



தமிழ்நாடு தமில்நாடு TAMILNADU

S 024828

D. SARAVANAN

Advocate, Arbitrator & Mediator  
"Orient Chambers" 4th Floor, No.73,  
Armenian Street, Chennai - 600 001.  
Phone: 044 - 4205 3051.

P.S. SHANMUGA SUNDARAM,  
STAMP VENDOR,  
L. NO. 54 / 109 / 88  
HIGH COURT CAMPUS,  
CHENNAI-600 106. (TAMIL NADU)

BEFORE THE SOLE ARBITRATOR MR.D.SARAVANAN  
.IN REGISTRY  
(C/o. NATIONAL INTERNET EXCHANGE OF INDIA)

Disputed Domain Name: [www.digitalbroadcom.co.in](http://www.digitalbroadcom.co.in)

Broadcom Corporation  
5300 California Avenue  
Irvine  
California 92617, U.S.A.

Complainant

Vs.

Deepak Katara  
Saibaba Enterprises  
1, Motiwala Bldg,  
Proctor Road,  
Mumbai,  
Maharashtra  
India

Respondent





தமிழ்நாடு தமில்நாடு TAMILNADU

D. SARAVANAN

Advocate, Arbitrator & Mediator  
"Orient Chambers" 4th Floor, No.73,  
Armenian Street, Chennai - 600 001.  
Phone: 044 - 4205 3051.

L 156551

P. S. SHANMUGA SUNDARAM,  
STAMP VENDOR,  
L. No. B4 / 109 / 88  
HIGH COURT CAMPUS,  
CHENNAI-600 104. (TAMIL NADU)

-2-

**The Parties:**

The Complainant is Broadcom Corporation having its mail address at 5300 California Avenue, Irvine, California 92617, U.S.A. Rep.by its Authorised Representative Ms.Anuradha Salhotra, LLS House, Plot No.B-28, Sector 32 (Institutional Area) Gurgaon - 122001, India.

The Respondent is Deepak Katara, Saibaba Enterprises, having his mail address at 1, Motiwala Bldg, Proctor Road, Mumbai, Maharashtra, India. Neither the Respondent represented himself nor represented by any one.

**5. The Domain Name and Registrar:**

The disputed domain name: [www.digitalbroadcom.co.in](http://www.digitalbroadcom.co.in). The domain name registered with .IN REGISTRY.

..3.



### **3. Procedural History:**

- June 29, 2009 : The .IN REGISTRY appointed D.SARAVANAN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.
- June 30, 2009 : Arbitral proceedings were commenced by sending notice to Respondent through e-mail as per Paragraph 4(c) of INDRP Rules of Procedure, marking a copy of the same to Complainant, Complainant's authorised representative and .IN REGISTRY.
- July 06, 2009 : The Arbitrator has submitted Statement of Acceptance and Declaration of Impartiality And Independence to the .IN REGISTRY.
- July 10, 2009 : Due date for filing Response by Respondent.
- July 16, 2009 : Arbitrator sent an e-mail to Respondent notifying his default, a copy of which marked to Complainant, Complainant's authorised representative and the .IN REGISTRY.
- : The language of the proceedings in English.

### **4. Factual Background:**

#### **4.1 The Complainant:**

The Complainant is Broadcom Corporation having its mail address at 5300 California Avenue, Irvine, California 92617, U.S.A. Rep.by its Authorised Representative Ms.Anuradha Salhotra, LLS House, Plot No.B-28, Sector 32 (Institutional Area) Gurgaon - 122001, India.

#### **4.2 Complainant's Activities:**

Complainant states inter-alia that it is a corporation organized and existing under the laws of the State of California, U.S.A.; and one of several companies contributing to the infrastructure that has brought high-speed internet and other services directly to homes and offices; complainant specializes in designing high-speed integrated circuits (IC) TV set-top boxes, cable modems, local area network (LAN) cards, laptop and desktop computers, digital televisions, DVD players, routers, networking equipment and





cellular phones; and its products enables the delivery of voice, video, data and multimedia to the throughout the home, the office and the mobile environment. The complainant further states inter-alia that they provide key technology and products in emerging broadband markets such as digital subscriber loop (DSL), fixed wire less, direct broadcast satellite, cable modems, digital set-boxes, residential broadband getaways, high-speed home networking and fast Ethernet networking and provides technology semiconductors for wired and wireless communications.

