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मध्य प्रदेश MADHYA PRADESH

BEFORE THE ARBITRATOR RAJESH BISARIA
UNDER THE

IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)
[NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)]

ARBITRAL AWARD

Disputed domain name: www.suryaequipments.in
INDRP Case no -1291

SURYA ROSHNI LIMITED

Padma Tower - 1,

Rajendra Place, New Delhi - 110008, India

-----Complainant

Vs.

SURYA EQUIPMENTS PRIVATE LIMITED

B-39, M.I.D.C. Gokul Shirgaon,

Kolhapur 416234, Maharashtra, India

Email: mktg@suryaequipments.co.in

-----Respondent no. 1

VEDBIZ TECHNOLOGIES PRIVATE LIMITED

F1 - 503, Bld - A5, Shivsagar City, PH - I, S N - 17,

Wadgaon BK Pune MH 411041

Email: career@vedbiz.com

-----Respondent no. 2



THE PARTIES

The **Complainant** is SURYA ROSHNI LIMITED having its Corporate office mailing address -Padma Tower - 1, Rajendra Place, New Delhi – 110008, India

The **Respondent no. 1** is SURYA EQUIPMENTS PRIVATE LIMITED, having its mailing address B-39, M.I.D.C. Gokul Shirgaon, Kolhapur 416234, Maharashtra, India

The **Respondent no. 2** is VEDBIZ TECHNOLOGIES PRIVATE LIMITED, having its registered mailing address-FI - 503, Bld - A5, Shivsagar City, PH - I, S N - 17, Wadgaon BK Pune MH 411041

THE DOMAIN NAME AND REGISTRAR

- 1 The disputed domain name: www.suryaequipments.in is registered with GoDaddy.com, LLC as per the WHOIS records.

PROCEDURAL HISTORY

2

The .IN REGISTRY appointed RAJESH BISARIA as Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of procedure.	05.11.2020
Arbitral proceedings were commenced by sending notice to Respondent through e-mail as per paragraph 4(c) of INDRP Rules of Procedure, marking a copy of the same to Complainant's authorized representative and .IN REGISTRY.	05.11.2020
Due date for filing Response by Respondent	15.11.2020
Respondent submitted application seeking additional time to file the reply by 19.11.2020	13.11.2020
Which was accepted and communicated by AT	15.11.2020
Respondent's response by submitting their Statement of Defense	19.11.2020
Complainant's response by submitting their Rejoinder.	26.11.2020



Request received from Respondent for online, in person hearing.	01.12.2020
Date for oral hearing fixed for 14.12.2020 by AT on	05.12.2020
Details of payment for the said hearing by Respondent Rs 2360/-, Reference no. N344201335794884 dated 09.12.2020	11.12.2020
Written Synopsis submission by Complainant	18.12.2020
Written Synopsis submission by Respondent	19.12.2020
The language of the proceedings.	English

FACTUAL BACKGROUND

3 The Complainant :

The **Complainant** is **SURYA ROSHNI LIMITED** having its Corporate office mailing address -Padma Tower - 1, Rajendra Place, New Delhi – 110008, India, with concerned person ; Mr. Rajeev Kothari (Vice President – Taxation and Legal Head at Surya Roshni Limited) and The Complainant's Attorneys in this administrative proceeding is Mr. Shrihar Tripathi [D/2299/2017], Mr. Harihar Tripathi [D/2917/2017], Ms. Poonam Yadav [D/9246/2019] and all other Advocates of BoostIP- Advocates and IP Attorneys at address A-303, Shikhar Enclave, Sector-15, Vasundhra, Ghaziabad, Uttar Pradesh - 201012; Contact number +91-9548888420; Email: legal@boostip.in .

4 The Respondent:

The **Respondent no. 1** is **SURYA EQUIPMENTS PRIVATE LIMITED**, having its mailing address B-39, M.I.D.C. Gokul Shirgaon, Kolhapur 416234, Maharashtra, India with authorized signatory Shri Vidyadhar Kulkarni, Managing Director and The Complainant's Advocate is Shri Ashish V. Sonwane, 507, Fortuna, Near Shivar Chowk, Pimple Saudagar, Pune – 411027



The **Respondent no. 2** is **VEDBIZ TECHNOLOGIES PRIVATE LIMITED**, having its registered mailing address-F1 - 503, Bld - A5, Shivsagar City, PH - I, S N - 17, Wadgaon BK Pune Pune MH 411041

