

Bond		Indian-Non Judicial Stamp Haryana Government		Date : 04/07/2019
Certificate No. G0D2019G2386			Stamp Duty Paid : ₹ 101 (Rs. Only)	
GRN No. 49828968			Penalty : ₹ 0 (Rs. Zero Only)	
Deponent				
Name: C A Brijesh	Sector/Ward : 27		Landmark : Millenium plaza	
H.No/Floor : Na	District : Gurugram		State : Haryana	
City/Village : Gurugram				
Phone : 0				
Purpose : AWARD to be submitted at Others				

BEFORE THE SOLE ARITRATOR C.A. BRIJESH
.IN REGISTRY
C/o NIXI (NATIONAL INFORMATION EXCHANGE OF INDIA)
NEW DELHI, INDIA

Dell Inc.

One Dell Way, Round Rock,
Texas 78682,
U.S.A.

... Complainant

Versus

Rookra

Tamil Nadu

... Respondent No. 1

And

Rookra Laptop Service Center

No. 5, 100 feet Tharamani Link Road,
Tansi Nagar (near Olympic Wedding Cards), Velacherry,
Chennai – 600042

Ph: 044 – 48510022

Email: info@rookralaptopservice.com

... Respondent No. 2



1. The Parties

The Complainant is Dell Inc., duly incorporated and existing under the laws of Delaware, U.S.A. having its principal office at One Dell Way, Round Rock, Texas – 78682, U.S.A, through its Authorized Representative, Mr. Akhilesh Kumar Rai, AZB & Partners, Advocates & Solicitors, having office at Plot A8, Sector 4, Noida – 201301, Uttar Pradesh, India. (hereinafter referred to as **Complainant**).

The Respondents are Rookra, Tamil Nadu and Rookra Laptop Service Center, No. 5, 100 feet Tharamani Link Road, Tansi Nagar (near Olympic Wedding Cards), Velacherry, Chennai – 600042 (hereinafter collectively referred to as **Respondent**).

2. The Domain Name and Registrar

The disputed domain name is <dellservicechennai.in>. The said domain is registered with 'GoDaddy.com, LLC'.

3. Procedural Timeline

May 27, 2019: The .INRegistry appointed C.A. Brijesh as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.

May 28, 2019: Arbitrator accorded his consent for nomination as Arbitrator and submitted Statement of Acceptance and Declaration of Impartiality and Independence to the .IN Registry

June 6, 2019: Parties to the dispute are informed of the constitution of the Arbitration panel and the effective date of handover i.e. June 3, 2019. NIXI also forwarded the soft copy of the Complaint to both the Arbitrator and the Respondent on this date, by means of the same email.



June 11, 2019: Arbitral Tribunal addressed an email to the Respondent, with a copy marked to the Complainant's Authorized Representative and NIXI, directing the Respondent to file its response, if any, in ten days.

June 24, 2019: Absent a response from the Respondent, the pleadings in the Arbitration proceedings were closed and the Tribunal proceeded to pass an Award on the basis of the material available on record.

The language of the proceedings shall be English.

4. Factual Background

4.1. Complainant's Activities

The Complainant states, *inter alia*, that it carries an established business as one of the leading providers of computer systems with business/sale of computer hardware, software, peripherals, computer orientated products such as phones, tablet computers, and computer related consulting, installation, maintenance, leasing, warranty and technical support services. Since the establishment of the company in 1984, the Complainant claims to be in business with 98 percent of Fortune 500 corporations, selling more than 100000 systems every day to customers in 180 countries including India and catering to more than 5.4 million customers every day. Further, the Complainant states that its products were available in India since 1993 through subsidiaries and tie-ups with various channel partners like authorized distributors and resellers all over the country. The products of the Complainant are therefore sold by means of 'DELL' exclusive stores and at other stores in several cities in India.

