



சுழிமுகாடு தமில்நாடு TAMILNADU

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17.5.2013

Sridharan

AL 596645
J. NELSON
STAMP VENDOR
L.No. 1367/21/98
HIGH COURT CAMPUS
CHENNAI 100

BEFORE S SRIDHARAN, SOLE ARBITRATOR

OF NATIONAL INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

DATED: 14th September 2013

Hearing: Mumbai

Award Delivered: Chennai

Microsoft Corporation, USA

...

Complainant

Versus

Piyush Somani
ESDS Software Solution Private Limited
Maharashtra, India

...

Respondent

Sridharan

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1. The Parties

- 1.1 The complainant, **Microsoft Corporation** is a company organized and existing under the laws of the State of Washington, USA, having its principal office at One Microsoft Way, Redmond, WA 98052-6399, USA, represented by Pravin Anand and Nishchal Anand, advocates of Anand & Anand, at First Channel, Plot No.17A, Sector 16A, Film City, Noida.
- 1.2 Respondent is Piyush Somani of ESDS Software Solution Private Limited, B-24 & B-25, NICE Industrial Area, Satpur MIDC, Nashik, Maharashtra – 422 007

The Domain Name and Registrar

- 1.3 The disputed domain name **<microsoft.co.in>** created on 16.02.2005 is registered with Directi Internet Solutions Pvt. Ltd (R5-AFIN).

2. Procedural History

- 2.1 On 24th June 2013, NIXI asked me about my availability and consent to take up the Complaint for arbitration. On the same day, 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 3rd July 2013, I received hardcopy of the Complaint. On the same day, 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. I further asked him to explain the delay of 8 years in initiating action.

- 2.3 On 4th July 2013, I received a soft copy of the Complaint. Complainant also sent his explanation for the delay.
- 2.4 On 6th July 2013, I received Respondent's reply.
- 2.5 On 30th July 2013, the Respondent wanted to know the process of hearing. On 5th August 2013, the counsel for the Respondent made a formal request for personal hearing and the same was granted by me.
- 2.6 The hearing was fixed on 18th August 2013 in Mumbai. Complainant and the Respondent attended the hearing on the scheduled date at the Business Center, Sahara Star, Mumbai.
- 2.7 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 The Complainant was set up in the year 1975 and is the biggest software publisher for personal and business computing in the world. The Complainant engages in the development, manufacture, licensing, and support of a range of software products for various computing devices. Its software products include operating systems for servers, personal computers (PC), and intelligent devices; server applications for distributed computing environments; information worker productivity applications; and software developments tools. The Complainant also sells video game console (Xbox), video games and engages in online business through various Internet portals (MSN etc.).
- 3.2 The Complainant's popular software products include the most widely used operating system software, MICROSOFT WINDOWS (various versions), and application software such as MICROSOFT OFFICE (various versions) and VISUAL STUDIO (various versions). These softwares are today installed and used on millions of computers all over the world, including India. Other popular software products of Complainant include Microsoft Windows Server System, Microsoft Publisher, Microsoft Visio, Microsoft Project and other stand-alone desktop applications. A more detailed list of the popular software programs of the Complainant's is filed in "**Annexure-A**".
- 3.3 Apart from computer software programs, the Complainant also manufactures a large range of computer peripherals (hardware). The Microsoft Hardware group established in 1982 has been an integral part of the Plaintiffs' growth for 27 years. During this period, the Complainant has built its reputation for technological expertise in hardware by developing and launching a series of successful devices including the ergonomically designed Mouse and Keyboard. The Complainant also provides its customers with the premium cloud computing and hosting services.
- 3.4 The Complainant Microsoft Corporation has a current market capitalization of \$ 290.95B as on 12th June 2013. This is ahead by leaps and bounds of other well-known and famous web sites. A copy of an excerpt from www.finance.yahoo.com showing the Complainant's Market Capitalization as on 12th June 2013 is at "**Annexure-B**".
- 3.5 The Complainant adopted the trademark "**MICROSOFT**" in the year 1975 and has used the said trademark continuously and extensively, not only as a trademark but also as a prominent, key, and leading portion of its corporate name. The trademark "**MICROSOFT**"

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is one of the most famous and well known trademarks in the world and is exclusively identified and recognized by the purchasing public as relating to the goods and services of the Complainant and no one else.

- 3.6 The Complainant is also the registered proprietor, in India of the trademark "**MICROSOFT**". The Complainant's registrations for the said mark are in Classes 9 and 16 and bear the registration numbers **430449** and **430450** respectively. The said registrations have been duly renewed from time to time and are valid and subsisting under the Trademarks Act, 1999. A photocopy of the said registration certificates are at "**Annexure-C**".
- 3.7 The Complainant through its website www.microsoft.com provides information of products or services offered by the Complainant and its affiliates. The Complainant debuted as an online service and Internet service provider on August 24, 1995, to coincide with the release of the Windows 95 operating system. The Complainant used the MSN brand name to launch and promote numerous popular web-based services in the late 1990s, most notably Hotmail and Messenger, before reorganizing many of them in 2006 under a new brand name, Windows Live. MSN Internet portal, MSN.com, still offers a wealth of content and is currently the 6th most visited domain name on the Internet.
- 3.8 The Complainant's rights in the trademark **MICROSOFT**, its variations/ service names, and other deceptively similar marks have been upheld before the Hon'ble Panels of the National Internet Exchange of India (NIXI) as well as the World Intellectual Property Organisation (WIPO). Copies of the Panels' decisions in the Complainant's favour are at "**Annexure-D**".
- 3.9 The Respondent in the present matter was using the disputed domain name **<microsoft.co.in>** to divert web traffic to its web hosting website www.host.co.in. Through the said website, the Respondent appears to be carrying on the business of providing cloud services to its customers which is identical to the one of the major businesses of the Complainant's. Coloured printouts of the Respondent's website www.host.co.in are at "**Annexure F**".
- 3.10 As soon as the Complainant became aware of the registration of the disputed domain name **<microsoft.co.in>** and its misappropriation, they, through their counsel, issued a cease and desist letter to the Respondent on 30th April 2013. Pursuant to the same, although the Respondent made the disputed domain name **<microsoft.co.in>** un-operational, he refused to transfer the same in favour of the Complainant despite repeated requests. Left with no other option, the Complainant has filed the present complaint. The emails containing the correspondence between the Complainant's counsel and the Respondent are at **Annexure G**.

B Respondent

- 3.11 Respondent has filed its reply to the complaint. Respondent's company is a Data Center and hosting service provider. It registered the disputed domain **<microsoft.co.in>** in the year 2005. Respondent realized that it cannot offer services from this domain, so it null-routed this domain, respecting Complainant's Trademark rights. Respondent's reply on merits will be discussed hereunder.
- 3.12 Complainant had no such policy of having regional domains in those days; neither have they had regional domains till date. They simply reverse hijack domains and redirect those to their main domain, which is www.microsoft.com. This can be verified by opening the

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URL www.microsoft.co.uk . This is a clear case of Reverse Domain Hijacking and the Complainant has tried to pull back domains similar to their Trademark.

