

தமிழ்நாடு தமில்நாடு TAMILNADU  
9395  
7/4/2018

DR. SUDHIR RAJA RAVINDRAN

BN 535619

V. BEDHARAJAN  
Stamp Vendor

L.No:12144/B1/96  
Ekkattuthangal, Ch-32  
Mobile No: 9710019476

BEFORE THE SOLE ARBITRATOR, DR. SUDHIR RAJA RAVINDRAN

.IN REGISTRY

(NATIONAL INTERNET EXCHANGE OF INDIA)

.IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)

ARBITRATION AWARD

DATED: May 14, 2018

IN THE MATTER OF:

Mastercard International Incorporated  
2000 Purchase Street,  
Purchase, New York - 10577  
United State of America

VERSUS

COMPLAINANT

**M/s Champion Software Technologies Limited**

Through Managing Director - Nirmal Patel

Jalaram Plot Rajkot, Gujrat – 360005

India

RESPONDENT/ REGISTRANT

**DISPUTED DOMAIN NAME: "WWW.MASTERPAY.IN"**

**1. The Parties:**

**1.1.** The Complainant in this arbitration proceeding is represented by Mr. Akhilesh Kumar Rai, AZB & Partners, Plot No. A8, Sector 4, Noida – 201 301.

**1.2.** The Respondent in this arbitration proceeding is represented by Advocate Shantanu R. Phanse & .Advocate Kamlesh Y. Mali, Trademark and Copyright Attorney, A/A 203, 2<sup>nd</sup> Floor, Regal Plaza, Lokpuram Society, Opposite Hiranandani Meadows, Off. Pokharan Road No. 2, Thane – 400610.

**2. The disputed Domain Name:**

**2.1.** The disputed domain name **www.masterpay.in**. According to the WHOIS search utility of the .IN Registry, the Registrar of the disputed domain name is GoDaddy.com, LLC.

**3. Calendar of Major Events:**

S. No	PARTICULARS	DATE
1.	Date on which NIXI'S letter was received for appointment as Arbitrator	26/03/2018
2.	Date on which consent was given to act as an Arbitrator	26/03/2018
3.	Date of appointment of Arbitrator	12/04/2018
4.	Date on which the Hard copy of the complaint was received by Arbitrator	16/04/2018



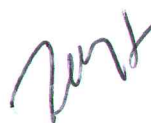
5.	Date on which notice was issued to the Respondent	16/04/2018
6.	Due date for filing of Counter Statement by the Respondent	23/04/2018
7.	Date on which Email of Respondent's counter was received	23/04/2018
8.	Date on which the Hard copy of the Respondent Counter was received	24/04/2018

#### 4. Procedural History:

4.1. This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (INDRP), adopted by the National Internet Exchange of India ("NIXI"). The INDRP Rules of Procedure ("Rules") were approved by NIXI on June 28, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes pursuant to the .IN Dispute Resolution Policy and Rules framed thereunder.

4.2. In accordance with the Rules 2(a) and 4(a), NIXI formally notified the Respondent of the complaint and appointed Dr. Sudhir Raja Ravindran as the sole arbitrator for adjudicating upon the dispute in accordance with the .IN Domain Name Dispute Resolution Policy and the Rules framed thereunder and the Indian Arbitration and Conciliation Act, 1996 and the Rules framed thereunder. The Arbitrator submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the NIXI.

4.3. The Complaint was filed in accordance with the requirements of the .IN Domain Name Dispute Resolution Policy (INDRP).

  
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4.4. On April 16, 2018, the Arbitrator issued a notice to the Respondent intimating the Respondent of the appointment of the Arbitrator and calling upon the Respondent to submit his response within seven (7) days, i.e. on or before April 23, 2018.

4.5. On April 23, 2018, the Respondent had filed its response via Email along with the documents and on April 24, 2018, the arbitrator received the hard copy of the Response.

## **5. Factual Background**

5.1. The complainant is a company incorporated under the laws of Delaware, United States of America. It is a multinational Corporation and is renowned for its financial services. The Complainant is a technology driven company and it uses technology and data- driven insight to make electronic payments secure and efficient. Complainant's core area of business is to provide services for processing payments. Additionally, the Complainant also provides allied good and services, including but not limited to, providing technology driven solutions for secure payment gateways and against thefts, advisory and consultation services. It also provides online wallet services or mobile wallet services through collaboration with various banks. The Complainant continuously adapts its services to the changing time and increasing digitalization. Currently, the Complainant provides its goods and services worldwide, in more than 210 countries and territories.

5.2. The Respondent is in the business and providing of services with respect to mobile recharge, DTH recharge, utility bill payment, domestic money transfer. The Respondent registered the disputed name < **www.masterpay.in** > on August 02, 2014.

