



தமிழ்நாடு தமில்நாடு TAMILNADU  
19-11-13  
Sridharan

AS 099353  
S. MALLINATHAN  
STAMP VENDOR  
L.No. 14661-B1/86  
Plot. 1706, 35th Street, I-Block  
ANNA NAGAR WEST, MADRAS-600 041

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

ARBITRATION AWARD

DATED: 10<sup>th</sup> November 2013

Rotomag Motors & Controls Pvt Ltd

... Complainant

Versus

CRI Pumps Private Limited

... Respondent

Sridharan

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<b>Versus</b>		
CRI Pumps Private Limited	...	<b>Respondent</b>

**1. The Parties**

- 1.1 The complainant, Rotomag Motors & Controls Pvt Ltd is a company incorporated under the Companies Act 1956, having its registered office at C-1/5, Vitthal Udyognagar, Near Anand- 388121, Gujarat represented by its Director-Operations & Systems, Mrs. Neelam Balani.
- 1.2 Respondent is CRI Pumps Private Limited having its registered office at 7/46-1, Keeranatham Road, Coimbatore, -641006, Tamil Nadu, India, represented by its counsel, Dr. K. S. Ravichandran of KSR & Co Company Secretaries LLP at Indus Chambers, Ground Floor, No. 101, Govt. Arts College Road, Coimbatore – 641018.

**The Domain Name and Registrar**

- 1.3 The disputed domain name **<rotomag.in>** created on 01.11.2012 is registered with Net4India (R7-AFIN).

**2. Procedural History**

- 2.1 On 3<sup>rd</sup> October 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 12<sup>th</sup> October 2013, I received hardcopy of the Complaint.
- 2.3 On 13<sup>th</sup> October 2013, 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. In the same mail I asked the complainant to submit additional submissions in support of his claims.
- 2.4 On 15<sup>th</sup> October 2013, I received a soft copy of the Complaint along with additional submissions.
- 2.5 On 28<sup>th</sup> October 2013, I received Respondent's counter.

*S. Sridharan*

- 2.6 On 29<sup>th</sup> October 2013 I forwarded the counter to the Complainant and asked him to file his rejoinder, if any.
- 2.7 On 2<sup>nd</sup> November 2013, the Complainant filed his rejoinder.
- 2.8 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 company involved in the manufacture, sale and after sale service of Permanent Magnet DC motors and its controllers since 1993. All products manufactured by the Complainant bear the trademark of ROTOMAG and its logo. The Complainant's products are sold all over India and abroad under this trademark. The Complainant has a website under the domain name [www.rotomag.com](http://www.rotomag.com).
- 3.2 The Complainant has registered various domain names rotomag.com (since 2001), rotomag.net (since 2003), rotomag.co.in (since 2011) and rotomagsolar.com (since 2013).
- 3.3 The Complainant has registered its trademark ROTOMAG in class 7 under No.618567. The registration is valid upto 3.2.2018. The Complainant's main products are Permanent Magnet DC motors and our trademark is meant to signify 'Rotating machine + Magnets'. This trademark is used by the Complainant on products manufactured by it.

#### **B Respondent**

- 3.4 The Respondent is one of the leading companies in India engaged in the business of pumps, motors, valves, cables and pump accessories. Registrant is very reputed and has been in this field for more than 4 decades. Respondent's products bear the brand name CRI. CRI is a well-known trade mark. CRI has been in use in the course of trade continuously and extensively for about 4 decades of existence and reputation. Respondent has 12 manufacturing units and 28 branch offices in India. Respondent has huge market for their products in India and has been exporting its products to many countries.

### **4. Parties Contentions**

#### **A Complainant**

- 4.1 The disputed domain name [<rotomag.in>](http://<rotomag.in>) bears the name and trade mark of the Complainant. The brand name and the company name of the Respondent are no way connected with the expression "Rotomag". Even if the Respondent has products which belong to the same broad product category as that of the Complainant, the Respondent's products do not use Permanent Magnets and hence they cannot have any legitimate interest in associating 'Rotomag' with their products. Respondent has till date not used this brand name in any of their product promotions.
- 4.2 Hence the disputed domain name [<rotomag.in>](http://<rotomag.in>) does not in any way imply or connect with any of the services or products of the Respondent. The use of the disputed domain name [<rotomag.in>](http://<rotomag.in>) conflicts with the legitimate interests of the Complainant and the so use of this disputed domain name [<rotomag.in>](http://<rotomag.in>) can result in internet users being attracted to the website of Respondent instead of the Complainant.

