

தமிழ்நாடு தமில்நாடு TAMILNADU

430  
10.4.2012

Saidhanan

Y 044188  
S. Mangalam  
S. MANGALAM  
STAMP VENDOR,  
66 MURTHY STREET,  
CHENNAI-600 033  
LICENCE No : 9942/89  
PHONE No: 2371 0754

BEFORE THE INTERNET EXCHANGE OF INDIA

Arbitration Award

Dated: 25<sup>th</sup> March 2012

Sberbank of the Russian

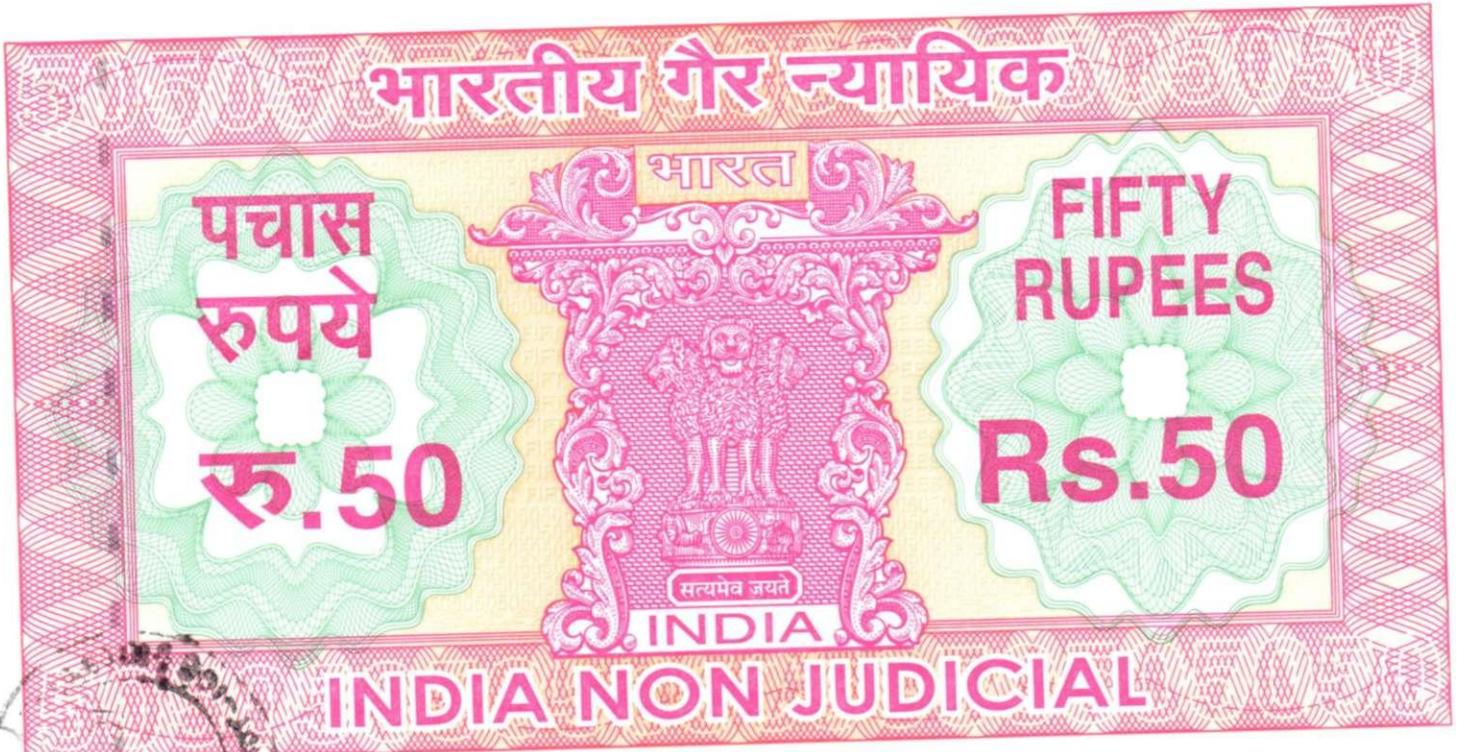
--- Complainant

-vs-

Dmitry Donetskov

--- Respondent

Saidhanan  
Arbitrator



தமிழ்நாடு தமில்நாடு TAMILNADU

Sridharan

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**BEFORE THE INTERNET EXCHANGE OF INDIA**

**ARBITRATION AWARD**

**ARBITRATOR: S.SRIDHARAN**

**DATED: 25<sup>th</sup> March 2012**

**Sberbank of the Russian,  
(contracted name Sberbank OAO)**

**Complainant**

**Versus**

**Dmitry Donetskov**

**Respondent**

**1. The Parties**

1.1 The complainant is "Sberbank of the Russian" (contracted name Sberbank OAO), a body corporate, incorporated and existing under the laws of Russia and having its registered office at 19, ul. Vavilova, Moscow 117997, Russia represented by Chetan Chadha, of Chadha and Chadha, Advocates, at F-46 Himalaya House, 23 K. G. Road, New Delhi.

1.2 Respondent is Dmitry Donetskov at 3, ul. Vitebskaya, Moscow 121354, Russia.

**The Domain Name and Registrar**

1.3 The disputed domain name **<sberbank.in>** is registered with Gdaddy.com Inc. (R101-AFIN).

**2. Procedural History**

*Sridharan*

- 2.1 On 24<sup>th</sup> May 2011, NIXI asked me about my availability and consent to take up the Complaint for arbitration. On 25<sup>th</sup> May 2011 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 1<sup>st</sup> February 2011, I received hardcopy of the Complaint along with Annexures.
- 2.3 On 04<sup>th</sup> June 2011, 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 07<sup>th</sup> June 2011, I received a soft copy of the Complaint from the Complainant.
- 2.5 On 17<sup>th</sup> June 2011, Respondent informed me that he was ready with the response and asked me about the form in which the response must be filed. I advised him that there was no particular format for response and he could file his response in a word file.
- 2.6 On 20<sup>th</sup> June 2011 Respondent filed his response.
- 2.7 On 5<sup>th</sup> July 2011, Complainant filed his rejoinder and also sought a personal hearing. Complainant's request was accepted and the hearing date was intimated to both the Complainant and the Respondent.

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Complainant attended the hearing held at NIXI premises on 23rd September 2011. Respondent did not participate. He sent a mail indicating his inability to attend the hearing as he was in Moscow.

2.8 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 Complainant is in the business of banking and providing diverse financial services. Headquartered in Moscow, the Complainant is a leading bank of Russia founded/incorporated in 1841. It obtained its present legal status in 1991. The complainant's bank is the largest credit institution in Russia and CIS, accounting for 27 % of the aggregate Russian banking assets and 26% of the banking capital. The complainant also has the largest countrywide branch network with 17 regional head offices and more than 18,880 retail outlets with about 2,41,000 employees. The Complainant conducts financial and credit operations for all levels of the Russian population; compensatory, pension and other payments are paid through the Complainant's branches. Therefore the Complainant is well known and renowned among all levels of population. This fact is also confirmed by numerous statutory acts of Russia which state that payments are entered to accounts opened in branches of the Savings Bank of the Russian Federation, i.e. the Complainant. The complainant has filed an extract from the Family Code of the Russian Federation, an extract from the

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Federal Law of the Russian Federation No. 159-FZ dd. 21 December 1996, an extract from the Law of Russia No. 4468-1 dd. 12 February 1993, an extract from the Federal Law of the Russian Federation No. 51-FZ dd. 18 May 2005 at Annexure 'B'.

3.2 The complainant is using the name SBERBANK extensively, continuously and uninterruptedly, ever since its incorporation for the services provided by it. Enclosed with this proceeding is a copy of incorporation certificate of the complainant marked as Annexure 'C'

3.3 Since its inception in 1991 the turnover of the complainant has increased to US\$ 305 billion till year ending March 2011 and the profits earned by the Complainant as per the books of account for year ending March 2011 is more than US\$ 6.5 billion. The complainant has around 19370 branches across the world and over then 200 000 persons are employed by the complainant in these branches.

