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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

Pronounced on: 12.12.2023

+ O.M.P. (COMM) 4/2022 & IA No. 178/2022

JOSEPH TAHENY

..... Petitioner

Through: Mr. Rohit Rattu, Adv.

versus

TEKTRONIX INC & ANR.

..... Respondents

Through: Mr. Jayant Kumar and Mr. Amit Mehta, Adv.

CORAM:

HON'BLE MR. JUSTICE SACHIN DATTA

JUDGMENT

O.M.P. (COMM) 4/2022

1. The present petition under Section 34 of the Arbitration and Conciliation Act, 1996 (hereinafter referred to as “the A&C Act”) has been filed on behalf of the petitioner seeking the following reliefs:

- “a) Call for records of proceedings in reference to arbitration between Tektronix Inc. v Joseph Taheny bearing Case No./NDRP/1415 from National Internet Exchange of India (NIXI).*
- b) Set aside Arbitral Award dated 21.09.2021 passed by Ld. Arbitrator, Mr. Sudhir Kumar Sengarin case no. INDRP/1415 in the arbitration matter between the parties herein;*
- c) Restore the domain Name “Tek.in” in the name of the Petitioner as the same being generic in nature.*
- d) Pass such further or other orders as this Hon’ble Court may deem fit in the facts and circumstances of the case in favour of the Petitioner and against Respondent herein.”*

2. The petitioner is aggrieved by the award dated 21.09.2021 (hereinafter referred to as the “**impugned award**”) passed by the learned



sole arbitrator appointed by respondent no.2 *i.e.*, National Internet Exchange of India (hereinafter referred to as “NIXI”) pursuant to arbitral proceedings that were conducted as per the .IN Dispute Resolution Policy, whereby the learned sole arbitrator *inter alia* directed that “www.tek.in” (hereinafter referred to as the “**disputed domain name**”) which was registered with the petitioner herein, be transferred to the respondent no. 1 – Tektronix Inc. (a company with its office at Oregon, United States of America) with a request to respondent no. 2 (NIXI) to monitor the transfer.

3. It is submitted that the petitioner is an Australian citizen who registered the disputed domain on 16.02.2005, while residing in Turkey.

4. It is the petitioner’s case that the disputed domain name was registered by the petitioner 14 years prior to the respondent no.1 registering its trademark “TEK” in India *i.e.*, in 2019. It is submitted that the disputed domain name was registered by the petitioner solely because it gave numerous advantages being a generic Turkish term. The petitioner claims that the disputed domain name was registered 14 years before the respondent no. 1 registered its trademark ‘TEK’ in India.

5. The respondent no.1 is stated to be the owner and trademark registrant of the marks “TEK” and “TEKTRONIX”. It is submitted on behalf of respondent no.1 that Tektronix was established in the year 1945 and is in the business of manufacturing test and measurement devices and is widely known as “TEK”. It is further submitted that the respondent no. 1 also owns the domain name “tek.com” since 1986 and “tektronixindia.com” since 2018. It is further submitted that respondent no.1 had registered its trademark with respect to “TEK” in India in 2019.



6. In July 2021, the respondent no.1 filed a complaint in respect of the disputed domain name before the respondent no. 2 - NIXI, which appointed a learned sole arbitrator on 06.08.2021 under the INDRP Rules of Procedure (hereinafter referred to as the “**INDRP Rules**”). The aforesaid complaint filed by respondent no. 1 *inter alia* alleged that the disputed domain name is confusingly similar to the trademark ‘TEK’ and ‘TEKTRONIX’, in which the respondent no. 1 has rights. The respondent no. 1 also alleged that the petitioner has no rights or legitimate interest in respect of the disputed domain name and that the disputed domain name was registered in bad faith by the petitioner. Arbitral proceedings were conducted pursuant to the aforesaid complaint and the impugned award was passed in Case No. INDRP/1415.

7. Based on submissions made by both the parties, and in accordance with the .IN Dispute Resolution Policy (hereinafter referred to as “**INDRP**”) and INDRP Rules, the learned sole arbitrator proceeded to hold that the respondent no.1/complainant’s trademark falls in the category of a ‘well known’ trademark and that the registration of the disputed domain name in no probability gives an impression that the disputed domain name does not belong to the complainant. Consequently, the learned sole arbitrator directed that the disputed domain name be transferred to the respondent no. 1 with a request to respondent no.2 to monitor the transfer.

