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Purchased by	PUNITA BHARGAVA
Description of Document	Article 12 Award
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Consideration Price (Rs.)	
First Party	PUNITA BHARGAVA
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**BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA  
.IN REGISTRY**

Arbitral Award in Case No. 1524  
Ms. Punita Bhargava, Sole Arbitrator  
Disputed domain name: <cgi.in>

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**In the matter of**

CGI Inc.

135 René-Lévesque Boulevard West

Montreal, Quebec

Canada H3G 1T4

... Complainant

v.

Jitendra Jain

Shop No 6, Acharya Smriti

Opp Adarsh Lodge

Near Basant Cinema

Chembur, Mumbai

Maharashtra – 400074

... Respondent

**1. The Parties**

The Complainant in this proceeding is CGI, Inc. of 135 René-Lévesque Boulevard West, Montreal, Quebec, Canada H3G 1T4 and also 1130 Sherbrooke Street West, 5th Floor, Montreal, Quebec H3A 2M8, Canada. Its representative is Ms. Madhu Rewari of M/s Anand & Anand of First Channel, Plot No.17A, Sector 16A, Film City, Noida, India.

The Respondent in this proceeding is Mr. Jitendra Jain of Shop No 6, Acharya Smriti, Opposite Adarsh Lodge, Near Basant Cinema, Chembur, Mumbai, Maharashtra 400074. His representative is Mr. Ankur Raheja Advocate of Cylaw Solutions of 805, Kaveri Kaustubh I, Bain Bazar, Sikandra Agra, 282007, India.

**2. Disputed Domain Name and Registrar**

This dispute concerns the domain name <cgi.in> (the 'disputed domain name') registered on February 16, 2005. The Registrar with which it is registered is Dynadot LLC of 210 S Eliworth Ave # 345 San Mateo, California 94401 United States of America.

**3. Procedural History**

This proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (Policy/INDRP), adopted by the National Internet Exchange of India (NIXI).

By its email of March 23, 2022, NIXI requested availability of Ms. Punita Bhargava to act as the Sole Arbitrator in the matter. The Arbitrator indicated her availability and timely submitted the Statement of Acceptance and Declaration of Impartiality and

Independence in compliance with the INDRP Rules of Procedure (Rules). In accordance with the Rules, by email of March 23, 2022, NIXI appointed the Arbitrator and also notified the Respondent of the Complaint.

As the Arbitral Tribunal is properly constituted, the Arbitrator sent an email to the Respondent on March 24, 2022 informing him of the commencement of the proceeding and providing him time till April 10, 2022 to file his Reply.

On April 8, 2022, the Respondent notified the Arbitrator of the appointment of Mr. Ankur Raheja, Advocate as his representative in the matter and provided the Arbitrator with authorization dated April 4, 2022 in favour of Mr. Raheja. Mr. Raheja sent a communication to the Arbitrator that since April 10, 2022 falls on Sunday, time to file Reply may be extended to Monday, April 11, 2022. This was granted by the Arbitrator by email of April 10, 2022. On April 11, 2022, the Respondent's Reply along with Annexures were submitted by email.

On receipt of the same, the Arbitrator asked the Complainant, through counsel Ms. Rewari, to file its rejoinder by April 22, 2022.

On April 12, 2022, Ms. Rewari asked the Arbitrator for 30 days to file Rejoinder. By email of same date, the Arbitrator repeated the date of April 22, 2022 for filing of Rejoinder, informing Counsel that the proceeding had to be concluded within a defined period.

Meanwhile, Mr. Raheja intimated all parties that the website [www.registry.in](http://www.registry.in) had changed and the links to INDRP decisions relied upon in the Reply were not resolving to the decisions anymore, though these were when the said Reply was filed. He also stated that he had contacted NIXI in this regard and was informed that the links will be made available in the next few days.

Ms. Rewari then wrote to the Arbitrator that as the website [www.registry.in](http://www.registry.in) is not operational, the Complainant is unable to access the links to the INDRP decisions relied upon by the Respondent and also the older INDRP orders and again asked for 30 days' time to file Rejoinder.

Taking note of the lack of availability of INDRP decisions on the website [www.registry.in](http://www.registry.in), the Arbitrator by email of April 13, 2022 asked counsels to share copies of the INDRP decisions relied upon by them in their respective pleadings and stated that thereafter, suitable additional time will be granted to the Complainant for filing Rejoinder.

On April 13, 2022, Mr. Raheja shared a link to access the 7 INDRP awards relied upon in the Reply.

The Arbitrator then wrote to Ms. Rewari on April 14, 2022 asking her to file Rejoinder latest by April 30, 2022, informing her that time is enlarged in view of intervening holidays that week.

By email of April 14, 2022, Ms. Rewari shared a link to the INDRP decisions referred to in the Complaint filed on March 17, 2022. She also stated that the website www.registry.in was not operational and until such time the site became operational, the Complainant cannot research case law and previous INDRP orders and appropriately respond to the claims of the Respondent. She asked for at least 30 days' time from when the www.registry.in website becomes operational to file the Rejoinder.

On April 20, 2022, Ms. Rewari updated the Arbitrator and others that the www.registry.in website was still not operational and repeated her request for at least 30 days' time from accessibility of the same to file Rejoinder.

The Arbitrator by email of April 20, 2022 asked Ms. Rewari if NIXI had indicated when INDRP decisions will be reinstated. In reply, counsel stated that she will check with NIXI and revert. On April 26, 2022, Ms. Rewari informed the Arbitrator and others that she had emailed NIXI on the issue but had not received any response until then. She also repeated her request for at least 30 days' time to file Rejoinder from when NIXI website became operational.

Appreciating that the Complainant wanted to rely on INDRP decisions in the Rejoinder and the right to rely on precedent could not be denied to any party, on April 28, 2022, the Arbitrator wrote to all concerned, including NIXI, that the issue/matter cannot not be kept open-ended. She asked NIXI to intimate either that the INDRP decisions are reinstated (and where) or that these are not going to be reinstated. The Complainant was granted 15 days from the date of NIXI's communication to file its Rejoinder. The Arbitrator also stated that in view of the exceptional circumstances of the sudden lack of INDRP decisions, the timeline of these proceedings would be extended.

By email of even date, Mr. Raheja updated the parties of an older link of NIXI to access INDRP decisions and stated that the time granted to file Rejoinder should be 7 days. He also stated that in case the Complainant brings in any new facts and events, then Respondent should be given an opportunity to file further response.

In response to this, Ms. Rewari emailed that NIXI had been asked to provide its formal communication on reinstatement of INDRP decisions and that Complainant would have 15 days from the date of NIXI's reply to file Rejoinder. She further said that since she is travelling for the INTA conference to Washington DC it will be difficult to file Rejoinder in such a short period of time. In addition, she stated that Complainant cannot reasonably be expected to rely on "temporary link" whose authenticity cannot be verified and enclosed Whois extracts to show that the domain names/links are not owned by NIXI.

Mr. Raheja then clarified that the older link to INDRP decisions shared by him is official. He stated that NIXI's older website was active till week ending April 10, 2022 and alleged that the Complainant was looking to delay the matter. He requested that the proceeding continue without delay.

The Arbitrator reviewed the INDRP decisions through the 'older link' provided by Mr. Raheja and found them to be in order. In any case, since the veracity of the INDRP decisions accessible through this older link was not in question, the Arbitrator wrote to the Complainant's counsel and other parties on April 29, 2022 that having reviewed the INDRP decisions through the older link, it was irrelevant where these were available and if Complainant relied on any of these, the Arbitrator would take them into consideration. The Arbitrator then informed Complainant's counsel that there is no real reason, including any travel plans, for the Rejoinder not to be timely filed. The Complainant was given time till May 11, 2022 to file the Rejoinder. It was also pointed out that this would be 30 days from the time the Respondent's Reply was received by the Complainant on April 11, 2022.

On May 11, 2022, the Rejoinder was submitted on the Complainant's behalf and a link to access the exhibits was provided. The Complainant reserved rights to file additional documents once [www.registry.in](http://www.registry.in) website was fully operational and also to file additional documents in rebuttal if the Respondent was allowed to file Rejoinder or any other documents.

Mr. Raheja, on May 12, 2022, objected to the Rejoinder as filed, specially to the excess words (18000 and above the 5000 words limit under INDRP) in the Rejoinder and excess annexures (in hundreds). He also objected to the Complainant filing new evidence at the stage of Rejoinder. He also questioned the authority of the Complainant's representative to act in the matter saying that he could not find any authorization in her favour. The Arbitrator acknowledged this communication, noting comments of the Respondent.

On May 16, 2022 disputing the allegations made by the Respondent and, inter alia,

stating that no new evidence had been relied upon, Ms. Rewari filed a general POA under the Trade Marks Act, 1999 from the Complainant in favour of her firm and stated that a fresh POA would be submitted if so directed.

The Arbitrator asked Ms. Rewari on May 17, 2022 to submit the POA under INDRP. For some reason, this email marked to the ids of NIXI officials at [legal@nixi.in](mailto:legal@nixi.in) and [rajic@nixi.in](mailto:rajic@nixi.in) bounced back.

On May 17, 2022, Mr. Raheja sent a lengthy mail to the Arbitrator pointing to procedural violations of INDRP and Rules by the Complainant regarding POA, word count, annexures and objecting to the Rejoinder on merits. He also alleged the Respondent is being harassed with personal visits and phone calls to his Mumbai office and attached call recordings received from the number 08108069466 wherein the caller wanted to buy "computer generated imagery". The Counsel also clarified that the caller was made aware that his call is being recorded. Lastly, an opportunity was sought to file brief written arguments.

The Arbitrator by email of May 23, 2022 informed Mr. Raheja that his detailed comments/objections had been noted, in view of which no further written arguments were called for.

On May 24, 2022, Ms. Rewari provided the Arbitrator with POA from the Complainant with an execution date of May 20, 2022. On the same date, Mr. Raheja requested the Arbitrator for an oral hearing (virtual) stating that only a limited response had been filed and that there was no clarity on whether or not the Rejoinder had been taken on record.