- 3.13 Respondent is not asking any money for this disputed domain name <microsoft.co.in>, Respondent is not willing to surrender the disputed domain <microsoft.co.in> till its registration ends in the year 2019. Respondent respects the Trademark of the Complainant and won't host any website using the disputed domain name <microsoft.co.in> . It can be verified from archive.org that this disputed domain name <microsoft.co.in> has never hosted a website. This domain has no history in Google search or any search.
- 3.14 Respondent enjoys very good relationship with Microsoft UK and Microsoft India, but the legal team hired by the Complainant has the only intention to reverse hijack the domains, as the incentives they must be getting would be based on the domains they hijack.
- 3.15 Courts in the US and UK have now stopped giving judgments in the favour of such cash rich organizations who threaten small companies or individual owners. I'll appreciate if you can do the justice in this case as well.
- 3.16 Respondent's reply on merits will be discussed hereunder.

4. Parties Contentions

A Complainant

- 4.1 The disputed domain name <microsoft.co.in> includes the word **MICROSOFT**, which is identical and confusingly similar as a whole to the well-known and registered trademark **MICROSOFT** in which the Complainant has statutory rights as well as rights in common law, by virtue of being a long-time and continuous user and a registered proprietor thereof.
- 4.2 Furthermore, due to the above mentioned factors, the trademark **MICROSOFT** has acquired fame and is exclusively identified with the Complainant's goods and services. As such, the use of the word **MICROSOFT** in the disputed domain name <microsoft.co.in> would be understood as a reference to the Complainant thus perpetuating confusion among consumers who wish to access the Complainant's web page. The complainant would like to place reliance on *KFC Corporation v. Webmaster Casinos Ltd. (L-2/6/R4)*, wherein the Domain name kfc.co.in was transferred to the complainant as it incorporated the KFC Trademark in whole.
- 4.3 The Complainant has spent substantial time, effort and money advertising and promoting the **MICROSOFT** mark throughout the world. As a result, the **MICROSOFT** mark has become famous and well-known, and the complainant has developed an enormous amount of goodwill in the mark, which goodwill has been recognised by various INDRP as well as UDRP panels.
- 4.4 Since the disputed domain name <microsoft.co.in> comprises the well-known and famous trademark **MICROSOFT**, it is evident that the Respondent can have no right or legitimate interest in the domain name. Further, it is apparent that the sole purpose of registering the disputed domain name <microsoft.co.in> is to misappropriate the reputation associated with the Complainant's famous trademark **MICROSOFT**, to encash on the goodwill attached to the Complainant's trademark/ name by, as in the present case, diverting traffic to one's website or selling the domain name for profit or, in the alternative, preventing the Complainant from registering a domain name in which it has full legal rights.

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- 4.5 Further, the Respondent is not commonly known by the disputed domain name <microsoft.co.in> nor has he made any demonstrable preparation to use the disputed domain name <microsoft.co.in> in connection with a commercial or bona fide purpose.
- 4.6 The Respondent has no rights or legitimate interest in the domain name as:
- i) The Respondent is not a licensee of the Complainant and neither has the Complainant granted any permission or consent to the Respondent to use the trademark **MICROSOFT** in any manner or to incorporate the same in a domain name.
 - ii) No website has been uploaded on the said domain name. In fact, the only reason the domain name has been registered is to misappropriate it to divert traffic to its own website.
 - iii) The Respondent has not shown any demonstrable preparation to use the domain name in connection with a bona fide offering of goods and services.
- 4.7 The Respondent's website is not *bona fide* since the Respondent is trading on the fame and recognition of the Complainant's well-known trademark in order to cause initial interest confusion and bait internet users to accessing its website is typically the strategy of such cyber-squatters. The Complainant submits that the Respondent has made obvious his intention to divert traffic through the disputed domain name <microsoft.co.in> to its own web hosting website www.host.co.in has therefore laid bare his intent to commercially exploit the Complainant's trademark and/or service mark and for the sole purpose of causing irreparable damage and injury to the Complainant's goodwill and reputation; resulting in dilution of the Complainant's trademark and/or service mark. In fact by acquiring the disputed domain name <microsoft.co.in> he has shown crass opportunism in encashing the popularity of the Complainant's services, which are available to the Internet users in the form of www.microsoft.com. Furthermore, an average internet user will be forced to believe that the services offered by the Respondent through its website www.host.co.in emanate from the Complainant thereby furthering the elements of confusion and dilution through the use of the disputed domain name <microsoft.co.in>.
- 4.8 Respondent has no bona fide intention to use the disputed domain name <microsoft.co.in> and the same has been registered only for the purpose of trafficking and for the sole purpose of causing irreparable damage and injury to the Complainant's goodwill and reputation, resulting in dilution of the Complainant's trademark and/or service mark. It is thus very clear from the conduct of the Respondent that he has been trying to reap unfair rewards by registering the disputed domain name <microsoft.co.in>. The Respondent has failed to demonstrate any bona fide use of the disputed domain name <microsoft.co.in>.
- 4.9 The disputed domain name <microsoft.co.in> was acquired by the Respondent on 16th February 2005. It is pertinent to note that the Complainant offers its online service via the domain name www.microsoft.com. The Respondents domain name <microsoft.co.in> includes the word **MICROSOFT** as a whole which shows the bad faith on the part of the Respondent as the Respondent by doing so plans to trade on the fame and recognition of the Complainant's well-known trademark in order to cause initial interest confusion and bait internet users to accessing its website. Respondent acquired the confusingly similar name, in which the Complainant has a substantial interest, as it being its registered trademark and/or service mark. The Respondent was aware of the commercial value and significance of the domain name www.microsoft.com and that's why Respondent grabbed the disputed domain name <microsoft.co.in>. It is nothing but an opportunistic bad faith registration on

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the part of the Respondent. The Respondent thus is trying to seek illegal commercial gratification.

