

ఆంధ్రప్రదేశ్ ఆంధ్ర ప్రదేశ్ ANDHRA PRADESH

Sl. No. 7729 Dt. 21/11/17

Sold to Harini Narayan Swamy
Sto, Dto, W/O R. Narayan Swamy R/o And

To Whom Self

BH 322731

KODALI GEETHA RANI
Licenced Stamp Vendor
Licence No 16-04-1/2013
8-3-191/132 167/C. Behind E-Seva
Jangal Rao Nagar, Hyderabad (South)
Cell: 94920 25252

BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

In The Matter Between

Acko Technology & Services Pvt. Ltd.
Unit 5 B'B'Wing, Third Floor
KN House, Saki Vihar Road
Opp Marwah Center Saki Naka
Andheri East
Mumbai - 400072
India

COMPLAINANT

Versus.

Shashank Singh
A/004 Sangeet Complex bldg. 10
Jesal Park, Bhyander East
Bhayander
Maharashtra 401105
India

RESPONDENT

Harini Narayan

1. The Parties

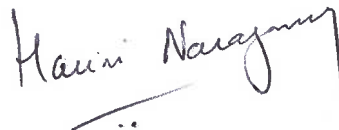
The Complainant is Acko Technology & Services Pvt. Ltd. of Mumbai India, represented in these proceedings by Mr. Karthik Mahalingam of Shardul Amarchand Mangaldas & Co. The Respondent is Shashank Singh, of Bhayander India represented in these proceedings by Mr. Sitesh Narayan Singh.

2. The Domain name, Registrar and Policy

The present Arbitration proceeding pertains to a dispute regarding the domain name <ackoinsurance.co.in> (hereinafter referred to as disputed domain name). The registrar for the disputed domain name is Go Daddy.com LLC. The Arbitration proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the .IN Domain Name Dispute Resolution Policy (the "INDRP Policy" or "Policy"), and the INDRP Rules of Procedure (the "Rules").

3. Procedural History

The sole arbitrator appointed in the case is Mrs. Harini Narayanswamy. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, in compliance with the Rules. The Arbitrator received the Complaint from the .IN registry on May 26, 2017 and on May 28, 2017 transmitted by email a notification of commencement of the arbitration proceedings to the Respondent. Under the INDRP Rules, copies of the said notification were sent to other interested parties to the dispute. The Respondent was given three weeks from the date of the notification to file a response. The Respondent's counsel sent an email dated June 22, 2017 requesting for a further four weeks to file a response. The Arbitrator granted further three weeks to the Respondent, and the response was filed on July 14, 2017.


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Factual Background

The Complainant and its subsidiary company are in the business of providing general insurance services. The Complainant uses the trademark ACKO in connection with its business. In July 2016, the Complainant purchased the domain name <acko.com> from Brandroot LLC, USA. The Complainant has filed trademark applications the details are:

Trademark	Application No.	Date	Class	Status
ACKO TECHNOLOGY & SERVICES PRIVATE LIMITED	3491654	February 23 2017	42	Advertised before Acceptance
ACKO GENERAL INSURANCE LIMITED	3491651	February 22 2017	36	Advertised before Acceptance

The Respondent has not provided any details of his business. The disputed domain name <ackoinsurance.co.in> was registered by the Respondent on October 25, 2016.

The Parties Contentions

A. Complainant's Submissions

The Complainant states it is a holding company, that operates the back-end technology processes of its wholly owned subsidiary, ACKO General Insurance Limited. The Complainant states the ACKO trademark was adopted in May 2016, when it registered the domain name <acko.in> through an agent. The domain name <acko.in> is redirected to the domain name <acko.com> which hosts the website for the Complainant's business. The Complainant states its website has been developed at considerable costs. The Complainant has submitted copies of its bank statements, copies of the "Whois" records

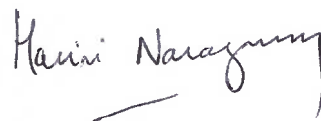
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for the domain names <acko.in> and <acko.com>, the invoice raised by Brandroot LLC, and printouts from the website <acko.com> as evidence.