3.4 "SBERBANK" has been pronounced the most expensive trademark at 2009 year-end (according to the rating by British company "Brand Finance"). As stated in the independent source. Internet newsnaner "Dni.ru" («Дни.Ру»), the cost of the Complainant's trademark has increased more than twice and a half over the past year and come up to 11.7 billion dollars. The Complainant is the 57<sup>th</sup> in the list of 500 most expensive world companies. Internet address of Brand Finance rating is:

[http://www.brandirectory.com/league\\_tables/table/global\\_500/index.php7p](http://www.brandirectory.com/league_tables/table/global_500/index.php7p)

age-3.

*Sudhakar*

The complainant is the owner/proprietor and registrant of the domain name www.sberbank.ru which was created on 25.07.2008 and is being visited by over 150 000 persons per day for various queries and services like loan queries, finance queries, net banking and other services. Complainant is owner and registrant of the domain name: www.sbrf.ru . Russian people generally consider the Complainant as a trustworthy financial organization guaranteed by the State and which has been carrying out its activity in "keeping safe" the savings of the Russian population and organizations over centuries. As a result, none of the Russian banks has such popularity and well-known reputation as the Complainant does. Complainant has filed copy of the complainant's website with English translation at **Annexure "D"**.

The complainant is also the registered proprietor of the trademark **"СБЕРБАНК РОССИИ" "SBERBANK OF RUSSIA"** on which the Complaint is based. The complainant has spent considerable amount in conceptualizing and popularizing its trademark and is continuously spending enormous amount in advertisement and promotion of said mark in year 2009-10 for business promotion and advertisement. Complainant has filed copies of few advertisement and promotional campaigns and media and press coverage of complainant at **Annexure "E"**. The **Sberbank of Russia** is the largest bank in Russia and Eastern Europe and in many regions **Sberbank** is practically the only bank capable of providing local administrations with complex banking services and of

*Sberbank*

rendering significant financial support in implementing investment and social programs. Complainant has filed the recent prints from online encyclopedia, 'Wikipedia' which give a brief introduction of the huge reputation and goodwill of "**SBERBANK OF RUSSIA**" at **Annexure 'F'**.

3.7 The complainant is the first to conceive, adopt, use and promote the mark SBERBANK in respect of the services. The complainant is also the first to conceive, adopt, use and promote the domain name [www.sberbank.ru](http://www.sberbank.ru). On account of extensive usage the said mark is being identified solely and exclusively with the Complainant and none other. Further since the mark is being used for banking services, which is a high stake business, use of any deceptive mark, would amount to fraud and cheating upon the general public at large. Moreover it is noteworthy that banking guidelines across the globe require that all the websites which have probability of duping an unwary customer or involved in phishing or dummy websites should be brought down and removed from the internet to protect the interest of the public. The domain used by the respondent is not only deceptively similar, but also is being used in a manner so as to give an impression that same is under control of the complainant, which tantamount to fraud and cheating. Complainant has filed a print of Respondent's domain/website [www.sberbank.in](http://www.sberbank.in) and [www.sberbank.biz](http://www.sberbank.biz) (with English translation) at **ANNEXURE "G"**.

3.8 The complainant owns all the intellectual property in the mark **SBERBANK** and has the proprietary right over the same. Respondent is illegally using

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the trademark of the Complainant in order to get undue advantage from the goodwill and reputation of the Complainant. Respondent has no bona fide justification to adopt the contested domain except for cybersquatting and using the same for purposes of earning revenue on *click through commissions on sponsored links*.

3.9 Complainant is the Registered Proprietor of the mark "SBERBANK OF RUSSIA". Following are the details of the registration of the mark of the Complainant in Russia:

a) Trademark "СБЕРБАНК РОССИИ" ("SBERBANK OF RUSSIA"), registered under certificate No. 209662, in classes (1 to 42) valid from 03 June 1999 (a copy is at Annexure "H" to this complaint.)

b) Trademark "СБЕРБАНК РОССИИ" under Certificate No. 349752 in classes 36: Insurance; financial affairs; monetary affairs; real estate affairs (registration is valid from 12 October 2007). A copy is at Annexure "I" to this complaint.

3.10 The Complainant is the owner of international trademark "СБЕРБАНК РОССИИ" ("SBERBANK OF RUSSIA"), registered on 07 February 2008. A copy is attached at Annexure "J". This trademark is registered in accordance with Madrid Agreement and Protocol in the Russian Federation, Armenia, Azerbaijan, Belarus, Kazakhstan, Kyrgyzstan, Latvia, Moldova, Tajikistan, Ukraine, Uzbekistan, Estonia, Georgia, Lithuania, and Turkmenistan.

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3.11 In India, the Complainant has two applications pending for registration under Trademark Application number 1873328 for mark SBERBANK and 1873329 for mark CEEPAHK «SBERBANK» and logotype both in class 36 for saving banks, issuance of credit cards, financial consultancy, exchanging money, electronic funds transfer, mortgage banking, installment loans, banking, financing services, safe deposits of valuables. Copy of representation sheet and online status are attached at ANNEXURE "K".

**B Respondent**

3.12 Respondent has registered his domain name sberbank.biz in February 15, 2005. And in fact he had waited much time when it would be free for registration because this domain was taken by other person. At that period of time official website of the Complainant was [www.sbrf.ru](http://www.sbrf.ru) even now and official trademark was "Сбербанк России" (in Russian language only). Respondent could not predict that the Complainant decided to do a rebranding. He opened his website at sberbank.biz domain more than 3 years earlier than the Complainant received "[sberbank.ru](http://sberbank.ru)" domain. It was happened only in July 25, 2008. His website is not about the Complainant as the Complainant tries to describe in this Complaint. His website dedicated to Sberbank of the USSR and banks that received its assets after collapse of the USSR. It is easy to understand and from the disputed domain name <**sberbank.in**> website too.

*Sudhanshu*

3.13 His website at sberbank.biz address exists for more than 6 years. It is very popular too. Many people and some companies (hypothecation agencies, credit brokers, auto dealers, banks, etc.) recommend using its services in blogs, in forums and at their websites. He uses different ways and all modern tendencies to inform his users about news and new services that he creates at the site. He also for much time uses such word as "sberbank" in RSS-channel - "[feeds.feedburner.com/sberbank](https://feeds.feedburner.com/sberbank)", blogs - "[sberbank.livejournal.com](https://sberbank.livejournal.com)" ([livejournal.com](https://livejournal.com) is the most popular blogging platform in Russia), Twitter - "[twitter.com/sberbank](https://twitter.com/sberbank)", etc. So his "sberbank.in" website is just one other service that was created for convenience of the users of his site.

3.14 Respondent registered the disputed domain name <[sberbank.in](https://sberbank.in)> in April 14, 2009. It is six months earlier than the "Date of Application" (October 14, 2009) for registration of the trademark of the Complainant in India. His website under the disputed domain name <[sberbank.in](https://sberbank.in)> is more than 2 years in use prior to the date of this Complaint.

3.15 Respondent is not a bank and his website does not operate in the same business fields as those that the Complainant has trademark protection for. The Complainant has registered its trademark in class 36.

3.16 There is .co.in domain zone (originally for banks, registered companies, and trademarks) and other domain zones in India that the Complainant can use for its activity. In fact, when the Complainant sent its first request to the Respondent and when it was UDRP procedure the Respondent

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recommended the Complainant to register "sberbank.co.in" domain name. It was free for registration at that period of time. But as we can see the Complainant nothing to do for registration of this domain name and now this domain was taken by the third person. There are banks in India that use "co.in" domain names for their official websites <http://www.rbi.org.in/scripts/banklinks.aspx> Official website of the Complainant in Ukraine - [sbrf.com.ua](http://sbrf.com.ua) too (but not [sberbank.ua](http://sberbank.ua) because Central bank of Ukraine was against it and people in Ukraine usually called as Sberbank their local bank - Sberbank of Ukraine (or Sberbank of the USSR).