- 4.10 The bad faith intention of the Respondent becomes obvious as the Respondent himself has admitted to misappropriating the disputed domain name <microsoft.co.in> to divert traffic to its own website www.host.co.in. In response to the Complainant's request to transfer the disputed domain name <microsoft.co.in>, the Respondent refused to do so stating that "I was hosting a website on this domain earlier and getting good visibility for Cloud Hosting Business...". Therefore, the bad faith registration and use of the disputed domain name <microsoft.co.in> becomes apparent in light of the admissions of the Respondent.
- 4.11 In the light of aforesaid submissions, the bad faith registration and bad faith use of the disputed domain name <microsoft.co.in> on the part of the Respondent is thus proved. In **Telstra Corp. Ltd. v. Nuclear Marshmallows** the Administrative Panel has very clearly articulated that the requirement in paragraph 4(a)(iii) (of UDRP) that the domain name "has been registered and is being used in bad faith" will be satisfied only if the Complainant proves that the registration was undertaken in bad faith *and* that the circumstances of the case are such that Respondent is continuing to act in bad faith." Similarly in **Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co** it was held by the Administrative Panel that "VEUVECLICQUOT.ORG" is so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith.
- 4.12 The Complainant submits that the Respondent has, no doubt, been aware prior to its registration of the disputed domain name <microsoft.co.in> that there was substantial reputation and goodwill associated with the Complainant's trademark and/or service mark, which inures and continues to inure to the Complainant.
- 4.13 The Respondent till the present day is not providing any service of its own on the disputed domain name <microsoft.co.in>, and has registered it with an intention of diverting traffic to its website www.host.co.in and generating revenue thereof. Further, since cloud hosting is one of the many services provided to its consumers by the Complainant, the said diversion will induce internet users to believe that the Respondent is in some way linked to the Complainant. With a domain name as innocuous as www.host.co.in, which merely talks about a service and not a trademark, the general public will be induced to believe that it is a service provided by the Complainant. Therefore, the bad faith intention of the Respondent is not only restricted to cause harm and injury to the Complainant but to also cheating internet users of quality web and cloud hosting services.
- 4.14 Hence, it is evident that the Respondent has neither intention nor reason to legitimately use the disputed domain name <microsoft.co.in> and is merely misrepresenting itself as the Complainant and inducing users to believe that it has some kind of affiliation with the Complainant. The Complainant submits that the disputed domain name <microsoft.co.in> was registered and is being used in bad faith as it resolves to a website of the Respondent. This conduct of the Respondent is evidence of registration and use of the domain name in bad faith. Some notable UDRP panels which have held that this conduct of the Respondent amounts to bad faith are **Zinsser Co. Inc., Zinsser Brands, Co. v. Henry Tsung and Micro Electronics, Inc. v. J Lee**.
- 4.15 The Respondent has registered the impugned domain name www.microsoft.co.in in order to disrupt the business of the Complainant. It is apparent that the Respondent has attempted to attract for commercial gain Internet users to the website to which the

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impugned domain name resolves to by creating a likelihood of confusion with the Complainants well-known and famous trademark **MICROSOFT**.

- 4.16 The Complainant's **MICROSOFT** mark is a well-known mark, and the Respondent is presumed to have had knowledge of Complainant's mark at the time it registered the confusingly similar domain name. Thus, this is prima facie evidence of the Respondent's bad faith use and registration. Therefore, it is submitted that the disputed domain name <microsoft.co.in> has only been registered in bad faith for monetary gains. Registration of a famous trademark without legitimate commercial interests in the same is prima facie evidence that the Respondent was well aware of the reputation and goodwill attached to the Complainant's trademark/name. Thus, the Respondent has registered the disputed domain name in bad faith. The complainant would like to place reliance on Rediff.com India Limited v. Mr. Abhishek Verma & Others. (L-1/1/R1), wherein the disputed Domain Name www.rediff.in was ordered to be transferred to the complainants. The panel held, "the Respondent has registered domain name before the Complainant, for selling, renting or otherwise transferring the same for monetary gains..." Therefore, it is submitted that the domain name has only been registered in bad faith for monetary gains. The proposition that the registration of a domain name incorporating a well-known trademark of the Complainant is bound to be in bad faith has been upheld by numerous UDRP decisions. Some notable cases which have upheld this proposition are Marie Claire Album v. Marie-Claire Apparel, Inc. Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co., Adidas-Salomon AG v. Domain Locations , wherein it has been held that registration of a well-known trademark of which the Respondent must reasonably have been aware is in itself sufficient to amount to bad faith.
- 4.17 Further, there is a likelihood that a potential visitor to the Respondent's future webpage that the subject domain name would resolve to, will be induced to:

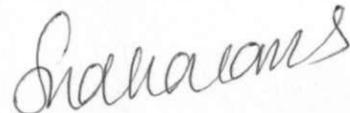
- Believe that the Complainant has licensed its trademark **MICROSOFT** to the Respondent or has authorized the Respondent to register the disputed domain name <microsoft.co.in>.
- Believe that the Respondent has some connection with the Complainant in terms of a direct nexus or affiliation with the Complainant or has been authorised by the Complainant.
- Believe that the website to which the disputed domain name <microsoft.co.in> resolves is affiliated to the Complainant or that it is the Indian arm of the Complainants Service, www.microsoft.com.

B. Respondent

- 4.18 The Complainant in the present dispute has inappropriately alleged Respondent for registering the disputed domain name <microsoft.co.in>
- 4.19 The respondent had registered the disputed domain name <microsoft.co.in> in the year 2005. It has been around 8 years since then respondent has legitimate right and ownership of the domain name.
- 4.20 The Complainant falsely alleges and claims that the Respondent's domain name is identical, confusing or similar to the name, trademark or service in Complainant has rights.

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- 4.21 The respondent has spent substantial time, effort, money for registration of the disputed domain name <microsoft.co.in> and utilized the domain name for legal and rightful purpose.
- 4.22 It is not true and correct to state that the Respondent has no rights or legitimate interest in the domain name.
- 4.23 The respondent has rights and legitimate interest in the disputed domain name <microsoft.co.in> as;
- i) The respondent has legally registered the disputed domain name <microsoft.co.in>
 - ii) The respondent has not misused the disputed domain name <microsoft.co.in>
 - iii) The respondent had registered the disputed domain name <microsoft.co.in> in 2005 itself and owns from past 8 years
 - iv) The complainant did not raise objection for such long duration. The respondent has registered the disputed domain name <microsoft.co.in> for legal bona fide purpose and not for misusing by email spamming or hoaxes, spyware, malware, viruses, dissemination of offensive material, money laundering, vandalism etc.
- 4.24 The respondent clearly stated of registering the disputed domain name <microsoft.co.in> in good faith by null routing it.
- 4.25 The Respondent never offered any monetary compensation to Complainant for surrendering the disputed domain name <microsoft.co.in>.
- 4.26 The Complainant has time and again forced to transfer the disputed domain name <microsoft.co.in> through its legal agency and have pressurized the Respondent to do so.
- 4.27 As the disputed domain name <microsoft.co.in> was easily available to acquire and own. The Respondent paid for registration and owned it appropriately from domain registration site.
- 4.28 If the complainant has registered the name MICROSOFT under Trademarks Registry then it is sole responsibility of complainant to protect and secure it.
- 4.29 The Complainant under the name of trademark rights is trying to infringe the policies of legitimate owners; as there have been numerous cases regarding this and the Complainant himself has filed such cases. Even the matter is raised and is seriously considered at The United States Patent and Trademark Office (USPTO) of trademark bullying as "the practice of a trademark holder using litigation tactics in an attempt to enforce trademark rights beyond a reasonable interpretation of the scope of the rights granted to the trademark holder". This shows that such trademark suits are filed against trademark holders in an attempt to forcefully dissuade that trademark holder from using their own trademarks. These actions, called strike suits, typically begin with a cease and desist letter objecting to how the business is using their trademark in commerce. If a cease and desist letter is disregarded or if the business responds that it will not cease their use, a lawsuit typically results. Trademark bullying is a problem because businesses are using their trademarks as a means to expand their market share without actually sometimes having meritorious claims enforcement of legitimate trademark rights by any party. This is what the complainant is trying to attempt.
- 4.30 Further, the Complainant is also trying to suppress the Respondent for transferring the domain which is "Reverse Domain Hijacking" case. The Complainant has a policy to redirect the disputed domain <microsoft.co.in> to their main domain which shows that it



wants to acquire business and is against Monopolistic and Restrictive Trade Practice under MRTP Act, 1969. Monopolistic trade practice is that which represents abuse of market power in the production and marketing of goods and services by eliminating potential competitors from market and taking advantage of the control over the market by charging unreasonably high prices, preventing or reducing competition, limiting technical development, deteriorating product quality or by adopting unfair or deceptive trade practices.

