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Purchased by	: Sudhir Kumar Sengar
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: Sudhir Kumar Sengar
Second Party	: Not Applicable
Stamp Duty Paid By	: Sudhir Kumar Sengar
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



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INDRPARBTTTRATION
THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: SUDHIR KUMAR SENGAR
INDRP Case No.1415

TEKTRONIX, INC

Vs

JOSEPH TAHENY

[Signature]

Statutory Alert:

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DisputedDomainName: www.TEK.IN

1. The Parties

The Complainant in this arbitration proceedings is Tektronix, Inc. with its office at 14150 SW Karl Braun Drive , P.O. Box 500, Beaverton, OR 97077, United States. The Complainant is represented by Advocate Amit Mehta of Sai & Mehta having their office at G-23/186, Sector 7, Rohini, New Delhi-110085, India (Attorney Code 188).

The Respondent is Mr Joseph Taheny, P.O. Box NO. 59, FULHAM Gardens, SA, AU-5024. The Respondent is represented by Advocate Ankur Raheja (D/93/05) of Cyber Solutions having office at 805, Kaveri Kaustubh I, Bain Bazar, Sikandara, Agra 282007, India.

2. Domain Name and Registrar

- (i) The disputed domain name is <tek.in>.
- (ii) The accredited registrar with whom the disputed domain is registered is Dynadot, LLC

3. Procedural History

The arbitration proceedings is in accordance with the .IN Domain Name Dispute Resolution Policy (the policy) adopted by National Internet Exchange of India ("NIXI") and INDRP Rules of Procedure ("the Rules") which were approved on June 28, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering disputed domain name with a NIXI registrar, the respondent agreed to the resolution of disputes pursuant to the Policy and the Rules.

As per the information received from NIXI, the history of the proceedings is as follows:

The complaint was filed by the Complainant with NIXI against the respondent. NIXI verified the Complainant and its annexures for conformity with the requirements of Policy and Rules.

On August 6, 2021, I submitted the statement of Acceptance and declaration of impartiality and Independence, as required by NIXI to ensure compliance with Paragraph 6 of Rules. NIXI notified the parties of my appointment as Arbitrator via email on August 6, 2021 and served an electronic copy of the complaint on respondent. I informed the Parties about commencement of arbitration proceeding on August 7, 2021 and Respondent was directed to submit a response within 10 days. On August 9, 2021, the Respondent via email sought extension for submission of response by another 15 days. The Respondent was granted 15 days extension via email dated 11.8.2021, for submission of response. On submission of response by respondent via email dated 31.8.2021, the Complainant sought 2 weeks time to file rejoinder but only one week time was granted to the complainant to file rejoinder. On receipt of reply of the Complainant via email dated 7.9.2021, the Respondent sought a few days time to file reply to the rejoinder of the Complainant. The respondent was granted 3 (three) days time to file reply. The respondent submitted reply to the rejoinder via email dated 10.9.2021. The Complainant and the Respondent were asked through email dated 12.9.2021 to submit brief submission of their case within three days. Both the parties submitted brief submission through emails dated 15.9.2021.

BRIEF SUMMARY OF CASE OF THE COMPLAINANT

1. Brief Facts

- a. Disputed Domain Name: <tek.in>
- b. Registration Date: February 16, 2005
- c. Any Business Website Hosted: No
- d. Offered on Sale: Yes, at US\$ 10,000
- e. Relevant Trademarks: TEKTRONIX and TEK
- f. Complainant: Tektronix, Inc. It is a major electronics manufacturer worldwide. It was established in year 1945 and is one of the world's foremost and leading company known for manufacturing test and measurement devices and widely known as "TEK". Indian trademark registrations of the Complainant: **Registration No. 4079347** in Class 9 for the mark **TEK**; **Registration No. 282694** in

class 9 for the mark **TEKTRONIX**; **RegistrationNo.282695** (Device) in class 9 for the mark **TEKTRONIX**; **Registration No. 198572** in class 9 for the mark **TEKTRONIX**.

- g. Worldwide trade mark registration of the Complainant: In United States, UK, Canada, Italy, New Zealand, Denmark, Myanmar, China, France, Philippines, Macedonia, Singapore, Israel, Australia, Tunisia, etc.

United States (trade mark Registration No.73004733 for the mark TEK as of October 26, 1973; trademark Registration No. 73069747 for the mark TEKTRONIX as of November 21, 1975); **Australia** (trade mark Registration No. 151947 for the mark TEKTRONIX as of December12,1958; trademark Registration No.327433 for the mark TEKTRONIX as of February1,1979).(Referpara6.viii of the Complaint for worldwide trademark registrations)

- h. Domain Names owned by the Complainant: <tek.com> since May 8,1986; <tektronixindia.com> since August 22,2018

- i. Whether Respondent has any rights or claimed any rights in the mark TEK: NO

- I. The domain name <tek.in> is confusingly similar to the trademark 'TEK' and TEKTRONIX' in which the Complainant has rights.**

The Complainant has worldwide trademark registrations for the mark TEK and TEKTRONIX.

The Complainant has 34 trademark registrations worldwide for the mark TEK including India and 107 trademark registrations worldwide for the mark TEKTRONIX including Turkey, Australia and India. The Complainant has been using the mark TEK and TEKTRONIX since at least 1973(which is also evident from the trademark registration in US) and thus, also has common law rights in the said trademarks. The Complainant registered the domain name <tek.com> on May 8,1986 (about 35 years ago) and hosting its global website thereat since then. Furthermore, considering the Complainant's rights in the domain name <tek.com> - the disputed domain name viz. <tek.in> is identical and confusingly similar to the Complainant's mark. Refer *ITC Limited v. Vishal*, INDRP/050(NIXI November30,2007). Owing to the statutory rights, common law rights and the rights in the domain name <tek.com> and <tektronixindia.com>, it can safely be concluded that the Complainant has rights in the market and TEKTRONIX and the disputed domain name is confusingly and deceptively similar with the said marks.

