



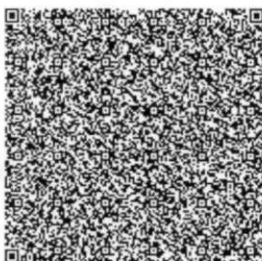
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INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

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Certificate No.	: IN-DL70286764880756L
Certificate Issued Date	: 28-Sep-2013 12:19 PM
Account Reference	: SHCIL (FI)/ dl-shcil/ HIGH COURT/ DL-DLH
Unique Doc. Reference	: SUBIN-DLDL-SHCIL38785435211815L
Purchased by	: AMARJIT SINGH ADVOCATE
Description of Document	: Article 12 Award
Property Description	: NA
Consideration Price (Rs.)	: 0
	(Zero)
First Party	: AMARJIT SINGH ADVOCATE
Second Party	: NA
Stamp Duty Paid By	: AMARJIT SINGH ADVOCATE
Stamp Duty Amount(Rs.)	: 100
	(One Hundred only)



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ARBITRATION AWARD

.IN REGISTRY - NATIONAL INTERNET EXCHANGE OF INDIA
.IN domain Name Dispute Resolution Policy
INDRP Rules of Procedure

IN THE MATTER OF:

Phoenix IT Solutions Ltd.

...Complainant

VERSUS

Mr. M. Ramesh

.....Respondent

Disputed Domain Name:

<phoenixitsolutions.in>

ARBITRATION AWARD

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IN THE MATTER OF:

Phoenix IT Solutions Ltd.
Level 5, 9-29-19/A,
Walter Heights,
Balaji Nagar,
Visakhapatnam-530 003,
INDIA.

...Complainant

VERSUS

Mr. M. Ramesh
Phoenix IT Solutions,
58, Second Floor, Arun Complex,
Sannathi Street,
Thiruvanaikaval,
Trichy-620 005

....Respondent

Disputed Domain Name:

<phoenixitsolutions.in>

1. THE PARTIES:

The Complainant in this arbitration proceeding is Phoenix IT Solutions Ltd., Level 5, 9-29-19/A, Walter Heights, Balaji Nagar, Visakhapatnam-530 003, INDIA.

The Respondent in the arbitration proceedings is Mr. M. Ramesh, Phoenix IT Solutions, 58, Second Floor, Arun Complex, Sannathi Street, Thiruvanaikaval, Trichy-620 005

2. THE DOMAIN NAME AND REGISTRAR

The disputed domain name <phoenixitsolutions.in> has been registered by the Respondent. The Registrar with



whom the disputed domain is registered is Directi Web Services Pvt. Ltd.

3. **PROCEDURAL HISTORY**

The Complaint was filed with the .In Registry, National Internet Exchange of India (NIXI), against Mr. M. Ramesh, Phoenix IT Solutions, 58, Second Floor, Arun Complex, Sannathi Street, Thiruvanaikaval, Trichy-620 005. The NIXI verified that the Complaint and the annexures to the Complaint and was satisfied that the formal requirements of the .in Domain Name Dispute Resolution Policy ("The Policy") and the Rules of Procedure ("The Rules") were complied with.

3.1 The Panel submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI to ensure compliance with the Rules (paragraph-6).

3.2 In accordance with the Rules, Paragraph-2(a) and 4(a), NIXI formally notified the Respondent of the Complaint and appointed me as a Sole Arbitrator for adjudicating upon the dispute in accordance with The Arbitration and Conciliation Act, 1996, Rules framed there under, .In Dispute Resolution Policy and Rules framed there under on **18th April, 2013**. The parties were notified about my appointment as an Arbitrator on **21st May, 2013**.

3.3 In accordance with the rules, paragraph 5(c), the Respondent was notified by me about the commencement of arbitration proceedings on **21st May, 2013** and the due date for filing his response.



The Respondent did not file any response to the Complaint filed by the Complainant.

- 3.4 By email dated 01.08.2013, the panel directed the registry to file Service Report of the delivery of complaint along with all the annexures to the Respondent within 2 days.

The panel further directed to the Complainant to forward the complaint as well as all the annexures in electronic form to the Respondent within 2 days with copy to the registry as well as to the panel.

