



தமிழ்நாடு தமில்நாடு TAMILNADU

37/87/28/12/2013 Sridharan

AL 197162  
J. SANTI  
STAMP VENDOR  
L.NO. 20/B3/2000  
PERAMBUR, CHENNAI - 600 039

BEFORE S SRIDHARAN, SOLE ARBITRATOR

OF NATIONAL INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

DATED: 27<sup>th</sup> April 2013

Xerox Corporation

USA

...

Complainant

Versus

Mani Kannan

T. Nagar, Chennai - 600 017

...

Respondent

Sridharan

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**Connecticut 06856-4505**

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**Mani Kannan**

**Quick2soft Technologies**

**T. Nagar, Chennai – 600 017**

... **Respondent**

**1. The Parties**

- 1.1 The complainant **Xerox Corporation**, is a company incorporated under the laws of USA, having its principal place of business at 45 Glover Avenue, Norwalk, Connecticut 06856-4505, US, represented by Shewatsree, Advocate of Fidus Law Chambers at C-39, Sector-20, Noida – 201301, Uttar Pradesh
- 1.2 Respondent is Mani Kannan of Quick2soft Technologies at Renga Road, Alwarpet, Chennai – 600 028 also at No. 3, Bagavantham Street, Near Venkatanarayana (Tirupati Devastana) Temple, T. Nagar, Chennai – 600 017.

**The Domain Name and Registrar**

- 1.3 The disputed domain name <[olympicxerox.in](http://olympicxerox.in)> created on 26.5.2012 is registered with Godaddy.com LLC (R101-AFIN).

**2. Procedural History**

- 2.1 On 11<sup>th</sup> March 2013, NIXI asked me about my availability and consent to take up the Complaint for arbitration. On the same day, 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.
- 2.2 On 22<sup>nd</sup> March, I received hardcopy of the Complaint. On the same day, 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.
- 2.3 On 26<sup>th</sup> March 2013, I received a soft copy of the Complaint.

*Sridharan*



- 2.4 On 6<sup>th</sup> April 2013, I received a request for personal hearing from the Complainant and I accepted his personal hearing request.
- 2.5 On 8<sup>th</sup> April 2013 I issued an email to the parties that there would be a hearing in the third week of April, probably on 18<sup>th</sup> or 19<sup>th</sup> April and I asked the parties to intimate their convenience.
- 2.6 On 16<sup>th</sup> April 2013, the Complainant by email informed me that the Respondent has not filed his response within the time allotted and withdrew the hearing request and requested me to pass an award on the basis of material facts contained in the Complaint.
- 2.7 On 16<sup>th</sup> April 2013, I replied that the Complainant has to establish his case independent of Respondent's response. In this case, since has already reached the public domain by reason of wider use by people all over the world, the Complainant has to establish how the complaint is maintainable, i.e. , the exclusive ownership claim of the Complainant to the mark Xerox. I gave the counsel for the Complainant some more time to get instructions from the Complainant. The Complainant was given time till 25.4.2013 to respond. I also informed him that I would return the hearing fee to the Complainant.
- 2.8 Complainant failed to respond before 25.4.2013. I again reminded by email dated 25<sup>th</sup> April 2013 the Complainant to establish his exclusive ownership to his mark Xerox.
- 2.9 Complainant has not at all responded till the date of this award.
- 2.10 Respondent has not filed any response to the Complaint.
- 2.11 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 is a US\$22 billion technology and services Fortune 500 company with operations spread over more than 160 countries and 140,000 employees worldwide. The Complainant offers the world's most pre-eminent and widely accepted array of innovative document solutions, services and systems, including photocopiers, printers, digital presses, publishing systems, facsimile machines, multifunction devices, toners, paper, ink, associated supplies, software and support specially designed for office and production printing environments.
- 3.2 The Complainant's business globally is carried out under its well-known and iconic trademark/trade name 'XEROX'. The Complainant's association with the trademark XEROX dates back to the year 1948 when no such word was known or in use. Ever since its adoption, the Complainant has extensively and continuously used the said trademark worldwide, including in India, where it has directly carried out operations through its Indian subsidiary, Xerox India Limited, since 1983.
- 3.3 The Complainant also operates the website [www.xerox.com](http://www.xerox.com) from the United States and accessible around the world and has held and operated the said domain name since January 9, 1986. The domain name particulars of the Complainant's website are annexed herewith as Annexure-A.