- II. The Respondent has no rights or legitimate interest in respect of the disputed domain name <tek.in>.**

The Complainant has not given any license or authorization to the Respondent to use the domain name <tek.in> or use the mark TEK in any manner. The Complainant has made out a prima facie case and then the onus shifts on the Respondent to show its rights or legitimate interest in the disputed domain name. As per Para6 of the INDRP Rules, a Registrant can establish its rights or legitimate interest in the disputed domain name by showing:

- a. *the Registrant's use of, or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services. The Registrant has failed to establish this. It has only stated that it wanted to develop this domain name but could not do.*
- b. *The Registrant has failed to show any demonstrable preparation to use the domain name. The Complainant registered the disputed domain name in 2005 and more than 15 years have passed since then but the Respondent has failed to submit any evidence to show demonstrable preparation to use the disputed domain name. The Registrant (as an individual, business, or other organization) has been commonly known by the domain name. The Registrant has not claimed that it has been commonly known by the domain name.*
- c. *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 Registrant is not making any use of the disputed domain name except offering it for sale at an exorbitant price i.e. US\$ 10,000. Lack of use of the disputed acronym and <tek.in> is a domain name hack. It is submitted that TEK is not a generic term. It is an arbitrary word. It does not have a dictionary meaning (refer <https://www.dictionary.com/misspelling?term=tek>). The Complainant has trademark registration for the mark TEK in India and thus, no third party can claim that TEK is a generic mark in India without filing a rectification petition against the trademark registration of the Complainant. The Respondent has not challenged the statutory rights of the Complainant and thus, he cannot contend that TEK is a generic term in India. Further, <tek.in> is not a domain hack since TEK is a trademark owned by the Complainant. The Respondent has not filed any evidence to show its demonstrable preparation to use the disputed domain name as a domain hack. In any case, if a domain hack infringes rights of the owner of the trademark, it does not give any legitimate right to the Respondent. Refer *Instant Domain Search Inc. v. Mark Cambridge*, INDRP/1268 (the Panel rejected the submission of the Respondent that the domain name <instantdoma.in> is a domain hack and directed transfer of the disputed domain name in favor of the Complainant). The Respondent has further submitted that it has invested in the domain name and it is permissible to invest in an intangible asset like a physical asset. The same is devoid of merits as the Respondent cannot invest in a domain name featuring the mark TEK when the Complainant had worldwide rights in the mark TEK/TEKTRONIX in 2005. The Complainant has trademark registrations in the US since 1973 (and registered in many other countries in 1980s) and domain name registration for <tek.com> since 1986. Thus, the Respondent cannot block a country level domain name in 2005 by featuring a trademark in which the Complainant had statutory and common law rights.

III. The domain name <tek.in> was registered or is being used in bad faith.

The Complainant has satisfied the first and second condition laid down in paragraph 4 of the INDRP policy. The third and the final condition is that the Respondent's domain name has been registered or is being used in bad faith. The Policy has used the word "or" and thus, the Complainant is required to only show either of the two i.e. bad faith use or bad faith registration. The fact that the Respondent is offering the disputed domain name for sale at an exorbitant price of US\$ 10,000, conclusively establishes that the disputed domain name was registered in bad faith. It is evident that the Registrant has not used the disputed domain name in last 15 years except for offering the domain name for sale. Thus, the only purpose of registering the disputed domain name is to sell the domain name at a higher price. The domain name will certainly be purchased by only someone who already has rights in the mark TEK or a competitor of the Complainant. Such registration and use of the domain name have been held to be in bad faith. Refer *Groupe Auchan v. Bui Tan Dat / Domain ID Shield Service Co., Limited*, D2014-1935 (WIPO January 4, 2015). It is further submitted that registering a domain name solely for the purpose of selling is against the NIXI policy as per their advisory (refer <https://www.registry.in/registry-advisory-la01sales-of-in-names-by-registrars>). Respondents' contentions that TEK is a generic term, domain hack or Acronym are frivolous and are devoid of any merits. Based on prior adoption of the trademark TEK, worldwide use, several trademarks and domain names registrations of the Complainant, and lack of rights and legitimate interest on the part of Respondent to use the domain and the established bad faith on the part of the Respondent, the Complainant contends that it has satisfied the requisite conditions laid out in INDRP. It is thus prayed that the instant Complaint be allowed by directing transfer of the disputed domain name in favor of the Complainant.

BRIEF SUMMARY OF THE RESPONDENT

1. The disputed domain was created by the Respondent (while he was residing in Turkey) on February 16, 2005, the day of launch of .IN Domains. Annexures contains Respondent's declaration in support containing professional details and the stay at Turkey, which is further evidenced by Annexures. Although the Respondent really need not have any explanation for registering a domain name when it didn't correspond to any trademark in existence at the time in any relevant jurisdiction. The fact is that the Respondent registered <tek.in>, while he was in Turkey since 2001, solely because it gave numerous advantages being generic (turkish) term, domain hack (tekin), short for teknoloji) and acronym:
 - a. Generic Term: A generic term in Turkish language to mean 'Single'/'Only'.

- In INDRP/957 - apanaghar.in: No one needs a license or permission to use generic terms.
- Domain Hack: The Respondent was also aware of one of the common first / last names in Turkey as 'TEKIN' <tek.in> . Explained in INDRP/1268 -InstantDoma.in.
 - Short Form: It indicates 'Technology' in Turkish, as in Turkish Language Technology is 'Teknoloji' and hence Tech becomes 'Tek'.
 - Acronym: It is an acronym that can mean different things to different people, as provided.