3.17 Complainant has not such registered trademark as "Сбербанк" (or "Sberbank" in Latin alphabet) in Russia and has not "monopoly right" to this word because it is generic and descriptive word that means "savings bank" in Russian language. Because the word is generic and descriptive I have a right to use the word in domain name on equal rights as the Complainant and other people. There also are other banks in Russia and other xUSSR countries that use the word "sberbank" as the part of their official names, domain names and trademarks (at official website of the Central Bank of Russia - [http://cbr.ru/credit/CO\\_Sites.asp](http://cbr.ru/credit/CO_Sites.asp) it is possible to find there these links [www.promsberbank.ru](http://www.promsberbank.ru) , [www.akademsberbank.ru/](http://www.akademsberbank.ru/) - they are banks and they can use "sberbank" as the part of the brands and domain names).

4. **Parties Contentions**

*Snelhovens*

## **A Complainant**

- 4.1 The disputed domain name <sberbank.in> is identical to the English transliteration of the main (distinctive) part of the Complainant's trademark registered in Russia - "CEEPEAHK" and fully identical to the distinctive part of the Complainant's trademark "**SBERBANK**" registered in accordance with Madrid Agreement and Protocol and trademark application in India. The Complainant is widely known under this name as the largest bank of Russia. The complainant is the registered owner of the domain name www.sberbank.ru and same is in use by the complainant. The complainant's websites/domains are visited by millions of people from all over the world including the tourists visiting India.
- 4.2 Respondent has no right over the mark SBERBANK nor has he been authorized by the complainant to use said name. Therefore, it is clear that the contested domain name is identical or misleadingly similar to the complainant's trade mark and domain names and has been registered in bad faith to cause confusion in the minds of the public and is a fraud upon the general public at large.
- 4.3 The disputed domain name <sberbank.in> is blatant imitation of the complainant's domain name www.sberbank.ru. The Respondent has cleverly registered said domain with extension ".in" so as to give impression that Complainant has a business interest in India and the said domain is for its Indian operations. Moreover the Respondent has illegally squatted upon the said domain so that in case the Complainant extends

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its business to India and requires the said domain, he may trade upon in. It is more clear from the fact that contested domain merely contains some links and no substantive matter about the respondent or its business. There is nothing in the contested domain name identifiable so as to belong to or be the proprietorship of the Respondent.

4.4 The Respondent's domain name without any due cause is taking unfair advantage of and is detrimental to the distinctive character and repute of the Complainants trade marks, corporate name and domain name. The respondent is very well aware of the existence of rights of the complainant on the mark SBERBANK and has deliberately and knowingly used the said name with malafide intentions. The use of the disputed domain name **<u>sberbank.in</u>** by the Respondent would create an impression that domain of respondent is in some way connected to the Complainant and content on same is endorsed by the complainant, however no such relation or endorsement actually exists.

4.5 The Respondent has neither used nor using the disputed domain name **<u>sberbank.in</u>** with a bona fide purpose nor he has any right to use the mark SBERBANK, and is clearly using the domain name in bad faith to mislead the consumers.

4.6 It is pertinent to note that the disputed domain name **<u>sberbank.in</u>** contains various links for Sberbank in Azerbaijan, Sberbank in Armenia, Sberbank in Belarus, Sberbank in Georgia, Sberbank in Kazakhstan, Sberbank in Kyrgyzstan. Sberbank in Latvia, Sberbank in Lithuania,

Sberbank in Moldova, Sberbank in Russia, Sberbank in Tajikistan, Sberbank in Turkmenistan, Sberbank in Uzbekistan, Sberbank in Ukraine, Sberbank in Estonia and on clicking on said links the page is directed to website [www.sberbank.biz](http://www.sberbank.biz) which is being used for obtaining commission fee from the sponsored link on said page. A copy is at **Annexure "G"**. It is pertinent to note that the disputed domain name **<sberbank.in>** does not provide Internet users with information about the Complainant's activity or any information about Complainant's bank, nor does the defendant has any right to use the name of the Complainant Bank in any sort of business activity. This therefore does not constitute a bona fide offering of goods or services.

- 4.7 The Respondent's website [www.sberbank.biz](http://www.sberbank.biz) (to which users are forwarded from the page with address [www.sberbank.in](http://www.sberbank.in)) contains numerous links that are related to the banking business, including links leading Internet users to the sites of banks which are Complainant's competitors e.g. to the website of a large bank Alfa-Bank <http://alfabank.ru/>; to the website of a large bank - "Banque Societe Generale Vostok"(BSGV) <http://www.bsgv.ru/>;- to other banks' websites. These banks do not have any connection with the Complainant. The Respondent's website sberbank.biz (pages <http://www.sberbank.biz/> <http://www.sberbank.biz/profile.html> ) is a clear imitation of the website of Sberbank and is also taking undue advantage of the complainants goodwill and reputation by hiding the information about the website's real

- owner. This means that the Respondent illegally uses Sberbank's trademark for commercial gains by misleading the consumers and leading them to believe that the website is owned by the Complainant.
- 4.8 All mentioned links being at the same time advertisements (located under tagging "**Advertorial**") are evidence of the Respondent's aim to get financial profit from advertising using reputation of the Complainant, its name and the distinctive part of trademark "SBERBANK" in the disputed domain name <sberbank.in>. The Respondent's adoption of the disputed domain name <sberbank.in> is clearly malafide and dishonest and the Complainant holds all Intellectual Property Rights in the trade and service mark Sberbank.
- 4.9 Respondent is an individual person who certainly has never been and could not have been known or associated with "sberbank" nor is he involved in any sort of banking business. The disputed domain name <sberbank.in> contains the word "bank" which means an organization carrying out banking activity (deposits, crediting, etc.) both in English and Russian languages and in many other languages. The Respondent is not recorded as such organization, has no right to carry out and has not in fact carried out any banking activity, therefore he could not become known under the domain names at issue. The Respondent is a natural, not legal, person, which appears to be incompatible with a legitimate interest in carrying out any banking activities. Thus the only reason the disputed

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domain name **<sberbank.in>** has been registered by the Respondent is squatting and earning illegal profits.

4.10 The Complainant's trademark "СБЕРБАНК РОССИИ" (SBERBANK ROSSII) has been registered and widely known long before registration of the domain names by the Respondent. The use of domain in question is clearly an attempt to misappropriate the goodwill and reputation of the Complainant. It is also pertinent to note that the disputed domain name **<sberbank.in>** has been registered after the registration of complainant's domain name [www.sberbank.ru](http://www.sberbank.ru).

4.11 The Respondent does not use the disputed domain name **<sberbank.in>** with bona fide intention. The Respondent clearly uses the disputed domain name **<sberbank.in>** for profit or misleading the public. The disputed domain name **<sberbank.in>** is clearly for the purposes of illegal profits and cybersquatting. As stated above, it is clear that the Respondent is giving the impression that the Respondent's website "[www.sberbank.biz](http://www.sberbank.biz)" (to which users are forwarded from the page with address "[www.sberbank.in](http://www.sberbank.in)") is the Complainant's website, and it also places advertisements of third parties (mainly banks) on his website on a commercial basis in order to make illegal profits by cashing in on the reputation of the Complainant.

4.12 Page "Feedback" (<http://www.sberbank.biz/sendmail.html>) of the Respondent's website says: "If you want to advertise on the site (including forum) please write in this section. Advertising is possible on both

commercial and non-commercial basis (in exceptional cases)". This announcement at the Respondent's website as well as the advertisements he places confirms the fact that the Respondent does not use the domain names legally with a bona fide intention or without the motive of illegally gaining profit. The disputed domain name <sberbank.in> is being used by Respondent for profits accrued out of commission from diversion of internet traffic.

