



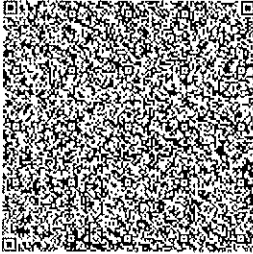
सत्यमेव जयते

INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No.	: IN-DL87883200502862P
Certificate Issued Date	: 30-May-2017 03:01 PM
Account Reference	: IMPACC (SH)/ dlshimp17/ HIGH COURT/ DL-DLH
Unique Doc. Reference	: SUBIN-DLDSLHIMP1776628193458687P
Purchased by	: SUDARSHAN KUMAR BANSAL
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: SUDARSHAN KUMAR BANSAL
Second Party	: Not Applicable
Stamp Duty Paid By	: SUDARSHAN KUMAR BANSAL
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



Please write or type below this line

IN. Registry
(National Internet Exchange of India)

COMPLAINANT

Maruti Suzuki India Limited

Vs.

RESPONDENT

Ragini Shrivastava

ARBITRATION AWARD

Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shcilestamp.com". Any discrepancy in the details on this Certificate and as available on the website renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

J.K. Bansal

INDRP ARBITRATION
THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR : SUDARSHAN KUMAR BANSAL

COMPLAINANT

Maruti Suzuki India Limited
Plot No.1, Nelson Mandela Road
Vasant Kunj, New Delhi-110070

Versus

RESPONDENT

Ragini Shrivastava
Behind Dharampur High School
Samastipur, Bihar, 848101

ARBITRATION AWARD

1. The Complainant is aggrieved by the Respondents Domain Name www.baleno.co.in and has accordingly made this Complaint seeking the relief that this Domain Name www.baleno.co.in (impugned Domain Name for short) be transferred to it or cancelled with costs.
2. The claim of the Complainant in gist and on the basis of which the present Complaint has been filed is as under:-
 - (a) The Complainant claims itself to be a subsidiary of Suzuki Motor Corporation of Japan and claims itself to be a highly reputed passenger car company of India and by virtue of its relationship with the said Suzuki Motor Corporation of Japan claims to be entitled to use several Trade Marks of this Japanese Company. One such trade mark is "baleno" which is being used in

J. K. Bansal

class 12 and 35 for many years and which according to the Complainant constitutes a very valuable asset and property for it. The Complainant claims the said trade mark "baleno" to be registered in India under Trade Mark No.474224 in class 12 for vehicles as of 25.06.1987 to which certificate was granted on 15.07.1993.

(b) The Complainant alleges the Trade Mark "baleno" to be used by its said parent company since 1987 and by it since about 1998 as a trade mark for its vehicle and presently for its hot seller hatch back vehicle. The Complainant claims to have its vehicles under the trade mark "baleno" in India since about the year 1998.

(c) According to the Complainant the said trade mark "baleno" has become a well known and a prominent mark in the past years. The Complainant claims to be running a website under the Domain Name "baleno" and further claims to have the exclusive rights to use the "baleno" Trade Mark in India and to protect it from infringement.

(d) The Complainant claims to have invested huge amount of time and money in making its "baleno" trade mark a known brand and claims that by virtue of extensive use and wide publicity of the trade mark "baleno", the trade mark "baleno" has become a well known trade mark and automobile consumers recognize its goods and services by the mark "baleno".

2.1 Against the impugned domain name the Complainant has alleged -

(a) The impugned Domain Name www.baleno.co.in is being unauthorizedly used by the Respondent in violation of its rights in the Trade Mark "baleno" in as much as the impugned Domain name is identical with

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and similar to the afore referenced "baleno" trade mark amounting to an infringement.

(b) The Respondent is using the Design and images of its vehicles on the Respondents website accessible from the impugned Domain Name as also furnishing thereon technical information and specifications of its vehicles by which, according to the Complainant, the Respondent is giving a wrong indication to the customers of the Complainant and is misleading the general public into believing that some association exists with it (the Respondent) with the Complainant.

(c) The Respondent is misleading the consumers to obtain unfair advantage in the market and to be falsifying the Complainant's "baleno" trade mark and by its activities taken as a whole are causing damage to the distinctive character and reputation of its "baleno" Trade Mark.

(d) The Respondent has no right and legitimate interest in the impugned Domain Name bearing the Trade Mark "baleno" and such a use is in bad faith and amounts to a misrepresentation besides being an unfair trade practice.

(e) The Complainant has placed on record snap shots from the Respondent's impugned website parked on the impugned Domain Name and alleges such a snap shot to bring out the bad faith of the Respondent and the bad publicity and disrepute being brought to the Complainant said trade mark thereby.

(f) The Respondents impugned use of the impugned Domain Name is against law, without any legitimacy, is an act of bad faith, is without the

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Complainants or its said parent company's authorization and is against the Complainants prior use and authority to use the Trade Mark "baleno". The Complainant alleges to have no information with respect to such use.

2.2 In support of its rights and use the Complainant has filed documents which would be dealt with in so far as they are relevant in the course of this Award.

