



தமிழ்நாடு தமிழ்நாடு TAMILNADU
35485
27/10/2014
S. muralidharan
Chennai

AT 148320
M. YOGANATHAN
STAMP VENDOR
L.No. 13612/B3/93
TRIPLICANE, CHENNAI

BEFORE S SRIDHARAN, SOLE ARBITRATOR
OF NATIONAL INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

DATED: 4th March 2015

Mahindra & Mahindra Limited

Versus

Complainant

Yitao of Apex Limited, Hong Kong

Respondent

Sridharan

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1. The Parties

- 1.1 The Complainant, Mahindra & Mahindra Limited, is a company having its registered office at Mahindra Towers, Dr G M Bhosale Marg, P K Kurne Chowk, Worli, Mumbai – 400 018. The Complainant is represented by Ms Smriti Yadav, advocate of M/s. Khaitan & Co - advocates at One Indiabulls Centre, 13th Floor 841 Senapati Bapat Marg, Elphinstone Road, Mumbai 400 013, India
- 1.2 Respondent is Yitao of Apex Limited T 76, C P Rama Road, Hong Kong – 999077.

The Domain Name and Registrar

- 1.3 The disputed domain name < www.mahindra.in > created on 21.4.2014 is registered with the registrar, Business Solutions (R54-AFIN).

2. Procedural History

- 2.1 On 27th January 2015, NIXI asked me about my availability and consent to take up the Complaint for arbitration.
- 2.2 On 30th January, I informed my availability and consent. I also informed NIXI that I had no conflict of interest with either of the parties and could act independently and impartially. I sent signed declaration of independency and impartiality to NIXI.
- 2.3 On 4th February 2015, I received hardcopy of the Complaint.
- 2.4 On 4th February 2015, I issued by email a Notice to the Respondent setting forth the relief claimed in the Complaint and directing him to file his reply to the Complaint within 15 days. I also sent an email about my appointment to arbitrate the complaint to the Complainant and asked the Complainant to send a soft copy of the complaint to me.
- 2.5 On 6th February 2015, I received soft copy of the Complaint from the Complainant.
- 2.6 Respondent has not filed any response to the Complaint.

Sridharan

- 2.7 Email is the medium of communication of this arbitration and each email is copied to all, Complainant, Respondent and NIXI.

3. Factual Background

A Complainant

- 3.1 The Complainant was incorporated in the year 1945 and its group/subsidiary companies are together referred as the Mahindra Group. The Complainant is the flagship company of the Mahindra Group.
- 3.2 The Complainant is among the top ten industrial houses in India and is a highly reputed, established and a well-known business house having interest in a very wide range of businesses and activities. The Mahindra Group has a leading presence in key sectors of the Indian economy, including the automotive sector, real estate affairs, building and construction services, financial services, trade and logistics, information technology, infrastructure development, hotel & resort and after-market, retail trade and also the educational field (hereinafter collectively referred to as "Goods/Services") and is continuing to expand its scope of goods and services every day. With over six decades of manufacturing and trading experience, the Mahindra Group has built a strong base in technology, engineering, marketing and distribution which are a key to its evolution as a customer-centric organization. The Mahindra Group employs over 2,00,000 people and has several state-of-the-art facilities in India and overseas. The Mahindra Group has presence in five continents and the Goods/Services of the Complainant are today available in every continent except Antarctica.
- 3.3 Over 62 years of its existence, the Complainant has been bestowed upon several awards and recognitions by several institutions and industry forum from time to time. Mahindra Group has also been honoured with the Bombay Chamber Good Corporate Citizen Award for 2006-07. The Complainant's Farm Equipment Sector has won the Japan Quality Medal, the only tractor company worldwide to be bestowed this honour. The Complainant has also received the Gold award for 'Brand Communicator of the Year' at the 9th Asia Pacific PR Award. The Complainant's gross revenue of traded and manufactured goods during the financial year 1 April 2012 to 31 March 2013 was about Rs. 43,961 Cr (Rupees Forty three thousand nine hundred sixty one crore Only). The Complainant was also recently listed in the top 50 Asia Pacific's biggest publicly traded companies by Forbes 2014 'Honor roll of the Fabulous 50'.
- 3.4 Since on or about 13 January 1948, the Complainant has carried on the aforesaid business of manufacturing goods under its well-known mark "MAHINDRA" and providing services under its corporate name, trade name and trading style viz. "Mahindra and Mahindra Ltd". The Complainant is popularly also known and referred to amongst the members of the trade and/or the general public by its trading name "MAHINDRA". The said trade mark "MAHINDRA" is distinctive of the Complainant's businesses/activities and the members of the trade and general public relate the same to the Complainant alone and no one else. The said trade mark is registered in various Classes in India and abroad. A list containing registration details in various countries of the world is attached at Annexure C. The mark "Mahindra & Mahindra" is also listed as a well-known mark on the official website of the Trade Marks Registry. A copy of the relevant extract from the online records of the Trade Marks Registry evidencing the same is annexed at Annexure D.