*Shelvarans*

- 4.3 In accordance with the Dispute Resolution policy, the Complainant would therefore request the cancellation of the registration of the disputed domain name <rotomag.in> in the name of the Respondent further transfer of the same to the Complainant.
- 4.4 The Complainant has made the following contentions in his additional submissions.
- 4.5 Complainant manufactures all its products under the brand name ROTOMAG and bear the logo of ROTOMAG. Complainant also bears the name Rotomag and its catalogues and advertising material bear this brand name. This name is identical to the disputed domain name <rotomag.in> registered by the Respondent. Complainant has registration for its trade mark Rotomag.
- 4.6 Respondent has no any rights or any legitimate interest in respect of the disputed domain name <rotomag.in>.
- a) The disputed domain name <rotomag.in> bears the trade name and trade mark of the Complainant.
  - b) Complainant has been manufacturing DC motors and pumps under the name rotomag since 1993 and its products are known and identified by this name.
  - c) Respondent has recently started manufacturing DC submersible pumps and it seems that they have a malafide intention of usurping the Complainant's brand equity by registering the disputed domain <rotomag.in> for their new line of DC pumps.
- 4.7 The Respondent has only recently started manufacturing DC submersible pumps. By registering the disputed domain name <rotomag.in> they intend to associate or indicate association with products manufactured by the Complainant. This is totally wrong and an inaccurate representation of facts and can lead to confusion in the minds of users regarding the Complainant's products. And it conflicts with the legitimate interests of the Complainant which has been manufacturing and selling products under the logo and trademark of ROTOMAG.

**B. Respondent**

- 4.8 I am summarizing the contentions of the Respondent as below.
- 4.9 The Complaint is not maintainable. No copy of board resolution is filed substantiating that the director has authority to sign and file the Complaint. The director has filed a copy of board resolution in her rejoinder.
- 4.10 The allegations are baseless and unwarranted. There is no relationship either in the course of trade or otherwise between the Complainant and the Respondent. The assertion that the disputed domain name <rotomag.in> is confusingly similar to the trade mark of the Complainant is incorrect. The allegation that the Respondent has adopted the disputed domain name <rotomag.in> with malafide intention is without any basis. Respondent has no requirement or intention to ride on the reputation of someone else. There is no need for the Respondent to usurp the so called brand equity or reputation of the Complainant. The Respondent has right / legitimate interest to the disputed domain name <rotomag.in>. The Complainant has failed to provide the strict evidence as per Para 6 of the INDRP Policy.
- 4.11 The Respondent is entitled to the benefit of harmless registration as the Respondent has not kept the disputed domain name <rotomag.in> active and has not used it commercially.



4.12 The Respondent has however no intention of renewing the registration of the disputed domain name <rotomag.in>. The disputed domain name <rotomag.in> will fall to the ground in its ordinary course of time. The Respondent has no objection in recording this undertaking in the award of the Hon'ble Tribunal.

4.13 The Respondent is not inclined to transfer the disputed domain name to the Complainant.

## 5. Discussion and Findings

5.1 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.

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

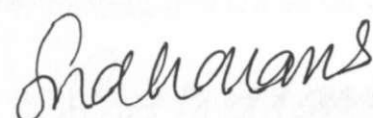
***Disputed domain name is identical or confusingly similar to a trade mark of the Complainant.***

5.3 The Complainant is the proprietor of the mark Rotomag. Complainant has been using Rotomag as a trade mark and trade name continuously since 1993. Complainant has a web site [www.rotomag.com](http://www.rotomag.com) which can be accessed easily by the internet users from any part of the world including India. The internet users can actively submit their interests to the Complainant through this web site. The complainant has registered its trade mark Rotomag in class 7 under No.618567 with effect from 3.2.1994. The registration is in force and valid upto 3.2.2018. The Complainant has also registered domain names [www.rotomag.com](http://www.rotomag.com) (created on 29.5.1999), [www.rotomag.net](http://www.rotomag.net), [www.rotomag.co.in](http://www.rotomag.co.in), [www.rotomagsolar.com](http://www.rotomagsolar.com). The disputed domain name <rotomag.in> was created on 1.11.2012. Obviously, the Complainant is the prior adopter of the mark Rotomag. The above facts have established that the Complainant has common law as well as statutory rights in respect of its Rotomag mark.