3. The .IN Registry appointed me as an Arbitrator to adjudicate this Complaint in accordance with the Arbitration and Conciliation Act, 1996; .IN Domain Name Dispute Resolution Policy; Rules of Procedure and/or by-laws, rules and guidelines made therein and notified the factum thereof to the Complainant through its authorized representatives, as well as the Respondent vide its email of 24.04.2017.

4. Thereafter I issued a notice to the Respondent vide E-mail dated 26.04.2017 with the copy of the Complaint and Annexures/documents filed herewith wherein the Respondent was notified about my appointment as the Arbitrator and was given an opportunity to submit its written response to the complaint stating its defence with supporting documents within a period of ten (10) days.

5. The Respondent duly responded to the notice by submitting its arguments/reply to the Complaint attached with its E-mail dated 30.04.2017.

6. In its reply against the Complaint the Respondent has alleged –

(a) "Baleno" to be a car product available in the market and providing details like color options technical specifications and the like does not

V.K. Bawa

amount to a trade mark violation and there are numerous websites where such kind of information is available. The Respondent has gathered together such information and presented it in a form that makes it easier for the public to make a informed decision. The impugned domain name is a small blog providing information about Baleno and other cars.

(b) There is no distinct nature of the website under the Impugned Domain Name and as such doesn't hamper the reputation of the brand.

(c) There are many other websites providing the kind of information being provided by the Respondent and the particulars of some such website found by the Respondent on its search on the google search engine with reference to "Baleno" have been furnished. In light thereof the Respondent contends the filing of this unilateral complaint against the Respondent is unjustified.

(d) That the Respondent is not misleading the general public and nor does it intend to do so. The Respondent claims to have mentioned in bold letters (just below the heading) that its website is not the official website of "Baleno" and which is apparent from the image of the website attached by the Complainant itself. The Respondent denies any intention to confuse the general public of its association with the Complainant and has offered to add a disclaimer to the effect that it has no such association.

(e) The images of the Baleno Car used on its website have been taken from the website www.images.google.co.in and that it is willing to remove them should the Complainant have any copyrights therein and on the Complainants so pointing out the same.

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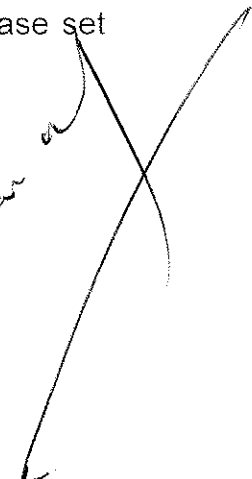
(f) That the top level domain name www.baleno.com is not owned by the Complainant. The Respondent can own its said impugned domain name and owning a trade mark doesn't give any right to own all the domains. The Complainant seeks to own all domain name related to their trade mark which is a problem and the Complainant seeks to do so through legal channels but the Complainant has started acting on it late and that many company's follow a standard practice to make an offer for the domain.

(g) That the Respondent owns this domain for more than 18 months and has invested thousands of hours on the developing its website and on its optimization and which it is not willing to surrender or transfer. The Respondent is willing to consider any offer for the domain if made by the Complainant.

7. On receipt of the Respondents said reply I caused the same to be served upon the Complainant vide notice dated 01.05.2017 with copy to the Respondent, granting to the Complainant an opportunity to file its rejoinder thereto within a period of seven days.

8. The Complainant submitted its rejoinder to the said reply under its letter dated 05.05.2017 sent with its E-mail dated 05.05.2017. In its said rejoinder the Complainant reiterated its rights, use and the Respondents impugned wrongs and contested the Respondents impugned defences. According to the Complainant the Respondents reply admits the Respondents impugned wrongs and establishes the Complainants case set up.

J.K. Bhatia



9. On receipt of the Complainant's said rejoinder I issued a notice to the Complainant and the Respondent vide E-mail dated 06.05.2017 where under the copy of the said rejoinder was served upon the Respondent.

10. The Respondent thereafter with its E-mail of 12.05.2017 submitted a reply dated 12.05.2017 to the rejoinder of the Complainant dated 05.05.2017 alongwith documents consisting of searches obtained from the search engine Google, a download from its own website and copy of available domains on the website www.godaddy.com. In its said reply to rejoinder the Respondent in gist reiterated its defenses while adding that there are numerous domains available containing the word/mark "baleno" and inlight thereof the Complainant cannot have any right to complaint ; the Complainant cannot claim all available domains just because it resembles their (Complainants) trade mark. The Respondent alleges that law doesn't guarantee a domain name to the owner of a trade mark.

11. The documents, the particulars of the websites and the available domains filed and alleged by the Respondent in so far as they are relevant would be dealt with in the course of this Award.

12. A copy of the said reply to rejoinder with documents was served by me upon the Complainant vide notice dated 12.05.2017 wherein it was indicated to both the parties that the said reply to rejoinder and documents are being taken on record and that I am proceeding to give my Award.

13. In light of the pleadings and material on record I now proceed to adjudicate this Complaint.

S.K. Bawa

14. From the respective case and pleadings of the parties hereto the following facts are clearly discernible, evident and undisputed.

