



ఆంధ్రప్రదేశ్ ఆంధ్ర ప్రదేశ్ ANDHRA PRADESH

DA 199291

Serial No: 27127

Denomination: 100

Date 12-08-2021

Stamp S. no DA 199291

Purchased By :

DR V GOPINATH ARBITRATOR

S/O LATE V K CHAINULU

VSP

For :

SELF

Sub Registrar

Ex. Office Stamp Vendor

SRO Visakhapatnam(R.O)

BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)

.IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)

Dr. Vedula Gopinath, Sole Arbitrator

Arbitration Award No. INDRP/1422, Dated 15th September 2021

In the matter of Arbitration between:

Paycom Payroll, LLC
7501 W, Memorial Road
Oklahoma City,
Oklahoma – 73142 USA

... Complainant

AND

Mr. Teerath Raj
Bengali tola New Bairahana
Allahabad, Uttar Pradesh – 211003 India.

... Respondent



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THE PARTIES :

- a. Complainant M/s. PAYCOM PAYROLOL, LLC, Authorised representative in these administrative proceedings is:

Mr. Zachary A.P. Oubre,
McAfee & Taft A Professional Corporation,
8th Floor, Two leadership Square
211 North Robinson,
Oklahoma City,
OKLAHOMA – 73102-7103
Phone No. 405-270-6023
E-mail : zach.oubre@mcafeetaft.com

- b. Respondent's address/details

Mr. Teerath Raj
Bngali tola
New Bairahana
Allahabad, Uttar Pradesh – 211003 India.
Phone No. (91) 8081628563 Email : trpranjal@gmail.com

II. DISPUTED DOMAIN NAME & REGISTRY:

- a) The following Domain name is the subject of this Complaint is
“<paycom.co.in>”.
- b) The Registry is the National Internet Exchange of India (henceforth referred to as NIXI).
- c) The name of Sponsoring Registrar of the Impugned Domain name “<paycom.co.in> is Endurance Domains Technology LLP.



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III. PROCEDURAL HISTORY / BACK GROUND :


06-08-2021	The .1N REGISTRY appointed Dr. Vedula Gopinath as Sole Arbitrator from its panel as per paragraph 5 of INDRP Rules of Procedure.
06-08-2021	Consent of the Sole Arbitrator along with declaration was given to the .1N REGISTRY according to the INDRP Rules of Procedure.
06-08-2021	.1N REGISTRY sent an email to all the concerned intimating the appointment of arbitrator. On the same day, the complete set of the soft copy of the Complaint with Annexure was sent to Respondent.
07-08-2021	Notice of Arbitration was sent to all concern by the Sole Arbitrator.
08-08-2021	Notice was sent by Arbitrator to the Respondent by e-mail directing him to file his response within 10 days, marking a copy of the same to the Complainant's representative and .1N Registry.

All pleadings are communicated through Electronic mode.

IV. COMPLAINANT'S DETAILS:

- a) The complaint is based on Complainant's rights in the United States Trademarks, service marks and registrations for PAYCOM®, either by itself in block letters or with additional wording or designs and/or a stylized P design. (U.S. Registration Nos. 2,318,824; 3,918,726; 3,921,874, and 5 others) The Registration Certificates from the United States Patent and Trademark Office database evidencing registrations are given in annexures 1-8 of the Complaint. The complainant is engaged in payroll and human service management and technology services .




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SOLE ARBITRATOR

- b) The Complainant also owns the domain name <paycom.com> from which complainant offers Complainant's Domain resolves are attached as evidenced of the domain name. (Anx 10 of complaint). The Complainant Company has spent large amount of money for developing and maintaining the website i.e., <paycom.com>.
- c) The Complainant has continuously used the Paycom Mark in connection with its Goods and Services since at least as early as November of 1998. The Complainant has utilized Complainant's Domain to offer to sell and advertise its Goods and Services since August 25, 1998.(ref. Anxs 9 and 10 of complaint).

V. PARTIES CONTENTIONS :

- (i) The Respondent registered the Disputed Domain Name in September 4, 2020. A printout of the entire WHOIS history records for the Deputed Domain and the supplemental information received from the .IN Registry Support Team. (attached as annexure 17 to the complaint)
- ii) That on accounts of the high, stringent and continuous adherence to non-compromising standards of quality applied by Complainant Company in the manufacture of



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SOLE ARIBITRATOR

goods bearing the trademark "<paycom.com>" the same is known for the superior quality and reliability and is extremely popular and highly demanded all over the world including in India.