4.31 Thus it shows bad faith of Complainant for filing the suit against the Respondent. Such mal-practice of Reverse Domain Name Hijacking is carried on the part of the Complainant from numerous years; suppressing the rights of legitimate owners of the domain name.

4.32 For the reason stated above the Respondent prays dismissal of the Complaint.

5. Hearing

5.1 Parties attended the personal hearing on the scheduled hearing date and reiterated their pleadings. I heard both the parties.

5.2 Before the hearing date, the Complainant raised certain serious objections to the grant of personal hearing to the Respondent. The counsel for the Complainant, Mr. Pravin Anand also spoke to me over phone and enquired whether I received his mails objecting the grant of personal hearing. I assured him that I received his mails and I would consider all of them on merits along with other issues of the Complaint. The Complainant informed that he would not share the cost of hearing. The Respondent informed me over phone that he would fully bear the cost of hearing. I advised the parties to attend the hearing and informed them that the parties' attendance would be recorded in the award.

5.3 Now I deal with the objections raised by the Complainant to the personal hearing. The Complainant raised the following objections and requested the Panel to decline the Respondent's request for personal hearing and to proceed with matter on merits.

a. INDRP Rule 10 states that: - *"There shall be no in-person hearings (including hearings by teleconference, videoconference, and web conference), unless the Arbitrator determines, in his sole discretion and as an exceptional matter, that such a hearing is necessary for deciding the Complaint"*. According to this rule "sole discretion and exceptional circumstances" must be shown together. The presence of the conjunction "and" therein makes it clear that exceptional circumstances must be shown to be granted a personal hearing. Else, the rules strictly prohibit any personal hearing. Had the conjunction been "or" sole discretion may have been exercised without exceptional circumstances being shown. But the Rule is not such. The Respondent before requesting for the personal hearing and the same being allowed must satisfy that the present case falls under those exceptional circumstances. The present case is straightforward, devoid of any exceptional circumstances and of subject matter dealt by this Panel on a routine basis.

b. The respondent till date has not filed his reply and is yet requesting for a personal hearing that too without establishing any exceptional circumstances surrounding the case.

5.4 The first objection revolves around my ability as an arbitrator to hear a party who wants him to be heard and the requesting party's right to represent his case before me. First of all, the proceeding before me is quasi-judicial in nature. All quasi-judicial proceedings are invariably guided by the principles of natural justice. Right to be heard is the basic tenant of

natural justice. If a party comes with a request that he is to be heard by the presiding officer, natural justice demands that the person must be heard. *Audi alteram partem* – no person should be judged without a fair hearing is the cornerstone of natural justice. Denial of personal hearing amounts to denial of justice. In this case, the Respondent has asked me to hear him. According to the complainant, in this case, there exists no exceptional circumstances and therefore, no hearing should be granted to the Respondent. The INDRP Rule also generally prohibits in-person hearings and a hearing if any needed, should be granted only on exceptional circumstances. The Rule obviously places an enormous amount of restriction on a party's right to be heard and goes against the very basic tenet of natural justice. Denial of hearing generally or for want of exceptional circumstances amounts to denial of natural justice. Therefore I decided to grant a hearing to the Respondent. By granting the personal hearing, I strictly followed the principles of natural justice. If I denied the Respondent his request for personal hearing, his right of being heard under the principles of natural would be breached. For these reasons, I granted the Respondent's request for personal hearing. At the same time, I granted an equal opportunity to the Complainant. I heard both the Complainant and the Respondent.

- 5.5 As regards the second objection, the Respondent has already filed its response. Immediately on receiving the objection of the Complainant, I checked the mails that I received from the parties. I noted that the Respondent did not mark a copy of his mail containing his response to the complaint on the Complainant. I advised the Respondent to copy all his mails on me, the complainant and NIXI. I sent a copy of the Respondent's reply to the Complainant, and asked the Complainant to file his response, if any to the reply of the Respondent. Complainant also filed his response. On the basis of the reply filed by the Respondent, the Complainant has approached the Hon'ble Delhi High Court with an infringement suit against the Respondent and has obtained an ex-parte interim injunction against the Respondent. The Complainant has sent me a scanned copy of the order of the Hon'ble Delhi High Court.

6. Discussion and Findings

- 6.1 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;
 - (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.
- 6.2 Each of the aforesaid three elements must be proved by a Complainant to warrant relief.

Disputed domain name is identical or confusingly similar to a trade mark of the Complainant.

- 6.3 The Complainant is the proprietor of the mark Microsoft. Complainant has been using Microsoft as a trade mark continuously since 1975. Complainant has active web site www.microsoft.com and internet users from any part of the world including India can browse and purchase the products and services of the Complainant. Complainant owns trademark and service mark registrations for its Microsoft mark in many countries around the world, including India. In India, the Complainant obtained registrations for the mark Microsoft under Registration No. 430499 under class 9 and under 430450 under class 16, both on 30.11.1984. The Complainant's domain name www.microsoft.com was created on

1.5.1991. The disputed domain name <microsoft.co.in> was created on 16.2.2005. Obviously, the Complainant is the prior adopter of Microsoft marks. The above facts have established that the Complainant has common law as well as statutory rights in respect of its Microsoft marks.

- 6.4 The Respondent has never denied the Complainant's right to its trade mark Microsoft. The main grievance of the Respondent is that the Complainant has operating a web site under another domain name and in such a case, the country specific domain name, i.e. the disputed domain name <microsoft.co.in> is not necessary for the Complainant.
- 6.5 The Complainant's Microsoft mark is famous and well known throughout the world including India. It is clearly seen that the disputed domain name <microsoft.co.in> wholly incorporates the prior Microsoft mark of the Complainant. The suffix ".co" and ".in" are descriptive and are not distinguishing parts of the domain name. The specific top-level and /or second-level of a domain name such as ".co" ".in" needs to be disregarded when determining the similarity or identity with the Complainant's Microsoft mark. The disputed domain name <microsoft.co.in> is similar to the Complainant's domain name www.microsoft.com.
- 6.6 I, therefore, find that:
- (a) The Complaint has common law and statutory rights in respect of its Microsoft mark.
 - (b) The disputed domain name <microsoft.co.in> is:
 - (i) Identical to the Complainant's prior Microsoft trade mark, and
 - (ii) Similar to the Complainant's domain name www.microsoft.com.