The registry did not file any Service Report in the matter.

- 3.5 The Complainant by email dated 02.08.2013, forwarded the complaint as well as all the annexures to the Respondent on his registered email ID as appearing in WHOIS record of the disputed domain name.

- 3.6 The Respondent failed and/or neglected and/or omitted to file formal response to the Complaint within time as was granted to him by notices dated **21st May, 2013 and 1st August, 2013.**

Therefore, the Panel has no other option in the interest of justice but to proceed with the matter on the basis of the pleadings, documents and material on record.

- 3.7 The Panel considers that according to Paragraph-9 of the Rules, the language of the proceedings should be in English. In the facts and circumstances, in-person hearing was not considered necessary for deciding



the Complaint and consequently, on the basis of the statements and documents submitted on record, the present award is passed.

4. **FACTUAL BACKGROUND**

- 4.1 The Complainant in these administrative proceedings is Phoenix IT Solutions Ltd., Level 5, 9-29-19/A, Walter Heights, Balaji Nagar, Visakhapatnam-530 003, INDIA.
- 4.2 The Complainant, Phoenix IT Solutions Ltd. is a Public Limited company organized and existing since 04th December, 1998 under provisions of the Indian Companies Act, 1956. The Company was originally incorporated under the name "Phoenix Cybertech (India) Private Limited" on 4th December 1998 which became a Public Limited on 03rd April 2001. The name of the company was changed to "Phoenix IT Solutions Ltd." on 14th May, 2001. The Complainant is a leading IT company offering a wide range of integrated solutions and services to the utilities sector from its own portfolio as well as partner offerings.
- 4.3 The Complainant has gained overwhelming attention by deploying and nurturing the most mature software applications and IT enabled services, unmatched in the industry, backed by continuously improving quality systems.
- 4.4 The Complainant is one of the leading companies in the world exclusively serving the software solutions and services needs of utilities, backed by its dynamic software suite built for utilities from ground up.



The Complainant's mPower Suite of software applications deployed at some of the most IT savvy utilities is a testimony to its strength and a clear demonstration of its capabilities in this area as turnkey system integrators providing end-to-end solutions for business transformation of its utilities clients.

4.5 The present dispute fall within the scope of INDRP and the Constituted Panel appointed by INDRP has the jurisdiction to decide the same. The Registrar of the disputed Domain Name has adopted the INDRP Rules, as per its Registrar Accreditation Agreement.

4.6 The complainant objects to the registration of disputed domain name <phoenixitsolutions.in> in the name of the respondent and seek the relief of transfer thereof.

5. **PARTIES CONTENTIONS**

5A **COMPLAINANT**

5A(1) The Complainant submits that he has bonafidely adopted their distinctive trade name "Phoenix IT Solutions Ltd." and has since inception been using the same and its constituents as their trade marks individually as well as in conjunction with other words including "PHOENIX", "Phoenix Powering Utilities" and PHOENIX IT SOLUTIONS. In addition to common law rights over their trade marks, the Complainant has also sought statutory protection for their numerous trade marks by filing necessary applications with Indian Trade Marks Registry.



5A(2) The Complainant submits that Phoenix IT Solutions Ltd. has conspicuously made strong efforts to advertise its products under its various Trade Marks, through every mode viable, including their websites "phoenix.co.in" and "phoenix.in". The website, for instance, not only depicts the Product suite/services but also elaborates its functionalities and other characteristics and is undeniably a great source of advertisement of the company, its Trade Marks and its products which all culminate and stand on a Phoenix IT Solutions platform.

5A(3) The Complainant further submits that the domain name "phoenix.co.in" was registered on March 31, 2003, while domain name www.phoenix.in was registered by the Complainant on 16th February, 2005 and these domain names have been used by the Complainant extensively since their registration. The exclusive use of these domain names by the Complainant has earned it goodwill and reputation over a period of time, and therefore use of any identical or similar domain name will cause confusion among consumers with regards to the source of the product/services availed.

5A(4) The Complainant further submits that he has earned tremendous goodwill by satisfying the needs of its client all over the country and abroad. Having catered to the needs of its clients meticulously, the Complainant has expanded its business to Afghanistan, Nepal and Saudi Arabia.

