



हरियाणा HARYANA

M 682659

**BEFORE THE NATIONAL INTERNET EXCHANGE OF
INDIA**

ARBITRATION AWARD

In The Matter Between

MARUTI SUZUKI INDIA LIMITED

Plot No 1, Nelson Mandela Road

Vasant Kunj

New Delhi 110070

INDIA

Complainant

Versus.

ICM Computer Consultants

New No. 6, Old No. 8

Kalakshetra Avenue, II nd Street

Tiruvanmiyur

Chennai 600041

INDIA

Respondent

Hanni Narayana

1. The Parties

The Complainant is Maruti Suzuki India Limited, and is represented in these proceedings by L.S. Davar & Co., New Delhi India.

The Respondent is ICM Computers of Chennai, India and is represented internally.

2. The Domain name, Registrar and Policy

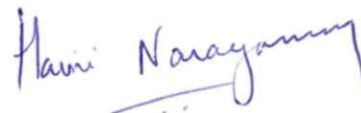
The present Arbitration proceeding pertains to a dispute regarding the domain name <maruticarinsurance.in>. The registrar for the disputed domain name is Silicon House.

The Arbitration proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the .IN Domain Name Dispute Resolution Policy (the "INDRP Policy" or "Policy"), and the INDRP Rules of Procedure (the "Rules").

3. Procedural History

The sole arbitrator appointed in the case is Mrs. Harini Narayanswamy. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, in compliance with the Rules.

The Arbitrator received the Complaint from the .IN registry on August 9, 2013 and on August 10, 2013 transmitted by email a notification of commencement of the arbitration proceedings to the Respondent. Under the INDRP Rules, copies of the said notification were sent to other interested parties to the dispute. The Respondent sent the response on October 1, 2013. The Complainant made a representation to the Arbitrator requesting for time to file a Rejoinder and was given an additional month for the same. The Complainant filed its rejoinder on November 12, 2013. The Respondent was given time till November 26, 2013 to file a reply to the Rejoinder. The Respondent did not file a reply to the Complainant's rejoinder.



Factual Background

The Complainant is in the business of manufacture and sale of passenger cars and uses the trademark MARUTI for its business. The Complainant has several registered trademarks for its mark in numerous countries and has provided a list of its registered marks, including details and copies of its registered marks. The Complainant has provided details of its Indian trademark registrations, some of these are:

MARUTI	REGISTRATION NUMBER	561721
MARUTI TRUE VALUE	REGISTRATION NUMBERS	647291, 647296
MARUTI SERVICE ZONE	REGISTRATION NUMBER	1723063

The Respondent is in the business of selling insurance products and services and conducts its operations under the brand EASY INSURANCE INDIA. The Respondent registered the disputed domain name <maruticarinsurance.in> on November 9 , 2011.

The Parties Contentions

A. Complainant's Submissions

1. The Complainant states it was incorporated on 24.02.1981 and was formerly known as Maruti Udyog Limited. It is a subsidiary of Suzuki Motor Corporation of Japan. Over the last thirty years, the Complainant states it has contributed as a growth engine for the Indian automobile industry and has impacted the lifestyle of an entire generation of Indians particularly the Indian middle class.
2. The Complainant states it has a network of 1100 centers in 801 towns and cities, and provides service support to customers at 2950 workshops in over 1400 towns and cities. The Complainant states it is focused on rapidly expanding sales and services and offers state of art research and development capabilities of international quality to stays ahead of times. In the fiscal year 2009 -2010 it was the only Indian company to manufacture and sell one million cars in a year.