On May 25, 2022, the Arbitrator informed Mr. Raheja that the Rejoinder will be taken on record and a hearing was not necessary for deciding the Complaint. It was also clarified that no further communication from either party will be taken into consideration.

Meanwhile, no communication was received from NIXI with regard to the INDRP decisions.

#### 4. The Complaint

##### Complainant and its rights as submitted by it

The Complainant is a Canadian Corporation with office address at 1130 Sherbrooke Street West, 5th Floor, Montreal, Quebec H3A 2M8, Canada. It is also at 135 René-Lévesque Boulevard West, Montreal, Quebec, Canada H3G 1T4.



The Complaint is based on the trade name, company name, trademark, and service mark CGI and its formatives. The Complainant states that it has filed applications to register/has secured registrations for the trade mark CGI and its formatives in, inter alia, India, Canada, European Union, Malaysia, and the United States of America. Details of its India and USA registrations are as under:

Indian Trade Mark: CGI

Registration No.: 2477470

Filing Date: 13/02/2013

User Detail: 11/10/2001

Goods and Services

Class 9 - computer software; computer software for office administration, business administration and management, electronic data processing, reporting, business intelligence, database management, customer relationship management, customer care and billing, enterprise content management, document management, data storage and retrieval of business information and business data, systems management, workflow automation, security, information technology, networks and telecommunications; user manuals packaged as a unit with the foregoing goods; downloadable electronic publications in the nature of computer software user manuals.

Class - 35 - business management, business administration, office functions, business consultancy; consulting services in the field of office administration, business administration and management, electronic data processing, reporting, business intelligence, database management, customer relationship management, customer care and billing, enterprise content management, document management, data storage and retrieval of business information and business data, systems management, workflow automation, security, information technology, networks and telecommunications; facilities management; systems integration services; information technology and systems outsourcing services for others; business process outsourcing services for others; business process reengineering; change management services; call center management services; billing services; invoice management; payroll processing services.

Class 36 - Financial affairs; insurance services; financial consulting services; financial management.

Class 42 - Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; consulting services in the field of information technology; information technology management services; consulting services in the field of computer-based information systems for businesses; information technology systems integration services; technical support services, namely, troubleshooting of computer hardware and software problems; computer software project management

service; cloud computing; data center management; managed security services, infrastructure services, enterprise storage services, printing and document management; creating, hosting and maintaining websites for others; providing temporary use of on-line non-downloadable software for office administration, business administration and management, electronic data processing, reporting, business intelligence, database management, customer relationship management, customer care and billing, enterprise content management, document management, data storage and retrieval of business information and business data, systems management, workflow automation, security, information technology, networks and telecommunications; software-as-a-service (SaaS), managed service provider (MSP) and application service provider (ASP) featuring software for use in office administration, business administration and management, electronic data processing, reporting, business intelligence, database management, customer relationship management, customer care and billing, enterprise content management, document management, data storage and retrieval of business information and business data, systems management, workflow automation, security, information technology, networks and telecommunications.

US Trade Mark: CGI

Serial Number: 77401091

Registration Number: 3539769

Filing Date: 20/02/2008

Registration Date: 02/12/2008

Goods and Services

Class 9 - computer software for use in customer relationship management; computer programs for document management; computer software to monitor and analyze customer information related to credit risk, account transactions, payment history, buying decisions, and customer behavior and characteristics, for use in the fields of financial services, telecommunications, government and healthcare; computer software for calculating, auditing, and administering commissions based on sales volume and customer account data; computer software for managing accounting and financial data, for managing data relating to funds, payments, costs and accounts receivable, and for preparing financial reports; computer software for use primarily by government human service agencies to manage, gather and report data relating to field visits, to record and transmit digital images, signatures and geographic data, to obtain maps and driving directions and to track the locations of caseworkers; downloadable electronic publications in the nature of computer software user manuals; downloadable electronic publications in the nature of articles and reports for use in the fields of financial services, logistics, health care, manufacturing, energy, retailing, telecommunications and public utilities; computer software for investment asset allocation and portfolio optimization; computer software for use by members of



the financial services industry to initiate, process and report financial transactions; computer software for financial calculation; computer software for use in the field of business and financial services, namely, software for preparing and evaluating credit and loan applications, for obtaining pertinent data relating to such credit and loan applications from a variety of sources, and for identifying categories of credit, loan or other financial services which may be suitable for the person or organization seeking the credit or loan; computer software for investment portfolio management, and for data analysis and reporting, used in the field of financial services; computer software for use by healthcare providers to manage patient records and to generate correspondence, invoices and reports; computer software for use by human resource departments to manage employee records and to generate correspondence and reports; computer gateway software for use in the field of telecommunications; computer software for processing billing and orders for goods and services; computer software for use primarily by government human service agencies to manage, gather and report data relating to field visits, to record and transmit digital images, signatures and geographic data, to obtain maps and driving directions and to track the locations of caseworkers; computer software for mobile workforce management, namely, software for communicating with field personnel, and for managing and reporting data on employee locations, schedules and tasks; computer software for use by electric utilities to control power distribution and manage restoration of power after outages; computer software for use in the oil and gas industry to capture and report field data

Class 35 - business administration and management; business records management; business risk management consultation; human resources management; business services, namely, analyzing procurement expenses and practices for governmental agencies; procurement, namely, purchasing goods and services on behalf of others, namely, purchasing apparel, office equipment and supplies, paper, computer hardware and peripherals, computer software, furniture, [medical equipment and supplies] vehicles, laboratory equipment and supplies, lighting fixtures and supplies, mail room equipment, materials used in construction and road repairs, transportation services, lodging services, mailing services, preparing and serving foods, printing, document storage, health care, information technology consulting, maintenance of computers and software, telecommunications and temporary employment.

Class 41 - Training services in the fields of computer software, information technology and business management

Class 42 - Technical support services, namely, troubleshooting of computer hardware and software problems; computer services, namely, hosting and maintaining a web site for others to exchange information about computer software use; Installation and maintenance of computer software; updating of computer software for others; computer project management services; creating and maintaining web sites for others.

It states that the registration certificate pertaining to this US registration No. 3539769

records the first use in commerce of the CGI mark as 1980 or 1998 - depending on the concerned goods/services.

The Complainant has also filed list of registrations for the CGI mark and its formatives worldwide including India along with copies of sample registration certificates and/or extracts from the relevant databases as Annexure B.

The Complainant states that it was founded in 1976 and is headquartered in Montréal, Canada. It is among the largest information technology (IT) and business consulting services firms in the world. It delivers a full range of services, including strategic IT and business consulting, systems integration, intellectual property and managed IT and business process services to help clients accelerate digitization, achieve immediate cost savings, and drive revenue growth. As of November 2021, the Complainant, under the trademark and trading style CGI, employs approximately 80,000 consultants and professionals worldwide. In India, the Complainant employs more than 17,000 consultants in Bangalore, Chennai, Hyderabad, Mumbai, and Pune who provide global delivery support to clients around the globe.

The Complainant, under the trademark and trading style CGI, delivers end-to-end services that cover the full spectrum of technology delivery, from digital strategy and architecture to solution design, development, integration, implementation and operations. Since 1976, it is a trusted partner in delivering innovative, client inspired business services and solutions. The Complainant helps to develop, innovate, and protect the technology that enables its clients to achieve their digital transformation goals faster, with reduced risk and enduring results. For years ending September 30, 2018, September 30, 2019, September 30, 2020, and September 30, 2021, the Complainant's revenues were CAD 11,506.8, 12,111.2, 12,164.1 and 12,126.8 million, respectively. These are stated to be attributable to the enormous goodwill and reputation in the trademark and trading style CGI. It has filed as Annexure C extracts from its website and 2020 and 2021 Fiscal Results in support of its claims.

It has filed as Annexure D extracts from its 1997 Annual Report showing use of the CGI mark and its formatives at that time; the Complainant states that this document shows that the trademark and trading style CGI has been an essential part of the Complainant's business identity since many years, so much so that any use thereof, whether in India or elsewhere, is only associated with the Complainant.

The Complainant states that it is popular amongst the public through its active presence on social media handles such as LinkedIn, Twitter, YouTube, and Facebook. These social media handles depict the CGI mark and have vast following/subscribers which, in itself, is proof of the popularity of the Complainant and resultantly its

trademark and trading style CGI. The said handles have been well received by the general public and have assisted in registering the Complainant's CGI brand in the minds of public. It has filed extracts from its social media handles as Annexure E.

The Complainant states that it conducts operations through its globally accessible website <https://www.cgi.com/en> and the corresponding domain <cgi.com> was registered on January 19, 1987. It also has an India-specific website located at <https://www.cgi.com/india/en>, has an Indian subsidiary named CGI Information Systems and Management Consultants Private Limited, has offices in 5 cities in India (Bangalore, Pune, Mumbai, Chennai, and Hyderabad) and conducts business in India since at least 2001. It has filed extracts from its website, 2001 and 2021 Annual Reports, list of CGI-formative domain names such as <cgi-india.com> owned by it and extract from the online database of the Registrar of Companies as Annexure F.

The Complainant states that it has used the CGI mark and its formatives on and in relation to various goods and services, as part of its company names such as CGI Inc., and the domain name cgi.com or many years. It has filed as Annexure G search results for CGI done through [www.google.com](http://www.google.com) and [www.google.co.in](http://www.google.co.in) and states that this displays results only pertaining to it.

The Complainant states it has been the recipient of several awards and accolades over the years adding to the popularity of its business under CGI, including the following:

- received the Gold honor in recognition of its "Best Remote Working Practices to manage delivery and operations effectively" in the wake of COVID-19 from the Confederation of Indian Industry (CII) National Excellence Competition 2020;
- included among the 2018 Thomson Reuters Top 100 Global Tech Leaders, which identifies tech industry's leaders that are excelling in an era of innovation;
- featured in the Forbes World's Best Employers 2020 (Oct 2020);
- held to be the Human Rights Campaign Corporate Equity Index - Best Place to Work for LGBTQ Equality;
- included in the Dow Jones Sustainability Indices for the 9th consecutive year (2019);
- ranks 19th among the Top 25 Enterprise Companies in FinTech (2018);
- recognized as Great Place to Work – Certified™ in India by the Great Place to Work® Institute.