5A(5) The Complainant also submits that nothing more is needed to prove the goodwill of the Company than the



fact that when a search of "Phoenix IT Solutions" is done on Google, the first result that comes is of Phoenix.co.in, which is of the Complainant only, clearly proving how the industry and users of such databases would treat Phoenix with.

5A(6) The Complainant's Trade Name "Phoenix IT Solutions", its domain names "phoenix.co.in" and "phoenix.in" as well as its Trade Marks "PHOENIX" and "PHOENIX IT SOLUTIONS" represent its invaluable proprietary rights and the Complainant vigorously enforces and vehemently defends such rights against any act of infringement and passing off. The Complainant also keeps a close watch on any activity resulting in transgression of its Intellectual Property Rights and is always prepared to take proactive measures against such acts.

5A(7) The Complainant submits that he has learnt that the Respondent/Registrant has registered the top level Indian domain name "PHOENIXITSOLUTIONS.IN" on 1st December, 2001.

5A(8) The Complainant submits that he has never authorized, licensed or otherwise permitted the respondent to use the name, trade mark or domain name consisting of Phoenix IT Solutions or to use "phoenixitsolutions.in" as a domain name and further asserts that the Complainant wishes to use "phoenixsolutions.in" as another domain name for protection of its own website, trade name and trade mark to avoid any such extreme misuse of the domain name.;



5A(9) The Complainant had also issued a Ceases and Desist letter to the Registrant on 8th December, 2012 asking to cease from using the impugned domain name "phoenixitsolutions.in, to which a reply was received on 24th December, 2012.

The Respondent has made a demand wherein Registrant states that "he has to be compensated to a tune of Rs. 25,00,000/- (Rupees Twenty Five Lakhs Only) to desist from using the name". This unreasonable and unethical demand clearly substantiates the bad faith involved in the use of the domain name.

5A(10) The Complainant further submits that in reply to the legal notice as mentioned above, all the other replies are also unjustified and lame excuses. The Complainant particularly highlights that it has been claimed by the Registrant that they are a Partnership Firm under the name and style of "Phoenix IT Solutions" ventured into IT Services in the year 2002. The Complainant fails to understand the existence of Registrant since 2002 as no documentary evidence to support is indicated or attached. Not only that, as mentioned in Para 14, the Registrant has registered the top level Indian domain name "**PHOENIXITSOLUTIONS.IN**" only on 1st December, 2011, more so when the Registrant is in software development, which practically cannot even function without a website. The Complainant further submits that as the Complainant was registered as Private Limited Company December, 1998, which became a Public Limited Company in 2001, the Registrant before forming a partnership firm in the name of "Phoenix IT Solutions" must have/should have



undertaken a search to find out the prior existence of a company/firm of the same name, more so being a Software/It Firm. Therefore, the very information of the Partnership First is with bad intent.

B. RESPONDENT

5B(1) The Respondent was given an opportunity to file his/her response to the Complaint by the panel by its notices dated 21st May, 2013 and 1st August, 2013. However, the respondent has failed to file any response within the prescribed time or to seek any extension of time. The case of the complainant, therefore, remained unrebutted.

6. DISCUSSIONS AND FINDINGS

6.1 The Complainant, while filing the Complaint, submitted to arbitration proceedings in accordance with the .In Dispute Resolution Policy and the Rules framed there under in terms of paragraph (3b) of the Rules and Procedure. The Respondent also submitted to the mandatory arbitration proceedings in terms of paragraph 4 of the Policy, while seeking registration of the disputed domain name.

6.2 Paragraph 12 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and that there shall be no in-person hearing (including hearing by teleconference video conference, and web conference) unless, the Arbitrator, in his sole discretion and as an exceptional circumstance, otherwise determines that such a hearing is necessary for deciding the Complaint. I do not think that the present case is of exceptional nature where the determination cannot be made on the basis of material on record and without in-



person hearing. Sub-Section 3 of Section 19 of The Arbitration & Conciliation Act also empowers the Arbitral Tribunal to conduct the proceedings in the manner it considers appropriate including the power to determine the admissibility, relevance, materiality and weight of any evidence.