Relevant Jurisdiction: At the time of <tek.in> registration, the Respondent could be aware of Trademarks in Australia (being Citizen) or Turkey (physical presence 2001-07) or given .IN extension, Indian Trademarks at the maximum. The Complainant never had any Trademarks in Australia or Turkey but recently in 2019 registered in India for 'TEK'. **Annexures** also provides that on searching for "TEK" from Australia, no results for the Complainant. In *The Way International v. Diamond Peters* [WIPO-D2003-0264], it was held "as to constructive knowledge, the Panel takes the view that there is no place for such a concept under the Policy... For that bad faith to be present, the Respondent must have actual knowledge of the existence of the trademark owner."

Also see *Century 21 Real Estate LLC v. Century 21 Main Realty Pvt. Ltd.* [CS(OS)No.1687/2007].

The Complainant registered its trademark in 2019. This of course is almost Fourteen (14) years after the Respondent registered the domain name on February 16th, 2005 . Whereas other Indian mark 'Tektronix' is not contained within the disputed domain, hence not relevant to the proceedings. Accordingly, not only did the Complainant not obtain any trademark rights until 2019 in relevant jurisdiction, but it didn't even adopt the Indian specific domain name TektronixIndia.com until 2018 and even does not own TekIndia.com (on sale).

2. **"TEK" is neither distinctive nor has acquired secondary meaning:** Complainant's mark TEK is neither a distinctive/coined term nor it has acquired Secondary Meaning / Well-known status. No evidence has been submitted by the Complainant to prove otherwise. In *Transportes AEROMAR v Aeromar* [WIPO-D2010-98] it was held: if a Complainant fails to produce evidence of its reputation as it existed, the inference must be it had none ! Further see decision in *INDRP/1195 - Enow.in* (Pg 8 Para h), the weaker the mark, the stronger should be evidence. Also Hon'ble Delhi High Court in *Living Media India Limited vs Jitender V. Jain And Anr.*, 2002 held that the word "AAJ" and "TAK" are individually descriptive & dictionary words and may not be monopolised by any person. In *Machani Infra Dev. Corp. (P) Ltd v. K, Anand*, WIPO-D2021-1352] the Complainant claimed that it is a well-known Trademark but no evidence from any third party sources, which can prove that Complainant has acquired secondary meaning in the mark, within relevant jurisdictions.

3. **Synopsis of Complaint / Rejoinder:** A synopsis / analysis of the Complaint has been included with the original response, while it has been further proved under response to the Rejoinder, that many misleading arguments have been made by the Complainant.

4. **INDRP & NIXI Policies:** The Para 4 of the INDRP, has the use of the word 'and' as amended in September 2020. Therefore, all the three clauses / conditions are required to be fulfilled by the Complainant, in order to prevail in these proceedings, hence old precedents not applicable. Further, there are no restrictions under .IN domain names registration - "Unlimited registrations are available in the following zones. Registration is available freely to all parties worldwide, and there are no nexus or other qualifications" . Furthermore, NIXI advisory intends to restrict .IN accredited domain registrars only from selling domain names at a premium.

A. Is the disputed domain name identical or confusingly similar to a trademark?

Though for the purpose of this clause, the Complainant has any Trademark registered anytime, which fulfils the standing requirement for the purpose of this clause only [INDRP/1208 -WatchWWE.in] as provided under response to the rejoinder. But otherwise 'TEK' is a generic word in wide use, therefore, by virtue of the word 'TEK' being generic in nature, it is non-distinctive and thus the rights to use or own the word 'TEK' cannot exist with one single entity or individual.

B. Has the Registrant, rights or legitimate interests in respect of the domain name?

First-come-first-basis: The system of domain name registration is, in general terms, a "first come, first served system" and, absent pre-existing rights which may be applicable to impugn a registration, the first person in time to register a domain name would normally be entitled to use the domain name for any legitimate purpose it wishes." Where a Respondent registers a domain name consisting of a dictionary term because the Respondent has a good faith belief that the domain name's value derives from its generic or descriptive qualities rather than its specific trademark value, the use of the domain name consistent with such good faith belief would establish a legitimate interest. In *Hall mark Licensing v. Privacy Administrator* [NAF-FA1941032;2021], where the domain name was on sale. Held that Respondent has rights and legitimate interests in the domain name because it corresponds to a well-known descriptive dictionary word.

Wide Use: The 'Tek' in addition to being a word in Turkish dictionary, is used as a brandable word by numerous organizations. Organizations like Johnson & Johnson own Trademark in India since 1943 for tooth brushes. provides google search results from Australia and more websites using 'Tek' in their name. Otherwise, there are over 300 domain names registered in different extensions with the sole word 'Tek'. But still the Complainant is pretending that it coined the term TEK and that it is the only one on earth that is entitled to use it. This is remarkably self-serving and fanciful conjecture [INDRP/957; *apanaghar.in*].

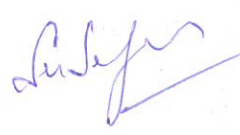
Domain Name Investment: The Respondent understands that this can give legitimate interests, as quoted in *TikTok.in* [INDRP/1228- Page no 11, Para no 4, see Response to rejoinder], and also the same has been upheld in *Tickets.in* [INDRP/1187]. He has developed sites like NewLira.com, Takeny.com, Joe.in, Mantra.in and so on. That is, the Respondent's intention has been development as well but he has complete right to put the undeveloped domain names on sale. Last year he successfully sold *www.edit.in*. Please see onwards has a list of UDRP decisions, wherein complaints have been denied even when the generic domains have been on sale. See article on Secondary Market. Also See *Fresenius Kabiv. Domain Manager* [WIPO-D2018-0491] and *Deep Focus v. Abstract Holdings International* [WIPO-D2018-0518].

