

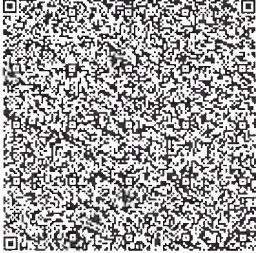
सत्यमेव जयते

INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No.	: IN-DL05568478465587P
Certificate Issued Date	: 15-Jul-2017 12:37 PM
Account Reference	: IMPACC (SH)/ dlshimp17/ HIGH COURT/ DL-DLH
Unique Doc. Reference	: SUBIN-DLDLSHIMP1712219172261129P
Purchased by	: AMARJIT SINGH ADVOCATE
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: AMARJIT SINGH ADVOCATE
Second Party	: Not Applicable
Stamp Duty Paid By	: AMARJIT SINGH ADVOCATE
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



.....Please write or type below this line.....

(Signature)

Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shcilestamp.com". Any discrepancy in the details on this Certificate and as available on the website renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

ARBITRATION AWARD

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

IN THE MATTER OF:

SBI Card & Payment Services Pvt. Ltd.
Unit 401 & 402, 4th Floor,
Aggarwal Millennium Tower,
E-1, 2, 3, Netaji Subhash Place,
Pitampura,
New Delhi-110034

..... Complainant

VERSUS

Gerasimos Ampatielos
Keramies,
Kefalonia-28100,
Greece

..... Respondent

1. THE PARTIES

The Complainant in this administrative proceeding is SBI Card & Payment Services Pvt. Ltd., Unit 401 & 402, 4th Floor, Aggarwal Millennium Tower, E-1, 2, 3, Netaji Subhash Place, Pitampura, New Delhi-110034.

The Respondent is Gerasimos Ampatielos Keramies, Kefalonia-28100, Greece.

2. THE DOMAIN NAME AND REGISTRAR

The disputed domain name <**www.sbicard.in**> has been registered by the Respondent. The Registrar with whom the disputed domain is registered is



Dynadot LLC (R117-AFIN), 210 S Ellsworth Ave
#345, San Mateo, CA 94401, US.

3. **PROCEDURAL HISTORY**

- 3.1 The Complaint was filed with the .In Registry, National Internet Exchange of India (NIXI), against Gerasimos Ampatielos Keramies, Kefalonia-28100, Greece. The NIXI verified that the Complaint together with the Annexures to the Complaint had satisfied the formal requirements of the .in Domain Name Dispute Resolution Policy ("The Policy") and the Rules of Procedure ("The Rules").
- 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, May 23, 2017. The parties were notified about the appointment of an Arbitrator on May 23, 2017.
- 3.3 The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI to ensure compliance with the Rules (paragraph-6).
- 3.4 NIXI, by its email of May 25, 2017 informed me that hard copy of the complaint along with Annexures sent to the respondent by courier



were not delivered as the given city and zip code was wrong. The complainant was advised to provide the correct city and zip code by NIXI, by its e-mail of 29th May, 2017. The complainant complied with the said requirement by its e-mail of May 29, 2017 and NIXI forwarded the said information to the courier agency on the same day.

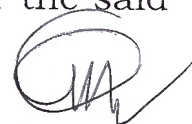
- 3.5 NIXI also forwarded complete record of the complaint and annexures to the respondent electronically by its email of May 23, 2017 and the said e-mails were duly served on the respondent.
- 3.6 The respondent was granted ten days time to file his response by this panel vide e-mail dated June 10, 2017. Since no response was filed within the prescribed period of time of ten days, the respondent was intimated about the default by e-mail of June 22, 2017 and was informed that the matter will be decided on the basis of the material available on record and in accordance with law.
- 3.7 The respondent neither respond to the e-mail of June 22, 2017 nor filed any response to the complaint.
- 3.8 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 is the joint venture between State Bank of India ("SBI") and GE Capital Corporation ("GE") of USA. In terms of the Joint Venture Agreement between SBI and GE, two companies namely Complainant and GE Capital Business Process Management Services Private Limited ("GECBMSPL") were incorporated in the year 1998 to run and manage the credit card business of SDI. The Complainant markets and distributes Credit Cards under the brand SBI CARD and GECBMSPL handles the technology and processing needs for the SBI CARD branded Credit Cards. Complainant is the subsidiary of SBI and SBI has more than 60% shareholding in the Complainant. The Complainant offers Indian consumers extensive access to a wide range of world-class, value-added credit cards under the brand and trade mark SBI CARD. The complainant is the registered proprietor of mark SBI CARD under the provisions of the Trade Marks Act, 1999 in respect of variety of services falling in classes 36, 38 and 42 as per the particulars mentioned in the complaint. The mark SBI CARD is being used since 1998.

