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11.4.2011

D. SARAVANAN
Arbitrator & Mediator
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P. S. SHANMUGA SUNDARAM
STAMP VENDOR,
L. No. B4 / 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.karnatakabank.in

M/s.Karnataka Bank Limited
"Mahaveer Circle"
Kankanady, Mangalore, Pin: 575001
State of Karnataka, India.
Rep. by Mr.B.Ananthapadmanabha
Assistant General Manager (DC)
ajantha@ktkbank.com

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Complainant

Vs.

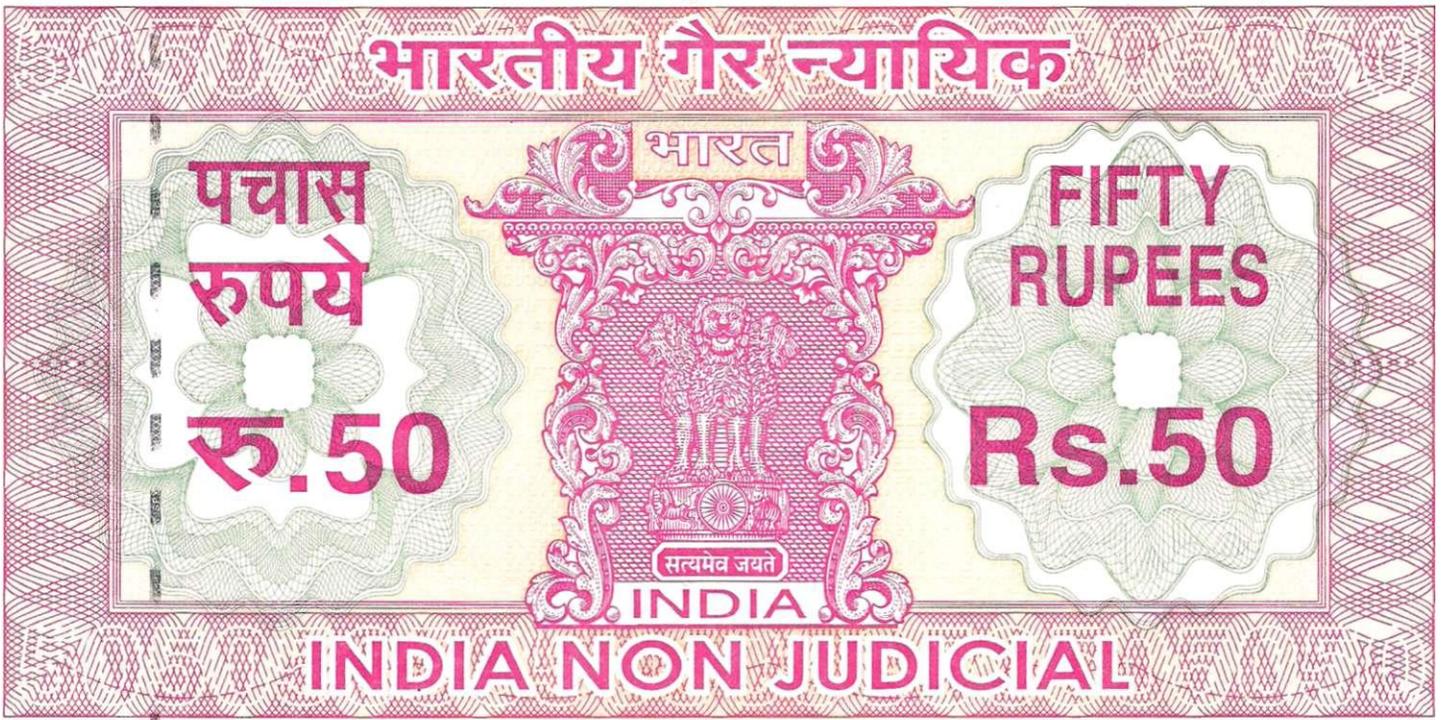
ELI/Shoval
P.O.Box 755, City: Mevaseret Zion
Postal Code: 90805
Country: IL
shoval@eskimo.com

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Respondent

..2.