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

- 6.7 It is already seen that:
- (a) The Complainant is the prior adopter and user of the Microsoft mark. The Complainant's Microsoft mark is well known in many countries across the globe including India.
 - (b) The Complainant's Microsoft mark was adopted in the year 1975. The mark Microsoft was registered in India in 1984. The Complainant's domain name www.microsoft.com was created on 1.5.1991. The disputed domain name <microsoft.co.in> was created on 16.2.2005.
- 6.8 Respondent did not register the disputed domain name until 16.2.2005. Complainant has adopted and used the mark Microsoft and a domain name containing the mark Microsoft before Respondent registered the disputed domain name <microsoft.co.in>. It is unlikely that the Respondent was unaware of Complainant's existence of trademark and domain name rights before registering the disputed domain name <microsoft.co.in>.
- 6.9 Respondent however has claimed that he has already null routed the disputed domain name <microsoft.co.in>. I visited the web site of the Respondent under the disputed domain name <microsoft.co.in> twice, one immediately after receiving the complaint and another a week before the hearing date. First time, the disputed domain <microsoft.co.in> did not resolve into any web site. But on the second time, the disputed domain name <microsoft.co.in> resolved into the web site www.esds.co.in of the Respondent. In the personal hearing, I asked the Respondent to inform the actual status. Respondent informed me that the disputed domain name <microsoft.co.in> was null

routed by the Respondent. But due to certain technical error or defaults the disputed domain name automatically was again directed towards the site www.esds.co.in after few days of null routing the site. This act was not deliberate or reckless. I immediately checked the status in the course of the submission of the Respondent and the disputed domain name did not resolve into any web site. The Respondent has assured and affirmed solemnly that the domain name would be null routed. The Respondent never used it for commercial benefits and in future also would make no use of the domain name in bad faith. But respondent would be legitimate owner and would hold the possession of the domain name in future.

6.10 Considering the well-known status of the Complainant's mark Microsoft all over the world, I am not agreeing with the following contentions of the Respondent.

- a) The respondent had registered the disputed domain name microsoft.co.in in the year 2005. It has been around 8 years since then respondent has legitimate right and ownership of the domain name.

This long delay of 8 years may be substantially enough to tilt the balance in favour of the Respondent. Delay assumes significance in the case of domain names. In this age of internet, it is very easy to ascertain adoption of an identical or confusingly similar domain names from any part of the world. In this case, the Complainant is one of the internet giants and has been known for taking pro-active defensive actions to protect its intellectual properties. No body may claim ignorance of adoption of a domain name by others, particularly where monitoring is easy from any part of the world. It is easier to monitor these developments. In this respect, monitoring of domain name adoption is different from monitoring a trade mark adoption. An adoption of a trade mark may be localized and may pose serious difficulty in monitoring such localized adoptions from other parts of the country or world. It may even take considerable time, considering the geographical area involved, to assess the damage caused to the reputation and goodwill of the trade mark. But adoption of a domain name is not like that. Any and every adoption of a domain name irrespective of its language can be monitored effectively with the help of internet. Therefore, non-action for 8 long years by a complainant like Microsoft is not a thing a prudent business man would do in similar circumstances.

However, non-action on the part of the Complainant itself cannot help the case of the Respondent because of the special circumstances of the case. Trade mark Microsoft was very popular on the date of registration of the disputed domain name microsoft.co.in by the Respondent and the Respondent had prior knowledge of the Complainant and its mark Microsoft and therefore, Respondent cannot have any rights or legitimate interest in the disputed domain name microsoft.co.in.

- b) The respondent has rights and legitimate interest in the disputed domain name microsoft.co.in as;

- i) The respondent has legally registered the disputed domain name microsoft.co.in

The registration is subject to the rights of other parties. Mere registration will not grant absolute right to the registrant.

- ii) The respondent has not misused the disputed domain name microsoft.co.in

The Respondent had intermittently used the disputed domain name microsoft.co.in to redirect the users to its own official web site. Therefore, the contention that the Respondent has not misused the disputed domain name microsoft.co.in cannot be accepted.

Sudhakar

- iii) The respondent had registered the disputed domain name <microsoft.co.in> in 2005 itself and owns from past 8 years. The complainant did not raise objection for such long duration. The respondent has registered the disputed domain name <microsoft.co.in> for legal bona fide purpose and not for misusing by email spamming or hoaxes, spyware, malware, viruses, dissemination of offensive material, money laundering, vandalism etc

The Complainant is answerable for its non-action for 8 long years. However, Respondent cannot take umbrage under the non-action on the part of the Complainant, particularly in the context of Respondent's knowledge of the Complainant; past interaction with the Complainant and the Complainant's well known status of its mark Microsoft on the date of registration of the disputed domain name <microsoft.co.in>.

6.11 I agree with the following contentions of the Complainant:

- a) The sole purpose of registering the disputed domain name <microsoft.co.in> is to misappropriate the reputation associated with the Complainant's famous trademark **MICROSOFT**, to encash on the goodwill attached to the Complainant's trademark/ name by, as in the present case, diverting traffic to one's website or selling the domain name for profit or, in the alternative, preventing the Complainant from registering a domain name in which it has full legal rights.
- b) The Respondent is not commonly known by the disputed domain name <microsoft.co.in> nor has he made any demonstrable preparation to use the disputed domain name <microsoft.co.in> in connection with a commercial or bona fide purpose.
- c) The Respondent is not a licensee of the Complainant and neither has the Complainant granted any permission or consent to the Respondent to use the trademark **MICROSOFT** in any manner or to incorporate the same in a domain name.
- d) No website has been uploaded on the said domain name. In fact, the only reason the domain name has been registered is to misappropriate it to divert traffic to its own website.
- e) The Respondent has not shown any demonstrable preparation to use the domain name in connection with a bona fide offering of goods and services.
- f) The Respondent's website is not *bona fide* since the Respondent is trading on the fame and recognition of the Complainant's well-known trademark in order to cause initial interest confusion and bait internet users to accessing its website is typically the strategy of such cyber-squatters. The Complainant submits that the Respondent has made obvious his intention to divert traffic through the disputed domain name <microsoft.co.in> to its own web hosting website www.host.co.in has therefore laid bare his intent to commercially exploit the Complainant's trademark and/or service mark and for the sole purpose of causing irreparable damage and injury to the Complainant's goodwill and reputation; resulting in dilution of the Complainant's trademark and/or service mark. In fact by acquiring the disputed domain name <microsoft.co.in> he has shown crass opportunism in encashing the popularity of the Complainant's services, which are available to the Internet users in the form of www.microsoft.com. Furthermore, an average internet user will be forced to believe that the services offered by the Respondent through its website www.host.co.in emanate from the Complainant thereby furthering the elements of confusion and dilution through the use of the disputed domain name <microsoft.co.in>.

Sridharan

6.12 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 <microsoft.co.in>.