## **6. Parties Contentions:**

### **6.1. Complainant's Submission:**

6.1.1. The Complainant claims that the roots of the Complainant can be traced back to 1966. In 1979, the 'Master Charge: The Interbank Card was renamed as MasterCard. In 1968, ICA

started sowing the seeds for global networking by creating association with Banco Nacional in Mexico and with Eurocard in Europe. By the 1970s, ICA had formulated alliances with members from Africa, Australia, Japan, etc. In the 1980s, the Complainant expanded their footprint to Asia and Latin America. From 2009 to 2012, the Complainant made a series of strategic business acquisition. In 1985, the Cirrus System, LLC (Cirrus) was bought by the Complainant. Cirrus was a worldwide ATM network chain. Some of the other acquisitions of the Complainant include acquisition of Orbiscom, which became Mastercard Labs in 2010 and DataCash, which is a prepaid program management business of Travelex, now known as Access Prepaid. The Complainant claims that, they have launched a contactless card under the name 'PayPass' in 2012 and in 2013, the Complainant launched digital wallet services under the mark 'MasterPass'. Since its launch in February 2013, 'MasterPass' has increasingly made shopping easier for customers and merchants. Further information about 'MasterPass' can be found on [www.masterpass.com](http://www.masterpass.com).

**6.1.2.** The Complainant claims that they have a very strong internet presence with the website [www.mastercard.com](http://www.mastercard.com). The website can be accessed from anywhere in the world, including India and provides extensive information on the activities of the Complainant throughout the world. Additionally, the Complainant also has country specific domain names such as [www.mastercard.co.in](http://www.mastercard.co.in) for India. In addition to the details of the Complainant, these websites also provide details of products and services offered by the Complainant.

**6.1.3.** The complainant claims that in India, the Complainant has registered with the Indian Trademark Registry for its trademark **"PAYPASS"**, **"PAYPASS"**, **"CARDMASTER"**, **"MASTERPASS"**, **"MasterCOM"**, **"MASTERINDEX"**, **"Mastercard"**, **"MASTERCARD GLOBAL SERVICE"**, **"Mastercard Money Send"** in various Classes under trademark



Application numbers 1236582, 937155, 1236610, 2499438, 671244, 1248288, 842950, 1236748, 1195000 respectively. The Complainant has also produced evidence of registrations for MASTERPASS and PAYPASS by Complainant in various jurisdictions. In addition to the above, the Complainant also uses and has applied for marks like "Master Money", "Master wallet" and Master Mobile Transactions" solutions. Additionally, the Complaint had bought in record the Cease and desist notice sent to the Respondent dated March 16, 2017 and exchange of communication between the counsels of the Respondent and Complaint regarding various other domain names that consist of MasterPay, registered by the Respondent such as masterpay.co.in and masterpay.pro.

**6.1.4.** The Complainant alleges that in view of the aforementioned facts, it is evident that the conduct of the Respondent is not bona fide and it is simply trying to take advantage of the goodwill accrued by the Complainant over the years in its well-known trademarks. The Complainant has built immense goodwill for Complainant's Marks over years of toil and labor. The Complainant claims that, the Complainant is the prior adopter of 'Master' formative marks in respect of the financial services. Over the course of decades, the Complainant has advertised and promoted Complainants' Marks for various goods and services in the financial field. By virtue of such extensive use, 'Master' formative marks for financial services have come to be associated with the Complainant alone and the consuming public associates such marks with the trust and quality provided by the Complainant in its goods and services. The Complainant has built immense goodwill for Complainant's Marks over years of toil and labor.

**6.1.5.** The Complainant claims that, the Respondent was aware of the Complainant's Marks; despite the same the Respondent has adopted 'Master' formative mark for providing goods and services in the financial area of business. Further the Complainant claims that,

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the Respondent had provided no reasoning for adoption of the 'Master' formative mark which is similar to 'Masterpass' of the Complainant, despite the knowledge of well-known use of 'Master' formative marks by Mastercard. The only reasoning behind adoption of such a mark is to benefit for the reputation and goodwill of the Complainant by causing confusion.

**6.1.6.** The Complainant claims that bad faith is evident from the number of domain names registered by the Respondent and offering of the same services through each of the domain names. Moreover, in its brochure the Respondent has shown that the offending domain name was not registered/launched first in comparison to its other domain names, whereas the Whois records show that the offending domain name was the first domain name to be registered/launched by the Respondent. The bad faith on the part of the Respondent is further demonstrated by the use of the trade mark of 'Mastercard' on the brochure indicating the launch of mobile point of sale. The adoption of the trademark of the Complainant without a license or other authority is evidence of bad faith in itself. The Respondent has no reason to adopt the trademark of the Complainant. The use of the offending domain name by the Respondent is not for non-commercial and would not fall under the ambit of 'fair use'. It is submitted that the Respondent was aware of the trademark of the Complainant when it procured the registration of the Domain Name in August 2014.