Hanir Narayana

3. The Complainant states it has been ranked as India's most trusted brand in the automobile Sector by India's leading Business newspaper 'The Economic Times'. It has also been conferred JD Power Customer Service Index Award- India for the period 2000-2012. The Complainant states its biggest draw for the past twelve years has been the award for highest recognition by the customer. In 2011-12 for the twelfth consecutive time it has been ranked highest in J.D Power Asia Pacific 2010 India Customer Service Index (CSI) study: During the years 2009 to 2012 the Complainant states that its products and services received reputed awards and accolades. These are: J.D. Power Sales Satisfaction Index, Hatch back of the year Ritz by Auto Car. Car of The Year by Business Monitoring and Manufacturer of the year by CNBC Overdrive. Asia Pacific 2010 India Customer Service Index (CSI) study. National Award for Excellence in Corporate Governance by ICSI, Business Standard Company of the Year 2011, its DZire won the JD Power APEAL Study for a third time in a row. The Complainant provides details of its commitment to Road Safety.
4. The Complainant is also involved in sale and purchase of its products under the name and style of "True Value Pre Owned Cars" commonly called Maruti True Value. It is the India's largest certified used car dealer network, with about 358 outlets in 210 cities and is growing. All car related services are provided under one roof by its professionally trained manpower states the Complainant.
5. The Complainant states it adopted the trademark MARUTI in the year 1972 and is the registered proprietor of several trademarks in many classes and has worldwide trademark registrations. In India the trademark is registered under classes 4, 12, 16, 41 and 42. The Complainant consistently and prominently displays and advertises its goods under its registered Trademark MARUTI.
6. The Complainant states it has spent considerable amounts on marketing, sales and advertisement for the trademark MARUTI SUZUKI. Its advertisement expenses for its products under the trademark during 2010 -2011 was 4800 million rupees, and for year 2009 -2010 it was 4320 million rupees. The Complainant has filed copies of invoices showing sales in India under the Trademark MARUTI and MARUTI SUZUKI for the past year as evidence.

Hanvi Narayanan

7. The Complainant states it has about 114 domain names registered throughout the world having “Maruti” and “Maruti Suzuki” as a significant part of these domain names. The Complainant asserts that it is prior adopter of the word MARUTI and MARUTI SUZUKI throughout the world including India.
8. The Complainant has provided figures of its worldwide sales bearing the trademark MARUTI and MARUTI SUZUKI for the past five years. That the trademarks when used on or in relation to the goods as indicated, still indicates to purchasers the Complainant as a source of origin. Copies of magazine advertisements and published material are filed as evidence.
9. The Complainant states goods sold by Complainant under MARUTI trademark are of excellent quality and has worldwide repute. The Complainant argues that the disputed domain name is identical to its well known registered trademark of which it is the exclusive proprietor and the Respondent has no rights and legitimate interests in the disputed domain name. Is not the personal name or surname, trademark or service mark or trading name of the Respondent and the Respondent has no reason to adopt the domain name <maruticarinsurance.in> with it well known mark argues the Complainant. The Respondent has registered the disputed domain name in bad faith with intention of exploiting goodwill and reputation associated with the mark. The Respondent uses the MARUTI SUZUKI trademarks and pictures of the Complainant’s model cars and is unauthorized to do so. Thereby the Respondent causes confusion and deception as to source of sponsorship of the Respondent’s products and public may believe the Respondent’s products originate from the Complainant or is approved by Complainant or is connected in someway with the Complainant.
10. The Complainant argues that the Respondent registered the disputed domain name to trade on the reputation of the well-known mark that the general public associate exclusively with the Complainant and the disputed domain name will deceive the public into thinking that it is in some way associated with Complainant. Such use of the trademark is likely to causes confusion among the public and it prevents the Complainant from reflecting its mark in a corresponding domain name. Further it attracts Internet users to Respondent’s website or other online location, by creating a

Haviri Narayannay

likelihood of confusion with the Complainant's trademark as to source, sponsorship affiliation or endorsement of the Respondent's website and is bad faith registration and use. The Complainant therefore requests for transfer of the disputed domain name.

Respondent's Submissions

1. The Respondent ICM Insurance Brokers Pvt. Ltd. states that it is in the business of selling insurance for two and four wheeled vehicles of various car manufacturers and in particular for Audi, BMW, Chevrolet, Fiat, Ford, Honda, Hyundai, Mahindra & Mahindra, Mercedes, Mitsubishi, Skoda, Tata, Toyota and the Complainant's Maruti cars.