(a) The trade mark BALENO is duly registered in India under the Trade Marks Act, 1999 [the Trade Mark Act for short] under Trade Mark Registration No.474224 in class 12 as of 25.06.1987 in relation to Vehicles, apparatus for locomotion of land, air or water. This registration is in the name of Suzuku Jidosha Kogyo Kabushiki Kaisha (Suzuki Motor Co. Ltd.,), (a corporation duly organized and existing under the laws of Japan), 300 Takatsuka, Kamimura, Hamana-Gun, Shizuoka-ken, Japan, and its registration certificate was issued on 15th July, 1993. The particulars of this registration has been placed on record by the Complainant.

(b) The Complainant's contention of it being a subsidiary of the aforesaid Trade Mark registrant and of its using the Trade Mark BALENO under such a relationship is also not contested/disputed by the Respondent.

(c) That the Trade Mark "baleno" in relation to car products of the Complainant was already in existence, in vogue and in use in the market enjoying noticeable goodwill and reputation, to the knowledge and understanding of the Respondent, much prior to the adoption and alleged use of the impugned domain name by the Respondent. In fact the Respondent itself claims to be providing information like colour options technical specifications of the "Baleno" Car product of the Complainant besides other cars on its website accessible from the impugned domain name. Thus the trade mark "baleno" enjoys priority in adoption and use viz-a-viz the impugned domain name.

A.K. Bhandari

(d) The word/mark BALENO is a trade mark in relation to Car products and is its source identifier. In fact the respondent itself has identified the Complainant's Car Products as BALENO.

15. The factum of BALENO being a prior mark is also borne on from the fact that the afore-noticed Trade Mark registration under No.474224 is as of the year 1987 while the Respondent in its own reply has claimed to be using the impugned domain name since "more than 18 months". No where has the Respondent even claim that its impugned domain name was created prior to the year 1987 or was being used by it prior to the user of the "baleno" Trade Mark by the Complainant. A presumptive validity does exist in law in favor of the Trade Mark registration **[See Section 2(i) (v), and 31 of the Trade Marks Act, 1999].**

16. The trade mark BALENO is a registered trade mark in favour of the Complainant's parent company and by virtue of this relationship the Complainant has been so using the said Trade Mark. The Complainant and its said parent company can be considered to constitute a "single economic unit" **[George V. Records, SARL Versus Kiran Jogani & Anr., 2004 (28) PTC 347 (Del)]** and all use of the Trade Mark BALENO by the Complainant in India and its acquired goodwill and reputation enure to the benefit of the Complainant and its parent company.

17. As such I am of the considered view that the Complainant by itself and/or through its parent company can be held to enjoy a legitimate enforceable right and interest in the Trade Mark "BALENO" and/or "baleno" in relation to its goods and services of motor vehicles.

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18. There is a close relationship between Trade Marks and Domain Names. "Trade Marks" are source identifiers of goods or service from a particular source and distinguish them from those of others while "Domain Names" are source identifiers of the business of a particular entity. The basic principles of trade mark and passing off laws apply to domain name disputes **[Satyam Infoway Ltd. Vs. Sifynet Solutions Pvt. Ltd., 2004 (28) PTC 566 (SC)]**

19. The right conferred on a trade mark by virtue of its registration or by virtue of its prior user acquired goodwill reputation and distinctiveness encompasses within its fold the right to so use and exploit it as a domain name or part thereof. A domain name use "of a trade mark" in relation to goods or services amounts to the use thereof "as a trade mark" **[Section 2 (2), 27, 28 of the Trade Mark Act]**. This is more so as under the impugned Domain Name and the website triggered thereby there is an offer of services. Both the Complainant and the Respondent are using the respective trade marks and impugned domain name in the context of a commercial activity with the view to economic advantage and hence in the course of trade.

20. A Registered trade mark can be infringed by its rival unauthorized use as a part of a domain name ; as also the goodwill, reputation and distinctiveness attached to a trade mark (whether registered or unregistered) can be violated by way of passing off by a rival unauthorized use as a part of domain name. In either case the Trade Mark registration or the goodwill and reputation attached to a trade mark has to be protected against such unauthorized domain name use. **[See Bharti Airtel Limited Vs. Rajiv Kumar-2013 (53) PTC 568(Del); Tata Sons Limited Vs. D. Sharma & Anr.- 2011 (47) PTC 65(Del.); Dr. Reddy's Laboratories Limited Vs. Manu**

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Kosuri & Anr.-2001 PTC 859 (Del); Mars Incorporated Vs. Kumar Krishna Mukherjee & Ors.- 2003 (26) PTC 60 (Del)]].

21. In my considered view there is a complete identity, phonetic, visual, structural and conceptual between the Complainants trade mark "baleno" and the impugned domain name which bears the word/mark "baleno" as its essential and memorable feature. It is with respect to the word/mark "baleno" that the impugned domain name would be remembered and with reference to which the internet user(s) would access the internet services being offered by the Respondent. It is with reference to the word/mark "baleno" that an average consumer would remember the Complainant's vehicle products or would do business with it. The Respondent on its website under the impugned domain name is offering services viz informations pertaining to the Complainants vehicles under the Trade Mark "baleno". Thus a trade connection does exists between the Complainant and Respondent.