4.2 The complainant is also the owner of domain name www.sbicard.com created on May 4, 1999 and has an active website under the said



domain providing information with respect to the products and services of the complaint.

4.3 The disputed domain name <sbicard.in> was registered by the respondent on July 19, 2015.

5. **PARTIES CONTENTIONS**

5A **COMPLAINANT**

5A.1 The Complainant is the joint venture between SBI and GE. In terms of the Joint Venture Agreement, two companies namely the Complainant and "GECBPMSPL" were incorporated in 1998 to run and manage the credit card business of the SBI under the brand and trade mark SBI CARD. The Complainant markets and distributes SBI CARD and GECBPMSPL handles the technology and processing needs for the SBI CARD Credit Cards. Complainant is the subsidiary of SBI. The two joint ventures offer Indian consumers extensive access to a wide range of world-class, value-added payment products and services through SBI branded credit cards offered by the Complainant.

5A.2 Complainant was incorporated to handle the credit card business of SBI using cutting edge technology and global best practices. To achieve these aims SBI entered into a partnership with globally reputed financial



services and technology company GE in 1998. Today SBI is the largest bank and financial institution in India. Government of India is the largest shareholder in SBI with 61.58% shareholding. SBI has a past history of over 200 years which goes back to the first decade of the nineteenth century making it the oldest commercial bank in the Indian Sub — Continent.

5A.3 The Complainant has its headquarters at Gurgaon, Haryana, India and has branches in over 90 cities across India, The Complainant offers lifestyle, reward, shopping, travel, and banking partnership cards for personal needs, corporate, central travel, utility and purchase cards for corporate needs. It provides utility bill payment, card payment and value added services under the brand and trademark SBI CARD.

5A.4 Since the launch of credit card business under the brand SBI CARD in the year 1998 the Complainant has achieved great success with SBI CARD becoming one of the leading credit cards brand in India. Within short span of 10 months of the launch in 1998 SBI CARD reached "1 lakh" customer mark in 1999, by 2002 Complainant No. 2 had one million customers. Today SBI CARD issued by the Complainant is second most widely used credit card in India. Significant milestones achieved



by the SBI CARD issued by the Complainant since its inception is as under:

S.NO.	Date	Milestones Achieved
1.	1998	SBI Card enters the credit card space
2.	1999	Reaches the '1 Lakh' mark within 10 months of launch
3.	2002	SBI Card enters the '1 Million Cards' club
4.	2002	First partnership with a public-sector bank
5.	2003	SBI Card launches 8 Cities Affinity Cards with special tie-ups & offers
6.	2005	The 2 Million Cards Milestone crossed
7.	2006	SBI card launches SBI Railway Card for Indian Railway travelers
8.	2006	The launch of co-brand cards, SBI SpiceJet Card & TATA Cards, India's first Loyalty cum Credit Card
9.	2006	SBI Card becomes second largest Credit Card issuer with 3 million
		cards
10.	2010	SBI Platinum Card launched
11.	2011	Launches chip -based EMV Cards
12.	2012	Launches SBI Signature Card for HNIs
13.	2013	SBI Card launches the Air India SBI Signature Card and the Air India SBI Platinum Card



14.	2014	SBI card launches SBI "Style U " Cards
15.	2014	SBI enters the 3 Million Cards hub
16.	2015	SBI card launches 'the simply save' SBI Card
17.	2016	SBI card launches SBI Card ELITE
18.	2016	SBI enters the 4 Million Cards hub

5A.5 SBI CARD issued by the Complainant has tie ups with global service providers like MasterCard and VISA. News reports from various evidencing the above are enclosed as Annexure B by the complainant with complaint.

5A.6 The Complainant, currently has a market share of 15 per cent, has a customer base of million cards. It caters to both the individual and corporate segments. SBI CARD offers a number of cards under each of the following categories. Printout from the website of the Reserve Bank of India evidencing the above is annexed as Annexure C by the Complainant with complaint.

5A.7 The Credit Cards offered under the brand SBI CARD by the Complainant are based on the value proposition of 'Make Life Simple' which is the core promise of the brand. The proposition stands testimony to Complainant's continuous efforts of simplifying the lives of their customers, employees and other important stakeholders in multiple ways. To achieve the



objective of "Make Life Simple" for the customers and users of their SBI CARD the Complainant has launched specific initiatives based on information technology and mobile technology which can be accessed through the website of the Complainant no. 2 at www.sbicard.com. Some of these initiatives are:

- i. SBI Card offers 15 payment options, the only Company in India to offer 15 different modes of payment options to customers which include online payment options through the website www.sbicard.com.
- ii. One of the first few companies to have migrated to the Europay, MasterCard and Visa (EMV) platform. Complainant No. 2 uses this cutting-edge technology for its wide spectrum of SBI Cards.
- iii. Insta-Card for making immediate spends.
- iv. Comprehensive real-time SMS/e-mail alerts system with more than 60 types of useful and critical alerts for cardholders.
- v. Website www.sbical.l.cotu that allows cardholders to discover the power of convenience & manage their SBI Card account 24*7.
- vi. A cutting-edge IVR (Interactive Voice Response) system, which is truly customer-friendly and has a 110St of services for the customers.
- vii. The SMS channel for grievance redressal wherein cardholders can simply SMS the word



"Problem" to < 9212500888> and get their concerns addressed.

viii. SBI Cards is also highly active on Twitter & Facebook, the Social Media Channel thus enabling a 360 degree approach to reach out to customers & in turn giving them various ways to contact us.

5A.8 Aimed at card-less transaction, the Complainant is also in a process to customize and launch Host Card Emulation (HCE) technology for its SBI CARD so that data of a customer's card can be stored in his/her mobile. The technology will help in the use of mobile telephone for credit card transactions.

5A.9 Over the years the Complainant's SBI CARD has won numerous awards:

- Rated in CNBC Consumer Awards 2 years in a row (2007—2009).
- Winner of Best Mature Captive Delivery Unit in Asia (2009).
- Rated #2 in Business World Survey on Customer Satisfaction (2007).
- "Best Compliance Program-2014" award at The Inaugural Annual Compliance Awards 2014.
- SBI Cards won 'Gold' at Reader's Digest Trusted Brand Survey 2015, for the 6th time since 2008.
- Most Trusted Brand' by Reader's Digest Awards 2016, for the eighth time since 2008.



- 'Excellence in Customer Service' award by Asia BPO Summit, 2012-13. • 'Excellence in Customer Service' at the Asia Outsourcing Excellence Awards organized by CMO Asia, 2014.
- 'Best Credit card Programs' for SimplyCLICK SBI Card at the MasterCard Innovation Awards 2016.
- 'Best Issuing Institution across India & South Asia' 2012, for fraud management by Visa Inc.
- 'Most Innovative Technology Legacy Transformation' award for Card One Customer Relationship Management tool at International Gartner Awards 2016.
- 'Best use of Social Media in Marketing' at 4th CMO Asia Award,
- 'Excellent Compliance Performer' at Annual Compliance 10/10 awards, 2016.

Photographs evidencing some of the above awards are annexed as Annexure D.

5A.10 SBI, the majority shareholder of the Complainant has had a chequered history of over 200 years and is the oldest financial institution of Indian Sub-continent. Today SBI is a multinational banking and financial services company based in India. It is a state-owned corporation with its headquarters in Mumbai, Maharashtra. As at December 2012, it had assets of US\$501 billion and 15,003 branches, including 157 foreign offices making it the largest banking and financial services company in India by assets. It is ranked 149



in global Forbes list of 149 largest public companies as per the latest figures of Forbes Magazine. Printout of Forbes website evidencing the above is annexed as Annexure E.

5A.11 SBI in order to expand its financial offerings has set up many subsidiaries and entered into joint ventures to provide various financial services to corporations and individuals like SBI Capital Markets Ltd., SBI Funds Management Pvt Ltd, SBI Factors & Commercial Services Pvt Ltd, SBI Life, SBI General Insurance and SBI Cards & Payments Services Pvt. Ltd, (SBICPSL) the Complainant herein to name a few.

5A.12 The Website of the Complainant www.sbicard.com is at the heart of the above initiatives. In addition to the above the website www.sbicard.com also provides all information to the customers and potential customers regarding various credit cards, offers and product offerings with respect to the SBI CARD branded credit cards. The website www.sbicard.com is the most significant medium to interact with the existing customers and potential customers, Some of the printouts from the website www.sbicard.com are annexed as Annexure F.

5A.13 The website sbicard.com allows cardholders to discover the power of convenience & manage

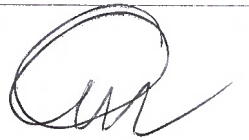


their SBI Card account 24*7. The adaptive and responsive website has 20 self-service features, including reward redemption, in addition to being mobile responsive. Besides the website - SBI Card Mobile App provides convenience of account management through mobile and is available across all mobile phone operating systems — iOS, Android, and Windows under the brand SBI CARD.

5A.14. The details of the complainant's trademark/brand are as under:-

- i. Complainant is the registered proprietor of the trade mark SBI CARD and other marks where SBI CARD forms an integral part. These marks have been registered with the Registrar of Trade Marks, Government of India. The details of the marks are as under. The copy of the proof of registration of Trade Marks issued under the Trade Marks Act, 1999 is enclosed as Annexure G.