4.2. Complainant's Use of 'DELL'

The Complainant states that the mark DELL was first used in the year 1988 and the Complainant has, since secured several registrations in various countries for the mark 'DELL' and variants



like DELLPRECISION, DELL CHAMPS, DELL PROSUPPORT, DELL PREMIUM CARE across various countries and in India. In this regard, the Complainant has provided copies of trade mark registration certificates marked as **Annexure 9** obtained for the said marks in India and a comprehensive list of the trademarks for DELL marked as **Annexure 1**. A perusal of the list and the corresponding registrations indicate that the mark/name DELL is being used extensively by the Complainant in India since 1992. The Complainant has a valid registration for the mark DELL under No. 575115 in class 9 since 1992. Thereafter, the Complainant obtained various registrations in India under different Classes viz. 2, 9, 36, 37, 38, 41 and 42 and the same are renewed, valid and subsisting. The Complainant emphasizes on registrations obtained in Class 37 to indicate the similarity of services offered between the Complainant and the Respondent.

The Complainant also operates the website www.dell.com which provides for extensive information of the activities of the Complainant and can be accessed from anywhere in the world, including India. The Complainant also operates country specific domain names like www.dell.co.in for India. These websites operated by the Complainant also provide for details of products, stores, authorized service centers details and retailers. In addition to this, the Complainant further relies on the list of domain name actions against third parties marked as **Annexure 2** to indicate vigilance in protection of the rights in the domain name to further substantiate its claim.

Based on the aforesaid, it is the Complainant's assertion that due to extensive and continuous use of the name DELL for about 30 years in India, the name DELL has come to embody substantial reputation, goodwill and distinctiveness and is exclusively associated with the business/products/services offered by the Complainant in the global market.

4.3. Respondent's activities and its use of DELL



The Respondent had registered the domain name <dellservicechennai.in> on November 11, 2016 as is clearly discernable from the WHOIS records as evidenced through **Annexure 3**. The Respondent maintains the website www.dellservicechennai.in (not accessible as on date) and claims to be an authorized Dell service center under the name of DELL SERVICE CENTER CHENNAI. Further, the Complainant claims that on the said website, the Complainant's mark DELL (as a word mark and trade mark) forms a prominent part and is prominently displayed on all the webpages of the website, in combination with the tagline of the Complainant "Power to do more". The Respondent also uses tag lines like "Your home and enterprise partner" and "Dell Laptop Support" at several places to indicate affiliation with the Complainant. The Complainant further states that the Respondent also offers services for the Complainant's products like Dell Screen Repair, Dell Power Issue, Dell Laptop Updates and Dell customer care. A perusal of the documents marked as **Annexures 5, 6 and 7** clearly affirms the aforesaid submissions. In addition, the Respondent also maintains the website www.dellservicecenterinmr.in.

Given that the Respondent has not participated in the present proceedings, no further information is available on its business activities and/or its use of the domain comprising the mark/name DELL.

5. Contentions of Parties as summarized in the pleadings

5.1. Complainant

a) The domain name(s) is (are) identical or confusingly similar to a trade mark or service mark in which the Complainant has rights.

i. Complainant submits that the Respondent has adopted the well-known trademark 'DELL' of the Complainant to provide post sale services for 'DELL' laptops and to offer the Complainant's products for sale. The Complainant further submits that the adoption of the mark is infringement and is for goods/services that are identical to that of the Complainant. The Complainant relies



on the **Annexure 8** to evidence the authorized Dell service centers in India of which the Respondent is not a part.

ii. Further, it is the assertion of the Complainant that it offers repair and maintenance services under the mark 'DELL' and has registered 'DELL' and 'DELL' formative marks in Class 37 of the NICE Classification (which includes repair and maintenance) as substantiated by trade mark registration certificates obtained in the name of the Complainant as in **Annexure 9**.

b) The Respondent(s) have no rights or legitimate interest in respect of the domain name(s)

i. It is the contention of the Complainant that the Respondent has no rights or legitimate interests in the disputed domain name and is taking advantage of innocent customers who may/may not inquire about the authenticity of the Respondent and the Respondent has represented itself, by means of the website, to be an authorized service center of Dell. In addition, the Complainant contends that even in the scenario that the Respondent informs the public of not being an authorized service center of Dell, it does not allow the Respondent to use the trademark 'DELL' of the Complainant as part of the impugned domain name and on the Website.

ii. The Complainant asserts that the Respondent has no right to use the mark 'DELL' of the Complainant as it is the sole property of the Complainant. The Complainant relies on its use of the mark and registrations secured in addition to stating that the use of the mark 'DELL' by the Respondent is not licensed and would thus constitute infringement of the trademark 'DELL'. The Complainant further states that the sole reason for adoption of the offending domain name by the Respondent was to take illegal advantage of the goodwill and reputation of the mark DELL built by the Complainant.