[K.R. Chinna Krishna Chettiar Vs. Sri Ambal and Co and Anr. AIR 1970 SC 146 ; Ruston & Hornby Ltd., Vs. Zamindara Engineering Co., 1970 (2) SCR 222 ; Corn Products Refining Co. Vs Shangrila Food Products Ltd., AIR 1960 SC 142 B.K. Engineering Company v/s U.B.H.I. Enterprises (Regd). Reported in AIR 1985 Delhi 210 (DB) ; Kirorimal Kashiram Marketing & Agencies Pvt. Ltd., Vs. Shree Sita Chawal Udyog Mill Tolly Vill 2010 (44) PTC 293 (Del.) (DB)].

22. Having regard to the complete similarity/identity between the Complainants Trade Mark and the impugned domain name and the nature of the goods/services involved an average consumer with imperfect memory would be led into believing some nexus, association or connection to exist between the Complainant and the Respondent or of the impugned domain name to be in fact of the Complainant or to be sponsored, licensed or

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affiliated with the Complainant or to be an extension of the Complainant's business, while in fact it is not so. This would invariably give rise to consumer deception. **(Montari Overseas Ltd., Vs. Montari Industries Ltd., 1996 PTC (16) 142 Del (DB) ; (McCarthy on Trademarks and Unfair Competition, 3rd Edition, Volume 3, Chapter 24, Para-24.03).**

23. Not only that any consumer or internet user seeking access to the Complainant or its products with reference to the Trade Mark "baleno" online, would be mislead to the Respondent's website in case they erroneously or inadvertently suffix the "second level" domain name viz BALENO with the cc TLD (country code top-level domain) .in instead of GTLD (generic top-level domain) .com. The user/consumer would be deceived by being led to somewhere else or in not reaching the Complainant.

24. The Complainant would have no control over the Respondent (or the Respondent's licensee or assignee) or over the standard or quality of the services being offered by the Respondent under the impugned domain name. Any inferior services offered by the Respondent (or its licensee or assignee) would invariably adversely affect the Complainant's business under the said word/mark "baleno". Not only that any internet user who may erroneously access the Respondent while intending to access the Complainant can be led by the Respondent to a competitor/rival of the Complainant, as the Respondent is offering information and comparisons on the same website of/with vehicles of other competitor businesses.

25. It is now settled law that a probability/likelihood of consumer deception is the test and not actual consumer deception and that lack of fraudulent intent or bonafide good faith on the part of the Respondent is immaterial and that the Respondent can be held liable despite it **[See Ruston & Hornby**

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Ltd. (Supra) ; Laxmikant V. Patel Vs. Chetanbhat Shah and Another AIR 2002 SC 275].

26. In the case of **Musical Fidelity Ltd. Vs. Vickers (2002) EWHC 1000 Ch.** a summary judgement was granted by the Court in favour of the claimant, a proprietor of the mark MUSICAL FIDELITY for audio equipment against defendant hi-fi seller who advertise business on the web via the domain name www.musicalfidelity.co.uk (a portal of his own site).

27. Consequently, I am of the confirmed view that the Respondents impugned domain name and its use would invariably cause business and clientele loss to the Complainant and would irreparably tarnish and dilute the goodwill, reputation, strength and standing of the Complainant, the Trade Mark "baleno" and the Complainant's business thereunder. Not only that even the consumers would suffer as they would not get what they expected and instead would be deceived. Consumer deception and loss and injury being caused to the Complainant as well as to the consuming public is inevitable.

28. The defense raised by the Respondent of it not violating the rights of the Complainant on the ground that the car product under the Trade Mark "baleno" is already available in the market and of it providing technical details and other information in a particular form in relation thereto and of other cars on its website to enable the public to make an informed decision, is in my view, fallacious and is a legal wrong for more than one reasons -

28.1. The argument raised over looks the basic and fundamental difference between trade marks/domain names on the one hand and the goods or services on the other. Trade Marks in gist are words/devices used in relation

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to goods or services to identify and distinguish such goods or services from a particular source and differentiate them from those of others **[Section 2 (1) (zb) of the Trade Marks Act]**. On the other hand "goods" could be anything that are a subject of trade and manufacture ; while "services" means services of any description which is made available to potential users and includes the provision of services in connection with business of any industrial or commercial matters **[Section 2 (1) (j) & 2 (1) (z) of the Trade Marks Act]**. Trade Marks and the goods or services in relation to which they are used are two different and distinct concepts. Just because the Respondent may be rendering services (like providing informations, comparisons etc.,) pertaining to the Complainant's car products under the Complainant's trade mark "baleno" does not give to the Respondent any entitlement or right over the Complainant's Trade Mark "baleno". This is more so as it is nobody's case, and nor can it be, that the word/mark "baleno" is generic or a descriptor with no secondary significance in relation to the class 12 goods and class 35 services being offered by the Complainant.