4.13 It is obvious that the disputed domain name <sberbank.in> in question is being used in bad faith and is registered in order to prevent the Complainant as the owner of the trademark from reflecting the mark in a corresponding domain name.

4.14 The registration of the domain <sberbank.in> is a clear case of *cybersquatting* with intention to take advantage of complainant's substantial reputation and its prominent presence on the internet in order to confuse public by creating an impression of authorization from complainant, divert business, tarnish the reputation and good will of the complainant and the said mark and unduly gain in all aspects to the detriment of the complainant.

4.15 The disputed domain name <sberbank.in> is held by the Respondent and is used for diversion of internet traffic and commissions from pay per view websites and sponsored links. This is in clear violation of the rights of the Complainant and is being done to gain illegal profits. Thus the use of disputed domain name <sberbank.in> by the Respondent is malafide and

is being done in order to divert maximum volume of Internet users to his website "sberbank.biz" when they enter the disputed domain name **<sberbank.in>** in question "sberbank.in", and in order to prevent the users from reaching Complainant's domain name and getting information about the complainant.

4.16 Disputed domain name **<sberbank.in>** merely contains several links which are all named in a fashion so as to create a confusion that those links lead to webpage of Complainant and its business in various countries, however the case is not so. Instead the said links lead to other website of Respondent and several other sponsored pages through which the Respondent earns illegal profits.

4.17 It is important to note that the Complainant through its Representative, with a view to resolve the dispute without administrative proceedings, had addressed a request to the Respondent to transfer the domain names to the Complainant. But, the Respondent refused to the request and replied that he was not going to transfer the domain names to the Complainant. By doing so, the Respondent confirmed that he, being aware of existence of the trademarks and legal rights of the complainant, created the website using the word "SBERBANK" with the intention to attract Internet users to his website and gain maximum profit, and therefore does not wish to transfer the domain names to the Complainant. *Said communication between complainant and respondent is annexed and marked Annexure 'M'.*

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4.18 Respondent has used the disputed domain name <sberbank.in> in order to attract Internet users to his web page, for the purpose of commercial gain in the form of *click through commissions on sponsored links*. These circumstances constitute evidence of bad faith registration and malafide use of the disputed domain name.

4.19 It is obvious that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website <www.sberbank.biz> (to which users are forwarded when entering address <www.sberbank.in>) by creating a likelihood of confusion with the Complainant's mark with regard to the source, sponsorship, affiliation, or endorsement of its website, and since the purpose of commercial gain is confirmed by the advertisements and links to the websites of the advertised companies placed on the Respondent's website, and also, as described above, by direct indication that the Respondent places advertisements on his website on a commercial basis <http://www.sberbank.biz/sendmail.html>);

4.20 Respondent attempts to attract users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website are confirmed by the fact that the Respondent registered multiple domain names using the distinctive part of the Complainant's trademark "SBERBANK" (under which the Complainant is widely known), created a website under one of such domain names and the other ones being used for automatic forwarding to this website, and the Respondent nowhere in

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any such websites indicate that same was developed by the Respondent, and not the Complainant. But for all that the Respondent places a lot of information about the Complainant on his website including such actual information as contacts, addresses of branches, information about credit cards, credits and other information which is of interest to an unlimited number of users in connection with an enormous authority and impeccable reputation of the Complainant, as well as trust of all Russian population to the Complainant as the largest savings bank of the country. This information along with giving the impression that the website belongs to the Complainant, and not the Respondent, allows the Respondent to attract to his site a large number of users.

4.21 Particular attention is drawn to the fact that even the section "Feedback" of the Respondent's website (<http://www.sberbank.biz/sendmail.html>) does not contain any indications that the site is developed and operated not by the Complainant, but by the Respondent, without any permission or license from the Complainant. The mentioned page contains only a window for users to enter their messages; there are no contact phone numbers, or address, or a name of the website's Administrator, i.e. the Respondent. All information is anonymous and creates the impression that the website is developed by the Complainant.

4.22 At the same time the "Profile" section <http://www.sberbank.biz/profile.html> contains name, address, contact phone numbers of the Complainant as well as other information about the Complainant, without mentioning the

*Sullivan*

fact that the website was not developed by the Complainant. Thus the Respondent gave the impression that the Respondent's website is the Complainant's website or the website developed on behalf of the Complainant.

4.23 That all circumstances stated by the Complainant reveal that the Respondent does not only place information about the Complainant for public access, but for doing this uses the disputed domain name **<sberbank.in>** which forwards the traffic to domain www.sberbank.biz which are confusingly similar with the Complainant's trademark. In this respect, the Respondent does not have any right upon the mark "sberbank", but uses it with intent to attract Internet users to his web-site for the purpose of commercial gain, exploiting the Complainant's popularity among the public and its impeccable reputation. The Complainant believes that the right to criticize or give information about another person does not extend to registering a domain name that is identical or confusingly similar to the domain name of the person, information about whom is given and gain commercially from the same by providing sponsored links.

4.24 The Respondent has no connection or affiliation with the Complainant; the Complainant did not give any endorsements to the Respondent, did not conclude any agreements to place information about the Complainant, and did not authorize the Respondent to use the Complainant's trademark.

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4.25 There is no doubt that the Respondent was fully aware of the Complainant's existence when he created the website as evidenced by the content of the Respondent's other website sberbank.biz which contains information about the Complainant and its contact details, and also by the fact that the Complainant is the largest and widely known bank in Russia. It proves that the contested domain name is registered and used in bad faith.

4.26 Disputed domain name <sberbank.in> has only sponsored links and no material. On clicking said link the page leads to another website owned by respondent, where most of the links are located under tagging "Advertorial" (these are mostly links to other banks' websites). This can be the evidence that the Respondent has intentionally attempted to attract, for commercial gain from advertising, Internet users to his website using reputation of the Complainant, its name and the distinctive part of trademark "SBERBANK". Such actions do not constitute a bona fide offering of goods or services, and certainly constitute a misleading diversion in the minds of the public.

4.27 Complainant's trademark has high monetary value. We consider it to be obvious that the Respondent chose the Complainant's trademark for the domain name <sberbank.in> especially for this reason. It is noteworthy that "Sberbank" has been pronounced the most expensive trademark at 2009 year-end (according to the rating by British company "Brand Finance"). As stated in the independent source, Internet newspaper

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"Dni.ru" («flHM.Py»), the cost of the Complainant's trademark has increased more than twice and a half over the past year and come up to 11.7 billion dollars. The Complainant is the 57<sup>th</sup> in the list of 500 most expensive world companies <http://www.dni.ru/economy/2010/2/24/186126.html>. Internet address of Brand Finance rating is: [http://www.brandirectory.com/league\\_tables/table/global\\_500/index.php?page=3](http://www.brandirectory.com/league_tables/table/global_500/index.php?page=3). Such ratings and their coverage in Russian mass media prove that the Complainant's trademark and firm name are widely known, that both individual persons and organizations being Internet users take great interest in the Complainant's activity which surely attracts advertisers and increase the cost of advertising located by the Respondent on his other website <[www.sberbank.biz](http://www.sberbank.biz)>.

4.28 All these facts prove once again that the Respondent registered the disputed domain name <sberbank.in> for the purpose of commercial gain by attracting and diverting Internet users to his other website and advertising through sponsored links on that website.

