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IN THE HIGH COURT OF DELHI AT NEW DELHI

Date of decision: 24th January, 2018

+ OMP(COMM) 223/2016

LENS. COM, INC.

..... Petitioner

Through

Mr.Jai A. Dehadrai, Mr.Shivangini
Gupta, Mr.Sidharth Arora, Mr.David
George & Mr.Anil Mishra, Advs.

versus

JU J FRIEND INTERNATIONAL

..... Respondent

Through None.

CORAM:

HON'BLE MR. JUSTICE NAVIN CHAWLA

NAVIN CHAWLA, J. (Oral)

1. This petition under Section 34 of the Arbitration and Conciliation Act, 1996 has been filed by the petitioner, Lens. Com, Inc challenging the arbitral award dated 29th June, 2015 passed by the Sole Arbitrator. The arbitration was conducted under the ‘.In Domain Name Dispute Resolution Policy (INDRP)’ published by the National Internet Exchange of India (NIXI).

2. The petitioner, claiming itself to be a renowned Multinational Company incorporated in USA and dealing in online business of selling contact lenses to the consumers in North America and globally, filed a complaint before NIXI against the respondent seeking transfer of the domain name ‘lens.in’ registered in favour of the

respondent.

3. In the complaint, it was alleged that the petitioner has been operating the portal 'www.lens.com' from 1999 in the United States of America and various other countries. It was further alleged that the petitioner is the registered proprietor of the trademark/service mark and domain name 'lens.com' in various countries. The petitioner filed the complaint invoking para 4 of the INDRP to seek the transfer of the domain name 'lens.in' from the respondent to the petitioner.

4. In the arbitration proceedings, the respondent failed to appear or even file a reply to the notice regarding the complaint. The Sole Arbitrator in its impugned award has passed the following direction:-

“Decision

The disputed domain name is not identical and confusingly similar to trademark of the Complainant. The Complainant also has failed to prove that the Respondent does not have any right or legitimate interest in the domain name. The Respondent has not registered the disputed domain name in bad faith. Therefore the Complainant is not entitled to transfer of domain name to him, as he has also not established his bonafide rights in the disputed domain name as per law discussed above. However, the Respondent through the third party has categorically claimed that they are not the owners of the disputed domain name and the dispute is unrelated to them. Also it is pertinent to note that despite repeated reminders the third party did not submit the requisite documents. The situation that has arisen is the Complainant has failed to prove its rights in the disputed domain name and the Respondent does not want to be related to the domain name.

Hence it is the decision of the panel that the Domain name may be confiscated by registry and the same may be kept with it. In accordance with Policy and Rules, the Panel directs that the

disputed domain name [www.lens.in] be cancelled.”

5. The petitioner is aggrieved by the final direction given by the Arbitrator confiscating the domain name. It is submitted by the counsel for the petitioner that in terms of INDRP, the Arbitrator has no power to order confiscation of the domain name; the power of the Arbitrator is limited only to order the cancellation of the registrant's domain name or to transfer the registrant's domain name registration to the complainant. It is submitted that once the arbitrator had concluded that the respondent was not the owner of the disputed domain name and the third party claiming rights thereof had not filed the requisite documents in spite of repeated reminders, the Sole Arbitrator should have ordered cancellation of the respondent's domain name and could not have ordered confiscation thereof.

6. As the respondent had failed to appear in spite of service of notice in the present petition, it was proceeded ex parte vide order dated 20th November, 2017. Even today, none appeared for the respondent.

7. I have considered the submissions made by the counsel for the petitioner. A Single Judge of this Court in ***Stephen Koenig vs. National Internet Exchange of India (NIXI) 2011 SCC Online Del 5384*** after examining the INDRP has held that in terms of para 10 of the INDRP, if the complainant succeeds then, it should result in the cancellation of the domain name registration in favour of the registered owner or in the transfer of the domain name to the complainant, however, further order of the arbitrator directing

confiscation and retention of the domain name is without any legal basis as there is no such provision in para 10 of the INDRP. Relying upon the judgment of the Supreme Court in *MD, Army Welfare Housing Organization vs. Sumangal Servies (P) Limited, (2004) 9 SCC 619*, it was held that the Arbitrator, while ordering confiscation of the domain name, had transgressed para 10 of the INDRP.

8. This judgment of the learned Single Judge of this Court was upheld by the Division Bench in *Stephen Koeing vs. Arbitrator Nixi 2015 SCC Online Del 13237*.

9. In view of the above, the direction of the Sole Arbitrator to the registry to confiscate the domain name ‘www.lens.in’ cannot be sustained.

10. This would, however, still leave the question, whether upon cancellation of the domain name ‘www.lens.in’, the same was to be transferred in favour of the petitioner. The Arbitrator in the impugned award has refused such transfer *inter alia* on the ground that the petitioner has failed to prove that the domain name ‘lens.in’ is identical or confusingly similar to the trade name of the petitioner; or that the respondent does not have any right or legitimate interest in the domain name; or that the disputed domain name was registered in bad faith or use in bad faith. It has, therefore, been held that the petitioner had failed to prove its rights in the disputed domain name.