The Complainant claims it has used the ACKO trademark since its incorporation and the name "Acko" is part of its trade name, therefore people in the trade are well aware that the ACKO mark belongs to the Complainant. Further evidence filed by the Complainant are invoices bearing the ACKO mark, media reports showing that Acko GI is backed by the industrialist Mr. N.R. Narayana Murthy, the founder of Infosys Limited.

The Complainant alleges that the ACKO mark is distinctive, unique and invented. It claims the mark is derived from the word "echo", based on the Complainant's business philosophy, which is, to resonate or to echo its customers' requirements and fulfil them. The Complainant states that the disputed domain name contains the entire ACKO trademark, in which it has rights. The Complainant asserts that previous Policy decisions have found the omission of one letter, does not deter a finding of confusing similarity between the dispute domain name and the mark. The present case is on a higher footing, argues the Complainant, as it contains a verbatim copy of the trademark along with the generic term 'insurance'. Merely adding generic words to a trademark, is insufficient to avoid a finding of confusing similarity, argues the Complainant.

The Complainant contends the Respondent has no rights in disputed domain name. The Complainant believes that the Respondent is not known by the name "Acko", and has no business by the name or any trademark rights in the name. The Respondent is not authorized or licensed by the Complainant to use its mark, therefore use of the mark by the Respondent without permission violates its rights, states the Complainant. The Complainant adds that the Respondent is not running a website or a business from the disputed domain name and the Respondent has no *bona fide* or legitimate interests in the disputed domain name. Hoarding a domain name with a view to making financial gain is not legitimate use, argues the Complainant. The use of the term 'insurance' with its mark in the disputed domain name constitutes passing off adds the Complainant.

Handwritten signature of Naini Narayana.

The Complainant states the disputed domain name has been obtained in bad faith as the Respondent's intention is to sell or transfer the disputed domain name to the Complainant for financial gain. The Complainant has filed an email communication where the Respondent has asked for a sum of USD 30,000 to transfer the disputed domain names <ackoinsurance.in> and <ackoinsurance.com> to the Complainant. The Complainant further argues that the Respondent is not operating a website from the disputed domain name, which shows that the Respondent lacks genuine interest in the disputed domain. The Complainant argues that the Respondent may falsely try to represent to the public that it is the Complainant, and it is likely to cause damage to the Complainant's reputation. Based on all the arguments, the Complainant requests for the transfer of the disputed domain name.

B. Respondent's Submissions

The Respondent states that the Complaint is not maintainable, in particular, under the Trademarks Act 1999, and that the Complainant has not come with clean hands and therefore is not entitled to the equitable relief of injunction. The Respondent states there is no cause of action, and the Complaint is an abuse of the process of law. The Respondent states the Complainant has deliberately concealed material facts that the Respondent owned the disputed domain name prior to the date the Complainant was authorized to do business in the field of insurance. The Respondent argues that the Complaint has been put forward in a vague manner, is false, distorted and misleading.

The Respondent states that the disputed domain name relates to a generic description of the insurance sector business, which is in tune with its "business of business". The Respondent avers that the Complainant being a company can afford to forum shop and use one favorable order in any one forum against him. The Respondent states that a Complaint was filed before the World Intellectual Property Organization (WIPO), Case No. D 2107-0821. The Respondent states that the Complainant has filed the order copy of the WIPO case with the rejoinder in the INDRP Case No. 890 / 2017. The Respondent argues that instead of filing before a single forum for all three domain names, the

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Complainant filed multiple litigations in different forums. The Respondent states that he has been put to great expense for defending the complaints and needs to be compensated.

The Respondent states that the business of the Complainant and the Respondent are completely and absolutely different from each other and there is not a single overlapping area. The Respondent argues that the Complainant has not provided an instance of passing off and therefore does not disclose a cause of action. The Respondent states that he has purchased the disputed domain name from the registrar on October 25, 2016.

The Respondent states that the sole motive of the Complainant is to hide its incompetency in not obtaining the disputed domain name on time and by dragging the Respondent to unnecessary litigation and thereby harming his reputation.

The Respondent further states that the domain name <acko.in> registered by the Complainant, has nothing to do with insurance business and that the ACKO mark was not even a registered at the time of registration of <acko.in> on May 23, 2016. The Respondent further argues that the disputed domain name was registered six months after the Complainant registered the domain name <acko.in> and states that the disputed domain name was available in the open market but the Complainant did not bother to register it. The Respondent argues that the Complainant has purchased the domain name <acko.com> for Rs.1,50,371, but is taking advantage of the forum by filing the present Complaint to grab the disputed domain name for free.

