



सत्यमेव जयते

# INDIA NON JUDICIAL Government of Uttar Pradesh

e-Stamp

Signature.....  
ACC Name: RAHUL VERMA. ACC Code: UP14003004  
ACC Add: Sub-Registrar, Noida, Mob. 9810434882  
License No.: 115/10, Tehsil & Distt. Dadri, G. B. Nagar, UP

<b>Certificate No.</b>	: IN-UP36832411226378T
Certificate Issued Date	: 19-Feb-2021 12:41 PM
Account Reference	: NEWIMPACC (SV)/ up14003004/ NOIDA/ UP-GBN
Unique Doc. Reference	: SUBIN-UPUP1400300463650410734241T
Purchased by	: PUNITA BHARGAVA
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	:
First Party	: PUNITA BHARGAVA
Second Party	: Not Applicable
Stamp Duty Paid By	: PUNITA BHARGAVA
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



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BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA  
.IN REGISTRY

Arbitral Award in Case No. 1348  
Ms. Punita Bhargava, Sole Arbitrator  
Disputed domain name: <hylandsoft.co.in>

**In the matter of**

Hyland Software, Inc  
28500 Clemens Road  
Westlake OH 44145  
United States of America

... Complainant

v.

Charles Mason  
1471 by A, NH16  
Near ISKON Temple  
Nayapalli, Bhubaneswar  
Orissa- 751015

... Respondent

**1. The Parties**

The Complainant in this proceeding is Hyland Software, Inc., a company duly organized and existing under the laws of the United States of America, having its address at 28500 Clemens Road, Westlake OH 44145, United States of America and is represented by attorneys Tia Malik and Manas Upmanyu of Lall & Sethi, of the address D-17, South Extension – II, New Delhi – 110049. The Respondent in this proceeding is Charles Mason of the address 1471 by A, NH16, Near ISKON Temple, Nayapalli, Bhubaneswar, Orissa- 751015.

**2. Disputed Domain Name and Registrar**

This dispute concerns the domain name <HYLANDSOFT.CO.IN> (the 'disputed domain name') registered on November 21, 2020. The Registrar with which it is registered is Endurance Domains Technology LLP (IANA ID: 801217).

**3. Procedural History**

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

NIXI vide its email dated March 1, 2021 requested availability of Ms. Punita Bhargava to act as the Sole Arbitrator in the matter. The Arbitrator indicated her availability and submitted the Statement of Acceptance and Declaration of Impartiality and Independence in compliance with the .INDRP Rules of Procedure (Rules) on the same date. In accordance with Rules, NIXI vide its email of March 3, 2021 appointed the Arbitrator and also notified the Respondent of the Complaint.

The Arbitrator sent an email to the Respondent on the same day informing it of the commencement of the proceeding and providing it time of two weeks to file its reply.

No reply was received from the Respondent within the time prescribed and so the Arbitrator sent an email to all concerned parties on March 23, 2021 that she would proceed to pass its award ex-parte taking into consideration all the material presented before it.

The language of this proceeding is English.

4. Background of the Complainant and its rights in the HYLAND/ HYLAND SOFTWARE marks as submitted by it

The Complainant was founded in the year 1991 and is a world-renowned developer of an enterprise content management (ECM) software suite called OnBase. The Complainant's OnBase suite has been used in healthcare, finance, insurance, education, manufacturing sectors and by government. It has offices in 13 countries and services over 19000 organizations worldwide.

Since its incorporation, the Complainant has continuously used the trademarks HYLAND and HYLAND SOFTWARE in connection with its products and services. It has registered the mark HYLAND SOFTWARE in Australia, New Zealand, Canada, European Union, United States of America in classes 9 and 42 and also has registration for HYLAND SOFTWARE in India in class 42 under no. 1779052 for 'computer software for [electronic document] imaging and document management; computer software for electronic document storage, management and retrieval'. It's application for the same mark viz. HYLAND SOFTWARE under no. 1779055 in Class 9 for 'design and development of computer software, consultation services in the fields of selection, implementation and use of computer hardware and software systems for others; customization of computer hardware and software for others; installation, repair, maintenance of computer software; technical support services, namely troubleshooting of computer hardware and software problems; computer software development; computer software design for others; hosting of digital content on the internet' has been accepted and published.

In addition, the Complainant registered the domain <hyland.com> in 1995 and operates the corresponding website [www.hyland.com](http://www.hyland.com), which contains information about it and its business.

The Complainant has extensive presence on social media platforms like Twitter, Facebook, You Tube, Instagram and LinkedIn under its HYLAND and HYLAND

SOFTWARE marks. It has also extensively advertised the said marks through various media, visual and print, at a huge cost without territorial limitation.

Based on the above, the Complainant states that the HYLAND and HYLAND SOFTWARE marks are well-known and it has exclusive rights in and to the same; these merit protection from third-party acts of cyber piracy and/or cybersquatting including that of the Respondent.