#### **4.3 Complainant's Trade Marks and Domain Names:**

According to the Complainant it is one of the world's largest fabless semiconductor companies, with revenue of \$4.66 billion in 2008, and holds over 3,100 U.S. and 1,400 foreign patents, more than 7,600 additional pending patent applications, and one of the broadest intellectual properties portfolios addressing both wired and wireless transmission of voice, video, and multimedia. According to the complainant they have been using the mark BROADCOM as early November, 1994 and have been using continuously and extensively in different jurisdiction of the world including India and that they are also the registered proprietor of the mark BROADCOM in various jurisdictions. The complainant further states that they own registrations and pending applications of the mark BROADCOM in various jurisdictions around the world, including but not limited to Argentina, Australia, Bangladesh, Canada, China, India, the European Union and the United States. The complainant marked the copies of few registrations as **Annexure A**.

The complainant states that they are the registered proprietor of the marked BROADCOM in India vide No.877840 dated 22.09.1999 and No.855367 dated 07.05.1999 under Clause 9.

The complainant further states that they spent a considerable amount of money promoting the BROADCOM brand worldwide and by virtue of continued use since 1994 they acquired a substantial reputation and goodwill in the BROADCOM brand and earned huge revenues. According to the complainant the trade mark BROADCOM is an essential part of the corporate name of the complainant and its distinctive style of trading. As per the complainant, the trade mark BROADCOM is



a world famous mark widely recognized in India and through out the world in which people associate the BROADCOM mark exclusively with the business of the complainant. The complainant marked the copies of a sampling of articles advertisements, brouchers published and circulated in different countries including India discussing the popularity of the BROADCOM trade mark as **Annexure B**.

The complainant further states that the website [www.broadcom.com](http://www.broadcom.com) was created on 9<sup>th</sup> May, 1994 and is equally popular among the viewers all over the world including India and according to the details of traffic rankings available on the website [alexa.com](http://alexa.com) the viewers of the complainant's website come from various countries including but not limited to India, United States, Germany, China, Japan, Indonesia, Pakistan, Spain, and Canada etc. The complainant further states that as per the status available on the website [alexa.com](http://alexa.com) as on 27<sup>th</sup> March, 2009, 24.3% of the traffic of their website is attracted from India. The complainant marked copies of the print out from the website [alexa.com](http://alexa.com) as on 27<sup>th</sup> March, 2009 as **Annexure C**.

The complainant further states that in September, 2007 they came to know of the advertisement of the mark DIGITAL BROADCOM in the name of the respondent published in the Indian Trademark journal under No.1163917 in clause 9 and during that time they also became aware of the website [www.digitalbroadcom.co.in](http://www.digitalbroadcom.co.in). The complainant marked the copies of the advertisements along with the old copies of the web pages obtained from the website [www.archive.org](http://www.archive.org) of [www.digitalbraodcom.co.in](http://www.digitalbraodcom.co.in) dated 7<sup>th</sup> December, 2006 and 9<sup>th</sup> January, 2007 as **Annexure D**. In such circumstances, the complainant instructed to their attorneys in India to contact the respondent and advice them of their prior rights of the complainant in their well known mark BROADCOM and instruct them to immediately cease and desist from the use of deceptively similar mark DIGITAL BROADCOM and a cease and desist letter sent by the complainant to the respondent through speed post and courier dated 18.09.2007 is marked **Annexure E**. However, as the complainant did not receive any response from the respondents, a reminder letter was also sent to the respondent on 15.01.2008 by speed post and courier which the complainant marked as **Annexure F**. Further **the complainant** also filed opposition against the application for the registration of



the mark DIGITAL BROADCOM before the trademark registry, Mumbai on 26th September, 2007 which was marked by the complainant as **Annexure G**. The complainant further submits that their subsequent enquires in the market revealed that the respondents had stopped the use of the mark DIGITAL BROADCOM and website [www.digitalbroadcom.com](http://www.digitalbroadcom.com) which was also not fully operational. The complainant marked copies of the print out dated 2<sup>nd</sup> February, 2008 as **Annexure H**. Thereafter, the complainant came to know that the website [www.digitalbroadcom.com](http://www.digitalbroadcom.com) has recently been updated on 30<sup>th</sup> January, 2009 and the complainant marked print out of the WHOIS database with the information regarding the updation of website as **Annexure I**.