2. The Respondent states that being in the business of rendering insurance services, its website provides an online tool for making comparisons of various insurance policies to obtain the most affordable rates. The Respondent states that more than 1.5 million people have visited the website connected to the disputed domain name <maruticarinsurance.in> and that 10 percent have chosen to get recurring service from ICM Insurance Brokers doing business as www.easyinsuranceindia.com. The Respondent says that its website helps consumers make comparisons for various insurance quotes based on various models of car manufacturers. Thereby the customer can compare the quotes of several insurance companies through its website and purchase the required insurance for the required vehicles. Services offered by the Respondent are only for residents of India and for insurance requirements in India, adds the Respondent.

3. The Respondent states that the Complainant has furnished several hundred pages to substantiate their claim that the Respondent is an unauthorized user of the disputed domain name. The Respondent argues that the Complainant is not in the area of selling insurance policies although they have obtained a domain name for the same. The Respondent alleges that the persons using their website and those who avail its services

Havri Narayn

are an educated lot, who can easily determine that Insurance Policies sold by the Respondent is not part of Complainant's services.

3. The Respondent argues that there is no indication of a tie up with the Complainant. The Respondent further argues that there is no other way that it uses the Complainant's brand but only to indicate the services being rendered by the Respondent are for specific brands and to offer the best car insurance to customers owning motor vehicles manufactured by the Complainant.

4. The Respondent further argues that there is no other way it can sell insurance policies without making reference to the "Maruti" name for selling insurance products for a specific model of Maruti car. Once the customer fills up the form, the customer is then directed to the site from where the payment gateway is facilitated. The Respondent argues the disputed domain name has nothing to do with the Complainant and the end customer knows he is not dealing with the Complainant as the payment is executed through the Respondent's website of easyinsuranceindia.com.

5. The Respondent states it is not trading upon the goodwill of the Complainant or setting itself to be part of the Complainant's spectrum of services. The Respondent states that it has to refer to the Complainant's brand MARUTI in order to sell insurance policies, as the insurance industry standards are specific to the brand of vehicles, model of vehicle etc. without which the insurance premium cannot be computed. The Respondent claims that it is only doing what is required in law for the time being in force and also what is legally permitted. Without such reference to the stable of the Complainant's products, there can be no transaction effected for the sale of insurance policies by the Respondent.

6. The Respondent states there are no trademark violations on its part and the INDRP dispute has been filed only to harass the Respondent. There is no question of confusion arising, as the persons using the services of the Respondent are a very educated lot.

Havini Narayannay

7. Goodwill is associated with a particular trade, argues the Respondent, and the Complainant is not in the space of selling insurance policies therefore question of goodwill with regard to the brand Maruti for insurance services does not arise due to non use of the brand for insurance brokerage, therefore the question of passing off also will not lie. The question of infringement with regard to Respondent's use of the name does not arise as the Complainant is not a registered proprietor of the brand MARUTI for insurance brokerage and therefore the Complainant has no case under the Trademarks Act 1999 either with infringement or passing off.

8. The Respondent further argues that the Complainant has approached the present forum to confuse and to obtain cancellation of disputed domain name. There is no reference to the Complainant in a manner suggesting violation on its part argues the Respondent, and customers are not likely to be misled as the end transaction is made through the "easyinsuranceindia" website.

9. The Respondent then answers paragraph-wise the allegations in the Complaint and states that the Complaint is hit by delay as the Respondent had registered the disputed domain name on November 9, 2011 and had started using it from February 2012. Therefore the Complaint has been filed a year and a half after the Respondent's use of the domain name. Given the visibility of its website in the age of instant communication, the Respondent argues the laws of acquiescence ought to apply equally rapidly.

