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BEFORE THE INTERNATIONAL EXCHANGE OF INDIA
ARBITRATION AWARD

ARBITRATOR: S. SRIDHARAN

Dated: 28th June 2009

Huawei Technologies Co Ltd --- Complainant
V

Mr. Shan mugam a.k.a Karan --- Respondent

Sridharan

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Huawei Technologies Co. Ltd

1. The Parties

- 1.1 The Complainant is Huawei Technologies Co. Ltd., a limited company, having its principal place of business at Bantian, Longgang District, Shenzhen 518129, People's Republic of China, represented by its counsel, Mukul Baveja & Rashi Nagpal of Fox Mandal & Co A-9, Sector-9, Noida NCR of Delhi - 201301

The Domain Name and Registrar

- 1.2 The disputed domain name <huawei.in> is registered with #1 Indian Domains dba Mitsu.in.

2. Procedural History

- 2.1 On 13th May 2009, the Arbitrator received a email from NIXI asking him to express his availability and consent to take up the Complaint for arbitration. By return mail, the Arbitrator confirmed his availability and consent. On the same day the Arbitrator by email sent an electronic



version of signed Statement of Acceptance and Declaration of Impartiality and Independence.

- 2.2 On 16th May 2009, the Arbitrator received hardcopy of the Complaint along with Annexures.
- 2.3 On 16th May 2009, the Arbitrator 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. Arbitrator also sent an email about his appointment to arbitrate the complaint to the Complainant and asking him to transmit a soft copy of the Complaint.
- 2.4 On 17th May 2009, Arbitrator noted that the notice meant for Respondent was wrongly sent to the email address of the domain name registrar. The mistake was rectified immediately and fresh notice was sent to the email address of the Respondent as specified in the Whois data base. Respondent was also informed that his time to file counter started from 17th May 2009. This mail bounced back for technical reasons and again it was sent on 19th May 2009.
- 2.5 On 18th May 2009, Arbitrator received soft copy of the complaint from the Complainant.
- 2.6 On 22nd May 2009, Arbitrator noticed the postal address of the Respondent in the Whois database and directed the Complainant to serve by reputed courier a copy of the complaint on the Respondent at his postal



address. Complainant was asked to submit the courier receipt to NIXI and intimate the Arbitrator the compliance of this direction.

2.7 On 25th May 2009, the Complainant by email confirmed that he would serve copy of complaint on the Respondent at his postal address and would comply with the directions of the Arbitrator.

2.8 The Respondent has not entered appearance. He has not filed any reply to the Complaint of the Complainant.

2.9 Email is the medium of communication of this arbitration and each email is copied to all, Complainant, Respondent and NIXI. Complainant took steps by courier to serve copies of the complaint on the Respondent and furnished copy of the courier receipt to NIXI.

3. Factual Background

A Complainant

3.1 The Complainant, Huawei was founded by Ren Zhengfei in 1988. The Complainant is one of the world's leading networking and telecommunications equipment manufacturer and supplier. It provides fixed network, mobile network, data communications, optical network, software & services and terminals, including modems — ranging from switching, integrated access network, NGN, xDSL, optical transport, intelligent network, GSM, GPRS, EDGE, W-CDMA, CDMA2000, a full series of routers and LAN switches, videoconferencing, terminals to other



key telecom technology fields. The Complainant also manufactures mobile phones.

- 3.2 The Complainant's products are marketed and sold in over 100 countries, including India. The Complainant has a huge customer base which spreads across the globe in several countries. Some of the key customers of the Complainant include Oi, Hola Paraguay, China Telecom, China Mobile, China Netcom, China Unicom, BT, Carphone Warehouse (UK), Tiscali (UK), Opal, BSNL (India). The Complainant's 3G equipment has been commercially deployed in the UAE, Hong Kong, Malaysia, Mauritius and the Netherlands.
- 3.3 The Complainant's global contract sales for 2006 reached USD11 billion (a 34% increase from 2005), 65% of which comes from overseas market. The Complainant has now become a leading vendor in the industry and one of the few vendors in the world to provide end-to-end 3G solutions. The Complainant has received many awards.
- 3.4 The Complainant has spent a huge amount of money on the promotion and advertisement of its services and products under the trade/service name/mark **Huawei** since 1988. The Complainant has given at **Annexure D** a statement of promotional and advertising expenditure incurred by the Complainant in the recent past along with a few advertisements released by it.
- 3.5 The profile and popularity of the Complainant under the trade/service name/mark **Huawei**, has been continuously increasing since the date of

