

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Inspite of repeated notices, the respondent has again not come forward and has not sent any reply/ defence/ counter to the either notice or complaint to the Arbitrator. Therefore, this matter is being decided ex-parte as per law of the land.

#### 4, \_\_\_PARTIES' CONTENTIONS:

- (i) The complainant has alleged that domain name of the respondent is identical and confusingly similar to his trademark in which he has rights.
- (ii) The complainant has further alleged that respondent has no rights or legitimate interest in respect of domain name and that respondent has no registered trademark of the said domain name and he has no affiliation with India.
- (iii) The complainant has further alleged that the domain name is registered by the respondent and is used by him in bad faith. The complainant has further alleged that the respondent has no plans to develop domain name into business and his intention is to sell domain name to him or to any other organization. The complainant has further alleged that the respondent is speculator and had registered various domain names for which he has no right or trademark. The complainant

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has further alleged that the respondent has put domain name on website to lure customers and sticking them on clicks on advertisement for his profit. The complainant has further alleged that the respondent has put other domain name such as CELEBRITY.IN, CELLULAR.IN, CHIME.IN, CONNECT.IN, CORPORATEGIFTS.IN, EMAILS.IN, FIELDHOCKEY.IN, FUTBOLIN, HOMEEQUITYLOAN.IN, ISNOT.IN, ITJOBS.IN, LAB.IN, LOCAL.IN, REFINANCING.IN, WAS.IN, WAY.IN, YAATRA.IN, RESTAURANT.IN on website to lure customers to his website so as to gain profit.

The complainant has sought the relief of transfer of domain name **isp.in** to him.

**5. OPINION/FINDING:**

The para no.4 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:-

**TYPES OF DISPUTES**

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Any person who considers that a domain name conflicts with his legitimate rights or interest may file complaint to .IN Registry on following premises:

- "i) the Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights;
- ii) the Registrant has no rights or legitimate interests in respect of the domain name and
- iii) The Registrant's domain name has been registered or is being used in bad faith."

**The para no.6 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:**

**6. EVIDENCE OF REGISTRATION AND USE OF DOMAIN NAME IN BAD FAITH**

**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:**

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**"i) Circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the domain name; or**

**ii) the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or**

**ii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or**

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location or of a product or service on the Registrant's website or location."

The para no.7 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:-

**7. REGISTRANT'S RIGHTS TO AND LEGITIMATE INTERESTS IN THE DOMAIN NAME**

Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purpose of paragraph 4 (ii):

- "i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstratable preparations to use, the domain name or a name corresponding to the domain name in connection with a bonafide offering of goods or services;
- ii) the Registrants (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant

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has acquired no trademark or service mark rights; or

- iii) the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

It is to be noted that prior to INDRP Policy there was other Dispute Resolution Policy, which was formulated and approved by ICANN. It is called Uniform Domain Name Dispute Resolution Policy (UDRP). The INDRP is substantially similar to this policy.

Before going into the merits and contentions raised by the complainant it has become necessary to give a finding as to upon whom the onus is there to prove the three conditions of para no. 4 of INDRP Policy.

That in Indian Evidence Act Section 101, 102, 103 clearly provides that onus of proof of a fact is upon a person who alleges that fact and whose case will fail if such fact is not proved.

It is most be noted that the para no.4 of the INDRP policy starts with following words, "Any person who considers

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that a registered domain name conflicts with his legitimate rights or interest may file complaint to the registry on following premises." This is a positive assertion and sentence.

Further paragraph 4(i) also constitutes a positive assertion and sentence. Paragraph 4(iii) and para no.6, which is supplementary/explanation to it, also have positive assertions/sentences.

The above clearly indicates that the onus of proving the contents of para no.4(1) and 4(iii) are upon complainant. To succeed he must prove them.

Para no.4(H) has also positive assertions/sentences but para no.7, which is supplementary and explanation it indicates besides others, the circumstances whereby the respondent could show that he has right or legitimate interest in the domain name. The contents of para no.7 have positive assertions/sentences, and they are the facts, which could be proved by the respondent himself. These facts are in special knowledge of respondent.