கமர்ஷியல் தமில்நாடு TAMILNADU, SARAVANAN

Advocate, Arbitrator & Mediator
"Orient Chambers" No.90 (Old No.79),
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S. SURESHKANTH SUNDARAM,
STAMP VENDOR,
L. No. 54 / 109 / 88
HIGH COURT CAMPUS,
CHENNAI-600 004. TAMIL NADU

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1. The Parties:

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The complainant is M/s.Karnataka Bank Limited, having their office at "Mahaveer Circle", Kankanady, Mangalore, Pin: 575001, State of Karnataka, India, Rep. by Mr.B.Ananthapadmanabha, Assistant General Manager (DC).

The respondent is ELI/Shoval, P.O.Box 755, City: Mevaseret Zion, Postal Code: 90805, Country: IL

2. The Domain Name and Registrar:

The disputed domain name:

www.karnatakabank.in

The domain name registered with .IN REGISTRY



April 04,2011 : Complainant forwarded their Rejoinder through email marking a copy to the Respondent and .IN Registry.

: The language of the proceedings in English.

4. Factual Background:

4.1 The Complainant:

The complainant is M/s.Karnataka Bank Limited, having their office at "Mahaveer Circle", Kankanady, Mangalore, Pin: 575001, State of Karnataka, India, Rep. by Mr.B.Ananthapadmanabha, Assistant General Manager (DC).

4.2 Complainant's Activities:

The Complainant viz., Karnataka Bank Limited, a leading 'A' Class Scheduled Commercial Bank in India, was incorporated on February 18, 1924 at Mangalore, a coastal town of Dakshina Kannada District in Karnataka State and is now a leading private sector Bank with a national presence having a network of 466 Branches spread across 20 states and 2 Union Territories.

4.3 Complainant's Trading Name:

The Complainant is the owner of the figurative trade mark(s) "Karnataka Bank" throughout in India, and the Complainant has registered, and operates globally a number of websites using its trademark 'Karnataka Bank' in Generic and Country Code Top Level Domain Name Extensions, such as, www.ktkbank.com, www.thekarnatakabankltd.com, www.karnatakabankltd.com, www.karnatakabank.net, www.karnatakabank.org, www.karnatakabank.info, www.karnatakabank.co.in, www.ktkbank.in, www.ktkbank.net, www.ktkbank.co.in, www.ktkbank.co, www.karnatakabankonline.com, www.karnatakabank.net.in, www.ktkbankltd.com www.karnatakabank.com, and www.moneyclick.karnatakabank.co.in and such registration of domain names are still valid and in force.



4,4 Respondent's Identity and activities:

The respondent is ELI/Shoval, P.O.Box 755, City: Mevaseret Zion, Postal Code: 90805, Country: IL

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

The complainant states that they are the owner of trademark registrations with the term 'karnatakbank' in several jurisdictions and the Complainant is the registered proprietor of the mark ['Karnataka Bank'] in India under the Trade Marks Act, 1999. The Complainant further states that as the disputed domain name is 'Karntakabank.in' which is clearly identical/confusingly similar to the Complainant's trademark in which the Complainant has exclusive rights and legitimate interest. The Complainant further states that the Respondent has not only registered and hosted the disputed domain "karnatakabank.in" and allowed hackers/attackers to use this domain to create a phishing site exactly similar to the Internet Banking Service hosted by the Complainant, hackers/attackers use this phishing website to send phishing mails to general public across the world and India generally under the subject name of "security unupdate of Karnataka Bank" inviting them to enter the Internet Banking login/userid/transaction ID, password, and email ID which phishing mails cause severe damage to Complainant's reputation and name in the Indian Banking Industry, the Complainant has also attached the proof as evidence under Annexure II.