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adoption and use of the mark. At present, the Complainant's trade name/mark is a name to reckon with and has acquired an enormous goodwill not only in India but in many countries across the globe. The **Huawei** mark/brand mark, due to its extensive use, advertisements, publicity and awareness throughout the world, has acquired the status of a WELL KNOWN TRADE MARK under Section 2(1)(zg) of the Trade Marks Act, 1999. The mark **Huawei** qualifies all tests for the well-known status of a mark under Section 11 (6) of the Trade Marks Act.

3.6 The Complainant considers its trade/service name/mark, **HUAWEI**, an important and an extremely valuable asset and thus in order to protect the same, has obtained numerous trade mark registrations in different countries including India, for the said mark. The Complainant has filed a copy of the Indian trade mark registration under No.773291 in class 09 at **Annexure E**. Copies of Chinese registrations are annexed at **Annexure F**. A list of registrations in other countries is annexed at **Annexure G**.

3.7 The name/mark **Huawei** is distinctive, unique and an invented mark. A mere mention of the said name/mark establishes an identity and connection with the Complainant and none else. The use of the mark **Huawei** either as a mark, name, domain name, or in any other form whatsoever constitutes infringement and passing off and is a violation of the Complainant's rights in his mark.

3.8 The Complainant, in order to expand its presence, decided to obtain a domain name registration. The Complainant settled for www.huawei.com

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as a natural extension of its corporate name for the registration of its domain name. The complainant has spent considerable amount of money and skill to develop a detailed website on its domain name. The website www.huawei.com is a comprehensive guide to the business activities of the Complainant. Further, the website provides contact details of the Complainant. A print out of the Home Page of the Complainant's website www.huawei.com is annexed at **Annexure H**.

3.9 The Complainant has always taken prompt actions against third parties which register identical or deceptively similar domain names in bad faith and hoard the said domain names without any legitimate interest. One such action was taken by the Complainant against a domain name hoarder for the domain name www.huawei.co.in . The Complainant took arbitration proceedings and the domain name was transferred to the Complainant. The Complainant has filed a copy of the award at **Annexure I**.

3.10 In November, 2007, the Complainant came to know that somebody has obtained a domain name registration for www.huawei.in. The Complainant immediately filed a domain name complaint before NIXI on November 20, 2007. The Ld. Arbitrator appointed by NIXI saw merit in the complainant's case and therefore granted an award of transfer of the domain name in favour of the Complainant. The said award in favour of the Complainant is annexed with the complaint as **Annexure J**.

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Thereafter, the Complainant took control of the domain name www.huawei.in.

3.11 However, due to inadvertence, the Complainant missed to renew the registration for the disputed domain name <huawei.in> before its expiry date. But when the Complainant undertook to renew its disputed domain name <huawei.in> it was shocked to know that another third party, i.e. the Respondent was in its possession. The Complainant therefore took immediate steps to get back the disputed domain name and instructed its counsels to write a legal notice to the Respondent. The legal notice sent to the Respondent categorically stated that the complainant has already secured rights in the domain name www.huawei.in, vide an award of an arbitrator appointed by NIXI. However, to its utter dismay, the Complainant has not received any official reply from the Respondent and the Respondent continues to hoard the disputed domain name <huawei.in> of the Complainant till date. The said legal notice dated October 22, 2008 sent by the Complainant to the Respondent is annexed at **Annexure K**.

3.12 Being aggrieved by the bad faith hoarding of the disputed domain name <huawei.in>, the Complainant has approached this Hon'ble Forum.

B Respondent

3.13 The Respondent has not filed any reply to the Complainant's Compliant in this arbitration.



Parties Contentions

Complainant

A mere glance at the disputed domain name gives rise to enormous confusion as to its origin as the disputed domain name <huawei.in> is identical to the corporate name of the Complainant. The utmost malafide intention of the respondent is evident from the fact that not even a single letter differs between the disputed domain name and the corporate name of the Complainant

Respondent has picked up the mark/name of the Complainant verbatim without even changing a single letter. Thus, the use of the disputed domain name by the Respondent is a prima facie case of cyber squatting and trade/service mark/name infringement.