Since para no.4(H) has positive assertions and since the circumstances mentioned in para no.7 are not exhaustive, as such there could be circumstances by which complainant can show that respondent has no rights or legitimate interest in

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Domain name. Thus the combined effect of para no.4(ii) and para no.7 is that, the initial burden of proof of their contents, is on complainant, which should not be very strict and if he is prima facie able to discharge this burden, then it', would heavily shift upon respondent, who has to prove the positive assertions made in para no.7, that he has right and legitimate interest in domain name. He can prove this by direct positive and congest evidence, which is in his special knowledge and power.

The WIPO's website "nt EP/larbiter.WIPO.int domains/search.overnew/index btml", wherein it is stated that "if complainant makes out a prima facie case, that respondent has no rights or legitimate interest, and respondent fails to show one of the circumstances of paragraph 4(c)", (similar to para no.7 of INDRP).

That as per WIPO case-D-2000-1816 and WIPO case-D-2000/797, which also states that burden of proof in arbitral proceeding in respect to para no.4 are upon complainant.

The UDRP & INDRP policy are substantially same and they have similar characteristics. The clause in UDRP policy "In the administrative proceedings the complainant must prove that each of these elements of paragraph no.4 are present" is only a clarifying clause, which clarifies that all the

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three elements of paragraph no.4 are to be proved and if any one of them is not proved, then, complainant would not succeed. This is also evident from WIPO cases. Moreover as discussed above the language of paragraph 4(i) to (iii) and para no.6 and 7 is clear and unambiguous, which show as to upon whom the onus if there.

The provisions of sections 101 to 103 of Indian Evidence Act also show that onus in present proceedings is primarily on complainant.

Further if the complainant fails in proving his complaint then he could be made liable for reverse domain hijacking. This also shows that complainant prima facie has to prove the contents of the complaint or else he could face adverse consequences of his failure/false complaint.

The other fact, which is to be dealt with before going into merit is, that, as to whether, the cases decided by WIPO - Administrative Panel could be considered, while deciding the present controversy. Moreover these cases throw light upon various important aspects of controversy. As such they would be considered, while deciding the present controversy, in so far as they do not conflict with INDRP.

*Lawyer for 2 -*

## 8. OPINION AND FINDINGS ON MERITS

A) Whether the domain name is identical or confusingly similar to a trademark in which complainant has right

It has been held in Indian decision **M/s Satyam Infoway Ltd. Vs. M/s Sifynet Solution (P) Ltd. JT. 2004 (5) SC 541**, that Domain name has all characteristics of trademark. As such principles applicable to trademark are applicable to domain names also. In the said case the words, 'Sify' & 'Siffy' were held to be phonetically similar and addition of word 'net' in one of them would not make them dissimilar. As per WIPO case D-2005-1087 in which Domain names 'Jded word biz' and trademarks JD EDWARDS/JDEDWARDS & Co., and JDED words and computers, were in question. It was held that Domain name has trademark in it entirely and as such they are identical. In the present case the domain name is '**isp.in**' and trademark is '**ISP**'. They are phonetically, similar and they both consist of similar 'letters or words' except that in Domain name letters, 'in', are added. The domain name also contains trademark in entirety. They are also similar in appearance. As such they both are identical and confusingly similar.

The other aspect is that the spheres of user of trademark and domain name, and the manner in which they are used or

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sought to be used. As per WIPO case D-2002-0693, wherein it's held that it's irrelevant that domain name or trademark carry on business in different fields, when they are similar phonetically or in appearance. It is held in Indian case **JT.2004 (5) SC 541**, that in modern times domain name is accessible by all internet users and thus there is need to maintain it as an exclusive symbol. It is also held that it can lead to confusion of source or it may lead a user to a service, which he is not searching.

Thus conclusion is that domain name and trademark, which may be used in different manner and different business or field, or sphere can still be confusingly similar or identical.