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

The Respondent has registered the disputed domain name intentionally to attract the bank customers and to conduct social engineering attack popularly referred to as Phising, in order to hack the complainant's customer credentials and to cause



financial loss to complainant and its customers by gaining unauthorized access using the customer credentials; phishing mails to general public with intention to mislead which is bad in law; damage to the reputation of the Bank which has a long and prestigious history of 87 years in Indian Banking Industry and is currently one of the reputed old generation private sector banks in India; and confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

B. Respondent:

The Respondent submitted its reply stating *inter - alia* that no evidence of any trademark rights were attached to the complainant and the complainant was called upon to produce evidence that the term "Karnataka Bank" is a registered trademark; the respondent registered many Generic domains related to India (mainly in area of tourism, travel, jobs etc.,) with no intention to infringe on any existing trademark, the respondent assumed that "Karnataka Bank" is pure generic term just like "Karnataka jobs" or "Karnataka hotel" or "Karnataka property"; domain was registered for future development as a website, and in the meantime has only been "parked" with companies such as Domiansponser.com or Sedo.com who provide web pages with ads to the domain name; the respondent never been using this domain to create a "phishing website" as falsely claimed in complaint; the respondent never hosted this domain; the domain has been hosted since its creation by an Indian Registrar (Resellerclub.com), the Direct Indian group of companies; the respondent never created or used any email account related to this domain; the respondent has no idea who/how was the domain used as a "fake site" to supposedly scam the complainant's customers' the 'evidences' attached to the complaint have nothing to do with the respondent; complainant should **investigate** who used Karnataka.in domain in any illegal fashion; the respondent owns thousands of domains and they never been accused of any activity; the respondent demand that these false allegations and lies be immediately withdrawn by



complainant, or they shall immediately file complaints against Karnataka Bank with the Reserve Bank of India and other Indian authorities in charge of regulating banks; they shall also ask that the Indian authorities investigate whether Karnataka Bank itself created that "phishing website"; the respondent shall gladly transfer domain to complainant, or just delete it, upon receiving proof of trade mark registration and the respondent would have done it if they were approached earlier by the Complainant Bank itself.

C. Rejoinder filed by the Complainant:

The Complainant states *inter - alia* that Karnataka Bank Is registered under the Banking Regulation Act and is functioning under the trade name and trademark since 1924; as per the common law principles it is not at all mandatory in India to register the mark; it is an undisputed fact that the trademark Karnataka Bank is exclusively associated with the compliant only; the complainant is the registered owner of the domain name www.karnatakabank.com, hence it is not necessary for the complainant to provide the Respondents with any proof of the trademark. The Complainant further states that any search engine would have proved the contrary and the Respondent ought to have run a check of the same and in the absence of it they are liable for their inaction; it is impossible to believe that the use of the term 'BANK' attached to any other name would result in a generic word; it is not legally possible anywhere in the world to use the word BANK loosely which once again proves the malafide intention of the Registrant. The Complainant further states that as informed by respondent, Registering the domain for future business gain itself is proof that respondent is "acted in bad faith", moreover, if they were intended for future development, how was the subject domain name used; parking the domain name with third party vendors, the Registrant have willfully allowed hackers/attackers to use the domain name for sending phishing emails, creating fake websites. The Complainant further states that they remind the Registrant that they are talking about domain name "karnatakabank.in" and not "karnataka.in" and further remind that if the respondent own thousands of websites they ought to



exercise diligence over the same. The Complainant further states that being reckless with respondent's products has inflicted huge harm to complainant's reputation and goodwill which at any cost shall not be allowed; and complainant strongly condemn respondent's allegations and false claims which has to be withdrawn immediately. By stating so, the Complainant requires the respondent to transfer the domain name "karnatakabank.in" at earliest to the complainant without requiring any further proofs and delay. The Complainant further states that the reply filed is without prejudice to Bank's right to file for infringement of trademark.

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.