4.29 Respondent is an individual person who certainly has never been and could not be known under the disputed domain names. The disputed domain name <sberbank.in> contains the word "bank" which means an organization carrying out banking activity (deposits, crediting, etc.) both in Russian language and in Latin transliteration in many other languages. The Respondent is not recorded as such organization, has no right to

*Sudharans*

carry out and has not in fact carried out any banking activity, therefore he could not become known under the domain names at issue and could not carry out any bona fide banking activity, or make preparations for carrying out such activity. Consequently, the Respondent could not register and use the disputed domain name <sberbank.in> in good faith for the purpose of carrying out banking activity. Based upon the foregoing evidence, one can say that the Respondent could have registered such domain names only for the purpose of further sale or in order to deprive the Complainant to reflect its trademark in the corresponding domain names and get profit by way of attracting users and advertising.

**B. Respondent**

4.30 Sberbank of the USSR (that is usually simply called as Sberbank) was created in July 1987 as result of the reorganization of the Soviet banking system. The structure of Sberbank of the USSR included 15 republican banks by number of the USSR countries. They had such names as "Russian Republican Bank of Sberbank of the USSR", "Ukrainian Republican Bank of Sberbank of the USSR", "Belorussian Republican Bank of Sberbank of the USSR", etc. Sberbank of the USSR was liquidated after collapse of the Soviet Union. The Complainant is not assignee of Sberbank of the USSR. The Complainant received only branch network of Russian Republican Bank of Sberbank of the USSR. It is only Russian part of Sberbank of the USSR. The Complainant has the registered trademark "Сбербанк России" (that means Sberbank of Russia

*Sudhakar*

in English). By the name of the country in the Complainant's trademark it is possible to understand the difference between the Complainant and other savings banks.

4.31 The registered trademark of the Complainant is "Сбербанк России" (that means Sberbank of Russia in English). This trademark was really in use in advertising, booklets, on the signboards of the all branches of the Complainant (including its Head Office), etc. Almost all branches of the Complainant has such signboards with words "Сбербанк России" and old logotype and now; address of the official page of the Complainant at the site of the Central bank of Russia is [www.sbrf.ru](http://www.sbrf.ru) too, you may check it here - [http://cbr.ru/credit/CO\\_Sites.asp](http://cbr.ru/credit/CO_Sites.asp) (this page has only Russian version] . Official domain name of the Complainant was [sbrf.ru](http://sbrf.ru) . SBRF is abbreviation of its full name; [www.sbrf.ru](http://www.sbrf.ru) address works even now. There are many banks that use abbreviations in their activity and domain names, for examples, ICICI means "Industrial Credit and Investment Corporation of India", HSBC means "Hongkong and Shanghai Banking Corporation", ICBC means "Industrial and Commercial Bank of China", etc.

4.32 There are different banks with the similar names when we can understand the difference between them only by the name of the country. For example, Royal Bank of Scotland - [rbs.com](http://rbs.com), Royal Bank of Canada - [rbc.com](http://rbc.com)

4.33 German Gref was getting new chairman of the Complainant in November 28, 2007. There also were changes in top-management of the

*Indharans*

Complainant too because some old top-managers leaved it then and sold all stocks that they had. Sometime later the Complainant received "[sberbank.ru](http://sberbank.ru)" domain in July 25, 2008. Two years ago in 2009 the Complainant decided to do a rebranding and to change its name in advertising from "Сбербанк России" ("Sberbank Rossii") to "Сбербанк" ("Sberbank") and updated its emblem. New logotype was presented at the site of the Complainant in December 14, 2009. You can see it there and now.

4.34 The Complainant must not spend much money and efforts for "conceptualizing and popularizing" such word as "sberbank" because many people know this word well since the USSR epoch. At that period of time it was only savings bank for all xUSSR countries (not only in Russia) and many people had deposit accounts in Sberbank (I meant Sberbank of the USSR in this case). They used (and use now) "sberbank" just as generic word.

4.35 You can see in Wikipedia that Sberbank was the bank in the USSR - [http://en.wikipedia.org/wiki/Category: Banks of the Soviet Union](http://en.wikipedia.org/wiki/Category:Banks_of_the_Soviet_Union). The Complainant is not assignee of Sberbank of the USSR so the link from this page of Wikipedia to the article at <http://en.wikipedia.org/wiki/Sberbank> should be about this bank but not about the Complainant which registered trademark and short name in Russia is "Sberbank Rossii" (but not Sberbank) ([http://en.wikipedia.org/wiki/List\\_of\\_banks\\_in\\_Russia](http://en.wikipedia.org/wiki/List_of_banks_in_Russia) Sberbank Rossii in list of Russian banks too).

*Endicorians*

4.36 I've registered my sberbank.biz domain name in February 15, 2005. And in fact I have been waited much time when it would be free for registration because this domain was taken by other person. At that period of time official website of the Complainant was [www.sbrf.ru](http://www.sbrf.ru). It works even now. Official trademark was "С6ep6aHK ПOCCMM" (in Russian language only). I could not predict that the Complainant decided to do a rebranding. I opened my website at sberbank.biz domain more than 3 years earlier that the Complainant received "[sberbank.ru](http://sberbank.ru)" domain (it was happened only in July 25, 2008). And my website is not about the Complainant as the Complainant try to describe in this Complaint. My website dedicated to Sberbank of the USSR and banks that received its assets after collapse of the USSR. It is easy to understand from my "sberbank.in" website too.

4.37 My website at sberbank.biz address exists for more than 6 years. It is very popular too. Many people and some companies (hypothecation agencies, credit brokers, auto dealers, banks, etc.) recommend using its services in blogs, in forums and at their websites. I use different ways and all modern methods to inform my users about news and new services that I create at the site. I also for much time use such word as "sberbank" in RSS-channel - "[feeds.feedburner.com/sberbank](http://feeds.feedburner.com/sberbank)" , blogs - "[sberbank.livejournal.com](http://sberbank.livejournal.com)" ([livejournal.com](http://livejournal.com) is the most popular blogging platform in Russia), Twitter - "[twitter.com/sberbank](http://twitter.com/sberbank)", etc. So my "sberbank.in" website is just one else service that was created for convenience of the users of my site.

*Sberbank*

4.38 The Complainant has not such registered trademark as "Сбербанк" (or "Sberbank" in Latin alphabet) in Russia and has not "monopoly right" to this word because it is generic and descriptive word that means "savings bank" in Russian language. Because the word is generic and descriptive I have a right to use the word in domain name on equal rights as the Complainant and other people. There also are other banks in Russia and other xUSSR countries that use the word "sberbank" as the part of their official names, domain names and trademarks (at official website of the Central Bank of Russia - [http://cbr.ru/credit/CO\\_Sites.asp](http://cbr.ru/credit/CO_Sites.asp) it is possible to find there these links [www.promsberbank.ru](http://www.promsberbank.ru), [www.akademsberbank.ru/](http://www.akademsberbank.ru/) - they are banks and they can use "sberbank" as the part of the brands and domain names).

4.39 Registered trademark of the complainant looks like graphical logotype with the words "Сбербанк России" (spells as Sberbank Rossii). I don't use this logotype and trademark of the Complainant at my site although it is usual practice in the internet when people published logotypes of different companies at their websites (such websites look better by this reason). But I don't do it because I don't want to infringe the rights of the Complainant.