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- 3.5 The Complainant is also the owner of the top level domain name www.mahindra.com as well as numerous variations thereof in the .com and other gTLDs. The domain name Mahindra.com leads to an active website. A copy of the homepage of the Complainant's website www.mahindra.com is attached at Annexure E. WHOIS extract of certain domain names containing the said trade mark "Mahindra" as a part of the same is attached at Annexure F.
- 3.6 The Complainant states that it has been incurring huge expenses in sales promotion and advertisements in relation to the goods and services bearing the said trade mark. A statement of gross revenue and advertisement expenses incurred by the Complainant during the years 1967 till 2014 certified by its Chartered Accountant in relation to the said trade mark is attached at Annexure.
- 3.7 The Complainant states that the said trade mark has acquired tremendous goodwill and reputation due to the aforesaid and is exclusively associated with the Complainant's. The said trade mark being a part of the Complainant's corporate name, trade name and trading style since 1948, has come to acquire a natural association with the Complainant in any field of business / activity. In fact, the said trade mark has become distinctive indicia of the Complainant in relation to all its business and activities. The Complainant states that the reference to said trade mark or any mark similar to the said trade mark, in any nature business would connote and denote reference to the Complainant and none else.
- 3.8 The Complainant submits that in the aforesaid circumstances, it has both statutory as well as common law rights in and over the said trade mark in relation to the aforesaid Goods/Services and/or similar goods and services. The said trade mark has come to be associated by the traders and members of the general public exclusively with the Complainant and no one else. The Complainant further submits that the use of any trade mark / domain name identical with or deceptively similar to the Complainant's aforesaid registered and well-known said trade mark in respect of the same or similar, cognate, allied or complimentary goods or services would tantamount to infringement and/or passing off.
- 3.9 The Complainant has been vigilant in protecting its trademarks and intellectual property rights and has time and again stopped various entities from using the marks which are identical and/or deceptively similar to any of the marks of Complainant. The Complainant has and is taking action against unauthorized use of the said trade mark. Copies of various decisions of the NIXI in favour of the Complainant are attached at Annexure I-1 to I-3.

B Respondent

- 3.10 The Respondent has not filed any reply to the Complainant's Complaint in this arbitration.

4. Parties Contentions

A Complainant

- 4.1 The disputed domain name < mahindra.in > registered by the Respondent incorporates in its entirety the well-known and famous said trade mark "Mahindra" of the Complainant in which the Complainant has statutory rights as well as rights under common law.