c) The domain name(s) was/were registered and is/are being used in bad faith

i. The Complainant contends that the registration and operation of the domain name www.dellservicechennai.in was done in bad faith and with the dishonest intention to mislead the



public into believing that the Respondent is the authorized service center of the Complainant. The Complainant further states that even its authorized service centers are not permitted to register domain names using the trademark 'DELL'. The adoption of the trademark by the Respondent is to confuse and deceive the relevant section of the public into believing that the domain name www.dellservicechennai.in is a website of the Complainant, which is not the case. The Complainant contends that using the offending domain name was for the reason to create an initial interest, luring them to the website and making illegal profits out of such representation.

ii. The Complainant further contends the bad faith of the Respondent is reflected by means of use trademark 'DELL' on the website and as a part of the domain name www.dellservicechennai.in. This is further elaborated by the Complainant by stating that such unauthorized/unlicensed adoption is in itself evidence of bad faith. Further, the Complainant submits that the use of the domain name is not for non-commercial use and does not fall within the ambit of fair use but to merely mislead the public. The contention of the Complainant is that the Respondent has adopted 'DELL' for services and/or goods that are identical to the Complainant only to make an illegal profit in addition to stating that the entire modus operandi of the Respondent is dishonest and illegal.

iii. The Complainant contends that the nature of the domain name in question is such that it creates an impression that it is the website of Dell service center in Chennai. Based on the said presumption, the Complainant states that such a registration results in duping the public, eroding the distinctive character of the Complainant's mark and dilution of the well-known mark of the Complainant and thus, evidences bad faith.

5.2. Respondent

As per the INDRP Rules of Procedure, the Complainant has forwarded a copy of the Complaint alongwith all annexures to the Respondent on June 6, 2019 under the directions of this Arbitral



Tribunal. This Tribunal issued a notice on June 11, 2019 to the Respondent directing it to file a response within ten days. Absent response from the Respondent thereto, the matter has proceeded *ex parte*.

6. Discussion and Findings

As per paragraph 4 of the .IN Domain Name Dispute Resolution Policy (INDRP), any person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

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

Based upon the pleadings, it is required to be examined as to whether the parties have been able to justify/rebut the aforesaid premises:

6.1. Identical or confusingly similar trade/service mark

As per the WHOIS records, the Respondent registered the disputed domain name 'dellservicechennai.in' on November 11, 2016.

The Complainant is the proprietor of the registered trade mark DELL and its variants in Class 37 in addition to registrations in several other classes with registrations in India dating back to the year 1992. In order to substantiate the same, the Complainant has relied on registration certificates and a comprehensive list for the trade mark DELL and its variants. It claims to have been substantially and continuously using the mark/name DELL in relation to its business/products/services.



The disputed domain name incorporates the mark DELL in its entirety. It has been held in *Inter-Continental Hotels Corporation vs. Abdul Hameed* (INDRP/278) as well as in *Indian Hotels Company Limited vs. Mr. Sanjay Jha* (INDRP/148) that when a disputed domain name incorporates a mark in entirety, it is adequate to prove that the disputed domain name is either identical or confusingly similar to the mark. Similarly, in case of *Farouk Systems Inc. vs. Yishi*, WIPO Case No. D2010-006, it has been held that the domain name wholly incorporating a Complainant's registered mark may be sufficient to establish identity or confusing similarity, despite the additions or deletions of other words to such marks.

As seen from above, the Complainant has registered trademarks in India since the year 1992 and is doing/operating business/website thereunder. The Respondent on the other hand registered the domain 'dellservicechennai.in' much subsequent to the Complainant i.e. November 11, 2016.

In the view of the foregoing discussions, the Complainant has satisfied this Tribunal that:

- i. The domain name in question "dellservicechennai.in" is phonetically as well as visually identical to the Complainant's prior registered trade mark DELL; and
- ii. It has both prior statutory and proprietary rights in respect of the mark DELL.