It has filed list of these awards, achievements, and certifications from its website as Annexure H and states that these achievements have only enhanced the preexisting popularity of the trademark and trading style CGI.

The Complainant finally states that it has spent substantial time, effort, and money

advertising and promoting the CGI Marks and Names throughout the world. As a result, the CGI Marks and Names have become famous, and the Complainant has developed enormous reputation and goodwill in the same, such that they are exclusively associated with the Complainant.

Statements in the Complaint regarding the disputed domain name and the Respondent

The Complainant states that as per the details provided to it by NIXI on March 14, 2022 (filed as Annexure A), the Respondent is based in Mumbai, Maharashtra.

As of November 2021, the disputed domain name redirected to an active website <https://atools.me/> purportedly operated by Atools Solutions FZ-LLC based in the United Arab Emirates. The website stated, inter alia, that "Atools is an IT Solutions and Digital Marketing Agency in UAE. We make it our business how you connect with people and our rewards are projects that reward our clients. Atools IT Solutions is all about empowering brands to connect, engage and build sustained relationships with their consumers online. Leveraging web-based technologies we serve up digital solutions for the companies."

However, at the time of filing of the Complaint, the disputed domain name did not resolve to any active website. Documents in support are filed as Annexure I. The Complainant states that even if the disputed domain name does not resolve to any active website, given the Respondent's previous conduct, there exists a looming threat of the Respondent resorting to unlawful activities through the disputed domain name.

The Complainant states that the Respondent has registered the disputed domain name by misappropriating, illegally and without authority, the CGI Marks and Names which are the exclusive property of the Complainant. Post registration, the Respondent appears to have, in the past, licensed or otherwise allowed use of the disputed domain name by Atools Solutions FZ-LLC in respect of the same/similar good and services. The Complainant states that the disputed domain name is being used to capitalize on its enormous reputation and goodwill in its CGI Marks and Names, the essential element of which is the term CGI, which has been incorporated into the disputed domain name registered by the Respondent.

The Complainant states that the Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users seeking the Complainant's products and services, to a competitor's website located at <https://atools.me/> offering the same/similar goods and services. This leaves no doubt that the Respondent has used the disputed domain name to mislead viewers and consumers looking for the Complainant's goods and services by redirecting them to the website of a competitor.



### Grounds of Complaint

#### (i) Identical or deceptively similar

The Complainant states that the disputed domain name <cgi.in> fully incorporates the essential element CGI of the Complainant's CGI Marks and Name in entirety and is thus confusingly similar as a whole to the Complainant's domain name cgi.com and the corresponding website <https://www.cgi.com/en>. WIPO panelists have, over the years, arrived at a consensus that if a complainant owns a trade mark registration, then it generally satisfies the threshold requirement of trade mark rights.

The replacement of the top-level domain name ".com" with ".in" makes no difference since the Respondent's website is likely to be perceived as an India-specific website belonging to the Complainant. .IN is a country code and non-distinctive. It is an essential part of every domain name. Thus, the .IN part of the disputed domain name does nothing to distinguish it from the Complainant's CGI Marks and Name, and in particular, the Complainant's registered domain name cgi.com. It has relied on *Accenture Global Services Private Limited vs. Sachin Pandey, INDRP/828*.

It has also relied on *Dell Inc. vs. George Dell and Dell Net Solutions, Case No. D2004-0512*, where it was held that "It is well established that the addition of a generic term to a trade mark does not necessarily eliminate likelihood of confusion." The Complainant states that there are numerous decisions holding a domain name to be confusingly similar to a registered trade mark when it consists of the mark plus one or more generic terms, such as the top level domain name .in. It cites *Space Imaging LLC v. Brownell, AF-0298 (eResolution Sept. 22, 2000)* which finds confusing similarity in an instance where the Respondent's domain name combines the Complainant's mark with a generic term which is obviously affiliated to the Complainant's business. The Complainant also places reliance on *Minnesota Mining and Manufacturing Company vs. Mark Overbey, WIPO Case No. D2001-0727*; *SBC Communications Inc. vs. Fred Bell a/k/a Bell Internet, WIPO Case No. D2001-0602*; *Wal-Mart Stores Inc. vs. MacLeaod b/d/a For Sale, WIPO Case No. D2000-0662*. It relies on *Busy Body, Inc. vs. Fitness Outlet Inc., D2000-0127*, where it was held that "the addition of the generic top-level domain (gTLD) name ".com" is likewise without legal significance since use of a gTLD is required of domain name registrants. ".com" is only one of several such gTLDs, and ".com" does not serve to identify a specific service provider as a source of goods and services".

The Complainant thus states that the disputed domain name is identical or confusingly similar to the Complainant's CGI Marks and Names.



(ii) No rights or legitimate interest

The Complainant repeats that the disputed domain name fully incorporates the registered mark CGI and the essential element CGI of the Complainant's CGI Marks and Names in entirety and is confusingly similar as a whole to the Complainant's domain name cgi.com and its trademark and trading style. It then states that the Respondent has no relationship with the Complainant. Nor has the Complainant authorized or licensed the Respondent to register or use the disputed domain name. Nor can the Respondent show that it is commonly known as CGI. The Complainant states that the disputed domain name has been used to mislead viewers and consumers looking for the Complainant's goods and services by redirecting them to the website of a competitor - Atools Solutions FZ-LLC.

The Complainant relies on *Google Inc. U.S.A. vs. Vaibhav Jain, INDRP/132*, wherein it was observed that 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 documented out of pocket costs directly related to the domain name is to be considered as evidence of the registration or use of the domain name in bad faith. The Complainant also relies on *Ganeden Biotech, Inc. and Kerry Luxembourg S.à.r.l vs. Rob Monster, WIPO Case No. D2019-3012*; and *Yusuf A. Alghanim & Sons W.L.L. v. Anees Salah Salameh, WIPO Case No. D2018-1231* where evidence on record showed that Respondent had used the disputed domain name to redirect users to a competitor's website, this use of the disputed domain name was held to be not a legitimate use, and could not support a claim to rights or legitimate interests.

The Complainant states that the Respondent has laid bare his intent to commercially exploit the Complainant's CGI Marks and Names, for the sole purpose of freeriding on and/or causing irreparable damage and injury to the Complainant's goodwill and reputation, resulting in dilution of the Complainant's CGI Marks and Names, and in particular, the mark CGI registered in India and in other jurisdictions. By acquiring the disputed domain name, the Respondent has shown crass opportunism in encashing the popularity of the Complainant's CGI Marks and Names. It is apparent that the Respondent's intention while registering the disputed domain name is to misappropriate the reputation and goodwill associated with the Complainant's CGI Marks and Names, in an attempt to unfairly benefit from the reputation and goodwill attached to it.

The Complainant submits that it is evident that the Respondent has no right or legitimate interest in the disputed domain name.

(iii) Bad faith

The Complainant reemphasizes that the disputed domain name acquired by the Respondent is confusingly similar to the Complainant's CGI Marks and Names, in which the Complainant has a substantial interest. The disputed domain name comprises of the Complainant's registered trade mark CGI in conjunction with the top level domain name .in.

The Complainant then alleges that the Respondent registered the disputed domain name in order to piggybank off the commercial value and significance of the Complainant's domain name cgi.com. It states that the Respondent is presumed to have had knowledge of the Complainant's CGI Marks and Names at the time it registered the confusingly similar disputed domain name keeping in mind the Complainant's prior use and/or registration of the domain name cgi.com. Even otherwise, the Respondent obviously had knowledge of the Complainant's CGI Marks and Names at the time it registered the confusingly similar disputed domain name by virtue of the fact that it has been used in an attempt to mislead viewers and consumers looking for the Complainant's goods and services by redirecting them to the website of a competitor, Atools Solutions FZ-LLC. This, the Complainant submits, is concrete evidence of the Respondent's bad faith in registering the disputed domain name.

The Complainant relies on Dell Inc. vs. AST Domains, Case No. D2007-1819 which held that "Given the notoriety of the Complainant's trademark, it is inconceivable to the Panel that the Respondent registered the domain name without prior knowledge of the Complainant and the Complainant's mark", finding bad faith and transferring dellvista.com. Not only is the disputed domain name highly likely to cause confusion, but Respondent's bad faith is clearly demonstrated by the evidence filed that shows that it is being used in an attempt to mislead consumers. Registration of a domain name based on awareness of a complainant's trademark rights is recognized as bad faith registration under the Policy. For these it relies on Lego Juris vs. Robert Martin, INDRP/125, Dell Inc. vs. Vijayan Anbalagan, Case No. FA 1531184, Etechaces Marketing and Consulting Private Limited vs. Dan Mahoney, INDRP/658, and Zurich American Insurance Company vs. Administrator Domain, WIPO Case No. D20070481.

The Complainant states that NIXI orders, in the past, have observed that a domain name owner's conduct of redirecting viewers to third-party websites or competitors' websites is evidence of bad faith on part of the domain name owner. It relies on Dell Inc. vs. Madugula Karthik, INDRP decision dt. July 10, 2020, Societe Des Prodi Its Nestle SA vs. Nescafe Limited, INDRP decision dated May 24, 2009 and Glen Raven, Inc. vs. DingDing, INDRP decision dated May 30, 2018. It has also

enclosed a List of Cases with the Complainant due to the word limit prescribed under the Policy.

Finally, the Complaint states that it has filed a reverse Whois search which shows that the Respondent has registered 263 domain names composed of different words/letters including <khadi.in>. In a complaint filed by Khadi and Village Industries Commission (KVIC), owner of the trademark and service mark KHADI, the domain name <khadi.in> was transferred from the Respondent. Based on this decision, the Complainant states that the Respondent is a habitual repeat offender who registers domain names incorporating third-party trademarks/ service marks, and thus, strict action must be taken against him.

Based on the above submissions, the Complainant seeks transfer of the disputed domain name and heavy cost on the Respondent as a deterrent.