6.3 It is therefore, appropriate to examine the issues in the light of statements and documents submitted as evidence as per Policy, Rules and the provisions of the Act.

6.4 In accordance with the principles laid down under Order 8 Rule 10 of the Code of Civil Procedure, the arbitrator is empowered to pronounce judgment against the Respondent or to make such order in relation to the Complaint as it think fit in the event, the Respondent fails to file its reply to the Complaint in the prescribed period of time as fixed by the panel.

6.5 The award can be pronounced on account of default of Respondent without considering statements or averments made by the Complainant on merit. However, in view of the fact that preliminary onus is on the Complainant to satisfy the existence of all conditions under the policy to obtain the relief's claimed, the panel feels it appropriate to deal with the averments made by the Complainant in its Complaint in detail and to satisfy itself if the conditions under the policy stand satisfied.

6.6 The Respondent has not filed its reply or any documentary evidence in response to the averments made in the complaint. The averments made in the complaint remain unrebutted and unchallenged. There is no dispute raised to the authenticity of the documents filed by the Complainant.

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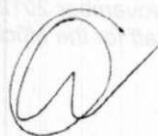
6.7 The onus of proof is on the Complainant. As the proceedings are of a civil nature, the standard of proof is on the balance of probabilities. The material facts pleaded in the Complaint concerning the Complainant's legitimate right, interest and title in the trade mark, trade name and domain name <phoenixitsolutions.in> and the reputation accrued thereto have neither been dealt with nor disputed or specifically denied by the Respondent. The Respondent has not also denied the correctness and genuineness of any of the Annexures/Exhibits filed by the Complainant along with the Complaint.

6.8 Under the provisions of Order 8 Rule 5 of the Code of Civil Procedure, 1908 the material facts as are not specifically denied are deemed to be admitted.

6.9 The decision of Hon'ble Supreme Court of India in the matter of **JahuriSah Vs. Dwarika Prasad** – AIR 1967 SC 109, be referred to. The facts as are admitted expressly or by legal fiction require no formal proof. (See Section 58 of the Indian Evidence Act, 1872).

6.10 The Panel therefore accepts the case set up and the evidence filed by the Complainant and concludes that the same stand deemed admitted and proved in accordance with law.

6.11 Paragraph 10 of the Policy provides that the remedies available to the Complainant pursuant to any proceedings before an arbitration panel shall be limited to the cancellation or transfer of domain name registration to the Complainant.



6.12 Paragraph 4 of the Policy lists three elements that the Complainant must prove to merit a finding that the domain name of the Respondent to be transferred to the Complainant or cancelled:

A. IDENTICAL OR CONFUSINGLY SIMILAR

6A.1 The Complainant contends that the Registrant's Domain Name is identical or confusingly similar to a trade mark in which the Complainant has rights.

6A.2 The Respondent registered the Disputed Domain Name on 01.12.2011.

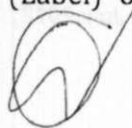
6A.3 The contention of the Complainant that by registering the impugned domain name <phoenixitsolutions.in> by the Respondent, the likelihood of confusion between the trademark of the disputed domain name cannot be avoided is upheld by this panel.

6A.4 The Complainant registered its company and adopted the mark "Phoenix" on 04.12.1998. The company has been registered by the Complainant is Phoenix IT Solutions Ltd. from 14.05.2001.

The domain phoenix.co.in was registered by the Complainant on 31.03.2003 and domain phoenix.in registered by the Complainant on 16.02.2005.

The Complainant claims common law right in respect of the mark "Phoenix".

6A.5 The Complainant has filed multiclass application(s) in respect of the Phoenix, Phoenix IT Solutions and Phoenix Powering Utilities (Label) on 05.12.2012



and 07.12.2012 claiming the user of the mark as 04.12.1998 and 21.02.2011 in respect of the label mark.