5 Complainant's Activities:

- (a) The complainant company, Surya Roshni limited, is one of the largest Indian multinationals with a revenue of USD\$840 million (6,000 crores INR) (around) for the year ending 2018-19, which was setup in the year 1973 with a small steel pipe unit in Bahadurgarh, Haryana (around 30 Kms away from Delhi). The Complainant was incorporated in the year 1973 and has been promoted by Shree Basudev Agarwal and his son Shri J.P. Agarwal. The revenue of the complainant company SURYA in the financial year 2015-2020 is ranging from Rs 3198.35 Cr to Rs 5471.05 Cr.
- (b) The Complainant began its lighting business in the year 1983 with the setting up its lighting products factory in the year 1984 at Kashipur, Uttar Pradesh followed by the second factory in the year 1992 in Malanpur, Madhya Pradesh. Other than the steel and lighting business, the Complainant also deals in Home Appliances, Fans, Geysers, Water Heaters, and other Heating and Cooking Appliances, CPVC/UPVC pipes and fittings, Solar lightning and solar operated Equipments, devices and various other products.
- (c) The Complainant company and their predecessors-in-title have been carrying on the business of manufacturing, marketing, exporting of variety of products such as Heating products including water heaters, geysers, immersion heaters, room heaters, air heaters and many more; etc and various other electrical devices and equipments, Also, PVC pipes including CPVC and fittings, UPVC pipes, Pressure pipes and fittings, Expansion loop etc. since year 1973 and thereafter. The 'SURYA' brand has now become a household mark through its use in almost every home since 5 decades of legacy in the Indian market. All the said goods and services of the Complainant are well covered in trademark classes from 1 to 42 of the Trade Marks Act, 1999.



- (d) Over the years and decades, the Complainant has grown into a leading player in the business of heating appliances, lighting and home appliances apart from other sectors. The Complainant not only caters to the Indian public but has presence in around 44 countries worldwide including Bangladesh, Pakistan, Sri Lanka, Nigeria, China, Algeria etc.

6 Complainant's Trade Marks And Domain Names :

- (a) That the Complainant owns and maintains a website www.surya.co.in which is the corporate website of the Complainant and detailed information about history, activities, products etc. of the Complainant can be obtained there from. The website acts as medium of communication between the Complainant and its consumers and affiliates. From the said website information can be obtained about the products and services offered by the Complainant.
- (b) The Complainant is the owner and the Registered Proprietor of the well-known Trade Mark 'SURYA' and variations thereof, which are registered under different classes before the Trade Mark Registry since as early as the year 1981.
- (c) The word 'Surya' also forms a forepart and is the most distinguishing feature of the Complainants corporate name and trading style. The trade mark 'SURYA' has been registered in India since as early as the year 1981 and has been maintained continuously since those days by the Complainant.

7 Respondent's Identity and activities :

- (a) The Respondent no. 1 is SURYA EQUIPMENTS PRIVATE LIMITED, having its mailing address B-39, M.I.D.C. Gokul Shirgaon, Kolhapur 416234, Maharastra, India.
- The Respondent no. 2 is VEDBIZ TECHNOLOGIES PRIVATE LIMITED, having its registered mailing address-F1 - 503, Bld - A5, Shivsagar City, PH - I, S N - 17, Wadgaon BK Pune Pune MH 411041



- (b) Respondent no 1 company was formulated in the year 1988 and its Incorporation number is 11-47650 of 1988 issued at Bombay on 08/06/1988 and its Corporate Identity Number (CIN) – U29129PN1988PTC047650. That the Respondent no 1 company operates in the field of Industrial Space-saving Storage Systems, with a novel concept of 'Movable Racks'. That in past 32 years of its operations, "Surya Equipments P Ltd" has developed goodwill and it has now become a "Go-to-brand" for the Industrial Storage Solutions. That the founder of the Respondent no 1, Vidyanandhas also worked in various industry bodies and trusts including 'Laghu Udyog Bharati' and "Srujan Trust" and has been very active in the promotion of 'Entrepreneurship'. He is also on the Board of Directors of 'Janata Sahakari Bank, Pune' one of the leading scheduled Co-op Bank within the state of Maharashtra.

SUBMISSIONS BY COMPLAINANT

- 8 Complainant submitted Domain name complaint with pages 1 to 23 and annexure from pages from 24 to 130. As per the INDRP Rules of Procedure, Clause 4(a) – *The (maximum) word limit shall be 5000 words for all pleadings individually (excluding annexure). Annexure shall not be more than 100 pages in total. Parties shall observe this rule strictly subject to Arbitrator's discretion.*

The Complainant more or less followed this Clause in submitting the above documents.

THE CONTENTIONS OF THE COMPLAINANT

- 9 **The domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights**

- (a) The trade mark 'SURYA' has been registered in India since as early as the year 1981 and has been maintained continuously since those days by the Complainant.



The aforesaid registrations for the Trade Mark 'SURYA' have been renewed from time to time and are valid and subsisting. By the virtue of the said registrations the complainant has the exclusive right to use the Trade Mark 'SURYA' in relation to the goods for which the Mark is registered.