The Respondent further argues that submissions made by the Complainant does not prove that the Complainant has spent substantial amounts for branding "ACKO GENERAL INSURANCE LIMITED" prior to October 25, 2016. The Respondent states that he doubts the authenticity of the invoices submitted by the Complainant. The Respondent states that the news reports and media articles are of the year 2017, which is much after the disputed domain name was registered by the Respondent. The Respondent states that the Complainant obtained clearance to do business in insurance from the IRDAI only on March 3, 2017.

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The Respondent states that the Complainant has admitted that it has made the trademark application for the mark ACKO GENERAL INSURANCE LIMITED on February 22, 2017 and has claimed use since November 3, 2016, which is after the Respondent had purchased the disputed domain name. The Respondent argues that the claims made by the Complainant are based on an “unregistered trademark”, and the Complainant is required to prove beyond reasonable doubt that the Complainant has reputation in the mark and that the mark has become a distinctive identifier of the Complainant’s goods. The Respondent argues that the Complainant has not filed documents showing that its mark has become a distinctive identifier of the Complainant’s goods or services. The documents filed by the Complainant are dated after the registration of the disputed domain name states the Respondent.

The Respondent states that he has no intention of selling, renting or transferring the disputed domain name. As the Complainant had repeatedly asked him to give a figure for the transfer of the disputed domain name, the Respondent states he had sent an email dated January 23, 2017 stating a figure. The Respondent says that he is in talks to start a business with the disputed domain name and is no longer interesting in selling it.

The Respondent further argues that if the Complainant was prepared and serious about launching its insurance business, it ought to have registered a domain name with the word “insurance” instead of registering the domain name <acko.in>, when the disputed domain name was available for six months till the Respondent purchased it. The Respondent states the INDRP and WIPO Arbitration and Mediation cases cited by the Complainant are not admitted, as the Respondent’s case is unique and has a different set of fact that has to be decided differently, and adds the similarity in the words in the disputed domain name and Complainant’s mark is merely a coincidence.

The Respondent argues that he is a prior user and has legally registered his domain name therefore his right is unquestionable. The Respondent states that he does not require authorization from the Complainant and that the Complainant violates the Respondent’s rights in the disputed domain name.

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The Respondent argues that the Complainant has failed to prove that the Respondent has made any attempt to attract an unsuspecting Internet user to its domain name for unlawful commercial activity. The Respondent states that he had agreed to transfer the disputed domain name to the Complainant when he quoted a figure by email, only because at that point, he was in acute need of money. The Respondent states at present he is not interested in selling or transferring the disputed domain name to the Complainant or any third party.

The Respondent concludes by stating that he shall not use the disputed domain name for any transactions that could jeopardize the Complainant's business, but will use it only for purposes of his own business. The Respondent requests the Complaint to be dismissed with costs.

Discussion and Findings

A complainant of a domain name dispute, can opt to file the dispute before a court of appropriate jurisdiction or alternatively before an approved dispute resolution service provider. WIPO Arbitration and Mediation Center, among others, provides dispute resolution services for generic top level domains (gTLDs) such as for the gTLDs ".com", ".biz" etc. If a complainant opts to file a case before any of the approved service providers, such a choice, in the Arbitrator's view, cannot be termed "forum shopping", as the choice of forum for domain name dispute is linked to the appropriate service providers for the Top Level Domain (TLD) or country code Top Level Domain (ccTLD). In any event, if the respondent to a domain name dispute is not satisfied with the complainant's choice of forum (other than a court) or the outcome of the domain name dispute filed before such a forum, the respondent has the option to take up the matter before a court of appropriate jurisdiction, if the respondent wishes to do so.

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Domain name disputes conducted under the INDRP Policy or under the UDRP Policy are not a trademark or passing-off action under the Trademark statute, but are determined under the said policy by an arbitrator or a panel. The arbitrator or panel makes findings and decides the case on the basis of the weight of the evidence submitted by the parties.