6A.6 The addition of a ccTLD “.IN” is not sufficient to escape the finding that the domain is confusingly similar to the Trademark and does not change the overall impression of the designation as being connected to the Complainant’s trademark. The disputed domain name includes the ccTLD <.in>. It has been persistently held that the addition of ccTLD suffixes does not circumvent the likelihood of confusion and that it should be disregarded to assess potential similarity between a domain name and a trademark (WIPO Case No. DC02012-0001, easyGroup IP Licensing Limited v. wang tao and Case No. INDRP/245, October 22, 2011, L’Oreal v. Corporate Domains – **Annex 21** et No. INDRP/125, February 14, 2010, Lego Juris A/S v. Robert Martin – **Annex 35**) merely because it is descriptive of the registry services.

6A.7 The disputed domain name reproduces Complainant’s trade mark in its entirety. In many WIPO decisions, Panels considered that the incorporation of a trade mark in its entirety may be sufficient to establish that a domain name is identical or confusingly similar to Complainant’s registered trademark (WIPO Case No. D2010-1059, RapidShare AG, Christian Schmid v. Invisible Registration.com, Domain Admin and WIPO Case No. D2008-0705, ACCOR v. Lee Dong Youn, Tenneco Inc. v. Toni Li, Case No. INDRP/130, March 5, 2010; ITC Limited v. Travel India, Case No. INDRP/065, April



15, 2008. In the case of OSRAM GmbH V. Yuri A Ivanov; (Case No. D2009-0692); it was held that incorporating a trademark in its entirety may be sufficient to prove that a domain name used by the Registrant is confusingly or identically similar to the trademark used by the Complainant.

6A.8. The Complainant registered the Domain Name <phoenixitsolutions.in> on 01.12.2011, which is much subsequent to the date of first adoption & use of the said mark by the Complainant in China.

6A.9 The Respondent has not disputed any contentions raised by the Complainant in the Complaint. The Panel also finds and holds that the disputed Domain Name <phoenixitsolutions.in> is identical and/or deceptively similar to the earlier registered trade marks and Domain names of the Complainant. The whole of Complainant's trade mark /domain name has been incorporated in the disputed domain name and there is bound to be confusion and deception in the course of trade by the use of disputed domain name. Therefore, the Complainant has been successful in proving that the domain name <phoenixitsolutions.in> is identical and/or confusingly similar to the Trademark of the Complainant.

6A.10 For all the above cited reasons, it is established that the Complainant has trademark rights in the Phoenix IT Solutions trademark and that the disputed domain name is identical or at least confusingly similar to this trademarks. Therefore, the condition of Paragraph 4(a)(i) of the IN Policy is fulfilled.



**B. RESPONDENT HAS NO RIGHT OR LEGITIMATE
INTEREST IN RESPECT OF THE DOMAIN NAME**

6B.1 The Respondents have no interest or legitimate right with respect to the Disputed Domain Name. Respondent is not affiliated with Complainant in any way nor has he been authorized by Complainant to use and register its trademark, or to seek registration of any domain name incorporating said mark.

6B.2. The complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

6B.3 The trademark incorporating the word Phoenix IT Solutions has not been licensed by the complainant to the respondent. Respondent is no way affiliated with Complainant. Complainant has not authorized or licensed Respondent to use and register the SHU UEMURA trademark, nor to seek registration of any domain name incorporating this trademark. In previous decisions, Panels found that in the absence of any license or permission from the Complainant to use such widely known trademarks, no actual or contemplated bona fide or legitimate use of the domain name could reasonably be claimed (WIPO Case No. D2010-0138, LEGO Juris A/S v. DomainPark



Ltd. David Smith, Above.com Domain Privacy,
Transure Enterprise Ltd. , Host master, **Annex 24)**

6B.4 The Respondent by his letter dated 24.12.2012, through his attorney, in response to Cease and Desist notice sent by the Complainant's attorney dated 08.12.2012 demanded a compensation of Rs. 25 lakhs in order to desist from using the name Phoenix IT Solutions and/or to settle the matter amicably.

The Respondent at the time of passing of this Award is not using the impugned domain for providing any services and/or any information on the said domain.

6B.5 Furthermore, Respondent has never provided evidence of being known or recognized by the Disputed Domain Name. Previous Panels have considered that where Respondent has not provided evidence that it is known or recognized by the domain name, Respondent has no rights or legitimate interests in the domain name (Case No. INDRP/256, November 4, 2011, Citroen v. Hyderabad; Case No. INDRP/127, February 24, 2010, Accor v. Tang Wei; Case No. INDRP/118, November 26, 2009, Starbucks Corporation v. Mohanraj - **Annex 26**).