C. Was the domain name registered or is being used in bad faith?

Purpose of Registration in 2005: The purpose and the facts related to the registration of the domain name, have been explained above. The Affidavit and further documents contain evidence as to the presence of the Respondent in Turkey in 2005. The response to rejoinder also evidences the familiarity of the Respondent with the Turkish language. Moreover, given the feature of the domain name <tek.in>, it's a good faith registration! Now here 'The purpose' is quite important to note that reads "you have registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise". But here the Respondent had registered the domain name due to generic nature while he was residing in Turkey due to the reasons provided above, while he never had heard about the Complainant previously

Grounds for Arbitration Proceedings

- A. The Disputed Domain Name is identical or confusingly similar to the name, trade mark or service mark in which the Complainant has rights;
- B. The Respondent has no rights or legitimate interest in respect of the domain name ; and
- C. The Disputed Domain Name was registered and being used in bad faith.



Complainant's Contention

Background of the Complainant and its statutory and common law rights Adoption:

The complainant in this arbitration proceedings is Tektronix, Inc., a corporation duly organized and existing under the laws of the State of Oregon, U.S.A. It was established in the year 1945 and is one of the world's foremost and leading company known for manufacturing test and measurement devices and widely known as "TEK". The company has been operating in manufacturing test and measurement devices in many countries of world including India. The Complainant has been a major electronics manufacturer in the US and by 1981 its U.S. payroll peaked at over 24,000 employees. Its manufacturing centers are in the USA, UK, Asia and sales and service subsidiaries are in Europe, North America, South America, Australia and Asia, including in India in the name of "Tektronix (India) Private Limited". It has offices in 21 countries and authorized distributor and manufacturer representative channels in worldwide including in India. Over the years, the Complainant has grown leaps and bounds and across boundaries and jurisdictions and is currently a market leader in each of the above segments, including in India. The Complainant has been awarded many prestigious global awards.

The Complainant has a direct presence in India by way of its fully-owned subsidiary Tektronix (India) Private Limited having its office in Bangalore. The Complainant contends that it conceived and adopted the mark TEKTRONIX and TEK (hereinafter collectively referred as to 'TEK mark') as early as 1954. The Complainant has been continuously and extensively using the TEK mark worldwide since then. As such, 'TEK' has now become a trade name of the Complainant. The Complainant further contends that it has a long history of prior use of the TEK mark. Over half a century ago, since at least as early as 1954, the Complainant adopted and began using its TEK mark in interstate and international commerce in connection with its goods and services. Particularly in India, there has been an extensive use of TEK mark. The Complainant has invested substantial sums of money in developing and marketing its products and services under the TEK mark in connection with its operations as one of the world's most well-known manufacturing test and measurement devices company. The TEK mark has been, and continues to be widely publicized through substantial advertising throughout the world, including in India. The Complainant is internationally renowned for its quality and standards in the manufacturing test and measurement devices. As a result, the general public has come to associate the TEK mark with goods and services of a high and uniform quality.

By virtue of the extensive and significant use worldwide including India, the reputation and goodwill earned by the Complainant, the TEK mark has attained the status of a "well-known trademark" (as defined under Section 2(1)(zg) of the Trade Marks Act, 1999) in India. The Complainant's TEK mark enjoys significant reputation, brand image and goodwill worldwide including in India.

The Complainant is also the registered owner of the TEK mark in India. The Complainant has been using the TEK mark not only as a trade mark and service mark, but also as its trade name. The Complainant accordingly registered the domain name <tek.com> on May 8, 1986 (about 35 years ago) and hosting its global website thereat since then. The said website is also accessible from India since last couple of decades. The Complainant also owns domain name registration for <tektronixindia.com> since August 22, 2018 and is hosting an India-specific website thereat since then. The Complainant recently became aware of the domain name www.tek.in registered in the name of the Respondent. The Registrant has redacted its details from the Whois records and thus, the Complainant approached the NIXI seeking details of the registrant of the disputed domain name.

GROUND OF CHALLENGE BY THE COMPLAINANT

The Complainant states that each of the grounds specified in the Policy for making the Complaint are applicable to the present Complaint for the reasons specified herein below:

I. The domain name <tek.in> is confusingly similar to the trademark 'TEK' and 'TEKTRONIX' in which the Complainant has rights

Complainant Contentions

The Complainant contends that the disputed domain name fully incorporates and is confusingly similar to the trademark TEK registered in favor of the Complainant. The disputed domain name is also deceptively confusingly similar to the trademark TEKTRONIX registered in favor of the Complainant. The disputed domain name <tek.in> is identical and/or confusingly similar to the Complainant's prior registered, used, and well-known trademark TEK