Thus the conclusion is that the domain name of respondent is identical and confusingly similar to the trademark of complainant.

Now the other important aspect that needs consideration is, as to whether the complainant has right in the trademark. It is important to mention here that as per the claim of the complainant the respondent has no trademark on the said domain name and has no affiliation with India whereas the trademark "ISP" was registered in December, 1975 in favour of the complainant and certificate of registration was issued by the Office of the Trade Mark Registry Central Building 101 M.K

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Road, Mumbai-400020. Thus the trade mark "ISP" was in existence at time of registration of domain name by the Respondent. The trademark of complainant is 'ISP'. It is pertinent to mention here that "ISP" is also abbreviation of "INTERNET SERVICE PROVIDER". It is a common word, has a dictionary meaning, it is extensively used. Thus it's a generic word, which can be used by anyone and not exclusively by one person as a matter of right. Reference is also drawn to sections 9 and 32 of The Trademark Act 1999, which prohibit use and registration of trademarks, which consists of common or generic words. To acquire exclusive right to use words like 'isp' as trademark, the complainant must show that the word had/has acquired secondary meaning before registration or after registration. He has acquired reputation or goodwill in it or that he is known or recognized or associated with it in or outside market. He must show that he has acquired these by extensive user, length and extent of sales, advertisement, length and extent of sales, consumer surveys, or by media recognition. Reference is also made to cases **2003(7) AD. Delhi 405, 2002(95) DLT-3 and 2002(97) DLT-1.**

This principle is settled in many above Indian cases and referred cases **JT 2004(5) SC 541 and 2004(5) SCC 287.** The complainant has only made submission that he has legitimate trademark in India, he is using trademark for many years , his Trade Mark was registered as far back as 1975 and

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the registration was issued by the Office of the Trade Mark Registry Central Building 101 M.K Road, Mumbai-400020. But these are bald and vague submissions, which are not substantiated by any evidence. These facts could have only been proved by complainant himself by direct positive and cogent evidence and the complainant has not proved their user also in business or trade.

Thus the conclusion is that though the domain name 'isp.in' is identical and confusing similar to the trademark of complainant 'ISP', but the complainant has failed to show/prove that he has right in the trademark, which is a generic word.

Whether the respondent has no right or legitimate interest in the domain name got registered by him

As already stated that paragraph 4(ii) of INDRP is to read with paragraph no.7. That in WIPO D-2005-0736, it is held that use of domain name by respondent should be bonafide without intent to mislead internet users or consumer or to divert them to his website and without our intent to tarnish trademark of complainant. These propositions are also in consonance with INDRP Policy.

That as per paragraph no.111 of INDRP and registration agreement (section 8.1), it's duty of respondent to ensure at

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time of registration of domain name, that it does not violate someone else's, right and that simple search by respondent would have shown that complainants trademark is already registered with trademark registry of Mumbai. Further, as per above para no.111 of INDRP and as per registration agreement, the respondent cannot knowingly use the domain name in violation of any applicable, laws or regulation or agreement, and that use of domain name by respondent is for lawful purposes.

As already stated that paragraph 4(ii) and 7 of INDRP are to be read together. Their combined effect is that, onus to prove the ingredients of these paras is prima facie on complainant. The onus is not very weak and prima facie, but it heavily shifts on respondent. Respondent can discharge the onus by direct cogent and positive evidence which are in his special knowledge and power. The complainant has made positive assertions that respondent has no legitimate right in domain name and there is no evidence of its use and the respondent has no trademark on the domain name neither he has affiliation with India. The complainant has made positive assertions regarding the fact that respondent has got registered various other domain names, in the .IN Registry for which the respondent has no right or trademark. The respondent has got registered various domain names as are already mentioned above. As such in above circumstance it is

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clear that the complainant has prima facie discharged the initial onus cast upon him by virtue of paragraph 4(ii) and 7 of INDRP.