6.2 Rights and legitimate interests

The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name. Paragraph 7 of the INDRP enumerates three circumstances (in particular but without limitation) and if the Arbitrator finds that the Registrant has proved any of the said circumstances, shall demonstrate its rights to or legitimate interest in the disputed domain name. The said paragraph is reproduced herein under:

“Registrant's Rights to and Legitimate Interest in the Domain Name- Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based

on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interest in the domain name for the purposes of Paragraph 4 (ii):

- i. Before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name with a bona fide offering of goods or services;
- ii. The Registrant (as an individual, business, or other organisation) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or
- iii. The Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Respondent has not filed any response in this case. In the absence of a response thereof, there is nothing on record to suggest that the Respondent has used or made demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with *bonafide* offering of goods/services; or is commonly known by the disputed domain name; or has made fair use of the domain name.

Further, as observed by the panel, in the case of *Inter-Continental Hotels v. Abdul Hameed* (INDRP/278), it is well established, that trade mark registration is recognized as prima facie evidence of rights in a mark. Complainant, in the instant case, is the owner of the registered trademark DELL in various jurisdictions in the world including India and has sufficiently demonstrated its rights in the trade mark DELL.

It is a settled position that if the Respondent does not have trade mark right in the word corresponding to the disputed domain name and in the absence of evidence that the respondent



was commonly known by the disputed domain name, the Respondent can have no right of legitimate interest. [See *Shulton Inc. v. Mr. Bhaskar*, (INDRP/483)]

At any rate, the Respondent is misrepresenting itself as the authorized service provider which clearly evidences that it cannot have any rights or legitimate interest in the domain name.

In view of the foregoing, it is evident that Respondent has no rights or legitimate interests in the disputed domain name.

6.3 Bad faith

Paragraph 6 of the INDRP enumerates the circumstances evidencing registration and use of domain name in bad faith. The said paragraph is reproduced herein under:

“Evidence of Registration and use of Domain Name in Bad Faith: For the purposes of Paragraph 4(iii), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:

- i. Circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or
- ii. the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or
- iii. by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion



with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.”

It appears that by registering the impugned domain name, the Respondent has attempted to attract internet users by creating likelihood of confusion with the Complainant's mark/source of origin. [See *Colgate – Palmolive Company and Colgate Palmolive (India) Ltd. v. Zhaxia*, (INDRP/887)]. Thus, the Respondent has registered the dispute domain name in bad faith to tarnish the trade mark and cause confusion in the minds of the public.

Further, it is crystal clear that the Respondent is misrepresenting itself to be an authorized service provider. Such misrepresentation tantamounts to bad faith. As observed in the case of *Adams and Remers LLP v. Michael Hallier/Whois Agent, Whois Privacy Protection Service, Inc.*, WIPO Case No. DME2015-0005, “A use intended to attract, for commercial gain, Internet users to the Complainant's online address thereby creating confusion with the Complainant's mark as to the service being offered at that location is clearly fraudulent and in bad faith”.

It is also evident that the objective of registering the domain name was aimed at preventing the legitimate owner of the trade mark from reflecting the same in a corresponding domain name.

Substantial number of precedents establish that registration of a domain name that is confusingly similar to a famous trademark by any entity that has no relationship to that mark is itself sufficient evidence of bad faith registration and use. [See *Pepperdine University v. BDC Partners, Inc.*, WIPO Case No. D2006-1003; *Veuve Clicquot Ponsardin, Maison Fonde en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163, *Mastercard International Incorporated v. Total Card Inc.*, WIPO Case No. 2000 – 1411].

Considering that the current status of the webpage corresponding to the domain name ‘dellservicechennai.in’ is non-operational/inaccessible, this would constitute passive/parked



holding of the website, which also contributes to bad faith. [See: *HSBC Holdings plc v. Hooman Esmail Zadeh* (INDRP/032), *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003].

In view of the foregoing, the panel is of the view that Respondent has registered the domain name 'dellservicechennai.in' in bad faith.

7. Award

From the foregoing findings, it is established beyond doubt that (1) the domain name is confusingly similar to the mark DELL which is proprietary to the Complainant, (2) the Respondent has no rights or legitimate interests in respect of the disputed domain name, and (3) the domain name is registered in bad faith.

Thus, in accordance with the Policy and Rules, this Arbitral Tribunal directs the Respondent to immediately transfer the disputed domain name 'dellservicechennai.in' to the Complainant.

The parties shall bear their own cost.

Dated: 03/08/2019



C.A. Brijesh
Sole Arbitrator