Submissions on behalf of the Parties

8. It is submitted on behalf of the petitioner that the disputed domain name ‘tek.in’ was registered by the petitioner in February 2005, which was fourteen years before the respondent no.1 registered its trademark ‘TEK’ in



India. It is further submitted that in 2005, the petitioner also registered a few other domain names such as “joe.in”, “mantra.in”, “siz.in”, *etc.*

9. It is submitted that the respondent no. 2 failed to follow the spirit of Rule 5 of the INDRP Rules and clause 12 of INDRP, which were applicable in the arbitration proceedings.

10. It is submitted that the impugned award has been passed without any relevant evidence on record. It is further submitted that the award is patently illegal as mentioned in Section 34 (2A) of the Act and as has been explained by the Supreme Court in *Ssangyong Engineering & Construction Co. Ltd. v. NHAI*¹.

11. It has been alleged that the award of the learned sole arbitrator suffers from unfairness and bias and reliance has been placed upon judgment of the Supreme Court in *Voestalpine Schienen GMBH v. Delhi Metro Rail Corporation Limited*² to supplement the contention that neutrality of arbitrator is critical to the entire process of arbitration.

12. It is submitted that the impugned award is one sided and has been passed without taking into account the submissions/contentions raised by the petitioner in the arbitral proceedings. It is further submitted that in the impugned award, the learned sole arbitrator used the exact words used by the respondent no.1 in their submissions before the arbitral tribunal.

13. It is submitted that no bad faith existed in the registration of the domain name by the petitioner since the registration of the domain name pre-dated the registration of the trademark. The petitioner has relied upon INDRP Judgments in respect of ‘Cars24.in’ and ‘Tickets.in’ to contend that

¹2019 SCC OnLine SC 677

²AIR 2017 SC 939



the disputed domain name was not registered in bad faith. It is further submitted that the petitioner invested in the disputed domain name because “tek” is a generic Turkish term which means ‘single’ and is also short for “teknoloji”, which is a Turkish word. The petitioner has relied upon *Gen.Mach.Prods. v. Prime Domains* (NAF-FA02531) to contend that as long as the domain name has been registered because of its attraction as a dictionary word, and not because of its value as a trademark, the same is permissible.

14. The petitioner has laid emphasis on various UDRP decisions before WIPO, pertaining to countries such as UK, USA, Canada, *etc.* where complaints were denied against famous Indian Trademark holders on the ground that there was no awareness about such trademarked names in those countries.

15. It is submitted that there is nothing on record to prove that “TEK” was registered by the respondent no. 1 in 1945. It is further submitted that there is no proof of the respondent no.1 had purchased the domain name “tek.com” in 1986.

16. The petitioner also submits that there is no way the petitioner could have had actual knowledge about existence of the ‘tek’ trademark. It is also submitted that in order to establish ‘bad faith’ on the part of the petitioner, the petitioner should have had actual knowledge about the existence of respondent no. 1’s trademark.

17. It is submitted that the learned Arbitrator has failed to mention the place of arbitration as envisaged under Section 31 (4) of the Arbitration and Conciliation Act, 1996. It is further submitted that the learned Arbitrator has failed to establish the procedure to be followed under Section 19 of the A&C



Act and in this regard, reliance has been sought to be placed on the judgment of the Bombay High Court in *Sahyadri Earthmovers v. L&T Finance Ltd*³.

18. It is submitted that the entire award passed by the learned sole arbitrator is one sided. It is further submitted that submissions/contentions raised by the petitioner in response to the complaint have not been considered by the learned Arbitrator. It is further submitted that the learned sole arbitrator has accepted the submission of the respondent no.1 in toto, by holding that "*Tek is not a generic term otherwise it could not have been registered in India*" and "*it is not a dictionary term*".