and TEKTRONIX as it incorporates and reproduces the Complainant's registered trademark "TEK" in its entirety and differs only in respect of addition of the country code Top Level Domain (ccTLD) extension ".in" which is insignificant. Due to overwhelmingly long, consistent, and extensive use, the Complaint has become known by the TEK mark. The Complainant has statutory as well as common law rights in the TEK mark and the disputed domain name is confusingly similar to the mark TEK as well as TEKTRONIX. The complainant has relied upon Society of St. Vincent de Paul, Council of the United States v. Alex Yip, D2004-0121 (WIPO May 25, 2004) wherein the panel held that "Complainant having been known by the acronym SVDP and having common law trademark rights in that acronym, this Panel finds that the disputed domain name which incorporates the acronym in its entirety and sequentially, is confusingly similar to the mark in which Complainant has rights". The Complainant extensively and prominently uses the mark TEK, as well as domain names incorporating the mark in disseminating, marketing, and advertising its goods/services. Further, considering the Complainant's rights in the domain names - particularly in <tek.com> - the disputed domain name viz. <tek.in> is identical and confusingly similar to the Complainant's mark. The Complaint has also relied upon ITC Limited v. Vishal, INDRP/050 (NIXI November 30, 2007) wherein the Panel held that "In the present case not only is the trademark entirely incorporated in the domain name, the second level domain name is identical to the Complainant's domain name in the dot com domain. Where the Respondent registers a domain name that is identical to the Complainant's domain name used for its official website in another domain it is held to be confusingly similar"). It is, therefore, to be concluded that the Complainant has rights in the mark TEK and TEKTRONIX, and the domain name <tek.in> is confusingly similar to the mark TEK and TEKTRONIX. Owing to the statutory rights, common law rights and the rights in the domain name <tek.com> and <tektronixindia.com>, it can safely be concluded that the Complainant has rights in the mark TEK and TEKTRONIX and the disputed domain name is confusingly and deceptively similar with the said marks. The 'WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition' clearly states: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case." Thus, as per WIPO jurisprudence, the Complainant in the instant case was not required to have a trademark registration in India, Turkey, or Australia.

Respondent's Contention

The respondent submits that at the time of registration, the Respondent could be aware of Trademarks in Australia (being Citizen) or Turkey (physical presence 2001-07) or given .IN extension, Indian Trademarks at the maximum. The Respondent further submits that the Complainant never had any Trademarks in Australia or Turkey but recently (2019) registered in India for 'TEK'. Other Indian mark 'Tektronix' is not contained within the domain name, hence not relevant. The Respondent contends that a domain registrant is not expected to have knowledge of Trademarks in other jurisdictions. Domain owner is subject to jurisdiction from where he operates and it is well established that the domain dispute policy does not require the Respondent to conduct trademark searches in every country of the world. The Respondent has relied on Freedom Card, Inc. v. Mr Taeho Kim, [WIPO-D2001-1320] ("no basis for inferring, that Respondent, in Korea, was aware, or should be deemed to have been aware, of Complainant or its U.S. trademark prior to the registration of the disputed domain") and John Fairfax Pub., Pty v. Domain Names 4U [WIPO-D2000-1403]. The Respondent further contends that it is axiomatic that Respondent could not have committed bad faith before Complainant acquired rights in mark in relevant jurisdictions. The Respondent further submits that the disputed domain was created on February 16, 2005 and that .IN domain names were launched on this day only. The Respondent further submits that it was a great opportunity to register generic domain names and relied on INDRP decision of Tickets.in wherein Respondent had registered hundreds of generic .IN domain names as an investment opportunity on February 16, 2005. The same were upheld as in good faith. The Respondent Mr. Joseph (alias 'Joe') Taheny was the original registrant of the Domain Name <TEK.IN> in 2005. The Respondent managed to register few other generic domain names on its launch day like Joe.in, Mantra.in, Edit.in, Siz.in and more. The Respondent became the recorded registrant on February 16, 2005 which is fourteen (14) years before the Complainant registered its trademark 'TEK' in relevant jurisdiction, and the 2005 date is sufficient to conclude there has been no bad faith registration. The Respondent further submits that the term TEK is a common 'Turkish' term (or short form or Domain Hack or an Acronym). The fact is that the Respondent registered <tek.in>, while he was in Turkey since 2001, solely because:

- Generic: It is a generic term in Turkish language to mean 'Single' or 'Only'.
- Domain Hack: The Respondent was also aware of one of the common first / last names in Turkey as 'Tekin' <tek.in>.
- Short Form: It indicates 'Technology' in Turkish, as in Turkish Language Technology is 'Teknoloji' and hence Tech becomes 'Tek'.

d. Acronym: It is also an acronym that can mean different things to different people - Türkiye Elektrik Kurumu (Turkish: Turkey Electricity Authority), Technology-Enabled Knowledge, Traffic Encryption Key and so on.

The Respondent contends that it is a well-settled law, that as long as the domain names have been registered because of their attraction as dictionary words, and not because of their value as trademarks, this is a business model that is permitted under the Policy. The Respondent has relied on *Gen. Mach. Prods. v. Prime Domains* (NAF-FA92531), *The Way International v. Diamond Peters* [WIPO-D2003-0264] wherein it was held "as to constructive knowledge, the Panel takes the view that there is no place for such a concept under the Policy... For that bad faith to be present, the Respondent must have actual knowledge of the existence of the trademark owner." The respondent has also relied on *Century 21 Real Estate LLC v. Century 21 Main Realty Pvt. Ltd.* [CS(OS) No. 1687/2007].

The Respondent further contends that not only did the Complainant not obtain any trademark rights until 2019 in relevant jurisdiction, but it didn't even adopt the Indian specific domain name TektronixIndia.com until 2018 and even does not own TekIndia.com (on sale). The Respondent further contends that "TEK" is neither distinctive nor has acquired secondary meaning: Complainant's mark TEK is neither a distinctive/coined term nor it has acquired Secondary Meaning / Well-known status. No evidence has been submitted by the Complainant to prove otherwise. The Respondent has relied on *Transportes AEROMAR v Aeromar* [WIPO-D2010-98] wherein it was held that if a Complainant fails to produce evidence of its reputation as it existed, the inference must be it had none! Further see decision in *INDRP/1195 - Enow.in*, the weaker the mark, the stronger should be evidence. The respondent has also relied on Hon'ble Delhi High Court in *Living Media India Limited vs Jitender V. Jain And Anr.*, 2002 held that the word "AAJ" and "TAK" are individually descriptive & dictionary words and may not be monopolised by any person and also on *Machani Infra Dev. Corp. (P) Ltd v. K. Anand*, WIPO-D2021-1352] where the Complainant claimed that it is a well-known Trademark but no evidence from any third party sources, which can prove that Complainant has acquired secondary meaning in the mark, within relevant jurisdictions.