28.2. Even if it was to be assumed that the Respondent could so use the Complainants trade mark in relation to the "services" being rendered by it (Respondent), the Respondent cannot so use the said trade mark by itself or part of domain name to create any mental image in the minds of the market and trade suggesting its (Respondent) said business to be related to the Complainant or to be associated sponsored affiliated or in some way connected with the Complainant or of some special relationship to exist between it (the Respondent) and the Complainant. In my view as set out above, the use of the Complainants trade mark "baleno" as an essential part of its impugned domain name and thereby triggering the use of its website giving information on the complainants car products under the trade mark "baleno" does create or has be potential of creating such a mental image of a

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relationship between the Complainant and the respondent in the mind of an average consumer amounting to a misrepresentation whereby loss and injury would be and/or potentially can be caused to the Complainant. As set out above the Complainant would have no hold over the respondent or the nature of the services being offered by it and would always suffer by any incorrect or erroneous information offered by the Respondent of the Complainant's vehicles under the trade mark "baleno". The Complainants goodwill and reputation would be at the mercy of the Respondent.

28.3. In this regard a celebrated judgment in the case of **Rolls-Royce Motors Ltd. Versus DODD reported in 1981 Fleet Street Reports 517** can be safely cited. In this case the defendant a Motor Engineer principally concerned with the repair of automatic gear boxes of the kinds used in Rolls-Royce and Bentley Motor Cars built a motor car and whereon, amongst other things on the lower end of each of this cars wings incorporated the words "Powered by 27 litre Rolls-Royce Merlin". In an action brought against it by the Rolls-Royce Motors Ltd., the defendant asserted that he had build the car to advertise his business and had never represented it as being of the Rolls-Royce design or that it was of the manufacture of Rolls-Royce and that the use of the word Rolls-Royce on the engine and wings thereof merely illustrated the true fact that the car was powered by a Rolls-Royce Merlin Aero Engine. The defendant had further asserted that by its said activities no injury of any kind or type would be caused or has been caused upon the plaintiff by such use. The court rejected the assertions of the defendant and held that such a use by the defendant amounted to a misrepresentation in as much as even if his (defendant) business was of not selling cars but he is indicating that he is capable of doing repair work in connection with such a car as Rolls-Royce and the court further held that the defendant by his acts is likely to injure and cause damage to the business and goodwill of the plaintiff

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in as much as the defendants car may be driven in certain conditions leaving the public thinking that the defendants cars are that of the plaintiffs or in some way the plaintiff is connected therewith or responsible thereto.

This decision was approved and followed by the Hon'ble Delhi High Court in its notable case of **Rolls-Royce PLC Versus R.R. Motors P. Ltd., reported in 1997 PTC (17) 60** wherein the Hon'ble High Court restrained the defendants from using the plaintiffs trade marks being used by the plaintiff in relation to motor car in relation to its (the defendants) trading style in connection with the defendants business of running a motor car repair workshop or garage. Even in this case the defendant had contended that it was not manufacturing or selling cars and was only offering car repair services.

29.a The Respondent in its defense has relied upon a number of websites found by it on the Google search engine searched by it with reference to the word/mark "baleno" allegedly offering the same kind of information being provided by it. The particulars of such websites is as under:-

- (a) <https://www.carwale.com/marutisuzuki-cars/baleno>
- (b) https://www.cardekho.com/carmodels/Maruti/Maruti_Baleno
- (c) <https://www.zigwheels.com/newcars/Maruti-Suzuki/Baleno>
- (d) <https://www.drivespark.com/cars/maruti-suzuki/baleno/>
- (e) <https://www.cartrade.com/maruti-suzuki-cars/baleno>
- (f) <http://www.carandbike.com/maruti-suzuki-cars/baleno>
- (g) <https://autoportal.com/newcars/marutisuzuki/baleno>

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(h) <https://www.gaadi.com/new-cars/maruti/baleno>

29.b In its defense the Respondent has also alleged the availability of various domains bearing the word/mark "baleno" as under:-

- www.baleno.co
- www.baleno.io
- www.baleno.xyz
- www.baleno.company
- www.baleno.asia
- www.baleno.me
- www.baleno.org.in
- www.baleno.uk
- www.baleno.guru
- www.baleno.net.in
- www.baleno.website
- www.baleno.ca
- www.baleno.ind.in
- www.baleno.tv
- www.baleno.com.au
- www.baleno.today
- www.baleno.news

In light thereof the Respondent has contended the Complaint to be not justified, the Complainant to have no right to complain against the Respondent impugned adoption and use, that the Respondent could not be singled out for a unilateral complaint against it and that the Respondent has

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not effected any trade mark violation. In my considered opinion these defenses and assertions are without any legal merit and are best rejected.

29.1. In respect of the domains mentioned in Para 29.a above it is apparent that the word/mark "baleno" does not form a part of the domain name of each of the said websites as indicated. The word BALENO indicated therein is merely a search result forming a part of the URL (Unique Resource Locator) and is not an indicator of origin or source of the website which is effected through the domain bearing the words carwale, zigwheels etc. On these websites an internet user or customer may seek or get information on the products/services of the Complainant under the Complainant's Trade Mark baleno. The word baleno appearing on the said URLs is a source indicator of the vehicle/cars products/services of the Complainant viz Maruti Suzuki as mentioned therein and does not indicate that that particular website to be of the Complainant or associated or authorized by it.