#### 5. The Reply of the Respondent

The Respondent filed its Reply along with Annexures on April 11, 2022 and denied the statements and allegations in the Complaint. He states that he is a tech-entrepreneur, engineering graduate and director at Scalium Digital Media Pvt. Ltd. He provides technology services including digital marketing under the brand GMC and launched his first online venture EParanoids in February 2004. He has filed an Affidavit as Annex I, inter alia, affirming this and sharing details of his LinkedIn Profile, an extract of which he has filed as Annex III(a), and his Twitter handle where he has over 77k followers.

The Respondent states that he understands the importance of short common word domain names and hence registered some common dictionary word domain names on its launch day - the day .IN domains became available for registration after expiration of the 'Sunrise Period' in which trademark holders registered domain names corresponding to their trademarks - like cgi.in (disputed domain name), animation.in, cms.in, phd.in, lpg.in, leads.in, calories.in, diet.co.in, reviews.in and more. He accordingly became the recorded registrant of the disputed domain name on February 16, 2005. According to him, this was a once in a life-time opportunity to register common word/generic domain names for development purposes. He states NIXI supports unlimited registration of .IN domain names by anyone and its Policy in this regard is filed as Annex X.

The Respondent states that he has put the disputed domain name in use and also others like getmoreclients.in (GMC), reviews.in, letters.org, diet.co.in, hairstyles.co.in, indianchild.com, goodparenting.in. He states that he has experience in digital marketing and understands the importance of Exact Match Domain Names (EMD).

He has shared a link to an article that talks of the importance of the Exact Match Domains for online marketing professionals.

Disputing that the disputed domain name is identical or similar to the Complainant's trademark, the Respondent states that CGI is defined in the dictionary. Dictionary.com provides the definition of CGI [filed as Annex II(a)], which originated earlier than the Complainant. Defined as "Computer-generated Imagery", CGI is a standard method used to generate dynamic content on web pages or otherwise an application of computer graphics to create visual/special effects animation in video games and movies. Westworld was the first movie to use CGI in 1973, followed by StarWars [Wikipedia extract filed as Annex II(b)] and many superhero/Marvel movies these days use CGI.

The Respondent states that he registered <cgi.in> as it is a well-known acronym to refer to computer-generated imagery. It is generic/descriptive in nature, it is non-distinctive and thus the rights to use or own CGI cannot exist with one single entity or individual. He states that CGI is used widely by numerous businesses globally as an acronym and has pointed to [www.cgi.net.in](http://www.cgi.net.in), [www.cgi.gov.in](http://www.cgi.gov.in), [www.cgi.org](http://www.cgi.org) and has filed as Annex XI a list of additional uses by third parties. He relies on One.com Group v. Stan, CAC-103567 where it was held "No-one can own a number or dictionary word to the exclusion of the rest of the world". He also relies on People Interactive (I) Pvt. Ltd vs Vivek Pahwa [2016; Shaadi.com v. SecondShaadi.com], wherein the Hon'ble Bombay High Court observed "Words in everyday language, words of the common tongue are not to be allowed to be monopolized" ... "the generic or commonly descriptive words are used to name or describe the goods in question. These can never become trade marks on their own. They never acquired distinctiveness or a secondary meaning. They do not tell one man's goods from another's. They do not indicate origin". He also relies on other cases on this proposition, a synopsis of which he has filed as Annex XII.

Relying on National Trust for Historic-Preservation v. Barry Preston, WIPO-D2005-0424, Private Media Group v. DHL Virtual Networks, WIPO-D2004-0843 and Zero Int'l Holding v. Beyonet Servs, WIPO-D2000-0161 <Zero.com>, the Respondent states it has been held that where a Respondent registers a domain name consisting of a dictionary term because he has a good faith belief that domain name's value derives from its common/descriptive qualities rather than its specific trademark value, the use of domain name consistent with such good faith belief would establish a legitimate interest.

The Respondent states that his purpose of registration was to use EMD <cgi.in> in relation to its dictionary meaning and by 2011, he developed the website corresponding to the disputed domain name by providing generic content as to



computer-generated imagery. The Respondent states that the said website was active till April 2016 and provided general information about CGI and animation only. He has filed extract and link <https://web.archive.org/web/20111113231127/http://www.cgi.in/> from the web archives and has filed as Annex IV(c) a list of articles from 2011 web archives of the website corresponding to the disputed domain name. The Respondent affirms this by Affidavit filed as Annex I. The Respondent states that he also registered <animation.in> which indicates his interest in animation/CGI field. He relies on INDRP/916-cars24.in wherein registrant owned domains ending with '24'.

Asserting his legitimate interest and use, the Respondent submits that 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. He relies on Inbay Limited v. Ronald Tse, WIPO-D2014-0096 and Hallmark Licensing v. Privacy Administrator, NAF-FA1941032, where it was held that Respondent has rights and legitimate interests in the domain name because it corresponds to a well-known descriptive dictionary word - mahogany - a common and well-known dictionary word used by numerous people and companies. He quotes HP-Hood v. Hood.com, NAF-FA313566, "where the domain name and trademark in question are generic - and in particular where they comprise no more than a single, short, common word, the rights/interests inquiry is more likely to favor the domain name owner."

Relying on Clause 6 (a) of the Policy, the Respondent states that before notice of this dispute, his demonstrable preparations to use the disputed domain are evident not only from the historical archives filed as Annex IV but also further technical/backend use from 2017 onwards by way of purchase of hosting services filed as Annex V(a). The Respondent had set up a website in mid-2011 which was active till April 2016. The said website included various articles on CGI - computer-generated imagery i.e., the use was in terms of dictionary meaning of the term 'CGI'. He relies on WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0") Para 2.10.1, which states that "In order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning". He cites Javier Narvaez Segura, v. Mrs. Jello, LLC, WIPO-D2016-1199 <loading.com> and GoSecure Inc. v. Billa Bhandari NAF-1954083, where the legitimate interest was upheld when the domain was inactive for 7-8 years but for a few years in the past it was actively used to render security services and later was being used for email operations only.



The Respondent states that due to technical issues the website was deactivated by mid-2016, and later in 2017, Respondent decided to use <cgi.in> as the host-name at the time of purchase of hosting services (Droplet) from DigitalOcean.com. Also <cgi.in> was used to configure custom nameservers. He has deposed to this in the Affidavit filed as Annex I. He has also filed as Annex-V(a) welcome email from DigitalOcean.com received by him on the WHOIS email ID, which reads "Your new Droplet is all set to go! You can access it using the following credentials:" Thus, since 2017, Respondent has used the disputed domain for configuration of its server as <cgi.in> being a short domain name, works well as a shortener. In 2019 he repurchased hosting services with <cgi.in> domain name and the IP address changed to 68.183.92.58, while the current hosting IP address is 139.59.29.5. Respondent also created custom nameservers (ns1.cgi.in; ns2.cgi.in and ns3.cgi.in with another IP) with the disputed domain, which are reflected since 2017-18 on the personal domain <jitendra.org>. He has filed as Annex V(d) emails from 2018 till 2021 and shared link for the WHOIS information of domain name <jitendra.org>. He states that the nameservers are active and all can be pinged in 'cmd' window and has shared details of IP 159.223.212.197 belonging to DigitalOcean looked up through <https://www.iplocation.net/ip-lookup>. He has relied on Enow.in, INDRP/1195, and Navistar V. Yazdi Tantra, INDRP/803 (Transtar.in), wherein just the email use was upheld as a legitimate, planned use, though there was no corresponding website.

The Respondent also submits that it is quite common for online businesses to have many domains in legitimate operation even if there is, on the face of it, no website. He cites that it is known that Godaddy.com uses domain name [www.domaincontrol.com](http://www.domaincontrol.com) for the purposes of provision of website hosting services and ns69.domaincontrol.com etc. are its custom nameservers. He has also provided a voluntary certificate as Annex XIII by a Delhi website development company Archer Softech Pvt Ltd. whose main website is at [www.archersoftech.com](http://www.archersoftech.com) but uses the domain [www.digitalcity.in](http://www.digitalcity.in) for Cpanel login for customers at <https://host.digitalcity.in:2083> and [www.indiaindia.org](http://www.indiaindia.org) as custom nameservers using ns1.indiaindia.org and ns2.indiaindia.org to show that both domain names digitalcity.in and indiaindia.org do not host a website and therefore appear to be passively held.

The Respondent states that the Complainant's basis to argue lack of legitimate interest and bad faith on his part is based upon redirection of cgi.in to [www.atools.me](http://www.atools.me). He states that this is a dummy website and he became aware of the redirection after receipt of the Complaint. Thereafter, he researched the issue and discovered that the domain <atools.me> and the disputed domain are hosted by the same hosting company Digital Ocean (details filed as Annex V) on the same IP address 139.59.29.5. He has filed as Annex VI details of the Reverse IP Lookup and WHOIS information for domain names cgi.in, atools.me and some others to show that these have the same IP address.

Attributing the redirection to a technical glitch, he states that as per WHOIS details, the domain <atools.me> is owned by a Gujarat based organization Pedals Up, with which the Respondent has no relation. He affirms this in the affidavit filed as Annex I. He has filed as Annex V(b) the support-ticket raised with the hosting company with regard to the redirection. He has also filed as Annex VII Google search results and communication showing that the email sent to contact@atools.me bounced back. He states that while some content to re-activate the website corresponding to the disputed domain name is restored but on the date of the Complaint, the disputed domain name did not resolve to a website.

Accordingly, the Respondent submits that none of Complainant's arguments or cases regarding lack of legitimate interest or bad faith are applicable to the facts of this case. He also objects to the averment in the Complaint that he (the Respondent) primarily registered the disputed domain name for selling to Complainant saying that there is no such evidence on record. He reiterates that he has made demonstrable preparation to use the disputed domain and his intent to use it in the long run and not part with it is further evident from the 2031 expiry date of the same. He relies on Easton Corp v. Best Web Limited, WIPO-D2016-1975 where it was observed that in assessing whether a respondent has rights or legitimate interests in a dictionary word, UDRP panels have tended to look at several factors: 'the status and fame of the trademark', 'whether Respondent has registered other domain names containing dictionary words or phrases', and 'whether the domain name is used in connection with a purpose relating to its generic or descriptive meaning'.