- (b) The complainant also holds various copyright registrations for the 'SURYA' trade mark label which was specifically designed and the said artistic lettering style being a unique design stands registered under the Copyright Act, 1957, under Nos. . A-129617/2019, A-86580/2009, A-64247/2003, A-61394/2002, A-60433/2002, A-55046/1998, A-54370/1997 and A-51050/1991. The copies of the above mentioned copyright registration certificates are exhibited as ANNEXURE – H.
- (c) By the virtue of numerous registrations, the vast and extensive sales in India and abroad, publicity and marketing of Complainants mark SURYA since as early as the year 1973 including advertisements and promotions on numerous authorized internet websites and excellent quality of goods in relation to which the Complainants mark is used in various countries, the Complainant has earned substantial reputation and valuable goodwill amongst the member of the trade and public so much so that any use of the Mark would invoke an instant and spontaneous association by the members of the trade and public with the Complainant and their quality products. Thus, the Complainants mark 'SURYA' has become a well- known mark.
- (d) When the Complainant came across an imposter website registered under the impugned domain name with the respondents, the complainant got shocked to note that the Respondents has created domain in year 2019 which is infringing upon the registered trademark of the Complainant.
- (e) Using the Complainant's registered trademark and well known brand 'SURYA', as the most prominent part of the impugned domain name. Upon a bare perusal of the website, the Complainant learned that the Registrant / Owner of the website flagrantly used the Complainant's registered trademark on the said



website for promoting services, which were identical to the goods and services of the Complainant Company in respect to its brand 'SURYA'.

- (f) The Respondent flagrantly and prominently used the Complainant's well known trademark and the immensely popular label "SURYA" as "SURYA EQUIPMENTS" for the identical goods & services.
- (g) It is apparent that the Complainant's arbitrary and unique trademark 'SURYA' is the most striking and essential feature of the impugned domain i.e. <www.suryaequipments.in>. Owing to confusing similarity of the impugned domain name with the Complainant's registered trademarks, the customers and internet users, are *inter alia* bound to:
 - (i) Visit the website, which is hosted on the impugned domain name, under pretext that the same belong to the Complainant;
 - (ii) Believe that the Respondent's business is an another vertical of complainant group or the Respondents are closely associated with the Complainant;
 - (iii) The Respondent is providing quality products and services as provided by the Complainant.

10 The Respondent has no rights or legitimate interests in respect of the domain name

- (a) It is much apparent that the Respondent has adopted and is using the highly deceptive domain name to usurp the immense reputation and goodwill associate with the Complainant's trademark. Admittedly, the Complainant is the registered proprietor and owner of the trademarks 'SURYA', 'SURYA ROSHNI' etc. and hence, the Respondent has no right or legitimate interest in respect of the impugned domain name, other than that of reaping undue benefit.

11 The domain name was registered and is being used in bad faith

- (a) It is amply clear that the Respondent / Website owner has adopted the impugned domain name with *mala fide* to:
 - Impersonate itself as the Complainant;



- Misrepresent itself and Pass off its unauthorized, spurious and substandard products and services as that of the Complainant; and
 - Misappropriate the Complainant's reputation, goodwill and customer loyalty for its own wrongful profits.
- (b) It is submitted that by use of impugned domain name, which clearly suggest that the Respondent is an authorized or somehow connected to the Complainant, it is much likely possible that the Respondent has already deceived, cheated and has duped several unwary customers of the Complainant. Such misrepresentation and cheating by way of impersonation, can have dire consequences involving hazardous accidental calamity and threat to life of the consumer. It is therefore submitted that in addition to causing blatant infringement of the Complainant's exclusive rights, the Respondent also pose grave danger to the customers, who are entrapped through the impugned domain name. The impugned domain name is thus registered under bad faith and hence be deleted / handed over to the Complainant.
- (c) It is submitted that undoubtedly, the Respondent / website owner registered and used the impugned domain name to attract the existing and potential customers of the complainant for commercial gain. It is verily believed that the Respondent has deceived the unwary customers, who may have availed the Respondents' products and services under confusion that the said products and services are offered by or are affiliated by the Complainant.

12 Remedy Sought:

Complainant prayed to grant the following relief:

In view of the aforesaid facts and circumstances, it is respectfully prayed to the Hon'ble Tribunal that it may be pleased to:

- (a) Transfer the impugned domain name, namely <www.suryaequipments.in> to the Complainant; and/or
- (b) Cancel the impugned domain name; and/or
- (c) Award cost of the proceedings to the Complainant;



And may pass any other or further order as it may deem fit in the interest of justice and in the interest of the Complainant.

13 Other Legal Proceedings

It is submitted that the complainant has not initiated any other legal proceeding against the impugned domain name.

RESPONSE BY THE RESPONDENT

14 Respondent submitted their Statement of Defence (reply to the Domain name complaint) with pages 1 to 15 and annexure from pages from 16 to 94. As per the INDRP Rules of Procedure, Clause 4(a) – *The (maximum) word limit shall be 5000 words for all pleadings individually (excluding annexure). Annexure shall not be more than 100 pages in total. Parties shall observe this rule strictly subject to Arbitrator's discretion.*

The Complainant followed this Clause in submitting the above documents.