II. The Respondent has no rights or legitimate interest in respect of the disputed domain name <tek.in>

Complainant Contention

The Complainant contends that the Respondent has no rights or legitimate interest in the disputed domain name. The Complainant has never assigned, licensed, or in any way authorized the Respondent to register or use its trademarks in any manner whatsoever. The Respondent does not have any rights or legitimate interest in respect of the disputed domain name. The Complainant has never authorized or licensed Respondent to use the TEK mark. The Complainant does not have any past dealings with the Respondent. The webpage hosted at the disputed domain name <tek.in> only informs that the said domain name is for sale and provides information related therewith. Thus, the Respondent has clearly seized on the unique name of Complainant's prominent business to trade off its goodwill and reputation to make unjust commercial gains. The webpage of the disputed domain name depicts no other activity. The Respondent is not commonly known by the domain name and has not acquired any trade/service mark rights to the knowledge of the Complainant. The Respondent is not making any legitimate non-commercial and fair use of the domain name. The Complainant has relied upon *Tata Motors Ltd. v. Mr. Baliram Devtwal*, INDRP/898 (NIXI June 15, 2017) wherein the Panel held that "the mere addition and difference in top level domain names of the words like '.in' does not differentiate the domain name from the registered trademarks or websites of the Complainant. The Respondent has not been using the registered domain name for any legitimate or charitable purpose. He is trying to earn unlawfully out of the registration of disputed domain name, by taking disadvantage of similarity of disputed domain name with the Complainant's name, fame, goodwill and global recognition.")

The Complainant further contends that the Respondent has no legitimate rights and interests in respect of the domain name <tek.in>. The Complainant further contends that the Complainant has made out a prima facie case and then the onus shifts on the Respondent to show its rights or legitimate interest in the disputed domain name. As per Para 6 of the INDRP Rules, a Registrant can establish its rights or legitimate interest in the disputed domain name by showing: "the Registrant's use of, or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services." The Registrant has failed to establish this. It has only stated that it wanted to develop this domain name but could not.

Further, <tek.in> is not a domain hack since TEK is a trademark owned by the Complainant. The Respondent has not filed any evidence to show its demonstrable preparation to use the disputed domain name as a domain

hack. In any case, if a domain hack infringes rights of the owner of the trademark, it does not give any legitimate right to the Respondent. The Complainant has relied on Instant Domain Search Inc. v. Mark Cambridge. INDRP/1268 wherein the Panel rejected the submission of the Respondent that the domain name <instantdoma.in> is a domain hack and directed transfer of the disputed domain name in favor of the Complainant). The Complainant contends that the Respondent contention "that he has invested in the domain name and it is permissible to invest in an intangible asset like a physical asset" is devoid of merits as the Respondent cannot invest in a domain name featuring the mark TEK when the Complainant had worldwide rights in the mark TEK/TEKTRONIX in 2005. The Complainant has trademark registrations in the US since 1973 (also in many other countries) and domain name registration for <tek.com> since 1986. The Complainant contends that the Respondent cannot block a country level domain name in 2005 by featuring a trademark in which the Complainant had statutory and common law rights.

Respondent Contention

The respondent contends that domain name registration pre-dates the Trademark in relevant jurisdiction by 14 years and has relied on Simon Zybek v. James Yarber, Blitzgolf [WIPO-D2021-1734] where it was laid down "Many decisions by earlier UDRP panels have consistently determined that, where the domain name in issue was acquired before a complainant's trade mark, no bad faith exists". The Respondent contends that "the Complainant states it was established in 1945 and separately states that it has been manufacturing products under the brand TEK but does not provide any specific evidence in support as to year since when used, in which jurisdictions and at what scale. In Fact, there's not even a single Annexure which reflects the brand TEK, except as a logo on the website. Further, Complainant claims to have been known as Tektronix (India) Pvt. Ltd. in India and having presence in different jurisdictions. But as to claims of having known as TEK since 1954, there is no evidence provided in support. Though the Complainant claims that it is well-known Trademark but no evidence from any third party sources to recognition made available, which can prove that Complainant has acquired secondary meaning in the term 'TEK', within relevant jurisdictions. It is impossible that the mark "TEK" can be regarded as a well known Trademark, when the same was registered in India in 2019 only. There is no Indian court judgment made available by the Complainant which refers to Complainant's trademark 'TEK' as a well known Trademark. In similar circumstances, in Machani Infra Development Corporation Private Limited v. K, Anand, WIPO-D2021-1352, wherein Machani Group claimed common law rights in the mark Machani since 1950s, but the Panel held the Complainant has not submitted any evidence from independent sources about the degree of actual public recognition of the designation MACHANI or consumer surveys that would establish that the public recognizes it as a symbol that distinguishes the Complainant's goods and services from those of others and that it has acquired a secondary meaning exclusively referring to the Complainant. Not only did the Complainant not obtain any trademark rights until 2019 in relevant jurisdiction, but it didn't even adopt the Indian specific domain name TektronixIndia.com until 2018 i.e. thirteen (13) years after the Domain Name registration. It is evident, now they are trying to mark their presence in India, hence these INDRP proceedings to hijack the disputed domain for free. The Respondent has also relied on Machani Infra Development Corporation Private Limited v. K, Anand, WIPO-D2021-1352, wherein Machani Group claimed common law rights in the mark Machani since 1950s, but the Panel held "the Complainant has not submitted any evidence from independent sources about the degree of actual public recognition of the designation MACHANI or consumer surveys that would establish that the public recognizes it as a symbol that distinguishes the Complainant's goods and services from those of others and that it has acquired a secondary meaning exclusively referring to the Complainant". The evidence only suggests that they may have been using Tektronix mark since initially and the mark TEK has been registered as Trademark in different jurisdictions, which does not include Australia at all and in India registered only since 2019. 'TEK' is generic word having a dictionary meaning or otherwise a domain hack and also used widely by numerous businesses globally as a brandable term. By virtue of the word 'TEK' being generic in nature, it is non-distinctive and thus the rights to use or own the word 'TEK' can not exist with one single entity or individual. 'TEK' was never registered in Australia or Turkey (during 2001-07) and applied in India in 2019 only, while the Respondent has registered the domain name since 2005, therefore, a prior user. In light of the above, the Respondent further contends that the Complainant does not have exclusive rights over the word 'TEK'. The system of domain name registration is, in general terms, a "first come, first served system" and, absent pre-existing rights which may be applicable to impugn a registration, the first person in time to register a domain name would normally be entitled to use the domain name for any legitimate purpose it wishes." Where a Respondent registers a domain name consisting of a dictionary term because the Respondent has a good faith belief that the domain name's value derives from its generic or descriptive qualities rather than its specific trademark value, the use of the domain name consistent with such good faith belief would establish a legitimate interest. The Respondent has also relied on H allmark Licensing v. Privacy Administrator