The Respondent states that his registration of the disputed domain name is in good faith and has relied on several UDRP cases on the point that in order to show bad faith registration, the Complainant must show that Respondent registered the domain name not for its common dictionary or descriptive meaning or for any other legitimate purpose, but rather specifically because it corresponded to protected trademark Sadig Alakbarov v. Yuxue Wang, WIPO-D2019-2253; Ancien Restaurant Chartier v. Tucows.com, WIPO-D2008-0272; Forever I Am v. HugeDomains.com, UDRP-D2021-1550.

The Respondent states that he registered <cgi.in> in reference to its dictionary meaning computer-generated imagery in 2005 and put the domain to use by 2011 in relation to its dictionary meaning whereas the Complainant applied for its trademark registration in India in 2013. While the Complainant claims earlier use, it has not produced evidence of any reputation it had in 2005 in India. Rather, CGI is not a distinctive mark and Complainant has no secondary meaning in it. The Respondent states that cgi is in wide third-party use as an acronym with over 230 different domains with different extensions registered by third parties of which few are owned by the Complainant.

The other approximately 200 domain registrants cannot be ignored.

With regard to the Complainant's rights, the Respondent states that Complainant's trademark registration for CGI in India dates to 2013 and in USA it dates to 2008, whereas the disputed domain name was registered on February 16, 2005. His registration of the disputed domain name predates the Complainant's registration for CGI in India by 8 years. He states that this 2005 date is sufficient to conclude there has been no bad faith registration of the disputed domain name. He has relied on Simon Zybek v. James Yarber, WIPO-D2021-1734, where it was observed "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."

He further states that the earlier usage date in the trademark registration is irrelevant for the purpose of domain dispute policy in the absence of registered trademark rights in 2005. He relies on Equity Trust Company v. Domain Vault, NAF-1976315 2022, where it was observed "... the date of first use in commerce claimed on a trademark application is of limited evidentiary value in administrative proceedings brought under the Policy. For the purposes of the present proceeding, this date amounts to a mere assertion which would still require to be suitably evidenced. Absent additional supporting evidence, which is lacking on the present record, the Panel is not prepared to find that the Complainant had unregistered trademark rights in a relevant trademark at the material time." He also relies on Stacy Hinojosa v. Tulip Trading Company, NAF-1725398, "The date of first use alone is not enough to establish common law rights in a mark. In order to have common lawrights, a complainant must establish secondary meaning."

The Respondent disputes that CGI is well-known. He states that there is no Indian court judgement made available by Complainant which refers to trademark "CGI" as well-known. The Complainant has made statements about spending substantial time, effort and money on advertising and promoting the CGI Marks and Names worldwide but has not filed any supporting evidence especially from February 2005 or earlier years to establish secondary meaning in the term. It has provided no sales volumes, customer volumes, advertising and marketing expenditures, media reports, or consumer surveys in India from independent of this recognition. Annexures filed are from its websites or printed literature which do not prove that CGI had acquired secondary meaning within the jurisdiction of India in 2005 or thereafter. The Respondent relies on Machani Infra Dev.Corp. v. Anand, WIPO-D2021-1352, wherein Machani Group claimed common law rights in the mark Machani since 1950s, but the Panel held "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". Relying on Real Estate Edge V. Rodney Campbell, WIPO-D2017-1366 where it was held that the weaker the mark the stronger must be the evidence, the Respondent states in this case, the mark is weak and so is the evidence.

For any existing trademarks in 2005 in any other country, the Respondent states that the domain owner is subject to jurisdiction from where he operates and it is well established that domain dispute policy does not require Respondent to conduct trademark searches in every country of the world. He relies on FreedomCard v. 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 v. DomainNames4U, WIPO-D2000-1403.

In response to the allegations in the Complaint regarding <khadi.in>, the Respondent submits that this has no legal value. He states that the INDRP award in question was not published online and NIXI does not have the process of providing certified copies. Correspondence of Respondent's counsel with NIXI is filed as Annex VIII(a). It has also filed a copy of a request under Right to Information Act and NIXI's response thereto as Annex VIII(b).

The Respondent states that he registered <khadi.in> in 2005 and khadi is understood to be a common word by laymen. He had made initial attempts to surrender <khadi.in> when it was appropriated by the Indian Government for its own use and has filed his correspondence with the counsel of KVIC as Annex IX. Consequently, he states that there is no violation of rights either in this matter or in the one relating to <khadi.in> and the Complainant's allegation that these were primarily registered for selling to Complainant's is false. The UDRP/INDRP decisions relied on by the Complainant are not applicable in the circumstance of the present case.

Relying on Tytex v. William Coam, WIPO-D2021-305 (carefix.com), wherein Respondent had a portfolio of 5500 domain names and was subject to four (lost) UDRPs, the Respondent states that every domain dispute matter is to be analyzed independently and success or failure in a previous UDRP cannot be a sole ground for another transfer or denial. Hence, previous INDRP decision of <khadi.in> cannot have any effect on this matter.

Further, the Respondent points out/submits that:-

- The Complaint does not once mention that CGI is a common word to refer to the well-known technological term computer-generated imagery, commonly used in



relation to video games or animation movies. In the matter of Radiantly Life v. JeevanDeep Services, INDRP/957; <apanaghar.in> it was held "the term APNAGHAR is a generic term and no one needs a license or permission to use the term".

- The Complainant has knowledge of the 2021 redirection to a dummy website but has deliberately not mentioned the legitimate use visible from 2011-16 on web archives.
- The Complainant has made reference to a dummy website corresponding to <atools.me>, which is not even operational by labelling it as their competitor. Per the WHOIS, this is owned by a Gujarat based company.
- It has provided vague information about itself and Google search results filed are recent pushed through SEO and not from 2005. The awards referred under Annex H are from 2017 onwards only.
- The scope of INDRP or UDRP is to deal with matters of pure cybersquatting, wherein it should be proved beyond any reasonable doubt that Respondent intended to target the Complainant. That is, domain dispute proceedings are summary proceedings, restricted to cybersquatting only and this forum is not civil or trademark court.
- INDRP/1195, INDRP/972, INDRP/978 and UDRP matter of KalyanJewellers.com, National Trust Historic Preservation v. Barry Preston, WIPO-D2005-0424 have observed that Respondent has right to register and use domain names to attract Internet traffic based on the appeal of commonly used descriptive phrase, even where domain name is confusingly similar to Complainant's registered mark. As the Policy was not intended to permit a party who elects to register or use common term as trademark to bar others from using the common term in domain name. Anyone has right to register common word(s) based domain for any future use and no one has the right to question it, unless they are strong trademark based domain names.
- Consideration to previous UDRP/INDRP losses or holding of strong trademarks only help when there is no good faith or demonstrable preparation to use evidence which is not the case here.
- It is a very wrong notion that anyone having a trademark can claim a common word domain name. If this was true then Reliance Group should have owned Reliance.com, Fireball whiskey should have owned fireball.com, Teva Pharma should have owned teva.com. acc.com, itc.com, axis.com, tvs.com, kalyanjewellers.com, woodland.com would have been with Indian trademark holders. There is a huge list of domain names that have been put to varied use or even held passively like ITC.com, TEVA.com, AXIS.com, KalyanJewellers.com, Reliance.com, etc. But a trademark holder cannot claim right to such domain names in summary proceedings.



Based on all of the above, the Respondent submits that there has been no violation of the Complainant's rights in terms of the Policy or otherwise and a false and misleading Complaint has been preferred by the Complainant. He asks for a declaration of reverse domain name hijacking.

**6. Rejoinder of the Complainant**

In the Rejoinder, the Complainant reiterates that it has been operating under CGI trade name since 1980 worldwide and its 1997 Annual Report features the CGI trade name and mark. It has been conducting operations through website <https://www.cgi.com/en>. Here the Complainant clarifies that the domain <cgi.com> was registered on January 19, 1987 by another entity as subsequently acquired by it and the same has resolved to its website since at least July 2002. It invites the Arbitrator's attention to its US registration certificates, Whois extracts, Wayback machine extracts dated July 2002 and up till April 2005 for the domain name CGI.COM and Annual Reports from 1997 to 2021 filed as Exhibit B. The Complainant also invites the attention of the Arbitrator to the various versions of the CGI logos used by it in red and alleges that Respondent has copied the same.

The Complainant reiterates that it has been operating under the CGI trade name and mark since at least 2001 in India including in Mumbai and that it is inconceivable that the Respondent was not aware of the same when it registered the disputed domain name 16/02/2005. It invites the Arbitrator's attention to its Indian registrations (Exhibit C) and particularly registration no. 1267125 filed February 16, 2004 with use since July 1, 2001, which it has repeatedly emphasized upon in the Rejoinder and Annual Reports of 2001, 2002, 2003 and 2004 which talk of the Complainant's operations in India. It talks of the India specific page of the website <https://www.cgi.com/en> and its other CGI-formative domain names including cgi-india.com. Here it clarifies that the said domain was registered on 18/07/2001 (by someone else) and was acquired by the Complainant subsequently (though no date of acquisition is given). It states that its Indian subsidiary CGI Information Systems and Management Consultants Private Limited was incorporated on 09/11/1995 (not as CGI) but underwent a name change in 2001 (Exhibit D) and states that presently it has operations in 5 cities in India. It has filed its correspondence with the Income Tax Department from 2002 along with letters sent to other government authorities and third-parties in India between 2001-2005 and a company newsletter dated November 2004 (Exhibit E) which also notes its participation in the Times Job Fair presented by TimesJobs.com. It has also filed various extracts (Exhibits F and G) of its website from 2004 referencing Complainant's 2002 India operations, services and solutions offered by it, its two offshore development centers which were ISO 9001 - 2000 certified, press releases, brochures etc. It has also filed letters issued to its employees and staff in India between 2001-2005 (Exhibit H) and a copy of the Annual Report 2004 of CGI Information Systems

and Management Consultants Private Limited (Exhibit I) and the income recorded therein to show that it had a significant presence under the CGI trade name and mark in India at the time. For the convenience of the Arbitrator, the Complainant also set out links from where relevant information/documents showing use of CGI prior to 2005 in India, can be accessed.