Under the INDRP Policy the Complainant has to establish the following three elements to succeed in the proceedings:

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

Identical or Confusingly Similar

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

The Respondent has submitted that the Complainant does not have registered rights in the ACKO mark. The term "trademark or service mark" in the Policy, covers both registered and unregistered or common law marks. The Arbitrator finds from the evidence, that the Complainant has adopted and used the ACKO mark in relation to its insurance business and has established that it has common law rights in the ACKO mark.

The evidence filed by the Complainant to demonstrate its common law trademark rights include: copies of Complainant's bank statements, copies of invoices bearing the ACKO mark, media reports referring to the Complainant's subsidiary Acko GI. The Complainant has also filed extracts from the "Whois" records for the domain names <acko.in> and

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<acko.com>, and documents of its purchase of the <acko.com> domain name from Brandroot LLC's. These documents establish its ownership and use of the ACKO mark and above mentioned domain names bearing its ACKO trademark shows the Complainant's use of the ACKO mark in commerce and in particular the Complainant's prior adoption and use of its mark with its online business.

The Arbitrator finds, based on the evidence on record, that the Complainant has established its rights in the ACKO trademark. The disputed domain name incorporates the Complainant's mark in its entirety and it is identical to the ACKO mark. The addition of the word "insurance" with the mark does not lessen the confusing similarity with the Complainant's mark, as the word "insurance" pertains to the Complainant's areas of business and heightens the confusing similarity. Internet users looking for Complainant online, are likely to be misled or confused as to the origin and ownership of the disputed domain name. It is well established that TLD extensions are generally not relevant in determining confusing similarity of the domain name with the trademark, See *AB Electrolux v. GaoGou*, INDRP 630 (Zanussi.in) October 19, 2014. The Arbitrator finds that the disputed domain name is confusingly similar to the Complainant's ACKO trademark.

The Complainant has successfully established the first requirement under paragraph 4 of the Policy, that the disputed domain name is identical or confusingly similar to a trademark or a service mark in which it has rights.

Rights and Legitimate Interests

The second element requires the Complainant to put forward a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain name. The burden of proving rights and legitimate interest is on the Respondent. If the Respondent fails to come forward with relevant evidence to prove rights and legitimate interest in the disputed domain name, the Complainant prevails.

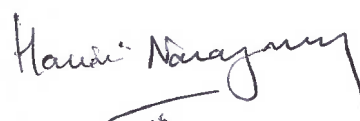


The INDRP Policy states that the Respondent can demonstrate legitimate interests in the disputed domain name if there are circumstances that show (i) that before notice of the dispute, the respondent had used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services or (ii) the respondent (as an individual, business organization) has been commonly known by the domain name, or (iii) The respondent is making legitimate, non commercial or fair use of the domain name without intent for commercial gain.

The Arbitrator finds no evidence has been provided by the Respondent that show any preparations are made by the Respondent to use the disputed domain name in connection with a *bona fide* offering of goods or services or that the Respondent has been commonly known by the disputed domain name or makes any legitimate non-commercial fair use of the disputed domain name.

The Complainant has argued that the Respondent has no rights or legitimate interests in the disputed domain name, as the Respondent is not known by the disputed domain name and has no business by the name or runs a website from the disputed domain name. The Complainant has further argued, that the Respondent is not likely to have any business related to insurance, as an entity doing business in the area of insurance in India, is required to obtain regulatory approvals from the authorities, The Insurance Regulatory Development Authority of India (IRDA). The Respondent has no rationale for registering the disputed domain name, argues the Complainant, except to create a false association with the Complainant's mark.

The Respondent has submitted that the disputed domain name relates to a generic description of the "insurance sector business", which is in tune with his "business of business". The Arbitrator finds that the disputed domain name contains the trademark ACKO that is owned by the Complainant, and therefore the disputed domain name cannot be said to a generic description of the insurance business sector, as submitted by the Respondent. No evidence has been provided by the Respondent regarding his business to support his statements. The Respondent has made conclusory statements, but

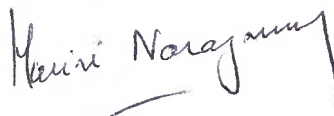


has not provided any evidence to support his bald statements to establish rights or legitimate interests in the disputed domain name.