4.40 The Complainant used the similar arguments and when it tried to take my domains by using UDRP procedure. And its Complaint was denied. It is possible to read about this case here <http://www.wipo.int/amc/en/domains/decisions/text/2010/d2010-0424.html>

*Sudhanan*

- 4.41 There is no sense to discuss many of the arguments of the Complainant about my website at sberbank.biz domain because its complaint was already denied.
- 4.42 I've registered "sberbank.in" domain name in April 14, 2009. It is six months earlier than the "Date of Application" (October 14, 2009) for registration of the trademark of the Complainant in India. My website was more than 2 years in use prior to the date of this Complaint.
- 4.43 I am not a bank and my website does not operate in the same business fields as those that the Complainant has trademark protection for. The Complainant registered its trademark in 36 class.
- 4.44 There is .co.in domain zone (originally for banks, registered companies, and trademarks) and other domain zones in India that the Complainant can use for its activity. In fact, when the Complainant sent me its first request and when it was UDRP procedure I recommend to the Complainant to register "sberbank.co.in" domain name. It was free for registration at that period of time. But as we can see the Complainant nothing to do for registration of this domain name and now this domain was taken by the third person. There are banks in India that use "co.in" domain names for their official websites <http://www.rbi.org.in/scripts/banklinks.aspx> Official website of the Complainant in Ukraine - [www.sbrf.com.ua](http://www.sbrf.com.ua) too (but not [sberbank.ua](http://sberbank.ua) because Central bank of Ukraine was against it and people in Ukraine

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usually called as Sberbank their local bank - Sberbank of Ukraine (or Sberbank of the USSR), see about it below).

- 4.45 The Complainant has not branches in India and people who live in India do not use the services of the Complainant. I think that by this reason they don't hear much about such bank as "Sberbank of Russia". The same I think that some people in Russia know about Indian ICICI bank because it works in Russia but they know nothing about banks of Thailand, Indonesia, Pakistan, etc. they don't know anything even and about banks of Poland - the country that is near Russia. I am a person who is interesting in economy and finances much but if you ask me what is the biggest bank of Indonesia (this country is bigger by population than Russia) then I answer "I don't know" and go to Google for searching the answer to this question.
- 4.46 There are pages about savings banks (sberbanks) that were parts of Sberbank of the USSR. I think it is clear from the content of "sberbank.in" website because this information is written in the title of each page of the site (there you can see the title "Sberbank of the USSR today").
- 4.47 There are only some links for examples where it is possible to see as news agencies and people use the word "sberbank" for calling other banks, in this case Sberbank of Ukraine and Sberbank of the USSR.
- 4.48 Some important facts. The Complainant is not assignee of Sberbank of the USSR. - The Complainant has not such registered trademark as "CSepGaHK" (and Sberbank in Latin alphabet) and has not any legal rights

*Sudhanand*

to this word. When I registered domain name sberbank.biz and opened my website the Complainant did not have the branches abroad Russia at all. It was local bank that works only in Russia. - The Complainant never had branches in such xUSSR countries as Armenia, Azerbaijan, Estonia, Georgia, Latvia, Lithuania, Moldova (including Transnistria), Kyrgyzstan, Tajikistan, Turkmenistan, and Uzbekistan. People from all these countries cannot associate the word "Sberbank" with the Complainant because the Complainant has not branches in their countries and people do not use the services of the Complainant. People from all these countries associate the word "Sberbank" with Sberbank of the USSR and their local (country, republican) savings banks where they have deposits accounts and receive loans for many years (since the USSR epoch). All savings banks (sberbanks) of Sberbank of the USSR are equal for me. The Complainant cannot have a monopoly right to the word "sberbank" because it is generic and descriptive word in Russia and other xUSSR countries. I think that and people in India don't know much about the Complainant and don't associate the word "Sberbank" with the Complainant.

4.49 I don't use the Complainant's trademark "СЕРБАНК РОССИИ" (SBERBANK ROSSII) in my domain names. The Complainant can register sberbankrossii.in or sberbankrossii.co.in domain names if it wants.

4.50 It is easy to understand from the title of website that my "sberbank.in" is about Sberbank of the USSR. But not about Sberbank of Russia. There are no any advertising at sberbank.in website. In fact it is only such

*Sherkova*

domain for my project in all domain zones. Because the word "in" has the sense in English language.

4.51 There are the links to websites that publishing news, analytical information, etc. about different companies that are listed at the stock exchanges. At my sberbank.biz website I publish the similar information. My website also has many useful for people tools (different types of calculators, forms, etc.).

4.52 ".In" is unique domain zone and "sberbank.in" is unique domain name for me because "in" has the sense in English language and my site about savings banks (sberbanks in Russian language) in different countries. For example, "Sberbank.in/Moldova" means "Sberbank (savings bank) in Moldova", etc.

4.53 I used the service of this site since 2001 till 2009 year while my website at Geocities.com service worked. But some time ago Geocities closed all sites at their server. You can read about it at their title page geocities.com. I saved letters about my accounts from Come.to service and Geocities.com; and may show them to Arbitrator if it will be necessary.

4.54 At the time when I registered my "sberbank.in" domain the Complainant did not have such registered trademark as "Сбербанк" (and Sberbank") neither in India nor in Russia. So I cannot prevent the Complainant to reflect its trademark in this domain name.

*Sberbank*

- 4.55 I was not trying to sell the "sberbank.in" domain and rejected the offer from the Complainant to buy this domain name, (see "Annexure M" in "Annexures.pdf" of the Complaint). I also was not trying to sell the "sberbank.biz" domain and rejected the offer from the Complainant to buy this domain name too. I also won the dispute for this domain under UDRP procedure and conclusion of the Panel was that I use it "for a legitimate offering of goods and services".
- 4.56 I did not register my domains with the intent of selling it or capitalizing on trademark of the Complainant or any other company. I just develop my website.
- 4.57 The Complainant didn't write anything about "administrative proceedings" in its letter (see "Annexure M" in "Annexures.pdf" of the Complaint). It wrote that it wanted to buy "sberbank.in" domain for \$5000 or any other price that I might ask. I answered that I registered "sberbank.in" domain not for sale and rejected this offer.
- 4.58 The Complainant registered its trademark in India 6 months later than I registered "sberbank.in" domain. The Complainant could not use its trademark in India because it didn't have such trademark at that moment. Maybe it doesn't use it even now. I don't live in India so I cannot be sure. It doesn't also have any domain names in India. So the Complainant cannot plead and establish this point.
- 4.59 Complainant has not such registered trademark as "С6ер6аHK" (or Sberbank in Latin alphabet) in Russia. By this reason it cannot receive

*Sudhakar*

"c6ep6aHK.pcp" (Sberbank in Cyrillic domain zone) domain in Russia too. The Complainant began to use sberbank.ru domain name for publishing information about its activity 3 years later than I opened my site at sberbank.biz domain. The Complainant also decided to do a rebranding (4 years later after the date when I opened the site at sberbank.biz domain). The Complainant registered in India as trademark its new logotype that was created after rebranding too. I think that people in India don't know much about the Complainant because it has not branches in India and Indian people do not use the service of the Complainant. Official website of the Complainant doesn't also have any information about its banking services for clients in English language or any other languages that can understand people from India. So I think that the Complainant cannot plead and establish and this point too.

4.60 For all the foregoing reasons the Complaint should be denied.

#### **Rejoinder**

4.61 In response to the reply, Complainant has filed his rejoinder. The gist of the rejoinder is as below.

4.62 The Respondent at the very beginning of the Response has referred to his domain name "SBERBANK.BIZ" and the decision of UDRP in said case. The domain ".biz" is a generic top-level domain (gTLD) and the tests applied in the said case are not applicable in the present case as the disputed domain in present case is "SBERBANK.IN" which is a country code top-level domain (ccTLD). The fact that the domain name

*Siddharanand*

Sberbank.biz admittedly belongs to the Respondent, does not imply that Respondent has a monopoly or any proprietary rights over the word SBERBANK. Further, the disputed domain name in this case, unlike the domain name contested in the UDRP, does not have any function or use of its own. It is being used merely to increase the traffic of his ".biz" domain. The disputed domain acts merely as a forwarding point for the traffic to the ".biz" domain. This clearly demonstrates bad faith on part of the Respondent.