19. The petitioner has also objected to the learned sole arbitrator upholding the respondent no. 1's contention that "tek.in" is neither a domain hack, nor a dictionary word. It is submitted that the learned sole arbitrator has mechanically accepted the contention of the respondent no. 1 that "the petitioner has not submitted any evidence to establish that he made efforts to develop the disputed domain name" without application of mind and has simply stated that "disputed domain will certainly be purchased by one who has rights in marks or competitor of the complainant". It is further submitted that learned sole arbitrator has erred in concluding that the petitioner failed to comply with the requirements of due diligence before registering the disputed domain name. It is further submitted that the learned sole arbitrator has wrongly held that the respondent no. 1 had acquired Common Law Rights in the mark TEK, since no evidence in support of the same was made available.

20. It is submitted that the learned sole arbitrator has failed to appreciate the fact that the domain name disputes either under UDRP or INDRP are

³2011 (4) Mh.L.J. 200



summary proceedings and not akin to proceedings in court. It is further submitted that INDRP proceedings are generally for clear cases of cyber squatting.

21. It is submitted that the learned sole arbitrator has failed to appreciate that where trademark rights have been acquired by a complainant after a domain name has been registered, then the registration of such domain name cannot be held to be done in bad faith. It is further submitted that such matters are out of the preview of the INDRP as held in the case of ‘Cars24.in’ [INDRP/916] and ‘Tickets.in’ [INDRP/1187]. In this regard, reliance is also placed upon the standards laid down for UDRP under WIPO Overview Para 3.8.1, which state as under:

“.....
Where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent.
.....”

22. It is submitted that the learned sole arbitrator has failed to appreciate the fact that the petitioner had been holding the disputed domain name since 2005 and was within its right to put the domain name for sale. In this regard, reliance has been placed upon INDRP award in ***Tickets Worldwide LLP v. Judia Portals*** [INDRP/1187, March-2020] wherein it was held as under:-

“.....
In simple terms, investment in generic domain names is like an opportunity to invest in a virtual property as soon as some new domain TLD is launched with future expectations. It can be compared to a situation when a new area/locality starts developing and people start investing in real estate and look forward to a long term investment or even a stock investment in IPOs.
.....”



23. It is submitted on behalf of the petitioner that no notice under Section 21 of the A&C Act was sent by the complainant (respondent no.1) to the petitioner herein. It is contended on behalf of the petitioner that the same is against the settled law laid down by this Court in ***Alupro Building Systems Pvt. Ltd. Vs. Ozone Overseas Pvt. Ltd.***⁴

24. It is submitted by the petitioner that the respondent no. 2 (NIXI) has failed to follow the spirit of the INDRP and the INDRP Rules made thereunder inasmuch as clause 5 of the INDRP states that “The .IN Registry shall appoint an Arbitrator from the list of empanelled arbitrators maintained by the Registry. The List of the Arbitrators shall be published online by the .IN Registry on its website at www.registry.in (<https://www.registry.in/>)”, whereas, the respondent no. 2’s list of arbitrators maintained at the said website did not contain the name of the appointed arbitrator, and the same position continues even till date. It is further submitted that the said website even otherwise never contained the qualifications of the respective empanelled Arbitrators. It is further submitted that this raises questions as to the reason why the arbitrator was appointed despite his name never being featured in the list. It is further submitted that the impugned award was not published online on the website (www.registry.in), in terms of the clause 12 of the INDRP.

25. *Per contra*, it is submitted on behalf of respondent no. 1 that no ground for interference with the impugned award has been made out by the petitioner. It is submitted that the jurisdiction of this court to interfere with the impugned award is limited unless there is an apparent error on the face

⁴MANU/DE/0495/2017



of the award and/or jurisdictional error and/or legal misconduct. Learned counsel has relied upon the following judgments to support this contention:

- i) Numaligarh Refinery Ltd. v. Daelim Industrial Company Ltd.,*⁵
- ii) Stephen Koenig v. Arbitrator, National Internet Exchange of India (NIXI) &Anr.*⁶