The Respondent has also stated that the business of the Complainant and the Respondent are completely and absolutely different from each other and there is no overlapping. The Respondent has however not mentioned what business he is doing, or the name of his business or any relevant evidence regarding his alleged business. Under the circumstances where the Respondent's submissions are bereft of any evidence, the reasonable inference that can be drawn under the circumstances, is that the Respondent ought to have registered the disputed domain name to attract Internet traffic based on the Complainant's trademark. Such use of the disputed domain name is not a basis to find legitimate rights or interests in favor of the Respondent.

The Respondent has argued that the disputed domain name was available for about six months from the date the Complainant registered <acko.in>, and that the Complainant ought to have registered it when it was available. The Respondent has also argued that the dispute domain name was registered prior to the Complainant receiving its approval from the appropriate authorities. These arguments however do not help the Respondent establish rights or legitimate interests in the disputed domain name. As previous discussed, the Complainant has established its prior adoption and use of the ACKO mark and if the Complainant opted to register a domain name with the trademark along with the word "insurance" after receiving clearance from the authorities, in the absence of any evidence from the Respondent, it does not support a finding that the Respondent has any legitimate rights in the the disputed domain name. Under the circumstances discussed, the Arbitrator finds the Complainant prevails.

Accordingly, for the reasons discussed, the Arbitrator finds the Complainant has made a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain name.

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Bad Faith

The third element of Policy requires the Complainant to establish the disputed domain name was registered in bad faith or is being used in bad faith.

The Arbitrator finds from the evidence and facts that: (i) The Respondent's choice of using the term "Acko", which has no dictionary meaning except to describe the Complainant's business along with the term "insurance" in the disputed domain name, gives rise to the inference that the disputed domain name targets the Complainant's trademark (ii) There is lack of evidence of any actual good faith use of the disputed domain name by the Respondent (iii) Circumstances of the case therefore indicates there is no reason to register to disputed domain name except to gain from the association with the Complainant's mark.

Domain names registered in anticipation of trademark rights, are found to be registration in bad faith, if it is found that the Respondent's intent in registering the disputed domain name was to capitalize on the Complainant's nascent trademark rights. This proposition is supported by the basic underlying principle of the Policy, which is to protect consumers from online trademark related deception at the hands of respondents who register confusingly similar domain names. It is reasonable to infer, under the circumstances discussed, that the Respondent knowingly and deliberately registered the disputed domain name using the ACKO mark in anticipation the Complainant's trademark rights and to capitalize on the Complainant's nascent trademark rights.

Under Paragraph 6 (iii) of the Policy, if the registrant of a domain name has register and uses the domain name to intentionally attract Internet users to the Respondent's online location by creating a likelihood of confusion with the trademark of another, it is considered evidence of bad faith. The Arbitrator finds the circumstances here suggest that the Respondent seeks to use the Complainant's mark in the manner mentioned under

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Paragraph 6 of the Policy, namely to attract Internet traffic based on its confusing similarity with the trademark of the Complainant and mislead Internet users.

Further inference of bad faith can be drawn from the Respondent's email showing that he was willing to sell the domain names <ackoinsurance.in> and <ackoinsurance.com> to the Complainant for amount of USD 30,000. The Respondent has denied he has any intention to sell the disputed domain name presently, but he has admitted his willingness to transfer the domain names in January 2017, when by his own admission, he was in need of the money. Based on the facts and circumstances of the case, the Arbitrator finds the disputed domain name was registered in bad faith and has been used in bad faith.

The evidence on record shows the Complainant's prior adoption of the name ACKO in connection with its business and the Complainant's user of the ACKO mark in commerce. The Respondent has registered a domain name that is confusingly similar to the Complainant's mark. The Respondent has not filed any evidence to established rights or legitimate interests in the disputed domain name or shown that he has made preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. The Complainant has provided evidence that the disputed domain name has been registered and is being used in bad faith. On balance, bases on the evidence on record the Arbitrator finds the Complainant has satisfied all three elements required under paragraph 4 of the Policy to obtain the remedy of transfer of the disputed domain name.

Decision

In light of all that has been discussed, it is ordered that the disputed domain name <ackoinsurance.co.in> be transferred to the Complainant.



Harini Narayanswamy

(Arbitrator)

Date: July 25, 2017