29.2. In contrast in the case at hand the Respondent is using the word/mark "baleno" as an essential part of its own domain name itself by claiming its own rights therein and the Respondent's website would be accessed by an internet user/customer with reference to the word/mark "baleno" believing it to be that of the Complainant and not otherwise. It is not a case of the Respondent using a completely different word/mark as its domain with reference to which its website can be accessed.

29.3. Even the search result so relied upon by the Respondent are the search results emanating out of the search from the Complainant's Trade Mark "baleno" and not that of the Respondent. From the Respondent's pleadings it is apparent that even the Respondent has made a search with reference to the word "baleno" under the clear impression and conscience

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that it is searching for the Complainant's products/services under the Trade Mark "baleno" which is of the Complainant.

29.4. In fact all such domains and the URLs even accepting them on their face value, shows that the word/mark "baleno" forming part thereof are being used as gateways to the Complainants "baleno" vehicles products/services and not de hors thereto. No independent rights or claims appear to have been claimed by the alleged third parties in their favour for the trade mark/domain "baleno".

29.5. Consequently it can safely be held that the Respondent has drawn a false inference and misleading comparison by indicating the word/mark "baleno" as being used by other websites as a part of the domain name while in fact they are only a part of the search result reflecting in the URL. Even such search results as set out above have been obtained with reference to the Complainant's products/services under the Complainant's Trade Mark "baleno".

29.6. Even in respect of the websites and domains mentioned in para 29.a and 29.b above no evidence has been placed on record to show and establish that these alleged third party(s) have any substantial, continuous or overwhelming use of the said websites and domains bearing the word/mark "baleno" over a period of time. Even the nature, character and extent of such use and if at all since when has been placed on record. The aforesaid are not established or proved just from the mere existence of such third party websites or domains. There is even no material on record to show that the alleged third parties are using the impugned websites or domains even prior to the use of the trade mark "baleno" by the Complainant **[See National Bell Co. & Anr. Vs. Metal Goods Mfg. Co. (P) Ltd. & Anr., 1971 SCR (1) 70,**

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Mex Switchgears Pvt. Ltd. Vs. Max Switchgears Pvt. Ltd., 2014 (58) PTC 136 (Del), Enterprise Holdings, Inc. Versus Enterprise Auto Rentals, 2014 (58) PTC 111 (Del), D.R. Cosmetics Pvt. Ltd. & Anr. Vs. J.R. Industries, 2008 (38) PTC 28 (Bom.)].

29.7. Even otherwise it is settled law that the right holders failure to take action against the rival use by third party(s) is no defense and gives no license to the Respondent to use the impugned domain name. A Trade Mark right holder is not expected to continuously be on the prowl for every use of a rival Trade Mark/Domain Name how so ever insignificant and inconsequential that it may be and to take legal proceedings to prevent such use. A right holder is not expected to take legal proceedings if it remains unaffected by such third party(s) use [Pankaj Goel Vs. Dabur India Ltd., 2008 (38) PTC 49 (Del.) (DB), M/s Hindustan Pencils Pvt. Ltd. Vs. M/s India Stationary Products Company & Anr. 1989 PTC 61, Dr. Reddy's Laboratories Ltd. Vs. Reddy Pharmaceuticals Limited, 2004 (29) PTC 435 (Del)] Besides in the present action it is right of the two parties before this Arbitral Tribunal which are to be examined and not qua others. Merely because some other third party(s) are using the violative Trade Mark/domains does not provide any justification or license to the Respondent to so use it [Indian Hotels Company Ltd. & Anr. Vs. Jiva Institute of Vedic Science & Culture, 2008 (37) PTC 468 (Del.) (DB)]. Such alleged third party(s) use is also irrelevant as it is nobody's case that the Complainant has abandoned any such rights in the said trade mark.

29.8. The Respondent itself has claimed a right to use the impugned Domain Name. Having claimed such a right the Respondent is now estopped from contending that no such rights can exist in the subject matter Trade Mark by virtue of alleged numerous third party(s) use. The Respondent

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cannot blow hot and cold in the same breath [See Automatic Electric Ltd. Vs. R.K. Dhawan, 1999 PTC (19) 81].

29.9. In addition to the rights of the right holders the interest of the trade consumers and the market has to be protected against any deceptive use as they are silent third parties to any proceedings concerning Trade Mark/Domain Name disputes.

29.10. The Respondent cannot be permitted by relying on alleged third party(s) use to perfect its own wrong. An imitation whether by one business or by numerous other businesses remains an imitation. The Respondent's wrong cannot be righted by following its musters. A number of pirates cannot defeat the rights of a true owner [The Tata Iron & Steel Co. Ltd. Vs. Mahavir Steels & Ors., 1992(1) Arb. L.R. 417].