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

a) The Complainant is the proprietor of the mark Microsoft. Complainant has been using Microsoft as a trade mark continuously since 1975. The mark Microsoft was registered in India in 1984. The complainant's products and services under the mark Microsoft are available for sale in India. The Complainant's domain name www.microsoft.com was created on 1.5.1991. The Complainant's web site is active and its products and services can be purchased through its website. The disputed domain name <microsoft.co.in> was created on 16.2.2005. Obviously, Complainant's rights in the Microsoft mark pre-dates Respondent's registration of the disputed domain name <microsoft.co.in>. The Respondent could not have ignored, rather actually influenced by, the well-known Microsoft mark of the Complainant at the time he acquired the disputed domain name <microsoft.co.in>.

6.13 Let me begin with the case of the Respondent. Respondent has raised the following arguments stating that he has registered the disputed domain name <microsoft.co.in> and has been using it in good faith. I am not agreeing with these arguments. I have given my reasons for my disagreement with the Respondent.

a) The Respondent has null routed the disputed domain name and this indicates good faith registration and use.

Respondent has no right at all to adopt a domain name consisting of the Complainant's trade mark Microsoft. Therefore, null routing is of no significance. Mere adoption is bad faith.

b) The Respondent has never offered any monetary compensation to Complainant for surrendering the disputed domain name <microsoft.co.in>.

Respondent's holding of the disputed domain name <microsoft.co.in> is not permitted. Therefore, his refusal to surrender for monetary consideration is immaterial.

c) As the disputed domain name <microsoft.co.in> was easily available to acquire and own. The Respondent paid for registration and owned it appropriately from domain registration site.

This fact is in favour of the Respondent. However, this alone will not entitle the Respondent to hold the disputed domain name <microsoft.co.in>. However, on equitable principles, the Complainant is ordered to pay the cost of the registration and periodic renewal for 8 long years to the Respondent.

d) If the complainant has registered the name MICROSOFT under Trademarks Registry then it is sole responsibility of complainant to protect and secure it.

Yes. There is a lapse on the part of the Complainant. The Respondent however cannot take advantage of the complainant's lapse. At the time of registration of the disputed domain name, the Respondent had knowledge of the Complainant and its trade mark Microsoft.

- e) The Complainant under the name of trademark rights is trying to infringe the policies of legitimate owners; as there have been numerous cases regarding this and the Complainant himself has filed such cases. Even the matter is raised and is seriously considered at The United States Patent and Trademark Office (USPTO) of trademark bullying as "the practice of a trademark holder using litigation tactics in an attempt to enforce trademark rights beyond a reasonable interpretation of the scope of the rights granted to the trademark holder". This shows that such trademark suits are filed against trademark holders in an attempt to forcefully dissuade that trademark holder from using their own trademarks. These actions, called strike suits, typically begin with a cease and desist letter objecting to how the business is using their trademark in commerce. If a cease and desist letter is disregarded or if the business responds that it will not cease their use, a lawsuit typically results. Trademark bullying is a problem because businesses are using their trademarks as a means to expand their market share without actually sometimes having meritorious claims enforcement of legitimate trademark rights by any party. This is what the complainant is trying to attempt.

The case of the Complainant may not amount to bullying of any sort. This complaint is a step in the direction of enforcing its legal rights.

- 6.14 Further, the Complainant is also trying to suppress the Respondent for transferring the domain which is "Reverse Domain Hijacking" case. The Complainant has a policy to redirect the disputed domain <microsoft.co.in> to their main domain which shows that it wants to acquire business and is against Monopolistic and Restrictive Trade Practice under MRTP Act, 1969. Monopolistic trade practice is that which represents abuse of market power in the production and marketing of goods and services by eliminating potential competitors from market and taking advantage of the control over the market by charging unreasonably high prices, preventing or reducing competition, limiting technical development, deteriorating product quality or by adopting unfair or deceptive trade practices. Respondent has cited the following cases in its favour.

- a) **Johnson & Johnson v. Chad Wright, WebQuest.com, Inc. WIPO Case No. D2012-0010**:- In this case, the Complainant is the registered owner of the mark TUCKS with a first use in commerce of October 19, 1965 in the United States of America. The Complainant also owns domain names that include the TUCKS trademark, including <tucks.info>, <tucks.biz> and <tucksbrand.com>. The disputed domain name <tucks.com> was registered on May 13, 2002. The Complaint was filed with the WIPO Arbitration and Mediation Center on January 4, 2012. Respondent conceded that disputed domain name <tucks.com> is identical to the TUCKS mark, in which Complainant has rights. Panel without giving any finding on the Respondent's legitimate rights to the disputed domain name concluded that the Complaint provides insufficient evidence to conclude that the disputed domain name was registered in bad faith and denied the complaint.

Respondent in the present proceedings relied on the following observations of the panel in the above case:

First, there is nothing in the record reflecting Respondent's intent to sell, rent or otherwise transfer the disputed domain name. The Complaint also does not show any circumstances upon which inferences of such an intention could be based. Therefore, the Panel rules that the Complaint fails to demonstrate circumstances that fall within Policy paragraph 4(b)(i).

In the Panel's view, the record suggests that the circumstances described in paragraph 4(b)(iv) of the Policy are potentially more germane. Under any circumstances, however, for Complainant to prevail, both the elements of bad faith use and bad faith registration must be established

Indulawan

The above case is not applicable to the present proceedings. In the above case, the Respondent's president, at the time of registration, had never heard of Tucks brand medicated pads. Further the panel proceeded on the basis that "tucks" is a common word and it cannot be said that there is little chance that Respondent was not aware of the trademark when registering. But in this present case, the Complainant's mark Microsoft is a well-known mark when the Respondent acquired the disputed domain name. The Respondent had knowledge of the Complainant's mark Microsoft at the time of his adoption of the disputed domain name.

b) ***Audi AG v. Stratofex WIPO Case No. D2012-1894:-*** The Complainant is the owner of the mark AUDI. The AUDI Mark has been registered in the United States since at least 1997. The disputed domain Name <audicity.com> was created on September 15, 2001 and redirects to Respondent's website that consists of what appears to be an old photo of San Francisco. The panel held that the disputed domain name is confusingly similar to the Complainant's mark Audi. The Panel did not return any finding on the Respondent's legitimate right or interests to the disputed domain name. The panel observed that there is no evidence that at the time of registration of the disputed domain name, the combination of "audi" and "city" would ever be a combination that would ever be of interest to the Complainant or have any value to third parties. Respondent has provided a plausible reason for registering a domain name. It has maintained the registration for 11 years, and claims to have used the domain name extensively for personal purposes during that time. From 2001-2012 the term "Audi City" was not in common use and there was no reason for the Respondent to consider that the Complainant would find that combination of words valuable. The Respondent has never used the domain name for commercial purposes, nor has he attempted to sell the domain name. The Panel held that the complainant failed to prove bad faith registration and use.