26. It is submitted that the impugned award does not suffer from illegality and is not against the public policy of India. It is further submitted that there is no allegation of misconduct or jurisdictional error against the learned sole arbitrator. It is further submitted that the allegation of the petitioner that certain words/phrases used by the respondent no. 1 in its written submissions in the arbitral proceedings also feature in the award has no substance and does not amount to bias or legal misconduct. It is submitted that full, fair, and complete opportunity was given by the learned sole arbitrator to both the parties. It is further submitted that after the appointment of the learned sole arbitrator on 06.08.2021, a notice of commencement of arbitral proceedings was sent by the said arbitrator to the petitioner *vide* email dated 07.08.2021. It is further submitted that thereafter, the petitioner acknowledged the receipt of the complaint on 09.08.2021 and sought an extension of 15 days for filing a reply, and the same was granted to the petitioner. It is further submitted that the petitioner had filed a reply on 31.08.2021 and had also filed a sur-rejoinder on 10.09.2021 in the concerned arbitration proceedings. It is further submitted that the learned sole arbitrator had directed both the parties to file a brief summary of the case and the same was filed by both parties. In view of the aforesaid, the

⁵(2007)10 SCALE 577

⁶2011 SCC OnLine Del 5384



respondent no. 1 submits that full, fair, and complete opportunity was granted to the petitioner by the learned sole arbitrator.

27. It is submitted that the complaint satisfied all the three requirements under the INDRP, i.e., whether (i) the Registrant's domain name is identical and/or confusingly similar to a Name, Trademark or Service Mark etc. in which the Complainant has rights, (ii) the Registrant has no rights or legitimate interests in respect of the domain name and (iii) the Registrant's domain name has been registered or is being used either in bad faith or for illegal/unlawful purpose and thus, there is no reason for interference with the award. In this regard, respondent no. 1 has relied upon the judgment passed by this Court in *Stephen Koenig vs. Arbitrator, National Internet Exchange of India (NIXI) & Anr.*⁷. Reliance has also been placed on *Jigar Vikamsey v. Bombay Stock Exchange Limited*⁸ to contend that delay in filing application for trademark registration in India does not permit any third party to "grab and use" a coined word for a domain name in bad faith.

28. It is submitted on behalf of respondent no. 1 that no plea in respect of competence of the arbitrator was taken by the petitioner in the arbitration proceedings and thus, the said plea cannot be taken by the petitioner before this Court. Reliance has been placed on Section 16 (3) of the A&C Act to contend that any plea as to the jurisdiction of the arbitrator must be taken no later than submission of Statement of Defense by the defendant in arbitration proceedings. It is further submitted that no such plea with respect to the jurisdiction of the arbitrator was taken at any stage during the arbitral proceedings.

⁷2011 SCC OnLine Del 5384

⁸ (2010) 1 Bcr 908



29. With respect to the contention of the petitioner that the arbitrator's name was not included in the list of empanelled arbitrators as per clause 5 of the INDRP, it is submitted on behalf of respondent no.1 that since the arbitrator in the present case was appointed by .IN Registry, it is evident that the arbitrator so appointed by the .IN Registry must be empanelled with .IN Registry. It is further submitted that the list of arbitrators filed on behalf of the petitioner to support the aforesaid contention is dated 20.12.2021, and the same cannot be relied upon as the arbitrator in the present case was appointed by the .IN Registry on 06.08.2021. It is further submitted that the list of arbitrators maintained by the respondent no. 2 is not permanent and the empanelment of an Arbitrator is for a period of 2 years as per .IN Registry's Policy for Empanelment of Arbitrators.

30. With respect to the contention of the petitioner that Section 21 of the A&C Act has been violated, it is submitted on behalf of the respondent no. 1 that no specific plea pertaining to the same has been taken in the petition and the same cannot be considered by this court. Reliance is placed on the judgment in *Maharashtra Industrial Development Corporation Ltd. v. Govardhani Construction Company*⁹ to state that all the grounds on which the Award is sought to be set aside have to be taken in the petition itself. It is further submitted that the complaint filed under INDRP itself is a notice to respondent in the arbitration proceedings, to refer the said dispute to arbitration. It is further submitted that Section 21 of the A&C Act does not mandate a notice by the complainant to the defendant. It merely prescribes the date on which the arbitral proceedings are deemed to have commenced. It is further submitted that in the present case, the date of commencement of

⁹(2008)4 Arb LR 42



arbitral proceedings is the date on which the complaint was first served upon the petitioner.