**6.1.7.** The Complainant requests for the following relief: "In accordance with Rule 3 of the INDRP, for reasons described in Section V of the Complainant, the Complainant requests the Administrative Panel appointed in this administrative proceeding to issue a decision that the offending Domain Name, which is confusingly similar to the Complainant's trademarks 'Masterpass' and 'Paypass' be transferred to the Complainant".



## **6.2. Respondent's Submission:**

**6.2.1.** The Respondent in response to the contentions raised by the Complainant in the present complaint denied in toto save and to the extent specifically accepted in the present response given by the Respondent.

**6.2.2.** The Respondent claims that the Respondent herein is engaged in the business and providing of services with respect to mobile recharge, DTH recharge, utility bill payment, domestic money transfer through the retailer under the distinctive unique mark MASTERPAY, in order to distinguish the services of the Respondent from that of others included in Class 36 of the Trademarks Act, 1999. It is further claimed that in order to run the business and provide the services as above mentioned, the Respondent had applied for registration of the domain name [www.masterpay.in](http://www.masterpay.in), before the Registrar of GoDaddy.com, LLC, in the year 2014. It is further submitted that the said domain is still in existence and the registration of the said domain is renewed periodically. The Respondent is using the said trademark Master Pay since 2014 with respect to the services provided as abovementioned. Hence the Respondent claims that, due to long and extensive use of the said mark, the Respondent has acquired distinctiveness in the market.

**6.2.3.** The Respondent Claims that Respondent is also providing aforementioned services through the domain name [www.champrecharges.com](http://www.champrecharges.com) which is also registered and the Respondent has also claims to secure trademark registration bearing Registration No. 3543235 of the mark ChampRecharges under the Class 36 as per the Trademarks Act, 1999. The Respondent further Claims that, the Respondent is also running the abovementioned business from the domain name [www.csmoney.in](http://www.csmoney.in) registered in the name of the Respondent. It is further submitted that the domain name [www.masterpay.in](http://www.masterpay.in) is completely different from the domain name [www.masterpass.com](http://www.masterpass.com). The visual aspect with





respect to the design and features shown on the domain www.masterpay.in is very much distinctive and is completely different from the Complainant's domain www.masterpass.com.

**6.2.4.** The Respondent claims that with regards to averments made in respect of paragraph No.39 of the Complaint, the Respondent states that the Complainant mark Masterpay is not well-known trade mark since it is not declared by any competent authority. The Respondent further submits that the word MASTER is the generic word and lacks distinctiveness, therefore no one can claim exclusive monopoly over the said dictionary word 'Master'. It is stated that there are several Proprietors who are using the word Master as either prefix or suffix worldwide and are registered too in various classes including Class 36, therefore the Complainant's mark MASTERPASS and the Respondent's mark MASTERPAY are entirely distinct and not similar and the services provided by the rival parties are entirely different. Hence, the Respondent would like to submit that the registration provided to the Complainant's mark and the details regarding & the promotion and publicity provided by the Complainant is not at all relevant with the present dispute between the Respondent.

**6.2.5.** The Respondent claims that the Respondent's mark MASTERPAY is entirely distinct and not similar and the services provided by the rival parties are entirely different. Therefore, the Complainant's contention raised in the complaint is devoid of any merits and by no stretch of imagination can it be inferred that using the word 'Master' would affect the business of the Complainant considering the fact that the services provided by the Complainant and Respondent are totally different and independent. The Respondent therefore concludes by stating that if the prayer as sought by the Complainant is granted then the Respondent would face a huge loss considering the fact that he has incurred big



expenses for software development and maintenance as well as for marketing and other promotional activities of www.masterpay.in .The Respondent has earned its own goodwill and transferring the domain as prayed by the Complainant in its name would cause irreparable financial loss to the Respondent and the same would not be in the interest of justice.

**6.2.6.** The Respondent requests for the following relief: “considering the facts and contentions as replied by the Respondent herein the complaint filed by the Complainant is devoid of any merit and the same is liable to be dismissed in the interest of justice.”

## **7. Discussion and findings:**

**7.1.** Under the .IN Policy, the registrant of the domain name is required to submit to a mandatory arbitration proceeding in the event that a complaint is filed in the .IN Registry, in compliance with the .IN Policy and the INDRP Rules.