The above case is not applicable. The panel proceeded on the basis that the term Audi City was not in common use from 2001 - 2012. It is not so in the present proceedings. The Complainant's mark Microsoft is well known even before the adoption of the disputed domain name by the Respondent. In the cited case, the Respondent used the domain name for sharing old family photos, to reference his sound files and as an email address. But in this case, the Respondent at least for some point of time redirected the disputed domain name to its own web site for commercial purposes. Further, strangely in the cited case, the panel believed many factors without any evidence. For this reason, I do not find any persuasive value in the case law.

c) ***Ticket Software, LLC v. Domains By Proxy, LLC / Stephen Troy - WIPO Case No. D2013-0215:-*** Complainant is the owner of U.S. Trademark Registration No. 2,956,502 for TICKETNETWORK, registered on May 31, 2005 for computer software which manages the buying and selling of entertainment tickets and business services providing an online marketplace for buyers and sellers of entertainment tickets. Respondent created many domain names including <ricketwork.com> on the same day, January 13, 2011. The Panel held that each domain name comprises a misspelling by a single letter of the complainant's registered mark TICKETNETWORK and domain names are confusingly similar to the complainant's registered trade mark. The Panel also found that the Respondent had no legitimate rights or interests in the domain names. As regards bonafide registration and use, the Complainant asserted that the Respondent "uses the domain names to redirect customers to a service known as EZ-shoplink.com where customers can buy tickets to entertainment events essentially resulting in monetary gain for the Respondent". But the panel held that the Complainant did not submit any evidence to reflect such a redirection of customers via the Domain Names to a website at "www.ez-shoplink.com" or any evidence of the Domain Names directing or redirecting to any website now or in the past. None of the Domain Names currently directs or redirects to any website.



Without any supporting evidence, the Complainant's limited assertions are not sufficient to support a finding that the Respondent has intentionally attempted to attract for commercial gain Internet users to a website by creating a likelihood of confusion with the Complainant's mark. For these reasons, the panel denied the complaint.

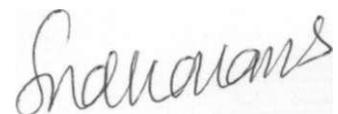
In the case on hand, the Respondent at least for some time redirected the disputed domain name to its own web site for commercial gain. Therefore, the above cited case law is not applicable to this case.

d) **Cosmetic Research Group v. John Miller WIPO Case No. D2012-0014:-** The Complainant owns SOSKIN mark registered on September 21, 1992 and several trademarks consisting of SOSKIN. Complainant entered into a licensing agreement with Aesthetimed (France) Ltd., whose CEO was the Respondent. The objective of the Agreement was to enable Aesthetimed (France) Ltd to develop a product based upon the know-how of the Complainant. According to Art. 1 of the Agreement, Aesthetimed (France) Ltd was granted a license to use and exploit the Complainant's trademark SOSKIN in Europe. Art. 2 added that the license extended to the whole Europe but for Greece and Cyprus. Art. 11 further made it clear that, upon termination, the license was automatically revoked. This agreement was completed by a distribution agreement, signed on the same day between the Complainant and Aesthetimed (France) Ltd. Each agreement was to automatically terminate upon the termination of the other one, as both were interrelated. According to the Respondent, an addendum to the distribution agreement was also signed by the Parties. On this addendum, it was agreed by the Parties that Aesthetimed (France) Ltd. was authorized to register a domain name including the SOSKIN Trademark. Due to allegedly unpaid bills, the Complainant terminated the agreements by way of registered letter dated April 11, 2011. The Panel held that the domain name is confusingly similar to the trade mark of the complainant and the Respondent has no right to the mark. As regards good faith registration, relying on the agreements between the parties, the panel held that disputed domain name <institutososkin.com> has not been registered in bad faith.

This case is not applicable to our case on hand as the parties are not bound by any agreement permitting the registration of the domain name by the Respondent.

e) **T. Rowe Price Associates, Inc. v. JA Rich, WIPO Case No. D2001-1044 -** On November 27, 1984, Complainant was granted registration in the mark, T. ROWE PRICE INVEST WITH CONFIDENCE, by the United States Patent and Trademark Office (USPTO), based on a first use of December 4, 1983. Then on October 11, 1994, Complainant was granted federal registration for the mark, INVEST WITH CONFIDENCE, by the USPTO for mutual funds. On August 2, 2000, the Domain Name <investwithconfidence.com> was registered by a third party not involved in this dispute. Respondent claims to have acquired the Domain Name on May 15, 2001, but Complainant contends that Respondent did not acquire the Domain Name until August 17, 2001, after the original Complaint in this matter was filed. The Panel while deciding bad faith registration observed as follows:

Based on the evidence presented, it seems more likely than not that Respondent has registered and used the Domain Name to attract Internet traffic based solely on the appeal of a commonly used descriptive phrase, as suggested by the evidence of third party use of "Invest With Confidence." Although the mark is registered, it does not appear to be famous or highly distinctive. When used by Complainant, it usually appears in connection with Complainant's well-known name "T. Rowe Price." Respondent has done nothing to suggest any connection with T. Rowe Price or competing investment services, beyond use of a Domain Name that happens to correspond to Complainant's mark, as well as to the names, marks or slogans of others. Setting aside conjecture, the undisputed evidence presented shows that Respondent has adopted and used the Domain Name as a



tool to direct Internet users to books about investments. The ordinary descriptive meaning of the Domain Name is apt for that purpose, and use in that manner is not bad faith.

In the present case, the Microsoft mark of the Complainant is so popular and well known in different parts of the world. Therefore, the above case involving so generic or common trade mark is not applicable to this case.

f) **The Honorable Ron Paul v. DN Capital Inc., Martha Roberts WIPO Case No. D2013-0371:-** The case involves the domain name <ronpaul.org> registered on July 28, 1999. Complainant Ron Paul is a former United States of America (hereafter "U.S." or "United States") Congressman and well-known political commentator, serving in the House of Representatives during different periods for the 14th and 22nd Congressional Districts of Texas. He is also a three-time candidate for President of the United States, and a leading spokesperson, in the political field, for issues such as limited government, low taxes, free markets, and monetary policies such as a return to the gold standard for the U.S. currency. Complainant has authored seven books, three of which have been New York Times Best Sellers.

The panel held that the Complainant has no legitimate rights in the domain name but did not return any finding on other two elements. The Panel did not elaborate on reverse domain name hijacking though it asserted it in the decision.

The cited case is not applicable to the facts of the present case.

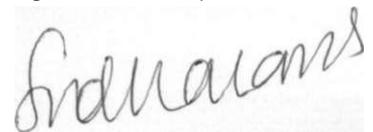
g) **Webpass, Inc. v. Paul Breitenbach WIPO Case No. D2010-1796:-** This is a case on reverse domain name hijacking. The disputed domain name <webpass.com> was created in 2001. At that time, the Complainant did not exist as a business entity. The Complainant first used its trademark WEB PASS in 2007. The Respondent has used the disputed domain name to promote a business known as WEBPASS, which offered the service of anonymous Internet browsing of various paid-Internet sites.