The Award

31. The arbitration proceedings were held in terms of the INDRP adopted by the NIXI, INDRP Rules and in accordance with the A&C Act. By registering the disputed domain name with a NIXI Registrar, the petitioner agreed to the resolution of disputes pursuant to the INDRP and the INDRP Rules.

32. *Vide* email dated 06.08.2021, the petitioner was duly served with a copy of the respondent no. 1's complaint alongwith annexures. The parties were informed about the commencement of the arbitration proceedings on 07.08.2021, and the petitioner was granted 10 days to file his reply. On 09.08.2021, the petitioner sought additional 15 days to file his response, which was granted, and thereafter, the petitioner filed his response on 31.08.2021. The petitioner also filed his reply to the rejoinder filed by the complainant on 10.09.2021 and both parties filed their brief submissions *vide* emails dated 15.09.2021.

33. The complaint of the respondent no. 1 before the .IN Registry was under clause 4 of the INDRP which reads as under:

"4. Class of disputes

Any person who considers that a registered domain name conflicts with his/her legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

- a) The Registrant's domain name is identical and/or confusingly similar to a Name, Trademark or Service Mark etc. in which the Complainant has rights; and*
- b) the Registrant has no rights or legitimate interests in respect of the domain name; and*
- c) the Registrant's domain name has been registered or is being used either in bad faith or for illegal/unlawful purpose."*



34. The aforesaid clause 4 of the INDRP, as amended in 2020, adds the word ‘and’ following clause a) and b), thereby inferring that all the aforesaid three conditions in clause 4 must be satisfied. Accordingly, the learned sole arbitrator proceeded on the basis that the burden was on the complainant to show that a) the registrant’s domain name is identical and/or confusingly similar to the Name, Trademark or Service Mark in which the complainant has right; b) the Registrant has no rights or legitimate interests in respect of the domain name; and c) the Registrant’s domain name has been registered or is being used either in bad faith or for illegal/unlawful purposes.

35. The learned sole arbitrator made the following observations in the award in terms of the abovementioned clause 4 of the INDRP:

a) Whether the registrant’s domain name is identical and/or confusingly similar to the Trademark in which the complainant has right;

36. As regards to the clause 4 (a), the impugned award holds that the domain name “tek.in” is identical to the word “TEK”, which is admittedly a registered trademark held by respondent no. 1. It has been observed by the learned sole arbitrator that contentions of the petitioner such as that the disputed domain name “tek.in” being a “domain hack” for “tekin” and/or a short form or acronym appeared to be an afterthought, given that “TEK” and “TEKTRONIX” were well established and operating in many countries. Relying upon the fact that the term “TEK” had been trademarked in various countries including in India, the learned sole arbitrator held that the trademark registrant was entitled to recognition and protection of rights obtained by virtue of such trademark registration.



37. With respect to clause 4 (a) of the INDRP, the impugned award holds that respondent no. 1 (complainant in the arbitral proceedings), by virtue of holding a trademark with respect to the term “TEK” had rights in the aforesaid term. Further, the learned sole arbitrator held the disputed domain “tek.in” is evidently confusingly similar and even identical to the trademark “TEK”. The findings of the learned sole arbitrator in this respect need no interference.

b) The respondent has no right or legitimate interest

38. The impugned award holds that since the complainant (respondent no. 1) had made a *prima facie* case and had established that the complainant had trademark rights over the term “TEK”, the onus would shift on the respondent (petitioner herein) to demonstrate that the respondent had legitimate interest as per clause 6 of the INDRP, which reads as under:

“6. Registrant's Rights and Legitimate Interests in the Domain Name

Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidences presented before him, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purposes of Clause 4(b):

(a) 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;

(b) 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

(c) the Registrant is making a legitimate non-commercial or fair use of the domain name, without the intention of commercial gain by misleadingly or diverting consumers or to tarnish the Trademark or Service Mark at issue.”

39. Thus, accordingly, it was upon the petitioner herein to demonstrate that a) the petitioner’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, b) that the petitioner was commonly known by the domain name and c) that the petitioner was making a legitimate non-commercial or fair use of the domain name, without the intention of commercial gain by misleadingly or diverting consumers or to tarnish the Trademark.