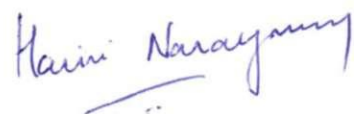
10. The Respondent raises several other extraneous issues regarding the signature on the documents submitted by the Complainant, the stamp paper and states that the Complainant has to file a legal use certificate to rely on the trademark certificates and also argues that various goods and services mentioned in the Complainant's registration certificates does not mention "insurance" services. The Respondent argues that Complainant ought not to have monopoly in a name that is the name of a Hindu deity. Based on all its submissions the Respondent requests for denial of the Complaint.

Havir Narayany

Complainant's Rejoinder

The Complainant in its Rejoinder refutes the Respondent's argument that "Maruti" being the name of a deity has no relevance to the issues in the present dispute as the Complainant has established secondary meaning in the name. The Complainant next refutes the argument of the Respondent that there are differences between goods and services offered by the Complainant and the services offered by the Respondent. The Complainant states the common field of activity argument is not tenable in domain name disputes and there are several courts decisions to support this argument. The Complainant reiterates its arguments of being the first to adopt and use the trademark MARUTI and has used it continuously for thirty years. The Complainant provides further details of its trademark registrations and figures of its extensive sales turnover under the mark from the year 1983 -84 till 2012 -13 and argues that the Respondent seeks to take advantage of the goodwill associated with its mark. The Complainant argues that the Respondent's submission of its payment gateway being "easyinsuranceindia.com" is no defence and argues that the Respondent ought to use the said domain "easyinsuranceindia.com" and not the disputed domain name with the Complainant's mark.

The Complainant re-emphasizes that its mark is well known and the public associate the Complainant with the mark. The Complainant answers paragraph-wise the contentions made in the Respondent's response and states that the Respondent had registered its "easyinsuranceindia.com" domain name in the year 2007 and the fact that the disputed domain name was registered in 2009 shows its *mala-fide* intentions. The Complainant further states that its sister concern is also providing car insurance services for cars and therefore likely hood of confusion is bound to arise. The Complainant strongly denies there has been delay in filing the present Complaint and argues that it took action when it became aware of the disputed domain name and states that there is no limitation to file a domain name complaint. The Complainant answers the allegations regarding the signature of its authorized representative and states that the Respondent has not signed the Response and adds that the Respondent is making frivolous arguments as it lacks defence for its case, and requests for the relief of transfer of the disputed domain name.



The Respondent did not reply to the Complainant's Rejoinder.

Discussion and Findings

Paragraph 4 of the INDRP Policy mandates that the Complainant has to establish the following three elements to succeed in the proceedings:

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

Identical or Confusingly Similar

The first element requires the Complainant to prove that the domain name registered by the Respondent is identical or confusingly similar to a mark in which the Complainant has rights.

The Complainant has demonstrated its rights in the MARUTI trademark and has submitted details of its Indian and international trademark registrations. Trademark registration is *prima facie* evidence of rights in a mark; the Complainant has accordingly established its rights in the trademark MARUTI in these proceedings. The Complainant has also established that the MARUTI mark has acquired secondary meaning due to extensive use by the Complainant for a period of about thirty years.

The disputed domain name consists of the trademark MARUTI along with the terms "car insurance" and the country code Top Level Domain (ccTLD) ".IN". The Complainant's



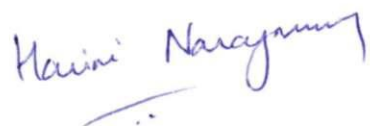
trademark is well known and combining two common words with the trademark of the Complainant does not lessen confusing similarity with the Complainant's mark.

As the disputed domain name clearly incorporates the MARUTI mark, the Arbitrator finds that the Complainant has satisfied the first element under paragraph 4 of the Policy, that the disputed domain name registered by the Respondent is identical and confusingly similar to a mark in which the Complainant has rights.