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interests in the domain name because it corresponds to a well-known descriptive dictionary word.

The respondent further contends that the 'Tek' in addition to being a word in Turkish dictionary, is used as a brandable word by numerous organizations. Organizations like Johnson & Johnson own Trademark in India since 1943 for toothbrushes. The Respondent also provides google search results from Australia and more websites using 'Tek' in their name. And also Otherwise, there are over 300 domain names registered in different extensions with the sole word 'Tek'. But still the Complainant is pretending that it coined the term TEK and that it is the only one on earth that is entitled to use it. This is remarkably self-serving and fanciful conjecture [INDRP/957; apanaghar.in].

The Respondent further submits that the Respondent understands that this can give legitimate interests, as quoted in TikTok.in [INDRP/1228], and also the same has been upheld in Tickets.in [INDRP/1187]. The Respondent contends that he has developed sites like NewLira.com, Taheny.com, Joe.in, Mantra.in and so on and the Respondent's intention has been development as well but he has complete right to put the undeveloped domain names on sale. Last year he successfully sold www.edit.in. The Respondent also relied on a list of UDRP decisions, wherein complaints have been denied even when the generic domains have been on sale. Fresenius Kabi v. Domain Manager [WIPO-D2018-0491] and Deep Focus v. Abstract Holdings International [WIPO-D2018-0518].



III. The domain name <tek.in> was registered or is being used in bad faith

Complainant Contentions

Bad faith is implicit in the registration of the disputed domain name. The Respondent registered the disputed domain name in issue on February 16, 2005, by which time the Complainant had been trading under the TEK mark (ii) mark for more than 50 years. In view of (i) Complainant's statutory and common law rights in the TEK mark (ii) the use of the mark by the Complainant for several years prior to Respondent's registration of the disputed domain name, (iii) Complainant's prior use of the TEK mark on the Internet, in other domain names and as a trade name, (iv) the tremendous fame, goodwill, and reputation associated with this mark, and (v) the content of the Respondent's website, it is impossible to conceive of any circumstance in which Respondent could have registered the disputed domain name in good faith or without knowledge of the Complainant's rights in the mark TEK. The Panel can infer Respondent's knowledge of Complainant's rights in the TEK mark based on its widespread registration and use of these marks existing at the time when Respondent registered the disputed domain name. *The Complainant has relied on Unisys Corp. v. Unisys Consulting, LLC*, D2004-0138 (WIPO April 15, 2004) (finding that the respondent had knowledge of the complainant's mark in consideration of the wide recognition of the complainant's mark, as well as the complainant's registration and use of its mark). The Respondent has offered the disputed domain name for sale at US\$ 10,000 on the webpage hosted thereat which conclusively establishes the bad faith. The base price quoted by the Respondent is sufficient to establish that the Respondent has registered the disputed domain name to obtain profit from the Complainant, which is in excess of out-of-pocket costs. The Complainant has also relied on *Elite Model Management Corporation v. Wesley Perkins*, D2006-0297 (WIPO May 15, 2006) wherein panel held that the offer for sale of the domain names in dispute domain show that Respondent registered the domain names in dispute for the purpose of renting, sharing or selling the domain name registrations to a competitor of Complainant for valuable consideration in excess of Respondents documented out-of-pocket cash related to the acquisition of the domain name in dispute."). The Policy has used the word "or" and thus, the Complainant is required to only show either of the two i.e. bad faith use or bad faith registration. The fact that the Respondent is offering the disputed domain name for sale at an exorbitant price of US\$ 10,000, conclusively establishes that the disputed domain name was registered in bad faith. It is evident that the Registrant has not used the disputed domain name in last 15 years except for offering the domain name for sale. Thus, the only purpose of registering the disputed domain name is to sell the domain name at a higher price. The domain name will certainly be purchased by only someone who already has rights in the mark TEK or a competitor of the Complainant. Such registration and use of the domain name have been held to be in bad faith. The Complainant has relied on *Groupe Auchan v. Bui Tan Dat / Domain ID Shield Service Co., Limited*, D2014-1935 (WIPO January 4, 2015). The Complainant further submitted that registering a domain name solely for the purpose of selling is against the NIXI policy as per their advisory (refer <https://www.registry.in/registry-advisory-la01sales-of-in-names-by-registrars>). Respondents' contentions that TEK is a generic term, domain hack or Acronym are devoid of any merits.