40. With respect to the above requirements, the learned sole arbitrator held that the petitioner failed to show its demonstrable preparation to use the disputed domain name and no evidence with respect to the same was submitted by the petitioner. The petitioner was observed to not be using the disputed domain name for any purpose other than offering it for sale for USD 10,000/-. It was further observed that the respondent no. 1 had trademark rights over the mark “TEK” and no third party such as the petitioner could claim that “tek” is a generic term. It was also held that the domain name “tek.in” is not a domain hack for “tekin” as claimed by the petitioner, since it is a trademark owned by the respondent no.1. The impugned award holds that the petitioner could not have blocked the domain name in 2005 by featuring/incorporating a trademark in which the complainant had statutory and common law rights. The contention of the petitioner that “tek” is a generic word having a dictionary meaning in Turkish was not accepted by the learned sole arbitrator stating that the respondent no. 1 had rights in the mark “tek” in a lot of jurisdictions, including in India, which may not have been permissible if it was a “generic” term. Overall, the petitioner failed to satisfy any of the conditions as mentioned in clause 6 of the INDRP.



41. It was also observed by the learned sole arbitrator that the petitioner had not claimed any rights over “tek” and neither did the petitioner have any rights as such, other than being the registrant of the domain name. It was further observed that the respondent no. 1 on the other hand had 34 trademark registrations for the mark “TEK” including in India, and 107 trademark registrations worldwide for the mark “TEKTRONIX”, and had been using the aforesaid trademarks since 1973. It was further observed that the domain name “tek.com” was registered by the respondent no. 1 in 1986, and the complainant/respondent no.1 had been hosting its global website at the aforesaid domain name “tek.com”

c) The domain name was registered in bad faith

42. Clause 7 (a) of the INDRP lays down the guidelines pertaining to determination of whether domain name was registered in bad faith. Clause 7 of the INDRP reads as under:-

“7.Evidence of Registration and use of Domain Name in Bad Faith

For the purposes of Clause 4(c), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the Registration and use of a domain name in bad faith:

(a) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the Trademark or Service Mark, or to 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

(b) the Registrant has registered the domain name in order to prevent the owner of the Trademark or Service Mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or

c) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant'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 the Registrant's website or location; or

(d) The Registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor.”

43. The use of the word “or” after each sub para in clause 7 of the INDRP indicates that any of the abovementioned conditions must be met in order to establish that the domain name was registered in bad faith. The learned sole arbitrator referred to the contents of the aforesaid prescription/requirement, however, has stated it to be from clause 6 of the INDRP (this appears to be an innocuous typographical mistake, perhaps owing to alteration/s in-numbering on account of amendment/s in the relevant provisions). The learned sole arbitrator, based on the finding that the petitioner had put the domain name on sale for USD 10,000/-, categorically held that the same is sufficient to establish ‘bad faith’. The learned sole arbitrator found that the petitioner failed to show any evidence that he had made efforts to develop the disputed domain name even after 15 years of registering it in 2005. The learned sole arbitrator held that the disputed domain name, which has been put up for sale for USD 10,000/-, shall be purchased by someone who has rights in the marks or the competitor of the respondent no. 1. Since the petitioner was preventing a registered proprietor of a trademark from using it as a part of his domain name and was not making any other use of the domain name than offering it for sale, the learned sole arbitrator held that that the petitioner was holding the domain name in bad faith.

44. The learned sole arbitrator, after being satisfied that all three conditions as set out in clause 4 of the INDRP are satisfied, held as under:

“Based on the submissions by both parties and perusal of brief summaries of both parties, I am of the view that the Complainant's trademarks falls in category of 'well known' trademark. However, as an



abundant caution, the complainant has also registered the trademark in many counties including India. Test of prudence demands fairness of action by the Respondent. On the other hand, so far as the Respondent has failed to provide any documentary evidence to justify that he intended to develop the disputed domain. He should have done due diligence before registration of domain. The Respondent has not been consistent in his submission about trademark TEK about his position in order to rebut the contention of the Complainant. The suggestion to the fact the particular trademark is not well known does not give an opportunity to the Respondent to use two (2) marks of the complainant while registering in India as domain name. The registration of the domain name in no probability gives an impression that the domain name does not belong to the Complainant. In view of the above read with all the facts of the present case, the Complainant's contentions are tenable. In accordance with the Policy and Rules, I direct that the disputed Domain Name be transferred to the Complainant with a request to NIXI to monitor the transfer."