- iii) The Complainant's trademark "<paycom.com>" qualifies to be a well-known trademark within the provisions of the Trade Marks Act, 1999 and is entitled to the widest protection.
- iv) The Complainant's goods sold and offered for sale under the trademark "<paycom.com>" are of excellent quality and thus have acquired reputation and goodwill through the world including India and intending purchasers identify and recognize goods under the trademark.
- v) The Webpage at which the Disputed Domain resolves, Respondent provided various links to websites relating to employee onboarding, online payroll, links to companies who are competitors to the complainant.
- vi) The complainant has alleged that respondents does not have rights or legitimate interest in respect of domain name and also the respondents have no registered trade mark rights of the said domain name. The complainant has alleged that respondents clearly intend to mislead potential customers of the complainant to its website.
- vii) The Complainant began using the Paycom Mark as early as November of 1998. The Complainant's Registrations likewise predate the registration of the Disputed Domain by the Respondent.



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Dr. VEDULA GOPINATH
SOLE ARIBITRATOR

- viii) The Respondent's Website heavily focuses on the Paycom Mark and Complainant, creating a false sense of sponsorship and/or affiliation between Complainant and Respondent and/or complainant and the Dispute Domain.
- ix) The Respondent's disputed domain name is identical or confusingly similar to the Paycom Mark because the dominant part of the Disputed Domain incorporates literal elements of the Paycom Mark.
- x) The Prior panels in similar administrative proceedings have found that the fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish confusing nature of the domain name.
- xi) The Respondent's Website utilizes the Paycom Mark or marks identical or confusingly similar thereto, without Complainant's authorization only buttressing the conclusion that the Disputed Domain is likely to be confused with the Paycom Mark.
- xii) As per the Complainant's knowledge, the Respondent is not the owner or beneficiary of a trade or service mark that is identical to the Disputed Domain.
- xiii) The Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized Respondent to register use the Paycom Mark in any manner.




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Dr. VEDULA GOPINATH
SOLE ARIBITRATOR

- xiv) The Respondent intended to attract Internet users for commercial gain by trading off the goodwill associated with the Paycom mark by creating likelihood of confusion with the Paycom Mark as to the source, sponsorship, affiliation or endorsement of the Disputed Domain name.
- xv) The complainant has submitted that its trademarks are well known in India. The complainant has further alleged that the respondent's intention is not to act in good faith but has got registered the disputed Domain name in bad faith.

B. RESPONDENT :

The Respondent in spite of Notices, didn't submit any response. As it appears the Respondent did not opt to reply at all.


V. DISCUSSION AND FINDINGS/REASONING :

(a) .IN Domain Name Dispute Resolution Policy (INDRP).

The Arbitral Tribunal after examination of the matter in details arrived in the following conclusion of Complainant's Compliance of INDRP Policy. In order to obtain the transfer of the Disputed Domain Name, Complainant should, according, prove all the following three elements to paragraph 4 of the Policy.

- (i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;




ARBITRAL TRIBUNAL
Dr. VEDULA GOPINATH
SOLE ARBITRATOR

- (ii) Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) The Disputed Domain Name has been registered and is being used in bad faith.
- (iv) Further pursuant to paragraph 6 & 7 of INDRP Policy, the Respondent have no legitimate interest and the same have been used in bad faith.

The Complainant has satisfied the aforesaid aspects to the satisfaction of the Arbitral Tribunal.

- (b) It has been contended that Respondent is only using the Disputed Domain Name in a way of create a likelihood of confusion in the minds of the public as to the source of the products and services offered on its website, and thus to misleadingly attract users to its website at Complainant's detriment and to benefit from the **PAYCOM PAYROLL, LLC** trademark's goodwill.
- (c) In case of failure of default of Respondent in sending response or reply to the complaint, the Arbitrator is empowered to announce the judgment as thinks proper and appropriate as per applicable laws.
- (d) In accordance with the Domain Name Dispute Resolution Policy, the contested Domain Name **<paycom.co.in>** is identical to the registered Trade Mark as well as Trading Name **<paycom.com>** of the Complainant.




ARBITRAL TRIBUNAL
Dr. VEDULA GOPINATH
SOLE ARIBITRATOR

VI. In view of the foregoing discussion, the Arbitral Tribunal arrives at a Logical conclusion of accepting the prayer of the Complainant.

VII. DECISION:

For all the foregoing reasons, in accordance with paragraph 10 of the .INDRP, the Arbitral Tribunal orders that the Respondent shall cease to use the mark "paycom" and also the disputed Domain Name i.e., <**paycom.co.in**> be transferred to the Complainant. There is no order as to costs.

National Internet Exchange of India (NIXI) are advised to take incidental or ancillary action involved in the transfer of the Domain Name as directed.

Visakhapatnam
Dated 15th Sept.2021




Dr. Vedula Gopinath
Sole Arbitrator

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