Respondent Contention

The Respondent understands that it is not bad faith to put a domain name for sale. Last year he successfully sold www.edit.in. The Respondent's main intention has been development but he puts the undeveloped domain names on sale. The Respondent lists UDRP decisions, where the complaints have been denied even when the generic domain names have been on sale. 'The purpose' is quite important to note that reads "you have registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise". But here the Respondent had registered the domain name due to generic nature while he was residing in Turkey due to the reasons provided above, while he never had heard about the Complainant previously

Findings and Discussion

The fact, which is to be dealt with before going in merits, is whether, the cases decided by WIPO Administrative Panel could be considered while deciding present case. Moreover these cases throw light upon various important aspects of controversy. As such they would be considered while deciding the present case in so far as they do not conflict with INDRP.

A. The disputed domain name is identical or confusingly similar.

The respondent submission that TEK is a generic, domain hack, short form or acronym appears to be after

thought because by 2005, TEK/TEKTRONIX trademarks were well established and the Complainant was operating in many countries of the world and had registered trademarks TEK/TEKTRONIX in many countries. The TEK is not generic otherwise it would not have been registered in many countries including India. Accordingly, it is evident that TEK is a descriptive term. The Respondent has also accepted that TEK is a brandable term. The respondent was expected to have performed due diligence to ensure the domain name registered does not infringe the rights of third party.

Based on the evidence presented before me, it is clear that the Complainant has acquired rights in TEK/TEKTRONIX as same is evident from its registration in various countries. The Complainant is consistently using said trademarks as well as prior registered domain <TEK.COM> (registered in 1986). Complainant has acquired common law rights that needs to be recognized and protected under these proceedings.

I, therefore, conclude that disputed domain <TEK.IN> is identical to trademark TEK and entirely included in <TEK.COM> except top level domain extension and confusingly similar to trademark TEKTRONIX of the Complainant as all three letters of disputed domain name are contained sequentially in the mark.

B. The Respondent has no right or legitimate interest.

Based on the submission of both the parties I am of the view that the Complainant has not given any license or authorization to the Respondent to use the domain name <tek.in> or use the mark TEK in any manner. The Complainant has made out a prima facie case and then the onus shifts on the Respondent to show its rights or legitimate interest in the disputed domain name. As per Para 6 of the INDRP Rules, a Registrant can establish its rights or legitimate interest in the disputed domain name by showing:

- (i) the Registrant's use of, or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.
- (ii) the Registrant (as an individual, business, or other organization) has been commonly known by the domain name.
- (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..

I am of the view that The TEK is not a generic term and it is not a dictionary word as the complainant has got these marks registered in many countries. Further, <tek.in> is not a domain hack since TEK is a trademark owned by the Complainant. The Respondent has not filed any evidence to show its demonstrable preparation to use the disputed domain name. Even if a domain hack infringes rights of the owner of the trademark, it does not give any legitimate right to the Respondent. I am of the opinion that the Respondent contention that he got the disputed domain because it was generic or domain hack or acronym is devoid of merit. The Respondent has not submitted any evidence to develop the domain for bona fide use. Further the Respondent has put the domain on sale for US \$10000.

For these reasons, it is held that the Complainant has proved that the respondent does not have any rights or legitimate interests and is infringing the trademark of the complainant in the disputed domain name.

C. The domain was registered in bad faith.

Based on the submission of both parties, I am of the view that INDRP paragraph 4(iii) requires that disputed domain name has been registered or being used in bad faith and the Complainant is required to prove one of these two conditions. Paragraph 6 of the INDRP provides that the circumstances which, if found to present, deemed to be evidence that a Respondent has registered and used a domain name in bad faith. The Policy Para 6(a) states that

"Circumstances indicating that the Respondent 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 is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or "

The Respondent has put on sale the disputed domain name for US \$ 10000 which is sufficient to establish bad

faith. The Respondent has not submitted any evidence to establish that he made efforts to develop the disputed domain even after 15 years of registering it in 2005. Further the Respondent has put the domain on sale at a price of US \$10000. The disputed domain will certainly be purchased by one who has rights in the marks or the competitor of the Complainant. The registration of a domain name solely for the purpose of selling is against the INDRP.

From the circumstances of the case and from the evidences put before me, registration of disputed domain <TEK.IN> by the Respondent is very much in bad faith.

DECISION/ AWARD

Based on the submissions by both parties and perusal of brief summaries of both parties, I am of the view that the Complainant's trademarks falls in category of 'well known' trademark. However, as an abundant caution, the complainant has also registered the trademark in many counties including India. Test of prudence demands fairness of action by the Respondent.


On the other hand, so far as the Respondent has failed to provide any documentary evidence to justify that he intended to develop the disputed domain. He should have done due diligence before registration of domain. The Respondent has not been consistent in his submission about trademark TEK about his position in order to rebut the contention of the Complainant. The suggestion to the fact the particular trademark is not well known does not give an opportunity to the Respondent to use two (2) marks of the complainant while registering in India as domain name. The registration of the domain name in no probability gives an impression that the domain name does not belong to the Complainant. In view of the above read with all the facts of the present case, the Complainant's contentions are tenable.

In accordance with the Policy and Rules, I direct that the disputed Domain Name be transferred to the Complainant with a request to NIXI to monitor the transfer.

This award is being passed within the statutory deadline of 60 days from the date of commencement of arbitration proceedings.

No order as to costs.

Dated 21-9-2021


SUDHIR KUMAR SENGAR 21/9/21
SOLE ARBITRATOR