45. The learned sole arbitrator's direction that the disputed domain name be transferred to the complainant was done as per clause 11 of the INDRP, which provides the remedy of getting the disputed domain name transferred to the complainant. Thus accordingly, the learned sole arbitrator directed the same, as per the INDRP.

Scope of Interference

46. At the outset, it is necessary to take note of the scope of examination in proceedings under Section 34 of the Arbitration and Conciliation Act, 1996 in the present dispute which is an international commercial dispute¹⁰.

47. In *Associate Builders v. Delhi Development Authority*¹¹, after taking note of the judgments of the Supreme Court in the case of *ONGC Ltd. v. Saw Pipes Ltd.*¹², *Hindustan Zinc Limited v. Friends Coal*

¹⁰under Section 2 (1) (f) of the Act.

¹¹(2015) 3 SCC 49

¹²(2003) 5 SCC 705



*Carbonisation*¹³, *McDermott International Inc. v. Burn Standard Co. Ltd.*¹⁴, *Centrotrade Minerals & Metals Inc. v. Hindustan copper Ltd.*¹⁵, *DDA v. R. S. Sharma & Co.*¹⁶, *JG Engineers (P) Ltd. v. Union of India*¹⁷, *Union of India v. Col. L.S. N. Murthy*¹⁸ and *ONGC Ltd. v. Western Geco International Ltd.*¹⁹, the Supreme Court delineated the scope of examination of an arbitral award in proceedings under Section 34 of the A&C Act. It was emphasized that when a Court is applying the “public policy” test to an arbitral award, it does not act as a Court of appeal and consequently, errors of facts cannot be corrected. A possible view by the arbitrator on facts has necessarily to pass muster as the arbitrator is the ultimate master of the quantity and quality of evidence to be relied upon when he delivers any arbitral award.

48. In *Ssangyong Engineering & Construction Co. Ltd vs. National Highway Authority of India*²⁰, the Supreme Court while considering the scope of the expression ‘public policy of India’ and in the context of Section 34 (2A) of the Arbitration and Conciliation Act, 1996 made the following observations:

“23. What is clear, therefore, is that the expression —public policy of India, whether contained in Section 34 or in Section 48, would now mean the —fundamental policy of Indian law as explained in paragraphs 18 and 27 of Associate Builders (supra), i.e., the fundamental policy of Indian law would be relegated to the —Renusagar understanding of this expression. This would necessarily mean that the Western Geco (supra) expansion has been done away with. In short, Western Geco

¹³(2006) 4 SCC 445

¹⁴(2006) 11 SCC 181

¹⁵(2006) 11 SCC 245

¹⁶(2008) 13 SCC 80

¹⁷(2011) 5 SCC 758

¹⁸(2012) 1 SCC 718

¹⁹(2014) 9 SCC 263

²⁰(2019) 15 SCC 131



(supra), as explained in paragraphs 28 and 29 of Associate Builders (supra), would no longer obtain, as under the guise of interfering with an award on the ground that the arbitrator has not adopted a judicial approach, the Court's intervention would be on the merits of the award, which cannot be permitted post amendment. However, insofar as principles of natural justice are concerned, as contained in Sections 18 and 34(2)(a)(iii) of the 1996 Act, these continue to be grounds of challenge of an award, as is contained in paragraph 30 of Associate Builders (supra).

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25. Thus, it is clear that public policy of India is now constricted to mean firstly, that a domestic award is contrary to the fundamental policy of Indian law, as understood in paragraphs 18 and 27 of Associate Builders (supra), or secondly, that such award is against basic notions of justice or morality as understood in paragraphs 36 to 39 of Associate Builders (supra). Explanation 2 to Section 34(2)(b)(ii) and Explanation 2 to Section 48(2)(b)(ii) was added by the Amendment Act only so that Western Geco (supra), as understood in Associate Builders (supra), and paragraphs 28 and 29 in particular, is now done away with.