**5. Respondent's default**

Despite notice of the present proceeding in terms of the Rules and an opportunity to respond, no response has been received from the Respondent by the Arbitrator.

**6. Grounds for Complaint**

The Complainant submits that the disputed domain name is deceptively and confusingly similar to its earlier well-known trademarks HYLAND and HYLAND SOFTWARE. The disputed domain name uses the trademark HYLAND in its entirety and a truncated version of the trademark HYLAND SOFTWARE, rendering it deceptively and confusingly similar to the earlier and well-known trademarks HYLAND and HYLAND SOFTWARE. Additionally, the ccTLD does not create a meaningful distinction from Complainant's said earlier and well-known trademarks. Further, the Complainant submits that it has applied for and registered the HYLAND SOFTWARE trademark with the Trade Marks Registry in India and intellectual property offices in other countries. These registrations serve to establish Complainant's rights in its HYLAND and HYLAND SOFTWARE trademarks and also provide constructive notice of its trademark rights to third parties. At the time the Respondent registered the disputed domain name, the Complainant had been using the HYLAND and HYLAND SOFTWARE marks for nearly three decades. Its rights, goodwill and reputation are all superior to that of the Respondent's.

The Complaint submits that its trademark HYLAND is a highly distinctive and well-known trademark and there is no plausible justification for the adoption of disputed domain name by the Respondent. The Respondent can demonstrate no legitimate interest in the same. The Respondent registered the disputed domain name after Complainant had established rights in the HYLAND and HYLAND SOFTWARE marks through use and registration. There exists no relationship between the Complainant and the Respondent that would give rise to any license, permission, or authorization by which the Respondent could own or use the disputed domain name. The Respondent is not commonly known by the disputed domain name and is not making legitimate non-commercial or fair use of the same. There is no evidence that Respondent is using the disputed domain name for a *bona fide* offering of goods or services. Rather, the Respondent is trying associate itself with the Complainant

with the *mala fide* intention to ride upon the goodwill and reputation of the Complainant's HYLAND and HYLAND SOFTWARE marks and unduly gain therefrom. Such adoption is against the Policy. Therefore, the Respondent does not have and / or cannot be permitted to own or even be considered to have any legitimate right or interest in the disputed domain name. The Complainant also submits that adoption and use of the disputed domain name is likely to confuse the trade and public that any services under the disputed domain name are being provided by the Complainant, which is not the case. This dilutes the brand equity of the HYLAND and HYLAND SOFTWARE marks of the Complainant. Given the reputation of HYLAND and HYLAND SOFTWARE marks, any use of the dispute domain name would constitute infringement of the Complainant's rights. The Complainant relies on Veuve Clicquot Ponsardin v. The Polygenix Group Co., WIPO Case No. D2000-0163 and also Telstra Corporation Limited v. Nuclear Marshmallows, Case No. WIPO D2000-0003 which holds that mere registration by Respondent of the disputed domain name is further evidence of Respondent's bad faith.

It is stated by the Complainant that bad faith of the Respondent in registering the disputed domain name can be simply established from the fact that the Respondent has registered the same by adopting the Complainant's earlier well-known trademark HYLAND. The Respondent had both constructive and actual notice of the trademarks of the Complainant. The Complainant submits that the Respondent has registered the disputed domain name in order to prevent the Complainant, who is the owner of the HYLAND and HYLAND SOFTWARE marks, from registering the same and reflecting its mark in a corresponding domain name. The Respondent has also created a website corresponding to the disputed domain name, which features the HYLAND mark, with an intention of misleading the members of trade and public into believing that the same belongs to or is created by the Complainant. This website is virtually identical to the Complainant's official website and a comparative analysis of the two establishes bad faith adoption. The disputed domain name uses multiple certificates and domains, the purpose of which appears related to mail delivery and file storage and suggests the Respondent's attempt to collect user information likely for future phishing scams and other fraudulent behaviour. These activities cannot be a *bona fide* or legitimate non-commercial fair use of the disputed domain name. To the contrary, this evidences the fact that the Respondent is using the disputed domain name in "bad faith" with the intention of diverting traffic by attracting internet users for commercial gain to its website by creating a likelihood of confusion with the Complainant's HYLAND and HYLAND SOFTWARE marks as to the source, sponsorship, affiliation or endorsement of its website and the services on them. The bad faith is also evidenced by the Respondent having affirmatively concealed its true identity by means of a proxy service. The Complainant also relies on Caravan Club v Mrgsale NAF Decision FA 95314. 35, where it was held that

registration of a well-known trademark by a party with no connection to the owner of the trademark and no authorization and no legitimate purpose to utilize the mark reveals bad faith. It also relies on Bennett Coleman & Co Ltd v. Steven S. Lalwani, (Case No. D 2000-0014), Bennett Coleman & Co Ltd v. Long Distance Telephone Company, (Case No. D 2000-0015), Thoughtworks Inc v. Super Software Pvt. Ltd. and Ors., 2017(69) PTC 303 (Del) and Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd. 2004, Supp (2) SCR 465 and provisions of the Policy.