#### **4.4 Respondent's Identity and activities:**

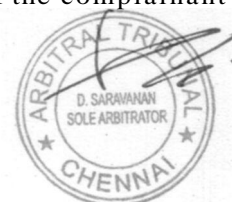
The Respondent is the registrant of the Domain Name <[digitalbroadcom.co.in](http://digitalbroadcom.co.in)> which is registered with .IN REGISTRY, National Internet Exchange of India, New Delhi. The name of the registrant is referred to as Deepak Katara, Saibaba Enterprises, having its mail address at 1, Motiwala Bldg, Proctor Road, Mumbai, Maharashtra, India, as per **Annexure I**.

#### **5. Parties contentions:**

##### **A. Complainant:**

- (a) **The Domain Name is identical or confusingly similar to a Trademark or service mark of the Complainant has rights:**

The disputed domain name viz., [www.digitalbroadcom.co.in](http://www.digitalbroadcom.co.in) is deceptively similar with the complainant's BROADCOM mark, as the disputed domain name incorporates complainant's mark in its entirety. However, the respondent has added a word DIGITAL which is generic word used to describe any media used by a computer. The complainant cites various domains owned by them for or that include BROADCOM, including but not limited to, [www.broadcom.com](http://www.broadcom.com), as well as [www.broadcom.co.in](http://www.broadcom.co.in) and [www.digitalbroadcom.com](http://www.digitalbroadcom.com), the later two of which revert to complainant's website [broadcom.com](http://broadcom.com). According to the complainant, given the enormous global reputation and goodwill enjoyed by the complainant, it is apparent that the respondent has fraudulently acquired the domain name [www.diaitalbroadcom.co.in](http://www.diaitalbroadcom.co.in), which includes the identical mark of the complainant



and is deceptively similar to the trading name / corporate name of the complainant, solely with an intention of diverting the consumers to their website and pass their goods as and for the goods of complainant. The complainant further states the disputed domain name is identical, phonetically and substantially similar to the well known mark / domain name/corporate name of the complainant and that the word 'DIGITAL' is descriptive of the computer related services and is commonly used in relation to the software and hardware products related to computer. The complainant further states that the addition of a word DIGITAL as prefix before well known mark of the complainant does not make it distinctive. To which, the complainant placed a reliance made on the case of Credit Suisse Group-versus-Kingdomdata.net Network, INC case No.D2004-0846 wherein it was observed that the addition of a descriptive word to the trademark does not serve to distinguish the domain names for the trademark and further reliance has been made on the case of Broadcom Corporation-versus-Arya Web Services claim NO.FA0507000523720 whereby the domain name [www.digitalbroadcom.com](http://www.digitalbroadcom.com) was considered to be deceptively similar to the domain name [www.broadcom.com](http://www.broadcom.com) and it was observed that the word 'DIGITAL' is commonly used in connection with the complainant's goods and services. By which, the complainant states that it is undoubtedly established that the disputed domain name is identical or at least confusingly similar to the trade mark and domain names over which the complainant has rights.

**(b) Respondent has no rights or legitimate interests in the domain name:**

According to the Complainant, the respondent neither has any legitimate interest in the disputed domain name nor is the lawful owner of any right relating to the complainant's mark, in which the respondent bears no relationship to the business of the complainant and is neither a licensee nor has obtained authorization of any kind whatsoever to use the complainant's mark. The complainant further states that their website [www.broadcom.com](http://www.broadcom.com) was constructed on 9<sup>th</sup> May, 1994. On the other hand, the disputed domain name was constructed on 13<sup>th</sup> August, 2005 which is a decade after the complainant had commenced the use of mark, corporate name and domain name BROADCOM. The complainant further states that they being the prior user of the mark BROADCOM or the lawful owner of the trademark/corporate name BROADCOM and the respondent do not