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- 3.4 The present Complaint is based on the following, among other, trademarks, of which the Complainant is the registered proprietor:
- a) XEROX under Registration No.155627 in class 01
  - b) XEROX under Registration No.217824 in class 07
  - c) XEROX under Registration No.217825 in class 09
  - d) XEROX THE DOCUMENT COMPANY under Registration No.546220 in class 09
- 3.5 The Complainant is also the proprietor of the following trademarks which are currently pending registration:
- a) XEROX under Application No.1302851 in classes 35,37 and 42
  - b) XEROX & Device under Application No.1648619 in classes 2,9,16,35,37,40 and 42
- 3.6 Proof of all the above trademark registrations and applications pending registration in the name of the Complainant are annexed at Annexure-B.
- 3.7 Around the month of August, 2012, the Complainant was made aware of the existence of domain name <http://www.olympicxerox.in>. Upon visiting this website, the Complainant noted that the said URL redirects to another website <http://www.xeroxpoint.in>. This website advertises 'Xeroxworld', which appears to be a brand/ trade name of photocopiers/ printers/ multifunction devices and/or related services along with the following description on the lead page:
- "The streamlined design fits easily on your desktop, and the toner cartridge is simple to access and replace, and requires minimum storage space. The Hi-Q LED print engine same breakthrough technology found in some of our higher-end devices."*
- 3.8 The said page also contains a list of 'Other Sites' (which also redirect to <http://www.xeroxpoint.in>) and links to sections titled 'About Us', 'Services', 'Price List', 'Contact Us' and 'Search'. However, none of these links are accessible and appear to be dead links.
- 3.9 A copy of the said webpage of the Respondent accessed by the Complainant is annexed at **Annexure-C**. The domain name details for the website <http://www.olympicxerox.in>, including the results of WHOIS Lookup Search on the .IN Registry website, are annexed at **Annexure-D**.
- 3.10 Following the discovery of the activities of the Respondent as narrated above, the Complainant, through its Indian subsidiary Xerox India Limited, sent a legal notice dated August 24, 2012 to the Respondent, outlining the legal rights of the Complainant in the trademark XEROX and calling on the Respondent to cease and desist from using the trademark/trade name XEROX and thus violating the rights of the Complainant therein. Upon receiving no response to the said notice, the Complainant sent another legal notice to the Respondent at its alternate address on September 25, 2012, reiterating the contents of the earlier notice and requesting a response to the same by October 1, 2012. Copies of the August and September 2012 legal notices sent by the Complainant to the Respondent are annexed as Annexure-E. The Complainant has not received any response to or acknowledgement of its communications from the Respondent to this day.

#### **B Respondent**

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

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#### **4. Parties Contentions**

##### **A Complainant**

- 4.1 The impugned domain name/URL <http://www.olympicxerox.in> registered and used by the Respondent directly uses the trademark/trade name XEROX as one of the operative words and this trademark/trade name is identical to that of the registered trademark XEROX of the Complainant.
- 4.2 As a consequence of the impugned domain name/URL being identical to the registered trademark of the Complainant as well as being extremely similar to the international website of the Complainant <http://www.xerox.com> operated by the Complainant, ordinary internet users are likely to be confused by the presence of the impugned domain name/URL on the internet ostensibly offering goods and services similar/identical to the Complainant and thus cause loss of business and reputation to the Complainant.
- 4.3 The Complainant, as the registered proprietor of the trademark XEROX and the continuous user of the same for several decades, is the sole and genuine rightsholder in the trademark/trade name XEROX and the Respondent, who ostensibly carries out business in photocopiers/ printers/ multifunction devices and/or related services, by registering the impugned domain name/URL is blatantly seeking to cash in on the brand value and reputation of the Complainant's trademark XEROX for the Respondent's personal gain.
- 4.4 The fact that the impugned domain name/URL has been registered by the Respondent despite having no affiliation, past or present, with the Complainant also clearly suggests that the Respondent has no legitimate rights or interests in respect of the impugned domain name/URL.
- 4.5 The fact that the said domain name/URL has only been created as recently as May 26, 2012 and that the Respondent also runs several other websites, all of which feature identical content and use the Complainant's trademark XEROX or some confusingly similar word(s)/name(s) clearly prompts the conclusion that the Respondent and that the same has been done purely for the purpose of promoting the Respondent's own business and causing loss of business and reputation to the Complainant and therefore, the registration and use of the impugned domain name/URL by the Respondent is clearly in bad faith.