4.63 Respondent has admitted the mark of the Complainant to be "Sberbank of Russia". It is a well settled law that the first part of a trademark is most distinctive part. Further, the Complainant has already applied for registration of the mark "SBERBANK" in India, the status of which is Accepted & Advertised. Also the same have been published in Journal dated 29.09.2010, i.e. the opposition period to oppose the same has also elapsed. It is to be noted that mostly banks are known by their first part, and it is more so common when the second part refers to the home country of the bank. In the Indian context, a good example would be of the State bank of India commonly called State Bank, or Union bank of India which is referred to as Union Bank in day-to-day language. Similarly, United Bank of India is commonly called United Bank. Thus if anyone uses SBERBANK everyone would directly relate it to 'Sberbank of Russia'.

4.64 All the history of USSR and other issues pointed by Respondent are irrelevant. Moreover even today the majority stakeholder in Complainant

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bank is Central Bank of Russia, which proves the wide coverage and trust Complainant bank enjoys. Thus the well-known character of the Complainant and association of trademark sberbank with Complainant cannot be denied and hence all the arguments of the Respondent lie flat on ground and clearly prove the deceptive similarity between the Complainant's trademark and Respondent's domain name.

4.65 Respondent's argument that he adopted the domain name before trademark application of Complainant in India is unacceptable. In today's economic scenario everyone knows that India is a popular destination. Thus adopting a well-known mark as domain for India specific domain name i.e. '.in' clearly shows Respondent's intention to use the domain for ulterior motives. The disputed domain is only used for purpose of diverting the traffic and said use cannot be treated as boanfide use. Respondent had admitted that Complainant registered domain name SBERBANK.ru in 2008 and disputed domain sberbank.in was registered on April 14, 2009 as per own contention of Respondent. It clearly proves that disputed domain is subsequent in time and is therefore bad in law.

4.66 Respondent's argument that Sberbank is not registered or is a generic term is untenable for the reasons already explained. Also it is pertinent to note that the said mark Sberbank is an accepted and advertised trademark in India, which clearly proves Complainant's right over the mark in Indian Territory. Moreover the Complainant is having a branch office in India and therefore use of disputed domain is misleading to the public in

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India. Furthermore the public in India is only aware of the bank called Sberbank which has branch in India as well (i.e. Complainant), no one would be knowing the Respondent in India nor would be searching for Respondent's alleged informative website 'sberbank.biz' by visiting India specific '.in' domain. The explanation given by Respondent is cooked story and cannot be treated as valid reason for adoption of disputed domain.

4.67 Complainant is the only bank using SBERBANK independently as its prominent feature and is recognized and known by said name in Russia and other territories of world. The Respondent refers to the Panel in the ".biz" case and states that the panel found his disputed website as 'making fair use of the disputed domain name'. However, in the present case the website is of no real value since it redirects the user to the Respondent's other website "sberbank.biz".

4.68 The website of the Respondent being registered prior to the Complainant does not free it of the accusation of being used in bad faith. The Respondent was aware of the existence of the Complainant and knew of its immense potential. It is also admitted by Respondent that Complainant registered its domain 'sberbank.ru' prior to the disputed domain. The registration of disputed domain clearly shows malafide intention of Respondent. It is evident that the Complainant had no real reason for registering the domain name and just did so to harass the Complainant with the knowledge that they would eventually require this domain name to expand their business to the territory of India.

*Indharams*

4.69 By his own admission, the Respondent has accepted that he is not a bank and does not operate in such business field. With strict regulations that require protection of consumers in cases of high risk of fraud, such as banks, the motive of the Respondent for registration of this domain name is questioned. Also registration of domain which in any way connotes banking services offered under it is bad in law and a fraud upon general public at large. The Respondent clearly has no real reason and is gathering domain names with the Complainant's trademarks with the motive of "cyber squatting".

4.70 The Respondent starts his argument stating the fact that the Complainant does not have a branch in India. This statement is incorrect due to the fact that Sberbank filed a request with the Central Bank of India in December 2009, shortly after which they were given principal permission to open an Indian branch. The address of the Indian branch is Upper Ground Floor, Gopal Das Bhawan, 28, Barakhamba Road, Connaught Place, New Delhi - 110001, IndiaDTel.: +91 (11)4004-8888.

## **5. Discussion and Findings**

5.1 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;

*Sudhanshu*

- (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.

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

Before proceeding further, I would like to set out in summary certain essential facts of this dispute as below.

- (a) Both the Complainant and the Respondent own domain names involving the expression sberbank. They had a dispute in respect of the domain name www.sberbank.biz of the Respondent and it was decided in favour of the Respondent.
- (b) Complainant is in the business of banking and providing diverse financial services. Headquartered in Moscow, the Complainant is a leading bank of Russia founded in 1841. In its current legal status, Complainant has been using the mark **sberbank** since 1991.
- (c) The complainant is the owner/proprietor and registrant of the domain names www.sbrf.ru created on 13.07.1998 and www.sberbank.ru created on 25.07.2008. The web sites are being visited by over 150 000 persons per day for various queries and services like loan queries, finance queries, net banking and other services.

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In Russia, the Complainant has obtained registrations for the mark "SBERBANK OF RUSSIA" in various classes. Its first registration dates back to 03 June 1999.

In India, the Complainant has two applications pending for registration under Trademark Application number 1873328 for mark SBERBANK and 1873329 for mark CEEPAHK «SBERBANK» and logotype both in class 36. I have checked the web site of the Indian trade marks registry at [www.ipindia.nic.in](http://www.ipindia.nic.in) . The status of the above marks is now registered. Registration relates back to the date of Application.

Complainant had already obtained permission from the Reserve Bank of India to open a branch in India. Its Indian branch is at Upper Ground Floor, Gopal Das Bhawan, 28, Barakhamba Road, Connaught Place, New Delhi - 110001, IndiaDTel.: +91 (11)4004-8888,

Respondent has registered his domain name [www.sberbank.biz](http://www.sberbank.biz) in February 15, 2005. He had waited much time when it would be free for registration because this domain was taken by other person. He opened his website at [www.sberbank.biz](http://www.sberbank.biz) more than 3 years earlier the Complainant received [www.sberbank.ru](http://www.sberbank.ru) domain. Respondent's web site gives links to websites publishing news, analytical information, etc. about different companies that are listed at the stock exchanges and gives similar information. It also has many useful tools for people (different types of calculators, forms, etc.). Respondent's website has nothing to do with Sberbank of Russia.

*Srinivasan*

- (h) Respondent registered the disputed domain name **<sberbank.in>** in April 14, 2009. Respondent is not a bank and his website does not operate in the same business fields as those that the Complainant has trademark protection for.

***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 Sberbank. Complainant has been using the sberbank mark in continuously since at least as early as 1991. Complainant has its branch in India at Delhi. The Complainant has registrations for the mark sberbank in Russia and international registration also. In India also, Complainant has obtained registrations under Nos. 1873328 and 1873329 for its mark sberbank. In 1998, the Complainant registered the domain name www.sbrf.ru and in 2008 the domain name www.sberbank.ru. The disputed domain name **<sberbank.in>** was registered on April 14, 2009.

5.5 Every domain name like a trade mark is a separate property and can be enjoyed, protected and alienated like a property. The disputed domain name **<sberbank.in>** is thus entirely different and separate from Respondent's <Sberbank.biz> and enjoys the status of a property distinct from his .biz domain property. The disputed domain name **<sberbank.in>** is an Indian property by reason of the country level suffix .in and this fact also makes it distinct from the Respondent's .biz domain name.

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5.6 Moreover, Respondent is not a bank and the disputed domain name does not operate in the same business fields as those that the Complainant has trademark protection.

5.7 For the above reasons, the .biz domain name of the Respondent is not relevant for deciding this Complaint. Similarly, the previous dispute between the parties in respect of the domain name <Sberbank.biz> and its decision in favour of the Respondent has no bearing on this Complaint.

5.8 I reject the contention of the Respondent that the expression sberbank is generic for the reason that the Complainant has obtained registration of for the same expression in India, that too during the pendency of the Complaint. The Respondent had not opposed the application of the Complainant and has not taken any steps available under the Indian Trade Marks Act 1999 for removing the registration from the records of the trade marks registry.