The name/mark **Huawei** is distinctive, unique and an invented mark. The mere mention of the said name/mark establishes an identity and connection with the Complainant and none else. The Complainant owns all the rights including statutory and common law rights in the said name/mark and is entitled to protection under the Indian Trade Marks Act, 1999. The use of the said name either as a mark, name, domain name, or in any other form whatsoever constitutes violation of the Complainant's statutory rights.

It is also well established that the specific top level of a domain name such as ".com", ".org" may be disregarded when determining whether it is

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identical or confusingly similar to the trade mark in which the Complainant has rights.

4.5 The Respondent, apparently, is in the business of holding domain names and selling them whereas the Complainant is an established business entity doing business under the brand **Huawei** since 1988. This is adequate evidence to show that the Respondent has no legitimate interests in the disputed domain name and is merely hoarding the same without doing any business from it.

4.6 The Respondent has no proprietary or contractual rights in any registered or common law trade mark corresponding in whole or in part to the disputed domain name <huawei.in>. Further, the Respondent is not authorized or licensed by the Complainant to use its trade/service mark/name or to use the disputed domain name. The Respondent is not running any website on the disputed domain name and thus not doing any business from it. The only conclusion that can be drawn from such an act of the Respondent is that the Respondent neither has any bona fide interest in respect of offering of goods and services nor it has any legitimate non-commercial or fair use of the disputed domain name <huawei.in>.

4.7 The illegality in the registration of the disputed domain name <huawei.in> arises from the fact that domain names today are a part and parcel of corporate identity. A domain name acts as the address of the company on the internet and can be termed as a web address or a web mark just like a

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trade mark or service mark. It is also the internet address of a company. The mere act of registration by the Respondent of the disputed domain name containing the entire corporate name of the Complainant in it constitutes passing off.

4.8 The fact that the Respondent registered the disputed domain name <huawei.in> just as it expired in October, 2008 is a prima facie evidence of malafide intentions and bad faith. The Respondent was very much aware that the Complainant has been conducting business through its primary domain name www.huawei.com and therefore it hoarded the disputed domain name <huawei.in> with the malafide intention to sell it and make illegitimate profit out of it.

4.9 The Respondent has obtained registration for the disputed domain name in bad faith for either or all of the following motives:

- (i) The disputed domain name <huawei.in> could be used by the Respondent to extract huge sums of money from the Complainant who has legitimate interest in it. This is pretty much evident as the Respondent is not running any website on the disputed domain name.
- (ii) Through the disputed domain name <huawei.in>, by activating a website, the Respondent may be able to represent itself as the Complainant or its authorized representative and cause damage to some third party by entering into transactions or contracts with them under the garb of being associated with the Complainant. This

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can be extremely dangerous and prejudicial to public interest as well.

- (iii) The Respondent can transfer or sell the domain name to some competing interest of the Complainant who may damage the goodwill and reputation of the Complainant by inserting prejudicial material in relation to the Complainant. This will lead to complete tarnishment of the Complainant's image if valuable property like the disputed domain name <huawei.in> falls into the hands of competing interests.

B. Respondent

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

5. Discussion and Findings

- 5.1 Respondent was served electronically (email) and by post. He was given sufficient time to respond to the Complaint. But the Respondent did not file his response. Since the Respondent has chosen not to respond to this Complaint within the time granted to him, I am proceeding to determine this Complaint on merits based on the materials available on record.

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:

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- (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.

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

5.4 The Complainant is the proprietor of the mark Huawei and has been using the mark Huawei since 1988. The Complainant has registrations for the mark Huawei throughout the world, including India. The Complainant has owned web sites such as www.huawei.com and www.huawei.co.in . Information about the Complainant and its products are available on the web sites. The Complainant's web sites wholly comprise its registered trade mark Huawei. The Complainant was the first owner of the disputed domain name <huawei.in> by virtue of an award dated 20.02.2008. It was not renewed later on by the Complainant. The Complainant's trade mark Huawei was registered first in India in 2006 and is effective from 24.10.1997. The disputed domain name <huawei.in> was registered by



the Respondent only on 12 October 2008. The Complainant is the prior adopter of the mark Huawei. The above facts have established that the Complainant has both common law and statutory rights in respect of its trade mark Kenneth Cole.