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:

The Arbitral Tribunal finds that the Complainant is a 'A' Class scheduled commercial bank in India which was incorporated way back on 18.02.1924 under the



trade name and trade mark i.e., Karnataka Bank, which is clearly established by a Certificate of Registration vide No.4 of 1923-1924 issued by the Assistant Registrar of Joint Stocks Companies, South Kanara, and the same is now a leading private sector bank with all India presence having a network throughout the country. In the course of the Complainant's Banking business they had registered various domain names under various gTLDs, and ccTLD, like www.karnatakabank.co.in, www.ktkbank.in, www.ktkbank.co.in, www.ktkbank.co etc., Since the Complainant's trade name and trade mark is coupled the place of its origin and the nature of its business i.e., Karnataka + bank, their trade name and mark i.e., Karnataka Bank Ltd., being a body corporate, by stretch of imagination, cannot be termed as generic term as elicited by the Respondents like "Karnataka Jobs", "Karnataka Hotel" and "Karnataka Properties". It is known to the common public in India that the trade name and trade mark Karnataka Bank is exclusively meant and associated with the Complainant. As the per the common law principles it is not at all mandatory in India to register the mark. Sub Section 2 of Section 27 of the Trade Marks Act, 1999 recognizes the common law rights of the trademark owner to take civil and criminal action against the any person for passing off goods or services of another person or the remedies thereof. Section 2(l)(zb) of the TM Act, 1999 defines "trade mark" to mean a registered trade mark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark etc., In other words, an unregistered trade mark is placed on the same footing as a registered mark in respect of trade mark offences, penalties and procedures and in respect of all civil actions as contemplated in Section 134 and 135, apart from the specific provision in Section 27 (2) for obtaining civil remedies on the basis of an action for passing off. Admittedly, the respondent is neither a registered trade mark owner over the disputed domain name nor carrying on any bonafide business under the disputed domain name. On the other hand, the disputed domain name is simply parked in websites such as www.domainsponsor.com and www.sedo.com which is known for its business of domain market place. Hence, this Tribunal of the firm view that the owner of the



unregistered trade name and trade mark could maintain an action for infringement of a trade mark and that action could only be maintained on the assumption that he was the owner of the trade mark and he had a proprietary right in the trade mark. The Complainant has provided evidences that it possesses trade name and trade mark "karnatakabank" since 1923. More so, the Complainant is the owner of registered similar domain names in the very same ccTLDs such as www.karnatakabank.co.in , www.ktkbank.in, www.ktkbank.co.in, www.ktkbank.co. That be so, Respondent's domain name, <karnatakabank.in>, consists of entirely Complainant's trademark, except .co. Thus, this Arbitral Tribunal comes to the irresistible conclusion that the disputed domain name <karnatakabank.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 Complainant has established a prima facie case of lack of rights and legitimate interest and the Respondent has failed to rebut the rights or legitimate interests of Complainant. Considering the above, and 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(iii) of the Policy apply.



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 a pattern of such conduct 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) Admittedly, the Respondent has registered more than 1000 domain names, who has also registered the disputed domain name which appears to have been selected precisely for the reason that it is identical or confusingly similar to trademarks and trade names of the Complainant. Registration of a domain name that is confusingly similar or identical to a famous trademark and trade name by any entity, which has no relationship to that mark, is itself sufficient evidence of bad faith registration and use.

iii) This Tribunal finds that the Complainant is doing banking business involving public money in a large scale. It is also known to public at large that there are instances of hackers/attackers inviting the customers of banks to enter the internet banking login/user id/transaction ID/password, email id etc., by which there are instances of fraud and cheating of hard earned money of customers of banks which ultimately affect the reputation of Banks. 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 and or through the sale of the disputed domain name to a competitor 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 <karnatakabank.in>, be transferred to the Complainant.

Dated at Chennai (India) on this 15th April, 2011.


(D.SARAVANAN)
Sole Arbitrator