**7.2.** The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:

**7.2.1.** The disputed domain name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights, and

**7.2.2.** The Respondent has no rights or legitimate interests in respect of the domain name; and

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

### **7.3. Identical or Confusingly Similar**

**7.3.1.** The first element requires the Complainant to prove that the domain name registered by the Respondent is identical or confusingly similar to a mark in which the Complainant has rights.

**7.3.2.** It is well established that trademark registration is recognized as prima facie evidence of rights in a mark. The Complainant by filing documents of its registered trademarks has established that it has rights in the trademark “the Complainant has registered with the

Indian Trademark Registry for its trademark "PAYPASS", "PAYPASS", "CARDMASTER", "MASTERPASS", "MasterCOM", "MASTERINDEX", "Mastercard", "MASTERCARD GLOBAL SERVICE", "Mastercard Money Send" in various Classes under trademark Application numbers 1236582, 937155, 1236610, 2499438, 671244, 1248288, 842950, 1236748, 1195000 respectively.

**7.3.3.** The Complainant has satisfied this Policy element in two ways. First, the disputed domain name reverses the Complainant's trademarks 'Masterpass' and 'Paypass'. Second, the dominant feature of Complainant's trademarks mark 'Masterpass' and 'Paypass' (and other, similar marks) and the disputed domain name is the word MASTER & PAY. Given the fame of Complainant's trademarks, which Respondent does not (and in good faith could not) deny, adding a common word that is an integral part of Complainant's business does not obviate confusing similar. This position was upheld in *MasterCard International Incorporated, MasterCard Europe SPRL v. IT Manager/ Crosspath (Case No. D2009-1714)*.

**7.3.4.** The disputed domain name incorporates the trademark in adequate to prove that the disputed domain name is either identical or confusingly similar to the mark. A domain name that entirely incorporates a Complainant's mark is sufficient to establish the confusing similarity of the disputed domain name with the mark. This position was upheld in *Akshaya Pvt. Ltd. v. Mr. Prabhakar Jeyapathy, (INDRP/277)*, *G.A Modefine S.A v. Naveen Tiwari, (INDRP / 082 )* and *L'Oreal v. Zeng Wei <loreal-paris.in>, ( INDRP/342)*.

**7.3.5.** The Arbitrator finds that the Complainant has satisfied the first element under paragraph 4 of the Policy.

#### **7.4. Rights and Legitimate Interests**

**7.4.1.** The second element requires the Complainant to show that the Respondent has no rights and legitimate interests in the disputed domain name.

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**7.4.2.** Under Paragraph 7 of the Policy, a Respondent or a registrant can establish rights in the domain name, if,

- i. Before notice of the dispute, the registrant had used or made demonstrable preparations to use the domain name in connection with a bonafide offering of goods or services or
- ii. The registrant (as an individual, business organization) has been commonly known by the domain name, or
- iii. The registrant is making legitimate, non commercial or fair use of the domain name without intent for commercial gain.

**7.4.3.** The extensive use of the said domain name and trademark shows that the Respondent has Rights and Legitimate Interests over the <[www.masterpay.in](http://www.masterpay.in)>.

**7.4.4.** In circumstances where the Respondent is connected to an entity that:

**7.4.4.1.** is operating a prima facie legitimate business;

**7.4.4.2.** under what appears to be a registered trading name that closely corresponds with the business name; and

**7.4.4.3.** is using the Domain Name for a website to promote that business and not target the Complainant in any obvious way;

The Arbitrator finds that the Complainant has not satisfied its burden to show that the Respondent is not using the Domain Name in connection with a bona fide offering of goods or services.

**7.4.5.** INDRP proceedings are for clear cases of cyber squatting, not for resolving trademark infringement and/or trademark dilution disputes or other matters more appropriately dealt with through the courts. The existence of significant factual



and legal issues makes this case inappropriate for resolution under this Policy/Forum.

**7.4.6.** The Arbitrator finds the Respondent has rights and legitimate interests in the disputed domain name and the Complainant has not satisfied the second element under paragraph 4 of the Policy.

**7.5. Bad Faith**

**7.5.1.** Given the Arbitrator's finding under the second element of the Policy, the Arbitrator concludes that in these circumstances it is not necessary to make a finding under this element of the Policy.

**8. Decision:**

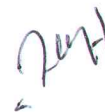
**8.1.** The Complainant has not established the three grounds required under the Policy to succeed in these proceedings.

**8.2.** For reasons discussed, the .IN Registry of the NIXI hereby denies the Complaint.

**8.3.** The Award is accordingly passed on this day of 14<sup>th</sup> day of May, 2018.

Place: Chennai

Date: 14.05.2018



Dr. Sudhir Raja Ravindran

Sole Arbitrator