15 Respondent Submitted their **Statement of Defence** as follows-

- (a) Firstly Respondent submitted preliminary and legal objection regarding non submission of complaint in accordance with the INDRP Rules of the Procedure.
- (b) That the main claim of the complainant is based on its registered generic/ weak trademark "SURYA". The word Surya is a generic word which means the Sun, the source of life on the planet and the Hindu deity. The name Surya being a generic mark must not have been registered as a Trade Mark as per the provisions of the section 9 of the Trade Marks Act, 1999 or as per the provisions of the 1958 act.
- (c) The name Surya is very commonly used in India, apart from the names of individuals. As per the data available on the Website of the Ministry of Corporate Affairs(MCA), there are 200 companies whose names starts with



Surya. Likewise, as per the data available from the website of the IPO, Trade Name "Surya" has been registered hundreds of times in various categories, including the categories listed in the complaint. It indicates the commonality and popularity of the said name and hence make it a generic/weak trade name/mark. Respondent no 1 has been operating under the said name since the year 1988 and has been carrying out its business in the domain of "Space Saving Mobile Storage System (Manual and Motorized) and Automated Storage and Retrieval Systems (ASRS)".

- (d) That the respondent no 1 is the market leader in its domain and has its systems installed in the corporate offices, leading pharmaceutical companies, banks and other manufacturing companies. Most of the Pharma Giants (Lupin, Abott, Cipla, Glaxo, Microlab, Sun Pharma, Torrent etc) are the customers of the Respondent no 1. That the major Indian competitors to the business of the respondent no 1 are – Godrej (Storage Solution group), Vinar Systems, Nilkamal Ltd (Formerly Nilkamal Bito), Kompress Ltd., whereas the international competitors include Scheffer Systems, Kardex Systems, Mecaulux, HK System. It is pertaining to note that, the respondent no 1 and the complainant are neither the competitors of each other, nor the complainant operates in the domain of business of the respondent no 1.
- (e) That, customers of the respondent no 1 involve it with multiple projects and repeat orders that indicates the trust and goodwill it has earned in Space Saving Mobile Storage System (Manual and Motorised) Equipments with its 32 years of existence. That the respondent no 1 supplies the storage systems throughout India and also exports internationally to Bangladesh, Brazil, Malaysia, Morocco, etc. Revenue figures for the respondent no 1 company since 2015-16 to 2019-20 ranges from Rs 165189621/- to Rs 297803361/-
- The copies of the certificate of incorporation along with the list of clients and the Brochures of the respondent no 1 and some of the latest invoices were annexed at ANNEXURE - A.



- (f) That the products of the respondent no 1 are neither identical nor similar with that of the offerings of the complainant. Following table compares the business operations of the parties on various critical factors.

Sr No.	Criteria	Respondent No1	Complainant
01	Area of Business: Products and Services offered	Space Saving Mobile Storage System (Manual and Motorised) Systems	Lights, Still Pipes and CR Strips, PVC Pipes, Fans, Home Appliances.
02	Business Model	B2B: Business to Business	B2C: Business to Customers
03	Sales channels	Wholesale to industries through references	Online and Offline Retail through distribution channels
04	Possibility of overlapping business	No	No
05	Average price of Goods and Services	In the range of 1-10 lakhs of Rupees	Less than Rs 100 for lighting products to under a lakh for Home Appliances. The major driver for the revenues for the complainant.

- (g) That, the respondent no1 registered the domain name, "suryaequipments.co.in" in the year 2005 and has been using it for its emails since then. It indicates that the respondent no 1 is using the said domain for very long period of 15 years. The respondent no 1 is relying on the "Pro Quidity B.V. v. Domains by Proxy LLC (WIPO Domain Name Decision: D2014-0765)" to ascertain the legitimacy of the usage of the domain name: "suryaequipments.co.in" since 2005. Interestingly it is the same year, when the domain name "surya.co.in" of the complainant was registered.

That moreover, the respondent is relying on the "Étro S.p.A. v. Hernan Villalobos (WIPO Domain Name Decision: D2014-0264)" wherein it has been ascertained the continuous and bona fide usage of the domain/trade name is sufficient to establish the legitimacy of the respondent over its domain/trade



names including the impugned domain name. The WHOIS report for the said domain names is annexed with the present reply at ANNEXURE -B.