5.5 The Complainant's Huawei mark is well known throughout the world including India. It is clearly seen that the disputed domain name <huawei.in> wholly incorporates Huawei, the prior registered trade mark of the Complainant.

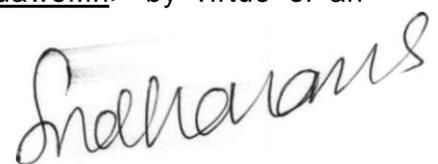
5.6 I, therefore, find that:

- (a) The Complaint has both common law and statutory rights in respect of its trade mark Kenneth Cole.
- (b) The disputed domain name <huawei.in> is confusingly similar to the Complainant's prior registered trade mark Kenneth Cole.

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

5.7 It is already seen that:

- (a) The Complainant is the prior adopter and user of the mark Huawei. The Complainant's mark Huawei is well known in many countries across the globe including India.
- (b) The Complainant's trade mark was adopted in the year 1988. It was registered first in India in 2006. The Complainant was the first owner of the disputed domain name <huawei.in> by virtue of an

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award dated 20.02.2008. Complainant failed to renew subsequently. The disputed domain name <huawei.in> was registered by the Respondent only on 12 October 2008.

- 5.8 The Respondent has not filed any reply and has not come up with any reason for adopting the disputed domain name <huawei.in>
- 5.9 The Respondent is not running any website on the disputed domain name <huawei.in> and thus not doing any business from it. The Respondent has no proprietary or contractual rights in any registered or common law trade mark corresponding in whole or in part to the disputed domain name <huawei.in>. Further, the Respondent is not authorized or licensed by the Complainant to use its trade/service mark/name or to use the disputed domain name.
- 5.10 The mere act of registration by the Respondent of the disputed domain name <huawei.in>. containing the entire corporate name of the Complainant in it constitutes passing off.
- 5.11 The above facts indicate that the Respondent neither has any bona fide interest in respect of offering of goods and services nor has it any legitimate non-commercial or fair use of the disputed domain name <huawei.in>.
- 5.12 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 <huawei.in>.

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

5.13 The Complainant's well known trade mark Huawei was adopted in the year 1988. It was registered first in India in 2006. The Complainant was the first owner of the disputed domain name <huawei.in> by virtue of an award dated 20.02.2008. The Complainant failed to renew it and the disputed domain name <huawei.in> was freely available to third parties for registration. The Respondent got registered it on 12th October 2008. Immediately on 22nd October, the Complainant issued a legal notice to the Respondent, *inter alia*, for transfer the disputed domain name <huawei.in> to the Complainant. But the Respondent did not send any reply to the legal notice. Thereafter, the Complainant filed this Complaint.

5.14 Mere non-renewal of disputed domain name <huawei.in> in 2008 by the Complainant does not entitle the Respondent to adopt the same. Even in the absence of prior adoption of disputed domain name <huawei.in> the Complainant is entitled to take action against the Respondent. It is because the disputed domain name <huawei.in> wholly incorporates the prior registered well known trade mark Huawei of the Complainant. Further, the Respondent has not come up with any reason for adoption of the disputed domain name <huawei.in>. The Respondent is not running any website on the disputed domain name <huawei.in> and thus not doing any business from it.

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- 5.15 The Respondent has no proprietary or contractual rights in any registered or common law trade mark corresponding in whole or in part to the disputed domain name <huawei.in>. Further, the Respondent is not authorized or licensed by the Complainant to use its trade/service mark/name or to use the disputed domain name.
- 5.16 It is apparent that the Respondent has registered the disputed domain <huawei.in>name for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who is the proprietor of the trade mark and trade name Huawei, or to a competitor of the Complainant, for a valuable consideration.
- 5.17 The Respondent has registered the disputed domain name in order to prevent the Complainant - the proprietor of the trademark and / or service mark Huawei from reflecting the mark in a corresponding domain name.
- 5.18 The above facts have clearly established the bad faith registration of the disputed domain name <huawei.in> by the Respondent.
- 5.19 The actions of the Respondent should not be encouraged and should not be allowed to continue. 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 prayed for in the Complaint.

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It is hereby ordered that the disputed domain name <huawei.in> be transferred to the Complainant.

Respondent is ordered to pay the Complainant a sum of Rs.5,00,000/- (Rupees five lakhs only) towards costs of the proceedings.



S.Sridharan
Arbitrator