##### **B. Respondent**

- 4.6 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.
- 5.4 I have gone through the Complaint. The Complainant has come up with the Complaint on the basis that it is the exclusive owner of the mark Xerox all over the world including India. The Complainant has also claimed certain registrations for the mark Xerox in India and some of its service mark applications are still pending.
- 5.5 It is common knowledge that Xerox is being used by many people in all parts of the world without any restriction or license from the Complainant. The mark Xerox is commonly associated with photocopy. It is very common to find photocopy shops in every nook and corner and all such shops operate using the mark Xerox. These photocopy operators freely use the mark Xerox without paying any royalty to the Complainant. Xerox has become synonymous with photocopying. By reason of this indiscriminate use by so many people, the mark Xerox has lost its distinctiveness long back. Xerox is now not able to distinguish the services of the Complainant from those of others in the market. Xerox is one of the marks which have reached the public domain. The inevitable conclusion is that Xerox is common to trade and nobody including the complainant can claim exclusive ownership to the mark Xerox.
- 5.6 Therefore, no amount of registrations or applications for registrations would help the cause of the Complainant. The mere presence of the mark Xerox on the register of trade marks does not confer any exclusivity to the Complainant. It is established that mere registration will not guarantee / establish exclusive ownership. And particularly in the case of marks which have become common to trade, registrations are of no effect. No one is expected to spend his precious time and money to take steps to remove such non-distinctive marks from the register. Everyone engaged in the photocopying business is entitled to use the expression "Xerox" in association with his business.
- 5.7 The above discussion would clearly show that the Complainant is not the owner of the mark Xerox as claimed by him to the exclusion of others.
- 5.8 Now we will take the first element on confusing similarity or identity under Paragraph 4 of INDRP. For easy reference, the first element is reproduced as below:
- Respondent's domain name is identical or confusingly similar to a name, trademark or service mark **in which the Complainant has rights**.*
- 5.9 It is obvious from the portion in bold that the Complainant has to establish his rights in the mark before demanding any comparison with the Respondent's disputed domain name. And the resolution of other two elements also depends on the exclusive ownership of the Complainant to its mark Xerox.
- 5.10 We have seen that the mark Xerox has reached the public domain and is common to the trade. The Complainant has no rights to the mark Xerox to the exclusion of others.
- 5.11 In the absence of exclusive ownership to the mark Xerox, no necessity has arisen to determine the satisfaction by the Complainant of any or all of the three elements of Paragraph 4 of INDRP. I have felt no need to proceed further with the Complaint since the Complainant has failed to establish its rights to the mark Xerox to the exclusion of others. It will not serve any purpose.
- 5.12 The Complainant has been specifically asked to establish its ownership to the mark Xerox and has been given sufficient time. The Complainant has not responded. The Complainant's inability clearly shows that the Complainant has nothing further to offer other than the facts mentioned in the Complaint. And the Complaint is not sufficient to establish the Complainant's exclusive ownership to the mark Xerox.

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6. **Decision**

- 6.1 For all the foregoing reasons, the Complaint is refused.
- 6.2 There shall be no order as to costs.



S.Sridharan  
Arbitrator