have any legitimate interest in the domain name which copies in entirety the trademark/domain name of the complainant. The complainant further states that the respondent was purporting to manufacture and sell identical goods as the goods of the complainant sold under the trademark BROADCOM and the complainant further states that even though the respondent had stopped the use of the mark DIGITAL BROADCOM in the market and the website [www.digitalbroadcom.co.in](http://www.digitalbroadcom.co.in) for a while subsequent to the cease and desist letters of the complainant, the respondent has now started the use of the disputed domain name on 30<sup>th</sup> January, 2009 which is now active without any connecting links. The complainant further states that the respondent's use of the disputed domain name will attract their customers by causing them mistakenly to believe that the respondent is carrying on activities that have been endorsed by the complainant. The complainant further states that the respondent is not known by the domain name who is not making any legitimate or fair use of the domain name. In this respect, the complainant places a reference to the case of Croatia Airlines d.d. versus Modern Empire Internet Limited case No.D2003-0455 wherein it was observed that the use of a domain name that is identical or confusingly similar to a trademark that applies to goods sold by a respondent is not a bonafide use. Further reliance has been placed by the complainant to the case eBay Inc. versus Akram Mehmood (WIPO Case No.DAE2007-0001) and Drexel University versus David Brouda (Case No.D2001-0067) to the effect that the rights or legitimate interests cannot be created where the user of the domain at issue would not choose such a name unless he was seeking to create an impression of association with the complainant. In these circumstances, the complainant states that the absence of any permission by the complainant proves that the respondent has no right or legitimate interest in respect of the disputed domain name. However, the complainant states that the respondent is put to strict proof, in case he claims of having a legitimate interest in the mark.

**(c) Respondent has registered and is using the domain name in bad faith:**

The complainant states that the given circumstances indicate that the respondent has registered or acquired the domain name with dishonest intention to mislead and divert the consumers and to tarnish the well known trademark /





corporate name BROADCOM of the complainant. The complainant further states that both the complainant and the respondent are in the same line of business and are direct competitors. Hence, the respondent has registered and using their domain name in bad faith for commercial gain and to benefit from the goodwill and fame associated with complainant's BROADCOM marks, and from the likelihood that internet users will mistakenly believe the domain name and its associated website are connected with complainant. The complainant further states that the respondent has registered and are using the domain name primarily for the purpose of disrupting the business of the complainant and that the respondent has no prior right and no authorisation given by the complainant concerning the BROADCOM trademark. The complainant further states that the offering of products competitive with complainant's product manifest respondent's clear intention to attract, for commercial gain, internet users to the disputed website by creating a likelihood of confusion with complainant's mark as to the source, sponsorship, affiliation, or endorsement of respondent's product and that the use and registration of a domain name by a direct competitor in an effort to sell competitive product is evidence of bad faith. The complainant further states that the respondent's bad faith registration of the domain name is established by the fact that the domain name completely incorporates complainant's BROADCOM mark and was acquired long after the BROADCOM mark became well known and that the respondent's bad faith use of the domain name is further evidenced by the fact that the respondent has sought to profit from the domain name to create affiliation with the complainant. Therefore, according to the complainant, respondent's use of the complainant's BROADCOM mark bolsters the reputation of respondent by creating an affiliation with the complainant's famous BROADCOM brand. The complainant has placed a reliance vide case No.D2007-1918 to the effect that in the absence of proof with regard to the true relationship between the disputants, the respondent did intentionally attract for commercial gain uses to its website by creating a likelihood of confusion of the complainant's mark. Further reliance has been placed on the judgment in case No.D2000-1100 wherein it was held that the respondent's use of the domain name at issue to resolve to a website where services are offered to internet users is likely to confuse the user into believing that complainant is a source of or is sponsoring the services offered at the site which constitutes evidence of bad faith registration and use. In respect of the



same point, the complainant has placed another reference on the judgment vide case No.D2000-0977.

**B. Respondent:**

The Respondent did not submit any response.

**6. Discussion and Findings:**

It has to be asserted as to Whether the Constitution of Arbitral Tribunal was proper? and Whether the Respondent has received the notice of this Arbitral Tribunal?

Having gone through the procedural history, this Tribunal comes to the irresistible conclusion that the Arbitral Tribunal was properly constituted and Respondent has been notified of the complaint of the Complainant. However, the Respondent did not choose to submit any response and that non-submission of the Response by the Respondent had also been notified to the Respondent on July 16, 2009.