- (h) That, the impugned domain name, i.e. SuryaEquipments.in has been registered in the year 2019 as part of the new business strategy for the respondent no 1 company. That with the advent of the technology it became imperative for every business to have online presence and demonstrate the products through digital channels. That therefore with the new domain name the respondent no 1 company has come-up with modern website and digital presence with interactive content displaying the effectiveness of its storage systems. The respondent no 1 company also created social media channels/profiles on YouTube, Facebook, Twitter and LinkedIn. That the links of the social media channels of the respondent no 1 are as mentioned in the following table:

Sr	Name	Link
1	Facebook	https://www.facebook.com/pg/Surya-Equipments-Pvt-Ltd-2170067059684205
2	YouTube	https://www.youtube.com/channel/UC4JKG1pGCcxjUQQzoWI604g
3	LinkedIn	https://www.linkedin.com/in/SuryaEquipments
4	Twitter	https://twitter.com/SuryaEquipments

- (i) That the respondent no 1 has been using the said social media channels for the legitimate promotion of its business only. That in order to develop the new age digital content the respondent no 1 company have engaged professional content creators and web development companies. That, the invoices for the payment done to the vendors and the screenshots of the respondent no 1 website and the said social media pages are collectively annexed at ANNEXURE - C.
- (j) The respondent no 1 is the member of various industry bodies such as EEPC, Chamber of Commerce, Laghu Udyog Bharti, etc. and has been serving various top companies for their storage requirements. That the respondent no 1 has also received very positive feedback/certificate even from the Department of Revenue of the Ministry of Finance, Government of India in the year 2007.



Respondent no 1 also received positive testimonials from its clients. The copy of the certificate and photo of a trophy received from one of its clients, Abbot as recognition, are collectively annexed at ANNEXURE - D.

- (k) Therefore, it is very clear from the facts presented herein above, that the respondent no 1 has been using the impugned domain name for the legitimate and bona fide purpose of carrying out its business. There is no similarity between the businesses of the complainant and the respondent no 1. Hence, it can be concluded that the respondent no 1 did not use the impugned domain name in bad faith and the complainant can't prove the same as per the mandate of the INDRP rules of procedure para 4 (vi). Therefore, in view of the above-mentioned mandate and facts the complaint is liable to be rejected/dismissed with exemplary cost.
- (l) That as mentioned above the respondent no 1 company was formulated in the year 1988 and its Incorporation number is 11-47650 of 1988 issued at Bombay on 08/06/1988 and its Corporate Identity Number (CIN) – U29129PN1988PTC047650.

REJOINDER BY THE COMPLAINANT

- 16 Complainant submitted their Rejoinder (along with the supporting affidavit with pages 1 to 32) as follows.
- 17 That the Complainant is the registered proprietor of the trademark SURYA in various classes since as early as the year 1981. The Complainant also has registrations in classes 20, 37 and 39, which being the relevant classes for the Respondent's goods and services under the impugned domain name.
- 18 That the Respondent neither has any trade mark registration in its favour nor any pending trade mark application. It is submitted that the Respondent has deliberately not filed any application being well-aware of the Complainant's well-known trade mark SURYA



19 That the impugned domain name has been registered on 22.01.2019 and as soon as the Complainant came across the impugned domain name appropriate proceedings were initiated.

20 Complainant referred and relied on

Inter-Continental Hotels Corporation vs. Abdul Hameed (INDRP/278) as well as *Indian Hotels Company Limited vs. Mr. Sanjay Jha (INDRP/148)* wherein it is held that when a disputed domain name incorporates a mark in entirety, it is adequate to prove that the disputed domain name is either identical or confusingly similar to the mark

Kenneth Cole Productions Vs. ViswasInfomedia, INDRP/093 wherein it is held that there is confusing similarity when the disputed domain name wholly incorporates the Complainant's trade mark, then it is bound to cause confusion and deception in the minds of the public.

21 That the Respondent has unsuccessfully tried to contend that the goods/ services offered via the impugned domain name are different than those of the Complainant. It is submitted that the goods/ services of both the Complainant and the Respondent are in respect of a common target customer base and are similar and related.

ORAL HEARING ON 14.12.2020

22 Oral hearing was conducted on 14.12.2020 . Both the parties submitted their facts and evidences regarding the disputed domain. As per the directives of the AT , Complainant & Respondent submitted written synopsis on 18.12.2020 & 19.12.2020 respectively.

DISCUSSION AND FINDINGS

23 After going through the correspondence, this AT comes to the conclusion that the Arbitral Tribunal was properly constituted and appointed as per Clause 5 of the



INDRP Rules of Procedure and Respondent has been notified of the complaint of the Complainant. In fact, no parties raised any objection over constitution Tribunal.