29.11. Just because third party(s) are allegedly using violative Trade Marks or Domain Names or such trade marks/domain names are open to sale by sponsoring Registrars does not mean that such third party(s) or users of Domain Names are immune from Trade Mark infringement/passing off/violation proceedings. Each case has to be dealt with on its own facts as and when such proceedings are initiated.

30. The Respondent's reliance of incorporating disclaimers on its website in bold letters (just below the heading) that this website is not an official website of BALENO and its offer to add disclaimers to the effect of no association with the Complainant in my view is without any cause and is only a malafide attempt to cover up its own wrong.

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30.1. The Complainant with its complaint has placed on record a screenshot of the home page of the Respondent's website obtained from the impugned Domain Name. The Respondent in its reply submitted with its E-mail of 30.04.2017 does not dispute this screenshot and has even relied upon it to substantiate its defense based on a disclaimer incorporation.

30.2. For ease of reference the disclaimer as incorporated on the aforesaid screenshot is reproduced hereunder:-

BALENO

UN"OFFICIAL" WEBSITE FOR MARUTI SUZUKI BALENO

30.3. A cursory perusal of this disclaimer reveals the Respondent to have disintegrated the word UNOFFICIAL into two words viz. UN and OFFICIAL and used the word OFFICIAL in quotes after the letters UN. Thus conveying a greater thrust, emphasis and significance on the words OFFICIAL. So construed, even to a layman, the clear reading and intention of this disclaimer is to mean and signify that the website is an indeed an official website for Maruti Suzuki BALENO viz Complainant.

30.4. The Respondent alongwith its reply to rejoinder dated 12.05.2017 has placed on record a screen shot obtained from its impugned website under the impugned domain name. In this screen shot the word "UNOFFICIAL" in the disclaimer are mentioned as a single word and without any quotes. In my opinion such an incorporation is of no consequence and only furthers the malafide of the Respondent. The use of the word UNOFFICIAL (as a single word) even otherwise conveys an idea that the Respondent is not "official"

Handwritten signature/initials
~~_____~~

[official means permission derived from the proper office or officer or from proper authority] authorized website of the Complainant but is instead an "unofficial" (not in an official manner or capacity) website of the Complainant. Both the words "official" or "unofficial" do suggest an association with the Complainant viz "official" conveying acting under an authority of the Complainant while "unofficial" conveying that it is of the Complainant but not under an official capacity. The use of both these terms is extremely misleading.

30.5. On these disclaimers the word/mark **BALENO** has been incorporated in bold letters while disclaimer of no association is mentioned below it in comparatively light letters. Such a disclaimer may escape the attention of an unwary internet user who may be guided by the predominance of the word/mark **BALENO**. Thus instead of avoiding confusion the disclaimer may actually aggravate it.

30.6. Such incorporations whether as per para 30.2. above or para 30.4. above are an act in bad faith and brings out the Respondent's malafide and fraudulent intent to convey an association albeit illegal/unauthorized between it and the Complainant. The obvious motive of the Respondent is to derive unjust gains on the Complainant's business and goodwill or else why would the respondent so use it. "The thing speaks for itself" (Res Ipsa Loquitur).

30.7. Such a disclaimer or an offer to put a disclaimer of no association or connection with the Complainant would be of no effect and nor would it remedy any/the wrong as the consumers or internet users stand deceived at the threshold of logging/entering into the website by using the impugned domain name itself. Such a usage of the Domain Name has been effected by the internet user/consumer under the impression that the impugned Domain

N.K. Dandia

Name belongs to or is associated with the Complainant. By not reaching the Complainant and instead reaching the Respondent by such a use the consumer stands deceived at the very inception as he has reached a destination where he did not intend to reach at the first instance.

30.8. In this regard the observations made in the judgement of **Bosewell-Wilkie Circus (Pty) Ltd., Versus Brian Boswell Circus (Pty.) Ltd., reported in 1985 Fleet Street Report 434** can be safely relied upon. In this case the respondent sought to allay all likelihood of confusion by maintaining that its ring master in its circus prior to the commencement of each performance announces that it has "nothing to do with any other circus which is currently touring South Africa". The court rejected such a disclaimer by holding that the spectators at a particular session have already bought their tickets and are seated after all by the time they hear the announcement and consequently the confusion would therefore already have taken place.

30.9. The grant, use or conferment of disclaimers, whether voluntary or by court/judicial orders, can never be as a matter of right and nor in the usual course. To do so would amount to negation of the scheme and intent of the trade mark laws which are in gist to protect Trade Mark/Domain name, the public and promote fair dealings. To permit disclaimers as a matter of right or as a matter of course would give a license to any violator to freely use an infringing mark by simply incorporating a disclaimer. This would be against the very mandate of law. Under the guise of disclaimer an infringer cannot be protected.

30.10. In the present facts and circumstances, permitting a disclaimer to be incorporated or giving credence to an already incorporated disclaimer would in gist amount to perpetuating an illegality and putting a premium on

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dishonesty. The Respondent under the guise of such disclaimers cannot be permitted to carry on its impugned violative use and especially as its own conduct is tainted and smacks of malafide. There are no equities with the Respondent to be balanced with the Complainant's rights. Permitting such a disclaimer or any other disclaimer would amount to giving the respondent the benefit of its own wrong.