Under paragraph 4 of the IN Domain Name Dispute Resolution Policy (INDRP), the Complainant must prove each of the following three elements of its case:

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



**(a) Identical or confusing similarity:**

i) The Arbitral Tribunal finds that the Complainant has provided evidences that it possesses registered trademark. The Respondent's domain name, <digitalbroadcom.co.in>, consists of entirely Complainant's trademark, except ccTLD and the word "digital". Addition of a word 'digital' which is commonly used in a particular industry, does not serve to distinguish the Domain Names from the Trade Mark. References placed, vide Case No.D2004-0846 and Claim number FA0507000523720 are squarely applies to the case on hand supporting the Complainant's cause. Thus, this Arbitral Tribunal comes to the irresistible conclusion that the disputed domain name <digitalbroadcom.co.in> is confusingly similar or identical to the Complainant's marks.

ii) The Arbitral Tribunal concludes that the Complainant has established paragraph 4(i) of the IN Domain Name Dispute Resolution Policy.

**(b) Respondent's Rights or Legitimate Interests:**

i) The Complainant contends that the Respondent has no legitimate interest in the disputed domain name. Paragraph 7 of the IN Dispute Resolution Policy sets out three elements, any of which shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name for the purposes of paragraph 4(ii) of the Policy. The Respondent had been given the opportunity to respond and to present evidence in support of the elements in paragraph 7 of the INDRP. The Respondent has not chosen to do so and has not filed any response in this proceeding to establish any circumstances that could assist it in demonstrating, any rights or legitimate interests in the disputed domain name. Although, the Complainant is not entitled to relief simply by default of the Respondent to submit a Response, the Arbitral Tribunal can however and does draw evidentiary inferences from the failure of the Respondent to respond. The Complainant has established a prima facie case of lack of rights and legitimate interest and the Respondent has failed to rebut the presumption of absence of rights or legitimate interests.



**ii)** Based on the record, the Respondent does not have rights or legitimate interests in the disputed domain name as the 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 and as such there is no evidence that paragraphs 7(ii) or 7 (ii) of the Policy apply. The Complainant asserts that they have not licensed or otherwise authorized the Respondent to use their trademark.

**iii)** The Arbitral Tribunal is satisfied that the Respondent has no rights or legitimate interests in respect of the disputed domain name and, accordingly paragraph 4(ii) of the Policy is satisfied.

**(c) Registration and Use in Bad faith:**

**i)** Paragraph 6 of the Policy provides the circumstances evidencing registration and use of a domain name in bad faith are that, by using the same, the Respondent has engaged in the similar business competing with the Complainant and the Respondent has intentionally attempted to attract, for commercial gain, internet users to the Respondent's web site or other online locations, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's web site or location.

**ii)** The Respondent has registered the domain name which appears to have been selected precisely for the reason that it is identical or confusingly similar to registered trademarks, trade names and corporate name of the Complainant. The Respondent has no affiliation with the Complainant. Registration of a domain name that is confusingly similar or identical to a famous trademark by any entity, which has no relationship to that mark, is itself sufficient evidence of bad faith registration and use.

**iii)** In view of the submitted evidence and in the specific circumstances of this case, this Arbitral Tribunal draws the inference that Respondent's purpose of registering the domain name was in bad faith within the meaning of the Policy. The Respondent has no legitimate rights or interests in the disputed domain name and




there was no real purpose for registering the disputed domain name other than for commercial gains, and that the intention of the Respondent was simply to generate revenue, either by using the domain name for its own commercial purpose or through the sale of the disputed domain name to the Complainant itself or any other person that has the potential to cause damage to the ability of the Complainant to have peaceful usage of the Complainant's legitimate interest in using their own trade names.

In the light of the above, this Arbitral Tribunal finds that the Complainant has established that the disputed domain name was registered and is being used in bad faith.

**7. Decision:**

For all the foregoing reasons, in accordance with paragraph 10 of the Policy, the Arbitral Tribunal orders that the disputed domain name **<digitalbroadcom.co.in>** be transferred to the Complainant.

**Dated at Chennai (India) on this 5<sup>th</sup> day of August, 2009.**



**(D.SARAVANAN)**  
**Sole Arbitrator**