24 Under Clause 4, of the .IN Domain Name Dispute Resolutions policy (INDRP), the Complainant must prove each of the following three elements of its case:

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

25 The Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

Complainant

- (a) The trade mark 'SURYA' has been registered in India since as early as the year 1981 and has been maintained continuously since those days by the Complainant.
- (b) The aforesaid registrations for the Trade Mark 'SURYA' have been renewed from time to time and are valid and subsisting. By the virtue of the said registrations the complainant has the exclusive right to use the Trade Mark 'SURYA' in relation to the goods for which the Mark is registered. (Annexure G, PAGES 79 to 114) (PRAKASH SURYA, SURYA, SURYA (LABEL), SURYA POWERLITE, SURYA ROSHNI, SURYA SLIMLITE, SURYA CHALLENGER & DEVICE OF SUN (DEVICE), SURYA HBT, SURYA (LABEL), SURYA POWER SAVER, SURYA WHEN THE SUN SETS SURYA RISES, SURYA WITH LABEL, SURYA TMT BARS (WITH DEVICE))



- (c) Respondent neither has any trade mark registration in its favour nor any pending trade mark application
- (d) The complainant also holds various copyright registrations for the 'SURYA' trade mark label which was specifically designed and the said artistic lettering style being a unique design stands registered under the Copyright Act, 1957, under Nos. A-129617/2019(title of work-Surya Every City Every Home, dated 30.05.2019), A-86580/2009(Surya Prakash ARLP-S, dated 10.08.2009), A-64247/2003(Surya, dated 17.03.2003), A-61394/2002(Surya dated 20.05.2002),A-60433/2002(Surya Utility, dated 03.01.2002), A-55046/1998(Surya dated 17.08.1998), A-54370/1997(Surya Roshini Ltd, date – not clear) and A-51050/1991(Surya Roshini Limited, date –not clear). The copies of the above mentioned copyright registration certificates (ANNEXURE – H).
- (e) The Complainant has earned substantial reputation and valuable goodwill amongst the member of the trade and public so much so that any use of the Mark would invoke an instant and spontaneous association by the members of the trade and public with the Complainant and their quality products. Thus, the Complainants mark 'SURYA' has become a well- known mark.
- (f) Respondents has created domain in year 2019 which is infringing upon the registered trademark of the Complainant.
- (g) The Respondent flagrantly and prominently used the Complainant's well known trademark and the immensely popular label "SURYA" as "SURYA EQUIPMENTS" for the identical goods & services.
- (h) It is apparent that the Complainant's arbitrary and unique trademark 'SURYA' is the most striking and essential feature of the impugned domain i.e. <www.suryaequipments.in>. Owing to confusing similarity of the impugned domain name with the Complainant's registered trademarks, the customers and internet users, are *inter alia* bound to:



- Visit the website, which is hosted on the impugned domain name, under pretext that the same belong to the Complainant;
- Believe that the Respondent's business is an another vertical of complainant group or the Respondents are closely associated with the Complainant;
- The Respondent is providing quality products and services as provided by the Complainant.

Respondent

- (i) That the main claim of the complainant is based on its registered generic/ weak trademark "SURYA". The word Surya is a generic word which means the Sun, the source of life on the planet and the Hindu deity. The name Surya being a generic mark must not have been registered as a Trade Mark as per the provisions of the section 9 of the Trade Marks Act, 1999 or as per the provisions of the 1958 act.
- (j) The name Surya is very commonly used in India, apart from the names of individuals. As per the data available on the Website of the Ministry of Corporate Affairs(MCA), there are 200 companies whose names starts with Surya.
- (k) That it is pertaining to note that, the respondent no 1 and the complainant are neither the competitors of each other, nor the complainant operates in the domain of business of the respondent no 1.
- (l) That the products of the respondent no 1 are neither identical nor similar with that of the offerings of the complainant.
- (m) That, the respondent no1 registered the domain name, "suryaequipments.co.in" in the year 2005 and has been using it for its emails since then. It indicates that the respondent no 1 is using the said domain for very long period of 15 years.



- (n) The respondent no 1 is relying on the Pro Quidity B.V. v. Domains by Proxy LLC(WIPO Domain Name Decision: D2014-0765) and Etro S.p.A. v. Hernan Villalobos (WIPO Domain Name Decision: D2014-0264).
- (o) That, the impugned domain name, i.e. SuryaEquipments.in has been registered in the year 2019 as part of the new business strategy for the respondent no 1 company. (Created on 22.01.2019 , page 24 annexure B, of SOC).

Facts & Findings

- (p) Complainant had registered trade mark 'SURYA' in India on 02.01.1982 (page 82 of SOC) and holds various copyright registrations for the 'SURYA' trade mark label from 1997 as mentioned in above para 25 (b). The Complainant's domain www.surya.co.in was registered on 30.01.2005 (page 60 of SOD) Respondent no 1 company was formulated in the year 1988 and registered the domain name, "suryaequipments.co.in" on 18.10.2005 (page 57 of SOD) and has been using it for its emails since then. Respondent no 1 registered the impugned domain www.suryaequipments.in on 22.01.2019. Respondent neither has any trade mark registration in its favour nor any pending trade mark application. Looking to this facts , it is crystal clear that impugned domain www.suryaequipments.in was registered by Respondent no 1 , after a reasonable big lapse of complainant's registration of SURYA trademark and their domain www.surya.co.in
- (q) The dispute domain name subsumes the entire trade mark SURYA of the Complainant. When a disputed domain name incorporates a mark in entirety, it is adequate to prove that the disputed domain name is either identical or confusingly similar to the Complainant's Trade mark.
- (r) It cannot be overlooked that whenever a domain name registration is sought, ample professional efforts need to be made to make sure that there is no pre existence of same or similar domain names on the world wide web, so as to



avoid any intentional or unintentional imbroglio or illegality of its operation and to ensure that no illegality are committed.