The Complainant then states that the Respondent has registered an identical domain name, used a nearly identical red CGI logo and allowed a competitor to use the disputed domain name. The Respondent has failed to demonstrate any rights or legitimate interests in the disputed domain name. By the Respondent's own submissions, he is not known in the market as CGI and has failed to establish any active use of the disputed domain name resolving to an active website prior to filing of this complaint. It relies on Malayan Banking Berhad v. Beauty, Success & Truth International, WIPO Case No. D2008-1393, wherein the Panel noted that "passive holding which is interspersed with sporadic or intermittent use of the disputed domain name, as in the present case, has also been found to be bad faith use."

Further, the Complainant states based on its searches on the Wayback Machine (Exhibits JI and J2), since at least the date of filing of Reply on 11/04/2022 the Respondent has been using red CGI logo. He has also failed to establish any active use of the disputed domain name – he allegedly put it to use in 2011 which implies that it was passively held for around 6 years after registration, in use until 2016 which implies that it was again passively held thereafter till at least late 2021 when it resolved to a third-party website <https://atools.me/> in November and December 2021, and currently resolves to a website showing a red CGI logo. The Complainant alleged that even when the disputed domain name was in use, the website content was hardly updated. This passive holding of the disputed domain name with use of a nearly identical red CGI logo (which is also reflected in the Annexures of the Respondent), is concrete evidence of bad faith on his part. The Complainant states that there is no plausible reason for the Respondent to come up with a nearly identical CGI logo, which it continues to do despite the Complaint. It relies on Fenix International Limited c/o Walters Law Group v. Whois Privacy, Private by Design, LLC / Edward Thompson, WIPO Case No. D2021-2071, where the Panel observed that use of an identical logo and use of a privacy service to mask the Respondent's true identity are each indications of bad faith; on Chrono24 GmbH v. Sam Manning, WIPO Case No. D2015-0243, wherein the Panel viewed use of a similar/nearly identical logo as evidence of bad faith and on L. Perrigo Company, Perrigo Pharma International DAC v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf/ Rebecca Jenkins, Merit Pharmaceutical, WIPO Case No. D2021-2770. Further, it states that redirection of the disputed domain name to a site that claimed to provide IT solutions, would appear to a layman or average consumer/viewer to be a competitor of the Complainant and it has refiled

relevant extracts (Exhibit J3) from [www.atools.me](http://www.atools.me). It also relies on Yusuf A. Alghanim & Sons W.L.L. v. Anees Salah Salameh, WIPO Case No. D2018-1231. The Complainant alleges that being the owner of the disputed domain name, the Respondent is bound to have full knowledge of and must have permitted the said third-party to use the disputed domain to the detriment of the Complainant and such conduct is concrete proof of bad faith on his part.

The Complainant states that the Respondent was also bound to be aware of it and its rights and basic due diligence would have revealed its business activities, Indian subsidiary, Indian registration no. 1267125 and the domain [cgi.com](http://cgi.com) which has resolved to the Complainant's active website since at least July 2002. It relies on Alaska Oil and Gas Association v. Obada Alzatari, WIPO Case No. D2021-3598, Solverde, S.A. v. Rojas Espinoza, Servicios de Lexicografia S.A. /Pierluigi Buccioli, Turn Invest Group Ltd, WIPO Case No. D2020-3138 on the issue of due diligence by way of Internet and trademark searches. It has filed copies of decisions relied on as Exhibits J4 and J5.

Disputing that CGI is a dictionary word or generic term, the Complainant states that the Respondent has provided no proof whatsoever that, at the time of registration of the disputed domain name on 16/02/2005, CGI was a dictionary word or a generic term. The results and other documents filed by the Respondent are from 2022 not 2005 or earlier and in the absence of any evidence showing that in or prior to 2005, CGI had become a dictionary word or a generic term, the Respondent's arguments in this regard are unfounded and lack merit. The Complainant has filed extracts from the Oxford English dictionary (2002 edition), Webster's dictionary (2003 edition), Bhargava's Standard Illustrated Dictionary (2003 edition), and Oxford Dictionary (2006 edition) (Exhibit K) to show that at the time there was no mention of CGI in dictionaries

It also states that given that the Complainant has registrations worldwide and in India for the word mark CGI and CGI-formative marks, any claims of CGI being a dictionary word or generic term are unfounded and contrary to the stand taken by Trade Marks Offices around the world including in India and refers to the details of registrations/certificates which it has again enclosed (Exhibit L1). It submits that no disclaimer or condition that CGI is a dictionary word/generic term has been imposed by the Indian TMO and registration for CGI word mark in various jurisdictions shows recognition of the Complainant's exclusive rights in the standalone CGI word mark. The Complainant clarifies that CGI is an acronym for "Conseillers en gestion et informatique" (French) which translates to "information systems and management consultants" in English and that its adoption did not bear any reference to Computer-Generated-Imagery at all. It also states that it is listed on various stock exchanges, received several awards and accolades, has been featured in news articles and

publications, and conducted many social initiatives under the CGI trade name and mark over the years worldwide and in India and has filed documents (all from its website) in support (Exhibit L2).

The Complainant further relies on the excerpt from WIPO Jurisprudential Overview 3.0 on the point that merely registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate interests on the Respondent but it has to be genuinely used or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights. The Complainant submits that the Respondent has allowed a third-party to conduct business under the disputed domain name and this is a clear attempt to trade off the Complainant's prior CGI trade name mark.

The Complainant states that even if the term CGI was in any dictionary at the time of registration of the disputed domain, this does not lead to any rights or legitimate interests in favour of the Respondent. It relies on Kampachi Worldwide Holdings, LP v. Registration Private, Domains by Proxy, LLC / Robin Coonen, Blue Ocean Mariculture, LLC, WIPO Case No. D2021-0371, wherein the Panel has noted that registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate interests on the respondent. It also relies on Oravel Stays Private Limited v. Perfect Privacy, LLC / Kannan, Vijayakumar, WIPO Case No. D2019-1979 and has filed copies of the said decisions (Exhibit L3).

In its parawise reply, the Complainant has denied all claims and contentions of the Respondent as being irrelevant, misleading or unwarranted and case law relied upon by him as being on unrelated legal issues and/or not containing any specific observations along the lines stated by the Respondent or that the Respondent has not explained the significance or applicability of each of them. It also states that there is no ground for a ruling of Reverse Domain Name Hijacking in the instant proceeding. The Complainant also reiterates the contentions regarding its rights in CGI and use thereof, lack of due diligence by the Respondent, use of nearly identical logo by him, lack of proof of CGI being a dictionary term in 2005. The affidavit filed by the Respondent is also stated to be insufficient, being written and executed by him without supporting evidence.

On the issue of third-party registration for CGI formatives, the Complainant has reserved its rights and states that registration dates of the alleged third-party domain containing CGI are subsequent to its <cgi.com> domain which was registered as early as 1987. It has enclosed Whois extracts of these (Exhibit N5).



It also states that the Respondent's claims regarding when .IN domain registrations were launched or became available to the public for registration, even if true, are inconsequential to this proceeding as is NIXI's stand of unlimited registration of .IN domains by the public. Respondent's claims of having an interest in computer-generated imagery and animation are denied as being an afterthought.

The Complainant alleges that animation.in is not being used by the Respondent (Exhibit N1). The redirection of the disputed domain name explained by way of technical glitch is denied as being unfounded. The Complainant relies on Operations B.V. and DHL International GmbH v. Eric White, WIPO Case No. D2010-0016 (Exhibit N2) where the Panel observed that the Respondent acknowledges that, at certain times, the disputed domain name was not used as a political protest site but rather as a conduit to other websites that were competitors of DHL in the field of transport and shipping. It is acknowledged that benefit flowed from the inclusion of such links. Whether or not the beneficiary was the Respondent directly or a third party does not obviate the fact that there was commercial use, or the Respondent bears the ultimate responsibility for the content or material appearing on its website... The Panel finds that the fact that the Respondent apparently allowed the domain name to be used for commercial links takes the domain name out of the category of genuine non-commercial fair use under the Policy... the Panel finds that the Respondent is not making legitimate non-commercial or fair use of the domain name.

On the issue of where the Complainant obtained copy of Order in INDRP 1346 regarding <khadi.in>, it is stated that the same was obtained from NIXI and correspondence with NIXI is enclosed (Exhibit N3). According to the Complainant, the Respondent's correspondence with NIXI on the same issue, particularly NIXI's response ought to be disregarded. It submits that the Respondent is a habitual repeat offender who registers domain names incorporating third-party trademarks/service marks and its offer to surrender <khadi.in> to the Indian government was made after filing of the complaint against him and his effort to amicably settle the matter was after he was made aware of the violation of the Policy.

The Complainant denies the contentions of the Respondent regarding scope of INDRP as misleading, wrong, self-serving and contrary to remedies envisaged thereunder.

The Complainant relies on Accor, SoLuxury HMC v. Giovanni Laporta, Yoyo.Email, WIPO Case No. D2014-1650 and R.C. Purdy Chocolates Ltd. v. Giovanni Laporta, Yoyo.Email Ltd, WIPO Case No. D2014-1670 (Exhibit N4) and states that any alleged technical/backend/background use of the disputed domain name is insufficient to establish rights or legitimate interests in the same, or even bonafide use of the same. In the Complainant's view, the Respondent has used computer jargon and lingo to



confuse and mislead the Tribunal. He has failed to prove plausible reason for registration of the disputed domain name or provide any bonafide use thereof and also how or why the disputed domain name was used as a "name server". There is no good faith registration or use of the disputed domain name.

In the circumstances, the Complainant requests for transfer of the disputed domain name with heavy cost on the Respondent as deterrent.