Mark	Registration	Class	Goods/Services	Date of renewal



SBI CARD	2962690	42	PROVIDING OF COMPUTER PROGRAMMING ESPECIALLY DEVELOPMENT OF PROGRAMMES FOR DATA PROCESSING IN CONNECTION WITH FINANCIAL AND MONETARY AFFAIRS AND FOR FACILITATING MONETARY AND FINANCIAL TRANSACTIONS OVER COMPUTER NETWORKS INCLUDING THE INTERNET AND SERVICES THAT CANNOT BE CLASSIFIED IN OTHER CLASSES	14/05/2025
FLEXI PAY SBI CARD EASY INSTALLMENT PLAN	12		FINANCIAL AFFAIRS AND INSURANCE SERVICES FALLING IN CLASS 36. TELECOMMUNICATION SERVICES FALLING IN CLASS 38. COMPUTER PROGRAMMING SERVICES FALLING IN CLASS 42	21/08/2017
SBI CARD DROPBOX LOCATOR	15	36	ALL SERVICES INCLUDING CREDIT CARD FACILIE PROVIDED UNDER SAID CLASS.	21/08/2017

- ii. The brand and trade mark SBI CARD has become associated with the Complainant not



only by virtue of trade mark rights but also by virtue of long, continuous and extensive use since 1998.

- iii. The trade mark SBI CARD by virtue of its continuous use and its popularity amongst the public is a well-known and famous trade mark in India. Public at large not only associates the brand SBI CARD with very high quality financial services but also place very high degree of trust in the Complainant since it owned and provides products and services on behalf of most reputed financial institution of India SBI. SBI which is largest government owned financial institution has withstood the test of times and public places enormous faith and trust in the same.
- iv. Complainant uses word SBI as part of its marks and domain name under authority from SBI which is majority shareholder of the Complainant. The exclusive mandate of the Complainant is to manage and run the credit card business of the SBI under the brand SBI CARD in collaboration with GE which provides the back end and technical support to the joint venture.
- v. Since 2012-13 Complainant has spent more than Rs. 20 Cr in promotion of their credit cards under the brand name SBI CARDS which includes campaigns like 'Lets connect lets Simplify', 'Platinum card' and SBI CARD's



brand association with cricketer Yuvraj Singh during the year 2006-07. Copies of advertisements for SBI CARD over the years is annexed as Annexure H and annexed as Annexure I are the copies of audited account statements showing the promotional expenses in last few years:

	Financial Year 2013-14 (For the year ended March 31, 2014)	Financial Year 2014-2015 (For the year ended March 31, 2015)	Financial Year 2015-2016 (For the year ended March 31, 2016)
Advertisement	Rs. 240,181,410	Rs. 382,253,255	Rs. 248,747,389
Sales Promotion	Rs. 1,467,576,368	Rs. 2,570,290,551	Rs. 3,622,628,256

vi. Some of the product offerings of the Complainant under the brand and trade mark SBI CARD are:

SBI CARD ELITE

SIMPLYSAVE SBI CARD

SIMPLYCLICK SBI CARD

SBI SIGNATURE CORPORATE CARD

SBI PALTINUM CARD

SBI GOLD & MORE CARD

SBI ADVNATGE CARD

SBI ADVANTAGE PLUS CARD

vii. Besides the above Complainant No. 2 has also entered into numerous co-branded card offerings with some of the leading brands in India some of these are:



SBI TATA CARD
SBI IRCTC CARD
YATRA SBI CARD
AIR INDIA SBI CARD
CAPITAL FIRST
MUMBAI METRO

- viii. Complainant's SBI CARD has been official credit card partner for BIG BILLION DAY shopping festival on the e-commerce website www.flipkart.com since 2015.
- ix. Such is repute of the brand SBI CARD that the abovementioned brands which are very famous in their own rights have tied up with the Complainant for offering services to their customers through the credit cards offered by the Complainant.
- x. In addition to the above Complainant offers SBI Co-branded cards with other banks like:
- Bank of Maharashtra
 - Karur Vysya Bank
 - South Indian Bank
 - Federal Bank
 - Oriental Bank of Commerce
 - Lakshmi Vilas Bank
- xi. Due to all the above mentioned factors the Complainant has a second highest customer subscriber based amongst all credit card providers in India and the various credit cards



provided under the brand SBI CARD are very popular in India.

- xii. The abovementioned factors also go on to show that Complainant is proprietor of the trade mark SBI CARD, By virtue of extensive use of the trade mark SBI CARD as shown above the public at large associates the trade mark SBI CARD with the Complainant herein.

5A.15. The Complainant has huge internet presence and its website www.sbicard.com is vital to its businesses. The Website targets both existing customers with various online services and also provides vital information for new customers. Large amount of business of the Complainant is derived from their Website.