## **7. Discussion and Findings**

The Arbitrator has reviewed the Complaint and the Annexures filed by the Complainant as well as the decisions cited by the Complainant. The Arbitral Tribunal has been properly constituted.

The Policy requires that the Complainant must establish three elements *viz.* (i) the Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights; (ii) the Registrant has no rights or legitimate interests in respect of the domain name; and (iii) the Registrant's domain name has been registered or is being used in bad faith. These are discussed hereunder:

### **(i) Identical or Confusingly Similar**

As regards this the first element, the Complainant has established that it has rights in the marks HYLAND and HYLAND SOFTWARE. The Complainant has been using the said marks since 1991. Its products and services under the HYLAND and HYLAND SOFTWARE marks are sold/offered in several countries. It has 13 offices worldwide and services over 19000 organizations in various sectors. HYLAND SOFTWARE mark is registered in several countries and there is also a registration for the same in class 42 under no. 1779052 for computer software related services as also a published application in class 9 under no. 1779055 for design and development of computer software and other software goods. The Complainant thus has rights in the HYLAND and HYLAND SOFTWARE marks.

The Arbitrator notes that the disputed domain name is HYLANDSOFT i.e., the disputed domain name wholly incorporates the Complainant's HYLAND mark and the word SOFT, short for SOFTWARE. Use of SOFT does not serve to distinguish the Respondent in any way and its addition cannot prevent a finding of confusing similarity under the first element. Rather, SOFT is indicative of the Complainant's business area and adds to the element of confusion.

It has been routinely held that when a domain name wholly incorporates a complainant's registered mark, this is sufficient to establish identity or confusing similarity. It is also settled that for the purpose of comparing a trademark with a disputed domain name, the country code top-level domain (ccTLD) can be excluded.

The Arbitrator accordingly finds that the first element is satisfied and that the disputed domain name is virtually identical and confusingly similar to the Complainant's registered trademark.

(ii) Rights or Legitimate Interests

As regards the second element, there are several contentions made by Complainant that the Respondent does not have rights or legitimate interests in the disputed domain name. The Respondent is not commonly known by the disputed domain name, nor authorized by or connected with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. There is no relationship between the Complainant and the Respondent that would give rise to any license, permission, or authorization by which the Respondent could own or use the disputed domain name. There is no evidence that Respondent is using the disputed domain name for a *bona fide* offering of goods or services. Rather, the Respondent is trying associate itself with the Complainant with the intent to ride upon the goodwill and reputation of the Complainant's HYLAND and HYLAND SOFTWARE marks and unduly gain therefrom. Such adoption and use of the disputed domain name is likely to confuse the trade and public that any services under the disputed domain name are being provided by the Complainant, which is not the case.

It has been held that where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of proof regarding this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In the present case, the Respondent has not countered or objected to the Complainant's claim. Accordingly, the Arbitrator finds that the Complainant has prima facie established that the Respondent does not have rights or legitimate interests in the disputed domain name.

(iii) Registered or Used in Bad Faith

As regards the third element of bad faith, based on the contentions of the Complainant describing use of the HYLAND and HYLAND SOFTWARE marks and associated business, registrations for the same, the Arbitrator accepts that these marks are associated with the Complainant. It's rights significantly predate the registration of the disputed domain name by the Respondent. The Arbitrator accepts the Complainant's contention that in view of the distinctiveness and reputation of the Complainant's marks, the Respondent would have had actual knowledge of the same when it registered the disputed domain name. The Arbitrator further accepts that the Respondent has sought to create a misleading impression of association with the Complainant in its choice of the disputed domain name. This supports a finding of bad faith. See *Starbucks Corporation v. Registration Private, Domains by Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico, WIPO Case No. D2019-1991*.

The Arbitrator has reviewed the extracts of the website corresponding to the disputed domain name (as it was on December 4, 2020) filed by the Complainant at Annexure K and accepts the Complainant's contention that, in hosting the said site and using HYLAND on the same, the Respondent has misled trade and public for commercial gain by creating a likelihood of confusion with the HYLAND and HYLAND SOFTWARE marks and also takes unfair advantage of Complainant's goodwill and reputation. The acts of the Respondent do not confer any legitimacy on him and are indicative of bad faith on his part. See *StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC, WIPO Case No. D2018-0497*. The Arbitrator also accepts that the Respondent has registered the disputed domain name to prevent the Complainant from registering the same.

Thus, the Arbitrator concludes that the Respondent's conduct constitutes bad faith registration or use of the disputed domain name within the meaning of the Policy.

Accordingly, the Arbitrator finds that the Complainant has established all three elements as required by the Policy.

#### 8. Decision

For all the foregoing reasons, the Complaint is allowed and it is hereby ordered in accordance with paragraph 10 of the Policy that the disputed domain name be transferred to the Complainant. There is no order as to costs.

This award has been passed within the statutory deadline of 60 days from the date of commencement of arbitration proceeding.



Punita Bhargava

Sole Arbitrator

Date: April 13, 2021