Reverse Domain Name Hijacking

The concept of reverse hijacking involves registration of the domain name by a party much before the adoption of the trade mark by the other party. But in the case on hand, the Respondent's adoption of the disputed domain name was much subsequent to the adoption of the trade mark by the Complainant. Therefore, the cases involving reverse domain name hijacking are of no use to the Respondent.

h) **Mark Kingsley Williams v. Bbhinds Pty Ltd - WIPO Case No. DAU2013-0010:-** The Complainant offers an advisory service in relation to intellectual property rights in the United Kingdom. The Respondent has for many years manufactured and sold children's clothing and nappies. On May 19, 2011, a company associated with the Respondent, Datweb Pty Ltd, registered the disputed domain name. Datweb Pty Ltd holds many domain name registrations. In an email from the Complainant to the Respondent it is alleged that on October 22, 2012 the Complainant was granted an Australian trade mark registration for the trade mark TRADEMARKDIRECT. On or around February 22, 2013, the Respondent acquired the disputed domain name from Datweb Pty Ltd.

The Panel held that the Complainant has not established confusing similarity of the domain name with its trade mark. The evidence adduced by both the Complainant and Respondent is insufficient to determine the extent of the Respondent's rights or legitimate interests in the disputed domain name. As the burden of proof falls on the Complainant, the Panel finds that the Complainant has also failed to establish its legitimate rights. The Complainant



has not established bad faith registration. There is insufficient evidence to support a finding of reverse domain name hijacking and the Respondent has not established its claim of reverse domain name hijacking. The Complaint that has been submitted appears to have been inadequately prepared and, in particular, inadequate evidence adduced to support its claim. The Respondent has not established its claim of reverse domain name hijacking.

The above case is not applicable to the case on hand.

i) **Jogos Atividades de Internet Ltda. v. Bennie Eeftink - Spil Games Intangibles B.V. WIPO Case No. D2012-0399**:- The Complainant is a Brazilian company. The Respondent is a Dutch company. The Disputed Domain Name <clickjogos.com> was registered on September 10, 2004. In this case, though the panel acknowledged that there had been a lengthy delay in bringing the Complaint, the facts did not warrant the application of the defence of laches.

In the case on hand also, I have held that there is a delay on the part of the complainant. But the Complainant's delay itself will not help the case of the Respondent.

6.15 I will now take up the case of the Complainant. I agree with the contentions of the Complainant.

- a) The Respondent acquired the disputed domain name <microsoft.co.in> wholly consisting of the trade mark Microsoft, in which the Complainant has a substantial interest, as it being its registered trademark and/or service mark. The Respondent was aware of the commercial value and significance of the domain name www.microsoft.com and that's why Respondent grabbed the domain name <microsoft.co.in>. It is nothing but an opportunistic bad faith registration on the part of the Respondent. The Respondent thus is trying to seek illegal commercial gratification.
- b) The bad faith intention of the Respondent becomes obvious as the Respondent himself has admitted to misappropriating the disputed domain name <microsoft.co.in> to divert traffic to its own website www.host.co.in. In response to the Complainant's request to transfer the impugned domain name, the Respondent refused to do so stating that "*I was hosting a website on this domain earlier and getting good visibility for Cloud Hosting Business...*". Therefore, the bad faith registration and use of the disputed domain name <microsoft.co.in> becomes apparent in light of the admissions of the Respondent.
- c) The Complainant has cited the following cases: - In **Telstra Corp. Ltd. v. Nuclear Marshmallows** the Administrative Panel has very clearly articulated that the requirement in paragraph 4(a)(iii) (of UDRP) that the domain name "has been registered and is being used in bad faith" will be satisfied only if the Complainant proves that the registration was undertaken in bad faith *and* that the circumstances of the case are such that Respondent is continuing to act in bad faith." In **Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.** it was held by the Administrative Panel that "VEUVECLICQUOT.ORG" is so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith.
- d) The Respondent has, no doubt, been aware prior to its registration of the domain name that there was substantial reputation and goodwill associated with the



Complainant's trademark and/or service mark, which inures and continues to inure to the Complainant.

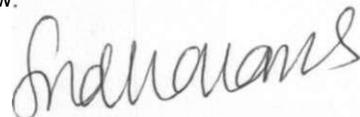
- e) The Respondent till the present day is not providing any service of its own on the disputed domain name **<microsoft.co.in>**, and has registered it with an intention of diverting traffic to its website www.host.co.in and generating revenue thereof. Further, since cloud hosting is one of the many services provided to its consumers by the Complainant, the said diversion will induce internet users to believe that the Respondent is in some way linked to the Complainant. With a domain name as innocuous as www.host.co.in, which merely talks about a service and not a trademark, the general public will be induced to believe that it is a service provided by the Complainant. Therefore, the bad faith intention of the Respondent is not only restricted to cause harm and injury to the Complainant but to also cheating internet users of quality web and cloud hosting services.
- f) The Respondent has neither intention nor reason to legitimately use the disputed domain name **<microsoft.co.in>** and is merely misrepresenting itself as the Complainant and inducing users to believe that it has some kind of affiliation with the Complainant. The disputed domain name **<microsoft.co.in>** was registered and is being used in bad faith as it resolves to a website of the Respondent. This conduct of the Respondent is evidence of registration and use of the domain name in bad faith.
- g) The Respondent has registered the impugned domain name www.microsoft.co.in in order to disrupt the business of the Complainant. It is apparent that the Respondent has attempted to attract for commercial gain Internet users to the website to which the impugned domain name resolves to by creating a likelihood of confusion with the Complainants well-known and famous trademark **MICROSOFT**.
- h) There is a likelihood that a potential visitor to the Respondent's future webpage that the subject domain name would resolve to, will be induced to:
 - 1. Believe that the Complainant has licensed its trademark **MICROSOFT** to the Respondent or has authorized the Respondent to register the disputed domain name **<microsoft.co.in>**.
 - 2. Believe that the Respondent has some connection with the Complainant in terms of a direct nexus or affiliation with the Complainant or has been authorized by the Complainant.
 - 3. Believe that the website to which the disputed domain name **<microsoft.co.in>** resolves to is affiliated to the Complainant or that it is the Indian arm of the Complainants Service, www.microsoft.com.

6.16 Thus it is clearly established that Respondent registered and has been using the disputed domain name **<microsoft.co.in>** in bad faith.

6.17 Respondent has incurred some amount towards registration and renewals for eight years. Considering the expenses incurred by the Respondent in registering and keeping alive the disputed domain name **<microsoft.co.in>**, I order on equitable principles the Complainant to pay Rs.50,000/- (Rupees fifty thousand only) to the Respondent towards costs.

7. **Decision**

7.1 For all the foregoing reasons, the Complaint is allowed as below.



- 7.2 It is hereby ordered that the disputed domain name <microsoft.co.in> be transferred to the Complainant.
- 7.3 Complainant is ordered to pay the Respondent a sum of Rs.50,000/- (Rupees fifty thousand only) towards costs of registration and renewals of the disputed domain name <microsoft.co.in>.
- 7.4 The transfer of the disputed domain name <microsoft.co.in> to the Complainant under Para 7.2 shall take effect only after the payment of costs under Para 7.3 by the Complainant to the Respondent.



S.Sridharan
Arbitrator