- i. It is submitted that the Website has SBI CARD as the distinctive element of the domain name and contains the trade mark SBI CARD in entirety.
- ii. Complainant owns the domain name www.sbicard.com, The domain www.sbicard.com was created on May 4, 1999 and has been continuously used since then, The domain is registered by General Electric Company, 3135 Easton Turnpike, Fairfield, CT 06828-0001, US the joint venture partner of the Complainant providing technology and back office support to the operations of the Complainant No. The website www.sbicard.com is integral to the business of

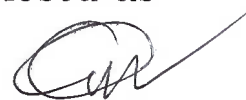


the Complainant No. 2 and it not only provides information with respect to the products and services of the Complainant but also gives platform to the customers to opt in or opt out of various services and also make payments and other e-commerce based online financial transactions in relation to their SBI CARD credit card. Large amount of business of the Complainant No. 2 is generated and executed on the website www.sbicard.com. Hence the website and domain name www.sbicard.com is critical component of the business of the Complainant.

iii. The website www.sbicard.com is one of the most popular websites and below is the list of monthly hits sinc2012:

Monthly Visits	2012	2013	2014	2015	2016	2017
January	18,11,450	25,26,275	32,54,993	47,33,728	96,99,451	1,42,67,953
February	18,62,240	24,68,562	29,17,083	42,13,281	87,80,497	1,26,53,423
March	20,43,165	28,28,453	33,48,495	47,37,140	94,86,157	1,41,11,142
April	20,24,043	27,39,455	31,29,872	45,30,546	90,61,988	51,85,574
May	21,87,409	27,57,687	32,66,366	51,81,162	93,01,221	
June	20,03,377	25,58,822	33,25,847	47,78,667	94,99,886	
July	22,24,010	29,76,045	34,82,232	51,69,343	10,565,259	
August	22,82,696	29,18,235	37,28,733	51,17,202	10,885,862	
September	22,444,158	28,15,331	37,70,060	49,34,850	10,574,528	
October	24,40,340	31,58,836	41,79,854	93,46,736	11,784,217	
November	25,00,837	29,70,683	41,50,436	98,99,079	11,742,550	
December	25,71,298	31,64,710	44,81,682	10,218,141	13,863,822	

Copy of the printout from tool Adobe Omniture from August 2015 to April 2017 which maps number of visitors on a website is enclosed as Annexure J.



- iv. The website www.sbicard.com is also viewed and visited from countries outside India, Chart below provides the details of the number of hits on the website from various countries:

Countries	2012	2013	2014	2015
India	24153056	31932596	40407673	43531195
United States	834064	940633	1047547	1101439
United Kingdom	220177	234100	244618	242357
Singapore	197152	273156	319054	299905

Hong Kong	95272	107813	112836	105905
United Arab Emirates	53599	77451	105532	126217
Germany	52854	57179	71864	75352
Australia	35840	43971	53769	55878
France	35263	42472	58942	68807
Canada	33454	50470	100821	37078

- v. Online metrics website www.alexa.com ranks www.sbicard.com as 150 most visited website in India, Print out from website www.alexa.com is annexed as ANNEXURE K. The Facebook page of SBI CARD has over 8.70 lac likes and followers and twitter handle @SBICARD_Connect has over 139.6k followers. Print out of the Facebook page is annexed as ANNEXURE L.



- vi. An entity desirous of trading or providing its services through the medium of the Internet invariably uses its existing trademark/trading style or service mark as its domain name so as to avoid confusion between what is advertised upon the Internet and the mark as used in the physical world. Further the use of the realworld trademark serves as the most visible, identifiable and verifiable indicator of the existence of the entity in question upon the Internet. In view of this, the Complainant domain name, located at the URLs www.sbicard.com as identified herein above, functions as a trademark in the Internet world, as the Complainant provides exhaustive information, advertisements and sales of its products through its said website. No entity other than the Complainant, therefore, has any right or justification to use the word "SBI CARD" or any deceptively similar marks in respect of its domain name / URL. Enclosed as Annexure M are print outs from the website https://archive.org/web/also known as Wayback Machine from 1999 to 2016 showing continuous use of the website www.sbicard.com by the Complainant.
- vii. The preceding paragraphs clearly demonstrate that the Trade mark SBI CARD are exclusively associated with the Complainants herein and can be classified as well-known trademarks under Article 6 Bis of the Paris Convention.



5A.16 The Respondent in the present dispute has registered the domain name www.sbicard.in thereby misappropriating illegally and without authority, the trade mark SBI CARD word which is exclusive property of the Complainant.

5A.17 The Complainant submits that Respondent is seeking to capitalize on the goodwill associated with the trademark of Complainants and has registered in bad faith and without authorization, the domain name in issue <sbicard.in> which

- i. Wholly incorporates the registered trade mark SBICARD of the Complainant.
- ii. Is identical to the Complainants' trademark SBI CARD.