## **7. Observations**

Before commencing the discussions, the Arbitrator wishes to place on record that there have been procedural lapses on behalf of the Complainant. There was no POA accompanying the complaint, the complaint and annexures were not paginated and the annexures were filed without index. These requirements should have been checked by NIXI.

Further, the Rejoinder filed by the Complainant far exceeds the 5000 words limit prescribed under the Rules. The exhibits run into hundreds of pages which is also in violation of the Rules. Moreover, the exhibits are filed in folders titled A, B, C ... I, J1, J2, ... J5, K, L1, L2, L3, M, N1, N2 .. N5 almost all of which have multiple documents titled 1, 2, 3, 4, ... or 0, 1, 2, 3, ... or 1a, 2a, 2b, ... screenshot1, screenshot2, ... 1, 2India, 2, 3India, 3. Apart from being filed in an extremely haphazard manner, these are without index and pagination. The Rejoinder itself also has no page numbering. Besides, it is extremely repetitive and at many places, extraneous bringing in information not originally pleaded in the Complaint – particularly, (i) the Complainant's Indian registration no. 1267125 which it did not refer to in the Complaint at all nor filed the registration certificate thereof but mentioned only in the exemplary list of marks filed by it as Annexure B, (ii) the use of the red CGI logo by the Respondent which it alleges is similar to its red CGI logo (which is in any case outside the scope of the inquiry under the Policy and belongs in another forum) and (iii) Wayback extracts. The Complainant has not provided any reason why it was unable to provide this information and documents with the Complaint. The Arbitrator also feels the need to point out that despite repeated requests by the Complainant's counsel for extension of time to rely on previous INDRP decisions, not a single one is referred to in the Rejoinder.

The Arbitrator has discretion whether to accept the Rejoinder and Exhibits in the manner filed bearing in mind the obligation to treat both parties with equality and to ensure they get a fair opportunity to present their case. In this case, the Rejoinder and Exhibits were taken on record only in the interest of natural justice, fair play and equity and not to penalize the Complainant for the lapses on the part of its counsel.

The Arbitrator also notes that NIXI has selectively shared Order dated May 3, 2021 in INDRP 1346 of 2021 with the Complainant's counsel but not the Respondent's stating that the decision is sensitive or confidential. This is not in line with Clause 12 of the Policy which requires publication of all decisions on the website of the .IN Registry. Additionally, NIXI's decision to unilaterally remove all previous decisions from its website without notice and not providing any information on the reinstatement or otherwise of these decisions is alarming, to say the least.

The Respondent has also raised allegations against the Complainant which according to the Arbitrator are extraneous to the issue at hand.

#### 8. Discussion and Findings

The Arbitrator has patiently and painstakingly reviewed the pleadings and annexures filed by Parties as also the numerous decisions relied upon by them. She has confined herself to issues directly relevant to the claims under the Policy.

Clause 4 of the Policy requires that the Complainant must establish three elements *viz.* (a) the Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and (b) the Registrant has no rights or legitimate interests in respect of the domain name; and (c) the Registrant's domain name has been registered or is being used in bad faith.

The requirements of Clause 4 of the Policy are conjunctive. Consequently, the failure on the part of a Complainant to demonstrate one element of the Policy results in failure of the complaint in its entirety. The elements are discussed as under:

##### (a) Identical or Confusingly Similar to a mark in which Complainant has rights

In order for the Complainant to make out a case under this element of the Policy, it must show that (i) it has rights in a trademark at the time of the Complaint; and (ii) that the disputed domain name is identical or confusingly similar to that trademark.

In the Complaint, the Complainant has relied upon the registration in its name for CGI in India under no. 2477470 dated February 13, 2013. It has filed the online extract from the TM Office website and the registration certificate of the same. It also relied upon its US registration no. 3539769 of December 2, 2008 and has filed the registration certificate of the same. Though this US certificate states the owner to be CGI Group Inc. and not the Complainant, the online extract corresponding to this registration from the USPTO website filed as Exhibit B 3a with the Rejoinder, reflects the Complainant as the owner.

In the Rejoinder, the Complainant has placed heavy emphasis on its Indian registration no. 1267125 for CGI logo dated February 16 2004. It has also filed USPTO extracts and registration certificates of two other US registrations for CGI logo and CGI under nos. 2445560 and 2445561, which are in its name.

On the basis of these documents, the Arbitrator holds that the Complainant had trademark rights in CGI at the time of filing the complaint.

List of CGI registrations in other countries provided with the Complaint does not bear registration dates. In the List, these are stated to be in the name of the Complainant but based on the registration certificates filed with the Complaint, it is seen that these registrations are in the name of CGI Group Inc. and not in the name of the Complainant. The relation between the two is not explained.

The Arbitrator notes that the disputed domain name is <cgi.in> i.e., the disputed domain name wholly incorporates the Complainant's CGI mark. It has been routinely held that when a domain name wholly incorporates a complainant's registered mark, this is sufficient to establish identity or confusing similarity. See *F. Hoffmann-La Roche AG v. Jason Barnes, ecnopt*, WIPO Case No. D2015-1305, *Swarovski Aktiengesellschaft v. mei xudong*, WIPO Case No. D2013-0150, *Wal-Mart Stores, Inc. v. Domains by Proxy, LLC / UFCW International Union*, WIPO Case No. D2013-1304.

It is also settled that for the purpose of comparing a trademark with a disputed domain name, the country code top-level domain (ccTLD) can be excluded.

Accordingly, the Arbitrator finds the first element in favour of the Complainant.

(b) Rights or Legitimate Interests

Under this element, the Complainant has made assertions of commercial exploitation of the disputed domain name for the sole purpose of free riding, causing harm to its reputation and that it is apparent that the Respondent's intention in registering the disputed domain name was to misappropriate the goodwill and reputation of the Complainant's CGI name and mark to unfairly benefit therefrom.

In a case like this, in order to establish a prima facie case under the second element of the Policy, the evidentiary burden on a Complainant to present supporting material for its claims is commensurately higher. Mere assertions that Respondent has no right or legitimate interest is apparent or evident does not constitute evidence. Thus, the Complainant has not discharged its burden.

On the other hand, the Respondent has provided a credible reason for registration of the disputed domain name. The Arbitrator has also considered the material on record and finds that the Respondent has made legitimate use of the disputed domain name in line with its common meaning. He has equitable interests therein.

The Arbitrator is not discussing this element in further detail in view of the findings with regard to the third element of bad faith. Etrack LLC v. Edward Sturrock, WIPO Case No. D 2021-3776.

(c) Registered or used in bad faith

The final criterion of the Policy requires the Complainant to show that the domain name was registered or used in bad faith. Clause 7 sets out the circumstances without limitation which, if present, constitute evidence of registration or use of a domain name in bad faith:

- (a) 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
- (b) 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
- (c) 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.

The bad faith element is an element of intent and the non-limiting examples given by the Policy are directed to the question of 'why did the Respondent register the domain name?' Was the registration informed by a specific predatory intent in relation to trade or service mark or was the domain name registered for reasons nothing to do with the Complainant and its claimed mark?

It is settled and is also the UDRP panels' consensus rule (WIPO Jurisprudential Overview 3.0) that where a domain name has been registered before a complainant has acquired trademark rights, only in exceptional cases would a complainant be able to prove the Respondent's bad faith because the registrant could not have contemplated the complainant's then non-existent rights.

In the present case, the Respondent registered the disputed domain name on February 16, 2005. On this date, the Complainant's Indian registration under No. 2477470 did not exist. Even the US registration pleaded in the Complaint is dated 2008. For reasons already stated, the exemplary list of marks and registration certificates filed with the Complaint do not help the Complainant's case.

With the Rejoinder the Complainant has filed details of an additional US registration under no. 2445560 (Exhibit B 1b) for CGI logo that predates February 16, 2005 and its other registration in India under no. 1267125 for CGI logo asserting that this predates the Respondent's registration of the disputed domain name. While the application for this was filed on February 16, 2004 with a claim of use of July 2001, the mark only matured to registration on November 21, 2006 (Exhibit C, 2a). Thus, this was a pending application on February 16, 2005. In any case, neither this registration or the US registration gave any rights to the Complainant in the words CGI standing alone. Also, the Complainant states in the Rejoinder that CGI is an acronym for the French phrase *Conseillers en gestion et informatique* which translates to "information systems and management consultants". To the Arbitrator, absent a showing of strong secondary meaning, this is descriptive of its business and the class 42 services covered by Indian trademark number 1267125, lack of disclaimer or condition notwithstanding.

It is not disputed that the Complainant was founded in 1976 or that it has used CGI as its trade and corporate name and trade or service mark or that it owns the domain <cgi.com> and operates the corresponding website or it had a US registration under no. 2445560 on the date of registration of the disputed domain name, but this by itself does not establish rights in India. While currently the Complainant may employ thousands of consultants across different cities in India, there is nothing in the Complaint regarding the scale of its operations here on February 16, 2005. As a matter of fact, the only documents filed with the Complaint that predate February 16, 2005 are (i) extract of its 1997 Annual Report, (ii) extract of its 2001 Annual Report that shows operations in India in Bangalore and Mumbai and (ii) master data of the Indian subsidiary which admittedly underwent a name change in 2001. As part of the Rejoinder, it has filed some documents to show use of CGI in India such as correspondence with government authorities and third-parties, a company newsletter, participation in Times Job Fair, ISO 9001 - 2000 certification of its two offshore development centers, letters issued to its employees and staff, copy of the Annual Report 2004 of CGI Information Systems and Management Consultants Private Limited but these do not provide the Arbitrator a basis for finding sufficient common law rights in CGI in India on the date of registration of the disputed domain name.



Even the averments regarding social media presence, awards, recognitions and articles filed with the Complaint are from the Complainant's website and from the last 3-4 years i.e., the record includes no evidence of scale of operations, employees, advertising, publicity or amounts spent on same, awards, articles or any other indicia of public recognition pre-2005. The Annual Reports and other material filed with the Rejoinder also do not show that its mark had acquired distinctiveness in India on the date of registration of the disputed domain name, let alone that it was famous.