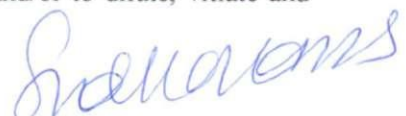
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- 4.2 The Respondent has incorporated the entire mark "Mahindra" of the Complainant in the disputed domain name. Such resemblance between the disputed domain name <www.mahindra.in> and the Complainant's registered and well-known trade mark as well as its domain name www.mahindra.com cannot be by any stretch of imagination be considered as a mere co-incidence. It is submitted that the disputed domain name <www.mahindra.in> is identical to the trade mark of the Complainant in which the Complainant has statutory and common law rights.
- 4.3 Under paragraph 3 of the INDRP, it is the Respondent's responsibility to determine whether the Respondent's domain name registration infringes or violates someone else's rights. Therefore, it was the Respondent's burden to verify before applying for the disputed domain name that the disputed domain name <www.mahindra.in> does not violate any third party rights. Considering the widespread usage of the well-known trade mark by the Complainant, the Respondent ought to have been aware of the Complainant's prior existence and usage of the said trade mark. Applying for a domain name incorporating the Complainant's said trade mark in its entirety clearly establishes that the Respondent has failed to comply with this responsibility. Such resemblance is without any reason and justifiable grounds and in fact implies deliberate attempt on the part of the Respondent to park / block the disputed domain name for unfair use.
- 4.4 Since the disputed domain name <www.mahindra.in> comprises of the well-known and famous said trade mark "Mahindra" in which the Complainant has sole and exclusive proprietary right and interests, it is evident that the Respondent cannot have any right or legitimate interest in the disputed domain name <www.mahindra.in>.
- 4.5 The trade mark is solely associated with the Complainant. Any use of the trade mark in respect of any goods/services is bound to relate them to the Complainant. Moreover since the Complainant is in diversified field as aforesaid the use of the said trade mark by the Respondent in its disputed domain name <www.mahindra.in> is bound to create confusion and the members of trade and public would lead them to believe that the Respondent is some way connected/associated with the Complainant. The Respondent cannot have any reason for adopting and registering the disputed domain name. The mark "Mahindra" is neither a personal name of the Respondent nor the Respondent is commonly known by the disputed domain name.
- 4.6 The Respondent is not making any legitimate non-commercial or fair use of the disputed domain name. Further the Respondent is not a licensee of the Complainant nor has the Respondent ever been authorized by the Complainant to use the trade mark or to register the disputed domain name <www.mahindra.in>. Indeed, the Complainant has no relationship whatsoever with the Respondent.
- 4.7 Given the prior use and registrations of the distinctive mark "Mahindra" by Complainant, the Respondent should be held to have actual or at least constructive knowledge of such uses. Respondent could not have established legitimate rights in the disputed domain name <www.mahindra.in>, which was undoubtedly registered in order to capitalize on the fame and reputation of the Complainant mark "Mahindra".
- 4.8 The Respondent has no rights or legitimate interest in the disputed domain name <www.mahindra.in>. The respondent does not have an active website on the disputed domain name <www.mahindra.in>. The disputed domain name <www.mahindra.in> redirects to an advertising website, which displays advertisements for automotive, which is

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one of the Goods/Services that the Complainant provides under the trade mark. It is apparent that the sole purpose of registering the disputed domain name is to misappropriate the reputation associated with the Complainant's said trade mark and create confusion among general public.

- 4.9 As the disputed domain name <www.mahindra.in> incorporates entirely the well-known, famous and registered mark "Mahindra" of the Complainant, it is evident that the Respondent can have no legitimate rights or interest in the disputed domain name <www.mahindra.in>. Rather, the sole purpose of the adoption of the Complainant's said trade mark in its entirety by the Respondent is to misappropriate the Complainant's well-known said trade mark "Mahindra".
- 4.10 The Respondent is presumed to have had knowledge of the Complainant's trade mark at the time it registered the identical/confusingly similar disputed domain name, moreover due to the Complainant's mark "Mahindra" being well-known. This knowledge indicates Respondent's bad faith and malicious intention in registering the disputed domain name <www.mahindra.in>.
- 4.11 Moreover the Respondent has no reason for adoption of the disputed domain name. The Respondent has registered the disputed domain name with a malicious intention to trade upon the Complainant's reputation and/or to attract for financial gains the internet users to the Respondent's website by creating a deliberate confusion and/or deception with the Complainant's said trade mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or to capitalize on the likelihood of confusion between its disputed domain name and Complainant's said trade mark "Mahindra".
- 4.12 By parking / blocking the disputed domain name, the Respondent is disrupting the Complainant's legitimate use of its said trade mark and preventing the Complainant and/or its affiliates from rightfully obtaining its registration. Such conduct of the Respondent clearly violates the legal right and interest of the Complainant over the said trade mark. It is further pointed out that the Complainant is a prominent business house known and respected across the globe and enjoys tremendous global recognition and reputation since decades. The Respondent being well aware of the widespread reputation and popularity of the said trade mark across the globe, clearly knew the number of internet users/internet hits that will follow by registering the disputed domain name, which is identical and/or confusingly similar to the Complainant's said trade mark.
- 4.13 Assuming while denying that the Respondent has registered the disputed domain name in good faith and/or legitimately, the Complainant fails to understand as to why the Respondent is providing certain hyperlinks offering Goods / Services of the Complainant. The Complainant submits that the Respondent has deliberately and in bad faith chosen the disputed domain name as 'mahindra' which incorporates the entire said trade mark.
- 4.14 The Respondent has obtained the registration of the disputed domain name <www.mahindra.in> with deliberate and mala fide intention of blocking the disputed domain name and thereafter make commercial gain by misleadingly diverting consumers from the official website of the Complainant. By no stretch of imagination can it be said that the Respondent is making a legitimate or fair use of the disputed domain name which is identical and/or confusingly similar to the said trade mark of the Complainant. The intention of the Respondent in seeking and obtaining its registration is undeniably with the intention of misleading the members of the trade and/or the general public and/or to dilute, vitiate and



weaken the inherent distinctiveness, strength, reputation and the proprietary value subsisting in the Complainant's said trade mark. Registration of the disputed domain name by the Respondent with no connection to the owner of the said trade mark, no authorization and no legitimate purpose to utilize the disputed domain name reveals bad faith on the part of the Respondent.