5A.18 The domain name <sbicard.in> is identical to the trademark trading style of the Complainant, thereby making confusion and deception inevitable.

5A.19 The domain name of the respondent www.sbicard.in was registered on July 19, 2015. This date of registration of domain name is well after the first use of the trade mark SBI CARD and domain www.sbicard.com by the Complainant.

5A.20 The Respondent is a typical cyber squatter as it is not using the domain name www



sbicard.in but has registered the same with the malafide intent to profit from the goodwill of the trade mark that rightfully belongs to the Complainant.

5B **RESPONDENT**

The Respondent, as aforesaid, did not file any response to the averments made in the complaint and/or the documents filed in support thereof. Consequently, the panel has to proceed with the matter on the basis of the material on record and pass appropriate orders in accordance with law.

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 thereunder 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.

6.5 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.



- 6.6 The decision of Hon'ble Supreme Court of India in the matter of **Jahuri Sah 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). The material facts stated in the complaint have neither been dealt with nor specifically disputed or denied by the Respondent.
- 6.7 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.
- 6.8 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. I, therefore, proceed to deal with the three elements under the policy irrespective of the deemed admissions made by the respondent to the averments made in the complaint and the documents filed on record.

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 trade mark details of the Complainant No.1 along with the copy of registration certificates and other documents have been provided in the above mentioned paragraphs and the list is not being reproduced here for the sake of brevity.
- 6A.3 The Complainant is the common law proprietor of the Mark SBI CARD as explained in preceding paragraphs. The continuous and wide use of the trade mark SBI CARD for last many years is not disputed.
- 6A.3 The Complainant is also the registered proprietor of the Mark SBI Card.
- 6A.4 The Complainant has been using the mark SBI CARD since the year 1998 when the first SBI CARD was launched in the market.
- 6A.5 Besides the statutory rights obtained by the Complainant for the mark SBI CARD, the Complainant also has common law rights by virtue of extensive use of the mark SBI CARD since 1998. Therefore, the Complainant has statutory as well as common law rights in the mark SBI CARD. In the paragraphs above it is shown that the Complainant has extensively



used the mark SBI CARD for last many years the contents of the same are not being reproduced for sake of brevity.

6A.6 The disputed domain name www.sbicard.in wholly contains the Complainants well known trade mark "SBI CARD" and is also confusingly similar to the Complainant's domain name www.sbicard.com. The Complainant's statutory as well as common law rights in the mark SBI CARD are infringed by the adoption/use of any identical or deceptively similar mark.

6A.7 The dominant part of the disputed domain name www.sbicard.in registered by the Respondent, contains the mark SBI CARD of the Complainant in its entirety thereby creating obvious connections to the Complainant's business thereby causing enormous confusion amongst internet users in general and people wanting to avail the services of the Complainants in particular who are likely to be misled into believing that the disputed domain www.sbicatd.in belongs to the complainant. The only point differentiating two domain names www.sbicard.in & www.scicard.com of the Complainant is g TLD <.com> and <.in> which as per settled principles of domain name dispute resolution cannot be taken into account while considering the similarity of the two domain names.

6A.8 It is settled principle of law that if the complainant owns a trade mark, then it generally satisfies the threshold requirement of the complainant having exclusive rights therein.

6A.9 The extensive use of the trade mark in question has been shown and proved by the complainant by documentary evidence. It is a settled position of domain name disputes jurisprudence that in order to assert trade mark rights in these proceedings and to prove that the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights, the Complainant can rely on its common law as well as statutory rights in its trade mark.

6A.10 In view of the common law rights vesting in the mark SBI CARD by virtue of extensive use of the trade mark SBI CARD since 1998 and also due to statutory rights vesting in and to the mark SBI CARD by virtue of registrations of the trademark. The Complainant has acquired exclusive rights in the said mark in relation to the services provided by them. Any third party, including the respondent, using the mark SBI CARD would be understood as a reference to Complainant leading to confusion and deception to the people at large who may wish to access the website of the Complainant only.



RIGHTS OR LEGITIMATE INTEREST

6A.11 The Complainant is therefore successful in establishing the first element of INDRP and the panel finds that the disputed domain name is identical to the mark/domain name of the complainant. Consequently, the first requirement of paragraph 4 of the policy is satisfied.

B. RIGHTS OR LEGITIMATE INTEREST

6B.1 Paragraph 7 of the Policy lists the following three non-existence methods for determining whether the Respondent has rights or legitimate interest in the disputed domain name:

(i) *before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;*

(ii) *the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights;*
or

(iii) *the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.*

6B.2 The Domain Names under the Policy are available to anyone on first come first serve basis. In case, any person or organization claims right over the Domain Name as violation of its trade/service mark rights, the onus is on such person/organization to prove the right in the mark and the burden thereafter shifts to the Respondent to prove its legitimate interest and the use of the Domain Name in good faith.