Although the Complainant asserts that the Respondent must have been aware of it prior to registration of the disputed domain name and ought to have conducted searches and due diligence (at the material time), the burden remains with the Complainant to support such inference. In the present case, this burden is not discharged by the Complainant either by preponderance of evidence or balance of probabilities. The Arbitrator is also mindful that the means and mechanisms to do searches/due diligence in India in 2005 were limited. This was not even called for in view of the rationale provided by the Respondent that the opportunity to register .in domains after expiration of the Sunrise Period was a one-time opportunity - which is sound. Any person could have legitimately registered any number of available domains on and after this date. The Arbitrator also accepts as credible the statement in the Respondent's affidavit regarding his adoption and registration of the disputed domain name and that he had no knowledge of the Complainant's mark.

The Arbitrator now deals with the specific averments in the Complaint with regard to this element. The Complainant has pleaded that (i) the Respondent registered the disputed domain name in order to piggybank off the commercial value and significance of the Complainant's domain name cgi.com; (ii) the Respondent is presumed to have had knowledge of the Complainant's CGI mark at the time he registered the confusingly similar disputed domain name; (iii) even otherwise, he obviously had such knowledge at the time he registered the confusingly similar disputed domain name as it has been used in an attempt to mislead views looking for the Complainant's goods and services by redirecting them to the website of a competitor, Atools Solutions FZ-LLC; (iv) domain name owner's conduct of redirecting viewers to third-party websites or competitors' websites is evidence of bad faith on part of the domain name owner; (v) a reverse Whois search which shows that the Respondent has registered 263 domain names composed of different words/letters including khadi.in which was transferred from the Respondent and (vi) it has relied on Google Inc. U.S.A. vs. Vaibhav Jain, INDRP/132, for the observation that 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 documented out of pocket costs directly related to the domain name is to be considered as evidence of the registration or use of the domain name in bad faith. This last point is not pleaded under the third element in the Complaint but under the second.

With regard to (i), (ii) and (iii), the Complainant has relied on Dell Inc. vs. ASTDomains, Case No. D2007-1819 but in the view of the Arbitrator, for the reasons discussed, the Complainant's mark is not on the same footing as DELL in terms of notoriety. Further, in that case, Respondent's bad faith was demonstrated by way of evidence that it was initially used for a website containing links to computer related articles, pay-per-click links to other websites of a more commercial nature offering a variety of different goods and services as well as commercial ads. There was also offer to sell the domain name to the Complainant.

There is no such evidence here. The Complainant has not shown that its trademark rights were being specifically targeted or singled out by the Respondent to piggyback upon. As the Complainant has not proved by evidence the scale, reach, repute of its trademark in India on the date in question, the Arbitrator cannot find that the Respondent must have had the Complainant (or a competitor) in sight when he registered the disputed domain name. In any event, the Complainant merely asserts without corresponding evidence that its mark and name is famous and that it is active in many countries etc. This cannot lead to any inference that the Respondent must have had knowledge of the Complainant's marks or, what is more, any intent to target its rights by piggybacking through the registration of the disputed domain name.

The other cases cited, Lego Juris vs. Robert Martin, INDRP/125, Dell Inc. vs. Vijayan Anbalagan, Case No. FA 1531184, Etechaces Marketing and Consulting Private Limited vs. Dan Mahoney, INDRP/658 and Zurich American Insurance Company vs. Administrator Domain, WIPO Case No. D20070481 for the proposition that registration of a domain name based on awareness of a complainant's trademark rights is recognized as bad faith registration under the Policy also do not help the Complainant. As already observed, the evidence filed by the Complainant does not show that it had such rights in India at the time the disputed domain name was registered as would suggest the Respondent ought to have been aware of it or its trademark.

The Complainant's alleges that the Respondent "obviously had such knowledge at the time he registered the confusingly similar disputed domain name as it has

been used in an attempt to mislead viewers looking for the Complainant's goods and services by redirecting them to the website of a competitor, Atools Solutions FZ-LLC". This is far-fetched. The disputed domain name was registered in February 2005 and the alleged redirection took place in November/ December 2021. The redirection is stated by the Respondent to be a technical glitch and he has given detailed explanation of how this has happened, which is entirely plausible. The Complainant has simply denied this explanation as unfounded. Besides, the Whois details indicate that the domain <atools.me> was registered in April 2021 by a Gujarat based entity. The Respondent states that he is not related to this Gujarat based entity and he has nothing to do with www.atools.me. There is nothing in the Complaint or Rejoinder that points the Arbitrator to the connection between the Respondent and www.atools.me except the redirection. The Arbitrator has also reviewed www.atools.me which prima facie does not appear to be a legitimate site – it does not contain any reliable contact information, the social media icons do not lead to any legitimate links, content has spelling and grammatical errors and the images seem to be stock. The mail of the Respondent to the email address mentioned on the site also bounced back. It does not appear to be a site that would mislead or divert the Complainant's customers.

With regard to (iv), the Complainant cites Dell Inc. vs. Madugula Karthik, INDRP decision dt. July 10, 2020, Societe Des Prodi Its Nestle SA vs. Nescafe Limited, INDRP decision dated May 24, 2009 and Glen Raven, Inc. vs. DingDing, INDRP decision dated May 30, 2018 for the proposition that a domain name owner's conduct of redirecting viewers to third-party websites or competitors' websites is evidence of bad faith on part of the domain name owner. The Arbitrator has reviewed these cases, all of which pertain to abusive registration, and finds that these do not aid the Complainant. Besides, the redirection in the present case is explained with suitable evidence and the Arbitrator accepts that the Respondent had no control over this redirection.

With regard to (v), the Arbitrator has reviewed the reverse Whois search results filed with the Complaint which is an extract containing 130 of the said 263 domain names registered by the Respondent. A careful examination of these do not indicate that any are or can be trademarks of any party being purely generic in nature. The fact that the Complainant has pointed to a dispute regarding only one other domain, namely, khadi.in attests to this. The Arbitrator has also reviewed the interim Order dated May 3, 2021 in INDRP 1346 of 2021 for <khadi.in> and the correspondence filed by the Respondent with Counsel of KVIC regarding his willingness to transfer the said domain. Clearly, a settlement was drawn up but not signed. Notwithstanding what is observed in Order dated May 3, 2021 by Arbitrator Pankaj Garg, it is clear that this was in interim order without any

discussion on the three elements mentioned in the Policy. An award was also to be passed in the matter. In the absence of this detailed award, the record in this case remains opaque. Also, each matter is decided on its own merits and based on its own facts and circumstances. The Arbitrator does not find that there is a history of cybersquatting or that the Respondent is a "habitual repeat offender" as the Complainant alleges and wants held.

With regard to (vi), there is no evidence whatsoever that the disputed domain name was registered or acquired for purpose of resale to the Complainant or the Respondent contacted the Complainant or any of its competitors for this purpose. The timing of the registration of the disputed domain name does not demonstrate targeting of the Complainant. The timing simply accords with the launch of the .IN domains. The Respondent's assertion that he understands the importance of short common word/ exact match domain names and registered common dictionary word domain names as a once in a life-time opportunity is credible. He says he registered the common word/generic domain names for development purposes, and even presuming this is not the case, registering of domain names is not by itself improper or illegal provided the elements of the Policy are not violated.

In the Rejoinder the Complainant has hotly disputed the Respondent's assertion that CGI is a dictionary term. It states that when the disputed domain name was registered in February 2005, CGI was not found in the dictionary and it has filed as Exhibit K, extracts from 4 dictionaries of 2002, 2003 and 2006 edition. It also states that the results and other documents filed by the Respondent to state that CGI is generic are from 2022 not 2005 or earlier and in the absence of any evidence showing that in or prior to 2005, CGI had become a dictionary word or a generic term, the Respondent's arguments in this regard are unfounded and lack merit. Now, while the Respondent has filed web extracts from 2022, the content of these extracts state origin of CGI was first recorded in 1970-1975, Westworld was the first movie to use CGI in 1973, followed by Star Wars. This and the evolution of the term based on usage in movies, video games and other fields cannot be ignored. In any case, no dictionary includes every single word or abbreviation and words precede their appearance in dictionaries. Words are not automatically added and per contra, dictionaries contain words not in use today. In any case, when dealing with a term like CGI, whether or not it is in a dictionary, one has to look at the nature of the term - short, not inherently distinctive, inherently attractive as a domain.

Further, the Complainant states that even if CGI was in any dictionary at the time of registration of the disputed domain, this does not lead to any rights or legitimate interests in favour of the Respondent and has cited case law in support. But there

is nothing placed on record by the Complainant to show that it had any exclusivity over this term in February 2005 when the Respondent registered the disputed domain name. Indeed, CGI has, as other three-letter acronyms, various meanings and does not refer only to the Complainant. The Respondent has filed examples and a list and the Arbitrator has also done her own research in this behalf.

The Complainant's reliance WIPO Jurisprudential Overview 3.0 and case law on the point that 'merely registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate interests on the respondent but it has to be genuinely used or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to tradeoff third-party trademark rights' is also to be read in favour of the Respondent as he used the disputed domain name in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights. The Wayback extracts filed by the Complainant and its own averment that the Respondent's website underwent no change attests to this and negates the allegation that the disputed domain name was registered or used in bad faith.

Accordingly, the Arbitrator finds no basis for inferring bad faith registration or use of the disputed domain name on the Respondent's part. The Complaint thus fails under the third element.

#### 9. Decision

For all the foregoing reasons, the Complaint is denied. There is no order as to costs.

The Respondent has requested for a declaration of reverse domain name hijacking. In the view of the Arbitrator, this is not one of the remedies under the Policy and there is no declaration in this behalf.

In view of the exceptional circumstances surrounding this matter, namely, the sudden lack of availability of previous INDRP decisions without notice, the volume of pleadings and exhibits and the time it took the Arbitrator to review the same, this award has been passed within the extended 90-day deadline from commencement of arbitration proceeding.

Punita Bhargava

Sole Arbitrator

Date: June 8, 2022