5.9 In the above circumstances, I can safely conclude that the disputed domain name **<sberbank.in>** wholly incorporates Sberbank, the registered trade mark of the Complainant. The disputed domain name **<sberbank.in>** is similar to the Complainant's domain names [www.sbrf.ru](http://www.sbrf.ru) and [www.sberbank.ru](http://www.sberbank.ru).

5.10 I, therefore, find that:

- (a) The Complaint has both common law and statutory rights in respect of its trade mark Sberbank.

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- (b) The disputed domain name <sberbank.in> is:
- (i) Identical to the Complainant's registered trade mark Sberbank and
  - (ii) Similar to the Complainant's domain name www.sbrf.ru and www.sberbank.ru.

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

5.11 It is already seen that:

- (a) The Complainant is the prior adopter and user of the mark Sberbank. The Complainant's mark Sberbank is well known in many countries across the globe including India.
- (b) Complainant has been using the sberbank mark in continuously since at least as early as 1991. Respondent registered the disputed domain name <sberbank.in> in April 14, 2009.

5.12 I agree with the contention of the Complainant. Respondent's argument that Complainant adopted the domain name <sberbank.in> before trademark application of Complainant in India is unacceptable. In today's economic scenario everyone knows that India is a popular destination. Thus adopting a well-known mark as domain for India specific domain name i.e. '.in' clearly shows Respondent's intention to use the domain for ulterior motives. The disputed domain <sberbank.in> is only used for purpose of diverting the traffic and said use cannot be treated as boanfide

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use. Respondent had admitted that Complainant registered domain name SBERBANK.ru in 2008 and disputed domain sberbank.in was registered on April 14, 2009 as per own contention of Respondent. It clearly proves that disputed domain **<sberbank.in>** is subsequent in time.

5.13 I visited the web site of the Respondent under the disputed domain name **<sberbank.in>**. The disputed domain name **<sberbank.in>** provides sponsored links and has no material. A click on any of the links leads to the Respondent's another web site under his.biz domain name. This web site in turn has links to other banks which are competitors of the Complainant. This shows that the Respondent has intentionally attempted to attract, for commercial gain from advertising, Internet users to his website using reputation of the Complainant, its name and the distinctive part of trademark "SBERBANK". Such actions do not constitute a bona fide offering of goods or services, and certainly constitute a misleading diversion in the minds of the public.

5.14 Respondent's current use is neither an example of a bona fide offering of goods or services as required under paragraph 7(i) of the Policy, nor is there any legitimate non-commercial or fair use of the disputed domain name **<sberbank.in>**. Respondent clearly has no legitimate rights or interests in the disputed domain name **<sberbank.in>**.

5.15 There exists no relationship between Complainant and Respondent that would give rise to any license, permission, or authorization by which Respondent could own or use the disputed domain name **<sberbank.in>**

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which incorporates the Sberbank mark in its entirety and which is confusingly similar to Complainant's marks.

5.16 Therefore, I have no hesitation to hold, for the above reasons that the Respondent has no right or legitimate interest in respect of the disputed domain name **<sberbank.in>**.

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

5.17 The Complainant is the proprietor of the mark Sberbank. Complainant has been using the Sberbank mark in commerce continuously since at least as early as 1991. The Complainant has registrations for the mark sberbank in Russia and international registration also. In India also, Complainant has obtained registrations under Nos. 1873328 and 1873329 for its mark sberbank. In 1998, the Complainant registered the domain name www.sbrf.ru and in 2008 the domain name www.sberbank.ru. The disputed domain name **<sberbank.in>** was registered on April 14, 2009.

5.18 The Respondent could not have ignored, rather actually influenced by, the well-known trade mark Sberbank of the Complainant at the time he acquired the disputed domain name **<sberbank.in>**.

5.19 As seen above, Respondent is currently using the disputed domain name **<sberbank.in>** primarily for giving links to his own .biz domain and from there to web sites of banks which are competitors of the Complainant. The Respondent is no way connected with the Complainant. Respondent's

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adoption of the disputed domain name <sberbank.in> is nothing but an unjust exploitation of the well known reputation of the Complainant's registered trade mark Sberbank.

5.20 I agree with the contentions of the Complainant. By his own admission, the Respondent has accepted that he is not a bank and does not operate in such business field. With strict regulations that require protection of consumers in cases of high risk of fraud, such as banks, the motive of the Respondent for registration of this domain name <sberbank.in> is questioned. Also registration of a domain which in any way connotes banking services offered under it is bad in law and a fraud upon general public at large. The Respondent clearly has no real reason and is gathering domain names with the Complainant's trademarks with the motive of "cyber squatting". Where a registrant has registered the domain name in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, evidence of bad faith will lie.

5.21 Respondent attempts to attract users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website are confirmed by the fact that the Respondent registered multiple domain names using the distinctive part of the Complainant's trademark "SBERBANK" (under which the Complainant is widely known), created a website under one of such domain names and the other ones being used for automatic forwarding to this website, and the Respondent nowhere in

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any such websites indicate that same was developed by the Respondent, and not the Complainant. But for all that the Respondent places a lot of information about the Complainant on his website including such actual information as contacts, addresses of branches, information about credit cards, credits and other information which is of interest to an unlimited number of users in connection with an enormous authority and impeccable reputation of the Complainant, as well as trust of all Russian population to the Complainant as the largest savings bank of the country. This information along with giving the impression that the website belongs to the Complainant, and not the Respondent, allows the Respondent to attract to his site a large number of users.

5.22 The Respondent has no connection or affiliation with the Complainant; the Complainant did not give any endorsements to the Respondent, did not conclude any agreements to place information about the Complainant, and did not authorize the Respondent to use the Complainant's trademark.

5.23 There is no doubt that the Respondent was fully aware of the Complainant's existence when he created the website as evidenced by the content of the Respondent's other website sberbank.biz which contains information about the Complainant and its contact details, and also by the fact that the Complainant is the largest and widely known bank in Russia. It proves that the contested domain name is registered and used in bad faith.

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5.24 Respondent is an individual person who certainly has never been and could not be known under the disputed domain name <sberbank.in>. The disputed domain name <sberbank.in> contains the word "bank" which means an organization carrying out banking activity (deposits, crediting, etc.) both in Russian language and in Latin transliteration in many other languages. The Respondent is not recorded as such organization, has no right to carry out and has not in fact carried out any banking activity, therefore he could not become known under the domain names at issue and could not carry out any bona fide banking activity, or make preparations for carrying out such activity. Consequently, the Respondent could not register and use the disputed domain name <sberbank.in> in good faith for the purpose of carrying out banking activity. Based upon the foregoing evidence, one can say that the Respondent could have registered the disputed domain name <sberbank.in> only for the purpose of further sale or in order to deprive the Complainant to reflect its trademark in the corresponding domain name and get profit by way of attracting users and advertising.

5.25 The Complainant through its Representative, with a view to resolve the dispute without administrative proceedings, had addressed a request to the Respondent to transfer the domain names to the Complainant. But, the Respondent refused to the request and replied that he was not going to transfer the domain names to the Complainant. By doing so, the Respondent confirmed that he, being aware of existence of the

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trademarks and legal rights of the Complainant, created the website using the word "SBERBANK" with the intention to attract Internet users to his website and gain maximum profit, and therefore does not wish to transfer the disputed domain name <sberbank.in> to the Complainant.

5.26 Thus it is clearly established that Respondent registered the disputed the disputed domain name <sberbank.in> in bad faith.

5.27 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 <sberbank.in> into any fair/useful purpose. 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 prayed for in the Complaint.

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

6.3 Respondent is ordered to pay the Complainant a sum of Rs. 10,00,000/- (Rupees ten lakhs only) towards costs of the proceedings.



S.Sridharan  
Arbitrator