6B.3 Since the disputed domain name www.sbicard.in comprises of the mark SBI CARD as a whole which is used in connection with Complainant's services in relation to finance, banking and credit cards for last many years, it is clear that the Respondent can have no right or legitimate interest in the said domain name, Further it is apparent that since the Respondent is not using the disputed domain name www.sbicard.in, the sole intention of respondent seems to be to sell the disputed domain name to the Complainant or its competitor at a profit as a result of the same.

6B.4 There exists no relationship between the Complainant and the Respondent. Further neither has the Complainant authorized or licensed the Respondent to register or use the domain name www.sbicard.in incorporating the trademarks of the Complainant, Furthermore, apart from having registered the

domain name www.sbicard.in, the Respondent has no obvious connection with the disputed domain name www.sbicard.in or with the trade marks forming part of the said domain name. Moreover the Respondent is not using the domain name and therefore, the mere assertion by the Complainant that the Respondent has no right or legitimate interest in respect of the said domain name is sufficient to shift the burden of proof to demonstrate that such right or legitimate interest in respect to the said domain name does exist. The Respondent does not offer any goods or services under the trade mark SBI or SBI CARD nor use the disputed domain name for any purpose except for advertisements on pay per click basis. This behavior of the Respondent is typical of cyber squatters.

6B.5 The Respondent's website is not bona fide since the Respondent himself is not engaged in any activity of its own to show that he has legitimate rights or interest in the disputed domain name. It appears that the Respondent neither in the past had nor in future has any intention to use the domain name www.sbicard.in in any legitimate and bona fide manner and has registered the disputed domain name to make undue profits riding on the goodwill of the Complainants well known and famous trade marks by using them as key words to generate links and advertisements. Such links and advertisements in many cases

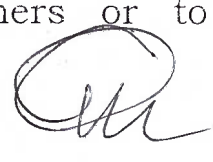


belong to the competitors of the Complainant thereby causing monetary loss to the Complainant. Furthermore, the eventual intent of the Respondent is to sell the domain name to the highest bidder. Such behavior of Respondent is strictly commercial in nature with an intent to divert the consumers of the Complainants who wish to visit the website of the Complainants but are diverted to other websites including those of competitors of the Complainant thereby tarnishing the reputation and goodwill of the Complainants and their trade marks which they have created by years of hard work. WIPO Panels have recognized that many domain names have both dictionary word meanings and trademark (or secondary) meanings, and when the links on the PPC landing page "are based on the trademark value of the domain names, in such cases the trend in UDRP decisions is to recognize that such practices generally do constitute abusive cybersquatting and commercial use of the domain name. Reference in this respect be made to the decision of Champagne Lanson v. Development Services/MailPlanet.com, Inc., WIPO Case No. D2006-0006 (PPC landing page not legitimate where ads are keyed to the trademark value of the domain name); The Knot, Inc. v. In Knot we Trust Ltd, WIPO case No. D2006-0340 (same); Brink's Network, Inc. v. As productions, WIPO case No. D2007-0353.



6B.6 From the facts available it can be said that the Respondent was never known by the disputed domain name and never sought any permission from the Complainant to register or use the disputed domain name the same was registered by him without any legitimate interest or bona fide. *Compagnie de Saint Gobain v. Com-Union Corp.*, WIPO Case No. D2000-0020 in which it was found that there are no rights or legitimate interests in the domain name where respondent was not commonly known by the mark or never applied for a license or permission from the complainant to use the trademarked name.

6B.7 In view of the above the Complainant has, by virtue of the facts available, proved negatively all the three elements mentioned in Paragraph 4 of the INDRP namely that:

- the Respondent has made any demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services prior to the dispute;
 - an indication that the respondent has been commonly known by the domain name even if it has acquired no trademark rights; or
 - the Respondent has made legitimate non-commercial or fair use of the domain name without intent to divert consumers or to tarnish the trademark.
- 

6B.8 The Panel rely upon the judicial and administrative decisions in support of the above findings:-

- i. Creative Technology Ltd. Vs. Cleveland Polite (Case No. D2005-1211).
- ii. Marker Volkl (International) GmbH Vs. Tucows.com Co. (Case No. D2012-1461).
- iii. The Knot, Inc. Vs. In Knot We Trust Ltd. (Case No. D2006-0340).
- iv. International Business Machines Corporation (IBM) Vs. Guanbing Meng (Case No. DCC2011-0006).

6B.9 The panel hold that the complainant has successfully proved the second element and demonstrated that the respondent have no legitimate right or interest in the disputed domain name.