- (s) There is confusing similarity when the disputed domain name wholly incorporates the Complainant's trade mark, then it is bound to cause confusion and deception in the minds of the public.
- (t) It is to believe that Complainant has earned substantial reputation and valuable goodwill amongst the member of the trade and public so much so that any use of the Mark would invoke an instant and spontaneous association by the members of the trade and public with the Complainant and their quality products.
- (u) Owing to confusing similarity of the impugned domain name with the Complainant's registered trademarks, Respondent's domain name is likely to cause confusion, mistake and deception, and hence constitutes infringement of Complainant's domain name and trademark, as well as constituting unfair competition.
- (v) Thus this Arbitral Tribunal comes to the conclusion that the disputed domain name www.suryaequipments.in is confusingly similar or identical to the Complainant's domain name www.surya.co.in and Trade mark (SURYA).
- (w) On the basis of the above facts and various judgments, the Arbitral Tribunal concludes that the Complainant has established 4(a) of the .IN Domain Name Dispute Resolution Policy (INDRP) and accordingly satisfies the said Clause of policy.

26 The Respondent has no rights or legitimate interest in respect of the domain name:



Complainant

- (a) Complainant had invested huge amount of money in popularizing and seeking registration of its trade mark SURYA and domain name and had generated huge revenues under its trade mark SURYA and thereby attained the status of a well-known mark. Therefore, the impugned adoption is prima facie dishonest just to ride on the Complainant's goodwill and reputation.
- (b) It is amply clear that the Respondent / Website owner has adopted the impugned domain name with *mala fide* to:
 - A Impersonate itself as the Complainant;
 - B Misrepresent itself and Pass off its unauthorized, spurious and substandard products and services as that of the Complainant; and
 - C Misappropriate the Complainant's reputation, goodwill and customer loyalty for its own wrongful profits.
- (c) It is much apparent that the Respondent has adopted and is using the highly deceptive domain name to usurp the immense reputation and goodwill associate with the Complainant's trademark. Admittedly, the Complainant is the registered proprietor and owner of the trademarks SURYA and hence, the Respondent has no right or legitimate interest in respect of the impugned domain name, other than that of reaping undue benefit.

Respondent

- (d) That the products of the respondent no 1 are neither identical nor similar with that of the offerings of the complainant.
- (e) An affidavit is given by the designer of the logo of the respondent and copies of the old payments and brochures made to the designer (Exb – D of Additional Affidavit)
- (f) Genuine and Unblemished track record of the respondent:
 - (i) Brochures indicating a list of clients
 - (ii) Copies of the certificates and accolades received by the respondent.



- (iii) Copies of the POs and SOs of high value issued to the respondent by some of its eminent clients such as Cipla, Serum and Lupin Ltd.
- (iv) CA audited profit and loss statements of the respondent since its inception (Exb – E of the Additional Affidavit)

Facts & Findings

- (g) Respondent no. 1 registered the domain name, “suryaequipments.co.in” on 18.10.2005 (has been using it for its emails since then) and the impugned domain www.suryaequipments.in on 22.01.2019. Respondent neither has any trade mark registration in its favour nor any pending trade mark application.
- (h) Respondent’s submission regarding products of both the parties being similar or identical was refuted by Complainant. The goods/ services of both the Complainant and the Respondent are in respect of a common target customer base and are similar and related.
- (i) It is established that Respondent neither has any legitimate interest in the trade mark SURYA nor is the lawful owner of any right relating to the Complainant’s mark. The Respondent no.1 bears no relationship to the business of Complainant and is neither a licensee nor has obtained authorization of any kind whatsoever to use the Complainant’s mark.
- (j) Thus this Arbitral Tribunal comes to the conclusion that the Respondent no. 1 does not have any rights or legitimate interest/intention to use the impugned domain name and it intends to make unjust commercial profits.
- (k) On the basis of the above submitted facts and various judgments , the Arbitral Tribunal concludes that the Complainant has established Clause 4(b) of the .IN Domain Name Dispute Resolution Policy (INDRP) and accordingly satisfies the said Clause of policy.