- 4.15 The disputed domain name <www.mahindra.in> has been registered and is being used in bad faith.

B. Respondent

- 4.16 Respondent has not filed any reply to the Complainant's Complaint in this arbitration.

5. Discussion and Findings

- 5.1 Respondent has not filed his response. I have not received any communication from him until the date of this award. Therefore, I am proceeding to determine this Complaint on the basis of the materials available on record.

- 5.2 The Complainant in order to succeed in the Complaint must establish under Paragraph 4 of .IN Domain Name Dispute Resolution Policy (INDRP) the following elements:

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

- 5.3 Each of the aforesaid three elements must be proved by a Complainant to warrant relief.

Disputed domain name is identical or confusingly similar to a trade mark of the Complainant.

- 5.4 The Complainant is the proprietor of the mark Mahindra. Complainant and its group companies have been using Mahindra as a trade mark continuously since 13 January 1948 in India. The Complainant owns numerous registrations for the trade mark Mahindra in many countries around the world including India. In India, the first registration of the Complainant under Application No. 322911 dates back to 10.02.1977. The Complainant's domain name www.mahindra.com was created on 29.11.1999. The disputed domain name <www.mahindra.in> was created on 21.4.2014. Obviously, the Complainant is the prior adopter of Mahindra mark. The above facts have established that the Complainant has statutory and common law rights in respect of its Mahindra mark.

- 5.5 The Complainant's Mahindra mark is famous and well known throughout India. It is obvious that the disputed domain name <www.mahindra.in> wholly incorporates the prior registered mark Mahindra of the Complainant. The expressions .in and .com need to be discarded while comparing the marks with the domain names. The disputed domain name <www.mahindra.in> is similar to the Complainant's domain name www.mahindra.com.

- 5.6 I, therefore, find that:

- (a) The Complaint has common law and statutory rights in respect of its Mahindra mark.

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(b) The disputed domain name <www.mahindra.in> is:

- (i) Similar to the Complainant's prior registered trade mark Mahindra and
- (ii) Similar to the Complainant's domain name www.mahindra.com.

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

5.7 It is already seen that:

- (a) The Complainant is the prior adopter and user of the Mahindra mark. The Complainant's Mahindra mark is well known in many countries across the globe including India.
- (b) The Complainant's Mahindra mark was adopted on 13.1.1948. The first Indian registrations for the mark Mahindra was obtained in 1977. The Complainant's domain name www.mahindra.com was created on 29.11.1999. The disputed domain name <www.mahindra.in> was created on 21.4.2014.

5.8 Respondent did not register the disputed domain name until 21.4.2014. Complainant has adopted and used the mark Mahindra and a domain name containing the mark Mahindra before Respondent registered the disputed domain name <www.mahindra.in>. It is unlikely that the Respondent was unaware of existence of Complainant's trademark and domain name rights before registering the disputed domain name <www.mahindra.in>.

5.9 I have visited the web site of the Respondent under the disputed domain name <www.mahindra.in>. It redirects to a non-active web site, which gives links to advertisements for automotive, which is one of the Goods/Services that the Complainant provides under the trade mark. It has links to sites such as www.cartrade.com, www.cardekho.com, www.bajajallianz.com etc. It is clear that the Respondent is not making any legitimate non-commercial or fair use of the disputed domain name <www.mahindra.in>.

5.10 In the absence of any reply from the Respondent, I agree with the contentions of the Complainant:

- (a) Since the disputed domain name comprises of the well-known and famous said trade mark "Mahindra" in which the Complainant has sole and exclusive proprietary right and interests, it is evident that the Respondent cannot have any right or legitimate interest in the disputed domain name.
- (b) The trade mark Mahindra is solely associated with the Complainant. Any use of the trade mark Mahindra in respect of any goods/services is bound to relate them to the Complainant. Moreover since the Complainant is in diversified field as aforesaid the use of the trade mark Mahindra by the Respondent in its disputed domain name is bound to create confusion and the members of trade and public would lead them to believe that the Respondent is some way connected/associated with the Complainant. The Respondent cannot have any reason for adopting and registering the disputed domain name <www.mahindra.in>. The mark "Mahindra" is neither a personal name of the Respondent nor the Respondent is commonly known by the disputed domain name <www.mahindra.in>.