Rights and Legitimate Interests

The second element requires the Complainant to show that the Respondent lacks rights and legitimate interests in the disputed domain name. The burden of proving rights or legitimate interests in the disputed domain name rests with the Respondent. Paragraph 7 of the Policy, provides a non-exhaustive list of circumstances that a Respondent could rely on to establish rights in the domain name. These briefly are: (i) if before notice of the dispute, the registrant had used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services or (ii) the registrant (as an individual, business organization) has been commonly known by the domain name, or (iii) The registrant is making legitimate, non commercial or fair use of the domain name without intent for commercial gain.

The Respondent has submitted that the disputed domain name is used in connection with a offering insurance services and that such use had commenced prior to receiving notice of the present dispute. The issue that arises here is whether the Respondent is using the disputed domain name in connection with a *bona fide* offering of services and if so whether the Respondent has legitimate rights in the disputed domain name. Previous domain name cases have considered the question whether making *bona fide* offering of goods and services using the trademark of another could be deemed as conferring legitimate interests in a domain name. In *Daimler Chrysler A.G v. Donald Drummonds*, WIPO Case No.D2001-0160, (with a dissent) it was found the use of the MERCEDES trademark was nominative fair use to accurately describe the business of the respondent



marketing automotive parts and accessories for Mercedes and the respondent was held to have a legitimate interest in using the MERCEDES mark in its domain name <mercedesshop.com> with a disclaimer on the website stating that the trademark

MERCEDES was owned by the complainant.

It is well settled that a reseller or a sales agent can have a legitimate interest in a domain name bearing the trademark of another if certain specific requirements are met. This proposition was acknowledged in the domain name case *Oki Data Americas, Inc. v. ASD Inc*, WIPO Case No.D2001- 0903(<okidataparts.com>), where it was held that an authorized reseller could legitimately use a complainant's trademark in a domain name provided certain factors were found present. The factors discussed in the *Okidata* case were:

- the respondent must actually be offering the goods or services at issue;
- the respondent must use the site to sell only the trademarked goods (otherwise, there is the possibility that the respondent is using the trademark in a domain name to bait consumers and then switch them to other goods or services);
- the site itself must accurately disclose the respondent's relationship with the trademark owner; and
- the respondent must not try to corner the market in all relevant domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.

The principles laid down in the *Okidata* case were followed in other cases such as in *Volvo Trademark Holding AB v Auto Shivuk* WIPO Case No D2005-0447 concerning the domain name <volvo-auto-body part-online.com>. Subsequently the *Okidata* principles were also adopted in cases where unauthorized resellers used trademarks in domain names. See *ITT Manufacturing Enterprises, Inc. ITT Corporation v. Nicoll, Differential Pressure Instruments, Inc.* WIPO Case D2008-0936, where the respondent in that case was offering for sale the complainant's surplus ITT Barton products and related testing, repair and warranty services. The respondent was an unauthorized reseller of the complainant's products and was found to be using the domain name in connection with a

Hanin Narayanan

bona fide offering of goods and services and the use of the trademark in the domain name was held to be legitimate use.

The facts that emerge from the submissions made by the parties and the material on record show that the Respondent is an authorized seller of insurance products. The Respondent has filed as evidence screen shots of its website that show it offers an online tool for calculating the insurance premium for a specific brand of car based on user input, where the user has to input the details of model of the vehicle, age of the vehicle etc. and the user will get the computed amount of the insurance premium for that particular car.

On the question of whether the Respondent has legitimate rights to use the trademark of the Complainant in its domain name, the Arbitrator finds, with reference to the *Okidata* factors, the Respondent is offering insurance products and services from the website linked to the disputed domain name. The Respondent has not registered numerous Maruti car-related domain names, and has placed a disclaimer on its website stating: “We hereby recognize that this logo is the registered trademark of Maruti Suzuki India Ltd.”

With regard to the second *OKIDATA* factor that stipulates that the respondent must use the domain name to sell only the trademarked goods (otherwise, there is the possibility that the respondent is using the trademark in a domain name to bait consumers and then switch them to other goods or services), the Arbitrator notes that the Respondent has admitted that it trades under the name “Easyinsuranceindia” and that customers are being diverted to the Easy Insurance India site for payment. Therefore the Respondent is clearly not offering its insurance products and services under its own trademark when it uses the disputed domain name but instead uses the disputed domain name with the trademark of the Complainant to attract customers and then diverts the customers from <maruticarinsurance.in> to its other website <easyinsuranceindia.com> for receiving payment.