27 The Respondent's domain name has been registered or is being used in bad faith:

Complainant

- (a) It is amply clear that the Respondent /web site owner has adopted the impugned domain name with mala fide to
- i. Impersonate itself as the Complainant;
 - ii. Misrepresent itself and Pass off its unauthorized, spurious and substandard products and services as that of the Complainant; and
 - iii. Misappropriate the Complainant's reputation, goodwill and customer loyalty for its own wrongful profits.
- (b) It is extremely unlikely that the Respondent created the impugned domain name independently. It is submitted that the Respondent was free to adopt any domain name instead of one comprising of the Complainant's trade mark SURYA in its entirety.
- (c) It is submitted that the Respondent has intentionally attempted to attract for commercial gain and to benefit from the goodwill and fame associated with the Complainant's trade mark SURYA and domain www.surya.co.in. Attract internet users to the impugned domain and its website thereon, by misleading them and creating a likelihood of confusion with the Complainant's trade mark as to the source, sponsorship, affiliation or endorsement of the said website.
- (d) It is submitted that in addition to causing blatant infringement of the Complainant's exclusive rights, the Respondent also pose grave danger to the customers, who are entrapped through the impugned domain name. The impugned domain name is thus registered under bad faith.

Respondent

- (e) That the contentions made in the paras as above are denied being false, imaginary and baseless.



- (f) Referred screenshots of the website and social media pages of the complainant (Exb – C of the Additional Affidavit)
- (g) Referred screenshots of the respondent's Website & Social Media Pages. (Exb – C Statement of Defence)
- (h) The complainant has claimed that it has established a toll-free line at 1800-102-5657 for its consumers to verify and validate the genuine Surya Products. However, the complainant could not refer to even a single complaint received against the respondent through the said toll-free number or any other means. (Pls refer para 15 of the complainant, page 7)
- (i) The way the complaint has been structured it appears that complainant follows a blanket template to threaten legitimate businesses by initiating false, vexatious and defamatory tactics. Such attempts to use the judicial process by demonstrating bad faith must be discouraged and an example must be set by awarding exemplary cost against such predatory practices.

Facts & Findings

- (j) It seems that Respondent's choice of domain name is not accidental and has been made with a view to derive unfair monetary advantage.
- (k) Looking to the prominence and well-known status of the Complainant's products and services , it is incomprehensible that the Respondent would have been unaware of the Complainant's trade mark SURYA at the time when the disputed domain.name was registered.
- (l) Plaintiffs are not supposed to chase every insignificant infringer. They can wait till the time the user of their name /mark starts harming their business interest and starts misleading & confusing their customers. Here the case is exactly same by the use of impugned domain, the interest of Complainant get affected as whole.



- (m) Respondent has intentionally attempted to attract for commercial gain and to benefit from the goodwill and fame associated with the Complainant's trade mark SURYA and domain www.surya.co.in.
- (n) Thus this Arbitral Tribunal comes to the conclusion that the Respondent no. 1 impugned domain is registered or being used in bad faith.
- (o) On the basis of the above submitted facts and various judgments, the Arbitral Tribunal concludes that the Complainant has established Clause 4(c) of the .IN Domain Name Dispute Resolution Policy (INDRP) and accordingly satisfies the said Clause of policy.

28 Domain Name Hijacking:

- (a) Respondent submitted in their Statement of Defence that UDRP rules define Reverse Domain Name Hijacking as using the policy in bad faith to attempt to deprive a registered domain name holder of a domain name.
- (b) Complainant has made this complaint with an attempt at forfeiting domain name hijacking or was brought primarily to rightly support the true domain holder. Complainant submitted his complaint in good faith without primarily to harass Respondent and constitute true use of administrative proceedings. This is already established in above Para 46, that Respondent no. 1 impugned domain is registered or being used in bad faith. After going through various documents submitted by Complainant, it is very well established that the complainant filed this complaint without any ulterior motive. So it is concluded by AT that the present complaint of the Complainant is an effort to save their trade mark & domain name from the impugned domain of Respondent with no intention to harass or abuse the process of law.



ARBITRAL AWARD

29 Now I, Rajesh Bisaria , Sole Arbitrator, after examining, hearing and considering the statements of both the parties and oral & documentary evidence produced before and having applied mind and considering the facts, documents and other evidence with care, do hereby publish award in accordance with Clause 13 of the INDRP Rules of Procedure , as follows:


Arbitral Tribunal orders that the Respondent shall cease to use the mark SURYA and also disputed domain name www.suryaequipments.in be transferred to the Complainant.

Further AT takes an adverse view on the bad faith registration of impugned domain by the Respondent and to restrict the act for future misuse, fine of Rs 10000/-(Rs Ten thousand only) is being imposed on the Respondent, as per the provision in clause 10 of .IN Domain Name Dispute Resolution Policy (INDRP) to be paid to NIXI for putting the administration unnecessary work.

AT has made and signed this Award at Bhopal (India) on **04.01.2021** (Fourth Day of January, Two Thousand Twenty One).

Place: Bhopal (India)

Date: 04.01.2021


(RAJESH BISARIA)
Arbitrator