11. Counsel for the petitioner submits that once the Arbitrator had ordered cancellation of the domain name in favour of the respondent, the transfer of the same in favour of the petitioner was only a consequential order that was necessarily required to be passed. I am

afraid that I cannot agree to such a submission. Para 10 of the INDRP gives the remedies that are available to the complainant pursuant to any proceeding before an Arbitrator. The same is quoted hereinbelow:-

“10) Remedies

The remedies available to a Complainant pursuant to any proceeding before an Arbitrator shall be limited to requiring the cancellation of the Registrant's domain name or the transfer of the Registrant's domain name registration to the Complainant. Costs as may be deemed fit may also be awarded by the Arbitrator.”

12. A reading of the above would show that the Arbitrator has the power to order cancellation of the registrant’s domain name or the transfer of registrant’s domain name registration to the complainant apart from awarding costs. Therefore, cancellation of registrant’s domain name automatically does not result in the transfer of the registrant’s domain name registration to the complainant.

13. The complainant would, even upon cancellation of the registrant’s domain name, independently have to establish his right to such domain name. The learned Single Judge of this Court in ***Stephen Koeing (supra)*** on this aspect has held as under:-

“36. At this stage it is necessary to clarify that while this might suffice for the purposes of Para 4(i) INDRP, it would not ipso facto entitle Respondent No. 2 to ask for transfer of the domain name in his favour under Para 10 INDRP, which aspect is discussed later.

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48. The cancellation of the registration of the domain name 'internet.in' in favour of the Petitioner would not automatically entitle Respondent No. 2 to its transfer in his favour. Clearly Respondent No. 2 was unable to show that he was actually using the trademark 'internet' in his business. Additionally, the fact that the word 'internet' is generic and that the trademark 'internet' of Respondent No. 2 is therefore a weak one, are relevant considerations that support the decision of the learned Arbitrator to decline the prayer of Respondent No. 2 for transfer of the domain name 'internet.in' in his favour.

49. Consequently, the impugned Award is upheld to the extent that registration of the domain name 'internet.in' in favour of the Petitioner has been directed to be struck off. The Award is also upheld to the extent that it holds that Respondent No. 2 is not entitled to the transfer of the said domain name in his favour. However, the direction in the impugned Award that the domain name 'internet.in' should be confiscated and kept by the .IN Registry is hereby set aside.”

14. In the present case also, the Arbitrator in his impugned award has *inter alia* held that the word ‘lens’ is generic in nature and is not entitled to protection as a trademark. In this regard, relevant finding from the award is quoted herein below:-

“However this panel is of the view that the request to ownership to the same has to be denied on the grounds of no proof of trademark registration for “*lens.in*” or “*lens*” in India with regard to the same [(Relevant decisions: Jagdish Purohit v. Mr. Stephen Koeing INDRP/6) July 7, 2006); Suresh Kumar Sareen v. Jim J INDRP/007 (October 4, 2006); Pepsico, Inc. v. Bijon Chatterji INDRP/014 (June 24, 2006); Pheonix IT Solution Ltd. v. Mr. M. Ramesh INDRP/495 (28th September, 2013); Gokul Kalyansundaram v. Eternal Softwares

INDRP/564 (February 2, 2014)].

However, it is only some types of commercial domain names that qualify for trademark protection. For instance, while domain names that use common or descriptive terms, may work very well to bring users to a website, they usually do not qualify for much trademark protection. This means that owners of such domain names generally won't be able to stop the use of these words and phrases in other domain names. In other words, by using common terms that are the generic name for the service or by using word that merely describe the service or some aspect of it, the owner of the name will have less trademark rights against the users of similar domain names than she would if her domain name was distinctive. Hence, it is a generic name and Complainant has not been able to prove that he has acquired any secondary meaning in the word "lens" / "lens.in". [Relevant decisions: Mr. Shevaldas C. Raghani v. Mr. Stephen Koeing INDRP/008 (May 3, 2006); Jagdish Purohit v. Mr. Stephen Koeing INDRP/6 (July 7, 2006); Suresh Kumar Sareen v. Jim J INDRP/007 (October 4, 2006); Pepsico, Inc. v. Bijon Chatterji INDRP/014 (June 24, 2006); Pheonix IT Solution Ltd. v. Mr. M. Ramesh INDRP/495 (28th September, 2013); Gokul Kalyansundaram v. Eternal Softwares INDRP/564 (February 2, 2014)]."

15. In any case, it is for the petitioner to show in an appropriate proceedings that with its continued use of 'lens.com' it has acquired a right over the generic word 'lens'.

16. In the present case, such evidence was not led before the arbitrator. However, as the confiscation of the domain name has been set aside by this Court by the present order, it would always be open to the petitioner to claim registration to the domain name 'lens.in' in accordance with the Rules of NIXI.

17. In view of the discussion above, the impugned order is set aside

only to the extent that it orders that the domain name 'www.lens.in' be confiscated by the registry and the same may be kept with it. There shall be no order as to costs.

NAVIN CHAWLA, J

JANUARY 24, 2018
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