Therefore, this panel is satisfied that the respondent has no rights or legitimate interest in respect of the disputed domain name.

6B.6 Additionally, Complainant had registered and used various domain names consisting in its mark Phoenix IT Solutions long before Respondent registered the disputed domain name.



Consequently, there can be no right or legitimate interest on Respondent's side (**Annexes 17** and Case no. INDRP/099, June 12, 2009, Societe Anonyme des Eaux Minerales d'Evian (SAEME) v. Rajesh Aggarwal – **Annex 27**).

6B.7 The respondent has not rebutted claims of the complainant.

6B.8 Therefore, this panel is satisfied that the respondent has no rights or legitimate interest in respect of the disputed domain name.

C Registered and used in Bad Faith

6C.1 For a Complainant to succeed, the Panel must be satisfied that a domain name has been registered and is being used in bad faith.

6C.2 Paragraph 6 of the Policy states circumstances which, if found shall be evidence of the registration and use of a domain name in bad faith:

6C.3 The bad faith in registering the impugned domain name by the respondent is apparent from the fact that the Respondent through his attorney has offered to Cease and Desist using the said domain name in case he is compensated for the said domain for Rs. 25 lakhs.

6C.4 Even if Respondent was unaware of Complainant, which is unlikely in the present case, a quick trademark search or online search on Google using the keyword "Phoenix IT Solutions" would have shown the existence of Complainant and its



trademark rights. According to the Policy paragraph 3, it was Respondent's responsibility to conduct a trademark search before registering the disputed domain name. Respondent's failure to conduct this search is evidence of registration in bad faith (L'Oreal v. Jack Sun, INDRP/343May 17, 2012).

6C.5

In the case of Monster.com (India) Pvt. Ltd. v. Domain Leasing Company, where the domain name in dispute was **monster.in**, the Arbitrator articulated that **the onus is on the Registrant to ensure that they are not infringing on any 3rd party rights.**

The bad faith and illegitimate interest of the respondent/registrant in the disputed domain can be corroborated by the demand that the respondent/registrant made to sell the domain name "phoenixsolutions.in" to the complainant at the cost of Rs. 25,00,000/- **Such an offer to sell the domain name clearly indicates that the Registrant had no legitimate interest in the domain name and that the registration was done in bad faith solely for the purpose of unlawful commercial gains.**

As held in the case of, REDIFF.COM INDIA LIMIED vs. MR. ABHISHEK VERMA AND iADVANCE MEDIA (INDRP/001) decided on April 2, 2006; the Registrant/Respondent has no legitimate interest in the disputed domain name because he had freely made an offer to the Complainant to sell the domain name within hours and thus it was held that this registration was done in bad faith and only with the



intention to sell it to the complainant, the arbitrator therefore cancelled the registration and transferred the disputed domain name to the Complainant.

6C.6 In view of the above, it is established that the disputed domain name is also being used in bad faith.

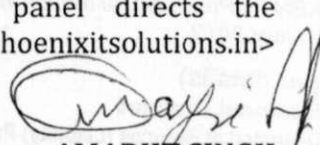
Consequently, it is established that Respondent both, registered and used the disputed domain name in bad faith in accordance with Paragraph 4 (iii) and Paragraph 6 of the Policy.

6C.7 The Respondents do not dispute any of the contentions raised by the Complainant. The facts and circumstances explained in the complaint coupled with the material on record clearly demonstrate that the domain name <phoenixitsolutions.in> was registered by the respondents in bad faith.

6C.8 The Panel accepts the contentions of the Complainant as have been raised by them and holds that the registration of the domain name on part of the Respondent is in bad faith.

7. **DECISION**

In view of the fact that all the elements of Paragraphs 6 and 7 of the policy have been satisfied and in the facts and circumstances of the case, the panel directs the cancellation of the domain name <phoenixitsolutions.in> as prayed for.


AMARJIT SINGH
Sole Arbitrator

Dated: September 28, 2013