31. The Respondents contention of it being using its impugned domain name for "more than 18 months" and consequently the Complaint to be not maintainable in my view is misconceived and no benefit can accrue upon the Respondent by such an alleged use.

31.1. There is no material on record placed to show that the Complainant had actually known about such a use by the Respondent or had stood by it. Even if it was to be assumed that the Complainant had such a knowledge and had delayed its Complaint the same by itself of no consequence in law. It is settled law that mere delay or long delay is not fatal unless it fructifies into acquiescence. As to what constitutes acquiescence has been held by the Hon'ble Supreme Court in **M/s Power Control Appliances Vs. Sumeet Machines Pvt. Ltd., (1994) 2 SCC 448: 1995 (15) PTC 165 (SC).** The Hon'ble Court observed that :-

"Acquiescence is sitting by, when another is invading the rights and spending money on it. It is a course of conduct inconsistent with the claim for exclusive rights in a trade mark, trade name etc. It implies positive acts not merely silence or inaction such as is involved in laches It is important to distinguish mere negligence and acquiescence. Acquiescence is one facet of delay. If the plaintiff stood by knowingly and let the defendants built up an important trade until it had become necessary to crush it, then the plaintiffs would be stopped by their acquiescence. If the acquiescence in the infringement amounts to consent, it will be a complete defence

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The acquiescence must be such as to lead to the interference of a licence sufficient to create a new right in the defendant

The Hon'ble Supreme Court in the very same judgement in respect of acquiescence quoted **Cotton, LJ in Proctor V. Bannis (1887) 36 Ch. D740** as under :-

"It is necessary that the person who alleges this lying by should have been acting in ignorance of the title of the other man, and that the other man should have known that ignorance and not mentioned his own title".

31.2. None of the conditions set out in the aforesaid judgment stand established. The Respondent itself has placed no evidence on record showing any user leave aside credible user for the last eighteen (18) months as claimed by it. There is no evidence on record to establish that the Complainant has stood by or actually encouraged the Respondent by active steps or that the Complainant had conducted itself in any manner inconsistent with its claim for exclusive rights and that too in a manner to create a new right in the Respondent.

32. The Respondents claimed use is otherwise without cause as its adoption and alleged use of the impugned domain name is tainted at inception and being so it cannot be purified subsequently. It is beyond doubt that the Respondent was aware of the prior "baleno" Trade Mark and its use by the Complainant in relation to its (Complainant) business. That being so the Respondent must be held to be aware of the consequences which would ensue from its adoption and use of the Trade Mark "baleno" as a part of its impugned domain name. A presumption/assumption of a wrong doing and

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dishonesty to encash upon the name and reputation of the Trade Mark "baleno" and the Complainant's business thereunder can be drawn against the Respondent **[See M/s Hindustan Pencils Pvt. Ltd. Supra]**.

33.a In answer to the Respondent's assertions against the Complaint that it (the Respondent) is not misleading the general public and is only providing information on vehicle products including of that of the Complainant which is already available in public domain albeit in a different form and that the Complainant seeks to own all domains related to the Trade Mark and that the Respondent cannot be singled out the following proposition from the celebrated judgment of **Parker Knoll Ltd. Vs. Knoll International Ltd. reported in (1962) RPC 265** can safely be cited –

"BUCKLEY, L.J. in his proposition gave the answer to that when he said: "He cannot rely on the fact that his statement is literally and accurately true, if, notwithstanding its truth, it carries with it a false representation".

33.b As also the following statement of law [followed in approval by the Hon'ble Delhi High Court in its celebrated judgment in **B.K. Engineering Co. Vs. UBHI Enterprises AIR 1985 Del 210 (DB)**] from the very same **Parker Knoll Supra** judgment can be cited-

"In the interests of fair trading and in the interests of all who may wish to buy or to sell goods the law recognises that certain limitations upon freedom of action are necessary and desirable. In some situations the law has had to resolve what might at first appear to be conflicts between competing rights. In solving the problems which have arisen

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there has been no need to resort to any abstruse principles but rather, I Think, to the straight –forward principle that trading must not only be honest but must not even unintentionally be unfair”.

34. Consequently I am of the confirmed view that the Respondent has no and nor can have any right or legitimate interest in the impugned domain name and which domain name has been registered with the Sponsoring Registrar and is being so used by the Respondent in bad faith. By the Respondents impugned usage and activities under the impugned domain name loss and injury would be caused and/or likely to be caused to the Complainant and the Complainants Trade Mark “baleno” and its goodwill and standing as well as to the market trade and public.

35. Trade Marks have been accepted to be valuable business asset to be protected against their wrongful use even as part of a rival domain name and all such violations have to be removed in the interest of the right holder as also of the consumers.

36. Accordingly, the complaint must be allowed.

It is hereby decided that the disputed Domain Name www.baleno.co.in be transferred to the Complainant.

Signed at New Delhi on this 30th day of May, 2017.


Sudarshan Kumar Bansal
Sole Arbitrator