REGISTERED 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 For the purposes of establishing registration and use of Domain Name in bad faith by the Complainant, any of the following circumstances should be present:-



- i) Circumstances indicating that the Registrant has registered or acquired the Domain Name primarily for the purpose of selling, running or otherwise transferring the Domain Name registration to the Complainant, who bears the name or is the owner of the trade mark or service mark, or be a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the Domain Name; or
- ii) The Registrant has registered the Domain Name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding Domain Name, provided that the Registrant has engaged any pattern of such conduct; or
- iii) By using the Domain Name, the Registrant has intentionally admitted to attract Internet users to the Registrant's Website or other online location, by creating a likelihood of confusion that the Complaint's name or mark as to the source, sponsorship, affiliation or endorsement of the Registrant's Website or location or of a product



or service on Registrant's Website or location.

6C.3 The disputed domain name, as aforesaid, was registered on 19.07.2015.

6C.4 The domain name www.sbicard.in registered by the Respondent is identical and confusingly similar to the Complainant's well known trade mark SBI CARD in which the Complainants have substantial interests and have generated huge amount of goodwill and reputation. The Respondent registered the domain name www.sbicard.in in order to piggy-back off the commercial value and significance of the Complainants domain name www.sbicard.com.

6C.5 Furthermore, it is evident from the factual background presented herein that the disputed domain name www.sbicard.in has been registered by the Respondent to take advantage of the goodwill associated with the Complainant's trade mark SBI CARD as can be seen from the advertising revenue being generated from the website on the disputed domain name and eventually force the Complainant to buy the disputed domain name at exorbitant costs or to sell the domain name to any third party. The above act of the Respondent is nothing but his attempt to seek illegal gratification by virtue of the bad faith registration of the disputed domain name www.sbicard.in. Reference is made to the



views of the WIPO Panel in Intel Corporation v. The Pentium Group, WIPO Case No. D2009-0273, "It is not reasonably tenable that the Respondent has gone to the trouble and expense of purchasing and registering the disputed domain name and having it hosted as a parking page website, with advertising links, without purpose. The ultimate purpose may be the sale of the disputed domain name, however it is not necessary for the Panel to know since it is a reasonable presumption that in the short term the disputed domain name generates revenue from click-through referrals. Whether this revenue accrues directly to the Respondent or to the host, or to both, is immaterial (Villeroy & Boch AG v. Mario Pingerna, WIPO Case No. D2007-1912). Upon the totality of the evidence, the Panel finds that the Respondent has attracted viewers for commercial gain by confusion within the meaning of paragraph 4(b)(iv) of the Policy, constituting registration and use in badfaith.

6C.6 The Complainant's trade mark SBI CARD is a well known and famous mark, and the Respondent is presumed to have knowledge of Complainant's trade mark at the time it registered confusingly similar domain name wholly based upon Complainant's prior use and registration of the mark. It has be held that the incorporation of a well-known trademark into a domain name by a registrant having no plausible explanation for doing so



may be, in and of itself, an indication of bad faith, to establish this. Reference is made to the following decisions of the panel Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group co., WIPO case No. D2000-0163; General Electric Company v. CPIC NET and Hussain syed, WIPO case No. D2001-0087; Microsoft Corporation v. Montrose Corporation, WIPO Case No. D2000-1568).

6C.7 Registration of a famous trade mark as a domain name, without any legitimate commercial interest in the same is prima facie evidence that the Respondent was well aware of the reputation and goodwill attached to the Complainant's well known trade mark. Based on the above, the panel find that the disputed domain name has been registered and is being used in bad faith.

6C.8 The unlawful registration of the domain name by the Respondent is likely to result in the dilution of the Complainant's trade mark SBI CARD. The illegal registration of the above-mentioned domain name is also likely to cause irreparable damage and injury to the Complainant's reputation and goodwill, which is unascertainable due to the intangible nature of the goodwill. The Complainant has a significant presence in India and the impugned domain name registration, namely <sbicard.in> in the name of the Respondent, is precluding the Complainant and their affiliates



from obtaining a domain name registration that is India-specific, which is invaluable in the marketing and sale of its products and services in the territories of India.

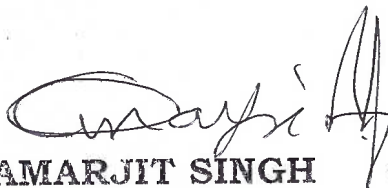
6C.9 In the above circumstances, the Panel concludes that the registration of impugned Domain Name was obtained in bad faith.

7. **DECISION**

The Complainant has succeeded in establishing all three elements of the policy.

In view of the above discussions, the Panel direct the transfer of impugned domain name <www.sbicard.in> to the complainant.

The respondent is also directed to pay cost of Rs. 20,000/- to the complainant.


AMARJIT SINGH
Sole Arbitrator

Dated: 15th July, 2017