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- (c) The Respondent is not a licensee of the Complainant nor has the Respondent ever been authorized by the Complainant to use the said trade mark or to register the disputed domain name <www.mahindra.in>. The Complainant has no relationship whatsoever with the Respondent.
- (d) Given the prior use and registrations of the distinctive mark "Mahindra" by Complainant, the Respondent should be held to have actual or at least constructive knowledge of such uses. Respondent could not have established legitimate rights in the disputed domain name, which was undoubtedly registered in order to capitalize on the fame and reputation of the Complainant mark "Mahindra".
- (e) The sole purpose of registering the disputed domain name <www.mahindra.in> is to misappropriate the reputation associated with the Complainant's trade mark Mahindra and creates confusion among general public.
- 5.11 Therefore, I have no hesitation to hold, for the above reason that the Respondent has no right or legitimate interest in respect of the disputed domain name <www.mahindra.in>.

Respondent's domain name has been registered or is being used in bad faith.

- 5.12 The Complainant is the proprietor of the mark Mahindra. Complainant has been using Mahindra as a trade mark continuously since 1948. The first Indian registration for the mark Mahindra was obtained in 1977. The Complainant's domain name www.mahindra.com was created on 29.11.1999. The disputed domain name <www.mahindra.in> was created on 21.4.2014. Obviously, Complainant's rights in the Mahindra mark pre-date Respondent's registration of the disputed domain name <www.mahindra.in>. The Respondent could not have ignored, rather actually influenced by, the well-known Mahindra mark of the Complainant at the time he acquired the disputed domain name <www.mahindra.in>.
- 5.13 As seen above, the Respondent is not making any legitimate non-commercial or fair use of the disputed domain name <www.mahindra.in>. The Respondent is no way connected with the Complainant. Respondent's adoption of the disputed domain name <www.mahindra.in> is nothing but an unjust exploitation of the well-known reputation of the Complainant's prior registered Mahindra mark.
- 5.14 Respondent's lack of response to the Complaint indicates that the Respondent has no reason and/or justification for the adoption of the Complainant's Mahindra mark.
- 5.15 In the absence of any reply from the Respondent, I agree with the contentions of the Complainant:
- (a) The Respondent has registered the disputed domain name <www.mahindra.in> with a malicious intention to trade upon the Complainant's reputation and/or to attract for financial gains the internet users to the Respondent's website by creating a deliberate confusion and/or deception with the Complainant's said trade mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or to capitalize on the likelihood of confusion between its disputed domain name and Complainant's said trade mark "Mahindra".
- (b) By parking / blocking the disputed domain name, the Respondent is disrupting the Complainant's legitimate use of its trade mark Mahindra and preventing the Complainant and/or its affiliates from rightfully obtaining its registration. Such conduct of the Respondent clearly violates the legal right and interest of the

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Complainant over its trade mark Mahindra. The Complainant is a prominent business house known and respected across the globe and enjoys tremendous global recognition and reputation since decades. The Respondent being well aware of the widespread reputation and popularity of the said trade mark across the globe, clearly knew the number of internet users/internet hits that will follow by registering the disputed domain name, which is identical and/or confusingly similar to the Complainant's trade mark.

5.16 Thus it is clearly established that Respondent registered the disputed the disputed domain name <www.mahindra.in> in bad faith.

5.17 The actions of the Respondent should not be encouraged and should not be allowed to continue. Respondent never intended to put the disputed domain name <www.mahindra.in> into any fair/useful purpose. Respondent not even considered it worth responding the complaint of the Complainant. Respondent did not file any response. The conduct of the Respondent has necessitated me to award costs of the Complaint to and in favour of the Complainant.

6. Decision

6.1 For all the foregoing reasons, the Complaint is allowed as below.

6.2 It is hereby ordered that the disputed domain name <www.mahindra.in> be transferred to the Complainant.

6.3 Respondent is ordered to pay the Complainant a sum of Rs.10,00,000/-(Rupees ten lakh only) towards costs of the proceedings.

I have returned all the records of this arbitration proceeding to NIXI.

S.Sridharan
Arbitrator