5.4 It is clearly seen that the disputed domain name <rotomag.in> wholly incorporates the prior registered mark Rotomag of the Complainant. The suffix ".co" and ".in" are descriptive and are not distinguishing parts of the domain name. The specific top-level and /or second-level of a domain name such as ".co" ".in" needs to be disregarded when determining the similarity or identity with the Complainant's Rotomag mark. The disputed domain name <rotomag.in> is similar to the Complainant's domain name [www.rotomag.com](http://www.rotomag.com).

5.5 I, therefore, find that:

- (a) The Complaint has common law and statutory rights in respect of its Rotomag mark.
- (b) The disputed domain name <rotomag.in> is:
  - (i) Identical to the Complainant's prior registered Rotomag trade mark, and





- (ii) Similar to the Complainant's domain name www.rotomag.com.

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

5.6 It is already seen that:

- (a) The Complainant is the prior adopter and user of the mark Rotomag. The Complainant's Rotomag mark is well known.
- (b) The Complainant's Rotomag mark was adopted in the year 1993. The mark Rotomag was registered in India in 1994. The Complainant's domain name www.rotomag.com was created on 29.5.1999. The disputed domain name <rotomag.in> was created on 1.11.2012.

5.7 Respondent did not register the disputed domain name until 1.11.2012. Complainant has adopted and used the mark Rotomag and a domain name containing the mark Rotomag before Respondent registered the disputed domain name <rotomag.in>. It is unlikely that the Respondent was unaware of Complainant's existence of trademark and domain name rights before registering the disputed domain name <rotomag.in>.

- a) I visited the web site of the Respondent under the disputed domain name <rotomag.in>. It resolved into the web page of its registrar, net4india. At the bottom of the web page, it is clearly mentioned – *This web page is parked free, courtesy Net4India*. It is obvious that the Respondent has no intention to use the disputed domain name in connection with a bona fide offering of goods or services. The Respondent has simply parked it. The Respondent has admitted in his pleadings that he has not kept the disputed domain name <rotomag.in> active and has not used it commercially. Further, the Respondent has no intention to renew the disputed domain name any further. The Respondent has agreed that the disputed domain name <rotomag.in> will fall to the ground on its own.

5.8 I am not agreeing with the Respondent's argument that he is entitled to the benefit of harmless registration. There is nothing like harmless registration. The issue to be decided is whether the Respondent has any right to the disputed domain name and not whether the registration is harmful or harmless.

5.9 Therefore, I have no hesitation to hold, for the above reasons that the Respondent has no right or legitimate interest in respect of the disputed domain name <rotomag.in>.

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

5.10 The Complainant is the proprietor of the mark Rotomag. Complainant has been using Rotomag as a trade mark and trade name continuously since 1993. The mark Rotomag was registered in India in 1994. The Complainant's domain name www.rotomag.com was 29.5.1999. The disputed domain name <rotomag.in> was created on 1.11.2012. Obviously, Complainant's rights in the Rotomag mark pre-dates Respondent's registration of the disputed domain name <rotomag.in>. The Respondent could not have ignored, rather actually influenced by, registered mark of the Complainant at the time he acquired the disputed domain name <rotomag.in>.

5.11 We have already seen that Respondent has no intention to use the disputed domain name in connection with a bona fide offering of goods or services. The disputed domain name <rotomag.in> expires on 01-Nov-2013. The Respondent has given an undertaking that he will not renew the registration of the disputed domain name <rotomag.in> and it will fall on the ground on its own.

*Srinivasan*

- 5.12 The above facts have clearly established that the disputed domain name <rotomag.in> has been registered or is being used in bad faith by the Respondent.
- 5.13 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 <rotomag.in> into any fair/useful purpose. 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 <rotomag.in> be transferred to the Complainant.
- 6.3 Respondent is ordered to pay the Complainant a sum of Rs.3,00,000/- (Rupees three lakh only) towards costs of the proceedings.



S. Sridharan  
Arbitrator