The Respondent has submitted in its pleadings that more than 1.5 million people have visited the site <maruticarinsurance.in> and that 10 percent have chosen to get recurring



service from ICM Insurance Brokers doing business as www.easyinsuranceindia.com.

The use of Complainant's trademark in the disputed domain name in this manner to intentionally and knowingly attract or draw customers to one website and then to divert customers to another site is evidently to derive benefit of the well known trademark of the Complainant.

Domain names like trademarks are considered as identifiers of source. The question whether the use of a trademark by a manufacture of unoriginal spare parts in its domain was discussed in the case *Volvo Trademark Holding AB v Peter Lambe*, WIPO Case No. D2001-1292, (volvoexhausts.com), it was held that a manufacturer of unoriginal spare parts is entitled to a certain limited use of the trademark of the manufacturer of the original products in connection with the *bona fide* offering of these goods, but this principle does not entitle the said manufacturer to incorporate the trademark in his business name or any other type of business identifier such as a domain name.

The same rational can be applied to the facts in the present case where the Respondent is providing ancillary services namely insurance for vehicles, including those vehicles manufactured by the Complainant. The Arbitrator recognizes that the Respondent is entitled to a limited use of the trademark in a descriptive manner in connection with its business to identify the Complainant's products for which it is offering insurance products or services, but it does not entitle the Respondent use of the Complainant's trademark in the disputed domain name for attracting customers and then diverting them, which is not recognized as legitimate use under the Policy.

Accordingly, for the reasons discussed, the Arbitrator finds the facts and circumstance of the case show the Respondent lacks rights and legitimate interests in the disputed domain name. The Complainant has accordingly satisfied the second element under paragraph 4 of the Policy.

Bad Faith

Havin Narayany

The third element requires the Complainant to establish the Respondent has registered or has used the disputed domain name in bad faith.

The Respondent's present use of the trademark in the domain name seems to be with the intention of getting customers based on the trademark of the Complainant and then diverting them to a different website from where payments are collected. The Respondent has argued that the Complainant uses the MARUTI mark in a descriptive manner to identify the vehicles for which it sells insurance and the users of its website are educated people who can discern that the Respondent is offering insurance and hence there is no bad faith on its part. The Respondent's website is however accessible only through the disputed domain name, which misleadingly appears to be a domain name of the Complainant and can mislead consumers and Internet users looking for products endorsed by the Complainant to the Respondent's website.

In *Volvo Trademark Holding AB v. Nick Bauer* WIPO Case No.D2002-1025 it was discussed that the respondent cannot be prevented from using the VOLVO trademark in a non- trademark sense on its website but as the website is accessible through the domain name, which misleadingly appears to be a domain name of the Complainant, consumers are likely to realize this only once they have actually accessed the site and see the disclaimer added by the Respondent. Furthermore, the disclaimer is at the bottom of the page along with a statement in very small print stating the website is powered by Easy Insurance India. Therefore such use of the trademark by the Respondent in the disputed domain name has the potential to confuse customers.

In view of the above circumstances, the Arbitrator is of the considered view that use the disputed domain name is being used in bad faith and the Complainant has established the third element required under paragraph 4 of the INDRP Policy.

Hanni Narayana

Delay

The Arbitrator notes the Respondent's submission that the Complainant has filed this action after a year and a half of developing its website in connection with its insurance business. The Arbitrator therefore orders costs of Rupees fifty thousand to be paid by the Complainant to the Respondent within four weeks of this order due to delay in taking the present action.

Decision

The Arbitrator orders the registrar to transfer the disputed domain name <maruticarinsurance.in> to the Complainant.



Harini Narayanswamy

(Arbitrator)

Date: December 16, 2013