The respondent on other hand has not come forward inspite of repeated notices to provide any positive, cogent and specific evidence that he is known or recognized by domain name, by its user and that he in fact uses it for providing goods or services. The respondent has neither put forth and has nor provided such evidence. The other aspect is as to whether the respondent has violated any laws, rules, regulations or policy as is alleged by the complainant. If paragraph nos.3,4 & 7 of INDRP is seen then such violation can only be, when the respondent uses or demonstrates preparation to use the domain name in a particular manner, like to divert or mislead internet users to his website, or to tarnish trademark of complainant malafidely or for commercial gain etc. The complainant asserts that "the respondent has put up the domain name on parking and is making money by luring customers to the website and tricking them into clicking Ads." The complainant also asserts that there is no evidence of use or demonstrable preparation to use or develop the domain name into a business by respondent also, and when there is no such evidence provided by respondent, then it cannot be said that respondent has caused any violation. The assertion of complainant is that the respondent at time of registering his domain knew or ought to have known about his

*Sawyer Krishna*

trademark and so he has violated complainant's right and the respondent has also violated paragraph no.3 of INDRP and clause 8.1 of registration agreement.

Thus the conclusion is that respondent has no right or legitimate interest in the domain name.

**Whether the respondent's domain name has been registered or is being used in bad faith**

It is to be seen as to whether the domain name has been got registered in bad faith. The paragraph no.4(iii) and 6 are relevant and as already stated, the onus is primarily upon complainant. The complainant has alleged that the respondent has got registered the domain name for selling it and that he also hijacks domain name to sell it for a profit. By referring to annexure-2(a) by a source of website, the complainant has alleged that the respondent has put up on "isp.in" and further this website clearly shows that the respondent has put the domain name on parking, and is making money by luring customers to the website and tricking them into clicking on Ads.

That in WIPO case it is held that parking of domain name with SEDO is bad faith. In a recent **WIPO case-D-2005-0736** wherein it was held that domain name parked with the SEDO are 5 times more likely to be so d and as such show the intention of selling, of domain holder and in another **WIPO case D-2005-1057** wherein it is held that if the domain name is got registered by respondent by knowing or

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keeping in mind the trademark of the complainant then this will constitute bad faith.

Thus from above discussion it's clear that the parking of domain name for making money by luring customers to the website and tricking them into clicking on Ads etc. are relevant factors in presuming or judging the intention of respondent of selling, renting or transferring etc of domain name and his intention to prevent owner of trademark or service mark from reflecting the mark in corresponding domain name.

The complainant has alleged that respondent had registered many domain names in the **.IN Registry** for purpose of selling them. In evidence thereof he has filed annexure 2(b). It is observed here that One does not require so many domain names to carry business and more so when there is no evidence of such substantial business or use of domain name for providing of goods or services. Obviously, the domain name is got registered to sell, transfer or rent it or to prevent other owner of mark to reflect the mark in corresponding domain name. Parking and putting up domain name also reflect such intentions (**WIPO Case - D-2005-0736**).

Keeping in view above facts and circumstances it is thus clear that the respondent has registered so many domain names and in spite of repeated notices, he has not come forward and has neither provided any substantial evidence of

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using them for business or for offering of goods and services. Moreover, one does not need so many domain names to do business. Moreover respondent has put up the domain name on parking on the website. The obvious purpose for registering domain names is to sell, rent or transfer it or to prevent other owner of mark from reflecting it in corresponding domain name. Thus the conclusion is that the respondent has got registered his domain name "isp.in" in bad faith.

#### 9. CONCLUSION:

The domain name of the respondent is identical and confusingly similar to trademark of complainant. The respondent also does not have right or legitimate interest in the domain name. He has got it registered in bad faith, as such he is not entitled to retain the domain name and it is to be struck off from registry. The complainant is also not entitled to transfer of domain name to him, as he has also not established his bonafide rights in trademark as per law discussed above. The claim of the reverse hijacking of respondent also cannot be alleged in above circumstances.

Hence-the Domain name may be confiscated by registry and the same may be kept with it.

Delhi

Date: 4-10-06

*Sanjay Kumar Singh*  
(Sanjay Kumar Singh)

Arbitrator