26. Insofar as domestic awards made in India are concerned, an additional ground is now available under sub-section (2A), added by the Amendment Act, 2015, to Section 34. Here, there must be patent illegality appearing on the face of the award, which refers to such illegality as goes to the root of the matter but which does not amount to mere erroneous application of the law. In short, what is not subsumed within —the fundamental policy of Indian law, namely, the contravention of a statute not linked to public policy or public interest, cannot be brought in by the backdoor when it comes to setting aside an award on the ground of patent illegality.

27. Secondly, it is also made clear that re-appreciation of evidence, which is what an appellate court is permitted to do, cannot be permitted under the ground of patent illegality appearing on the face of the award.

28. To elucidate, paragraph 42.1 of Associate Builders (supra), namely, a mere contravention of the substantive law of India, by itself, is no longer a ground available to set aside an arbitral award. Paragraph 42.2 of Associate Builders (supra), however, would remain, for if an arbitrator gives no reasons for an award and contravenes Section 31(3) of the 1996 Act, that would certainly amount to a patent illegality on the face of the award.

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30. What is important to note is that a decision which is perverse, as understood in paragraphs 31 and 32 of Associate Builders (supra), while no longer being a ground for challenge under —public policy of



India, would certainly amount to a patent illegality appearing on the face of the award. Thus, a finding based on no evidence at all or an award which ignores vital evidence in arriving at its decision would be perverse and liable to be set aside on the ground of patent illegality. Additionally, a finding based on documents taken behind the back of the parties by the arbitrator would also qualify as a decision based on no evidence inasmuch as such decision is not based on evidence led by the parties, and therefore, would also have to be characterised as perverse.

31. Given the fact that the amended Act will now apply, and that the “patent illegality” ground for setting aside arbitral awards in international commercial arbitrations will not apply.”

49. In view of the amended A&C Act, the ground of “patent illegality” as envisaged under Section 34 (2A) of the Act would not be available to the petitioner. Therefore, the scope of interference by this Court would be confined to whether the impugned award is against the public policy of India.

Analysis and Conclusion

50. In the above conspectus, having considered the respective submissions on behalf of the parties, the impugned award does not warrant any interference in exercise of the jurisdiction under Section 34 of the A&C Act.

51. There is no merit in the contention on behalf of the petitioner to the effect that the respondent no.2 (NIXI) failed to follow the spirit of the INDRP Rules, particularly Rule 5 thereof inasmuch as the arbitrator appointed in the matter was not reflected as one of the empanelled arbitrators in the publicly available lists of arbitrators.

52. Learned counsel for the petitioner, while referring to Rule 5(a) of the INDRP Rules has omitted to make a reference to Rule 5(b) of the Rules which provides as under:



“5...

b. The .IN Registry shall appoint, an Arbitrator from the .IN Registry’s list and shall forward the Complaint along with supporting documents to such Arbitrator.”

53. There is no basis for the contention that the appointed arbitrator was not from the .IN registry’s list.

54. Reliance sought to be placed by the petitioner on the list of arbitrators (Document-17 filed by the petitioner) dated 20.12.2021 is misconceived inasmuch as the concerned arbitrator in the present case was appointed much prior in point of time i.e. on 06.08.2021, and the award itself was rendered on 21.09.2021.

55. Moreover, and crucially, no jurisdictional objection was taken during the course of the arbitral proceedings on the ground that the appointed arbitrator was not duly empanelled, or on any other ground.

56. The petitioner clearly acquiesced to the jurisdiction of the learned sole arbitrator, and even assuming that there was any right to object to the jurisdiction of the learned sole arbitrator, the same stood waived by virtue of Section 4 of the A&C Act read with Rule 7 of INDRP Rules. The said Rule 7 is in the following terms:

“7. Waiver of Rules

Any party who proceeds with the arbitration with the knowledge that any provision or requirement of these rules has not been complied with and who fails to state his objection thereto in writing, shall be deemed to have waived his right to object.”

57. Likewise, the contention that the arbitral proceedings are vitiated for want of notice as contemplated under Section 21 of the A&C Act, is thoroughly misconceived. A perusal of Section 21 reveals that the same is prefaced with the expression “unless otherwise agreed by the parties”.



58. In the present case, the arbitration work was conducted strictly in accordance with the applicable INDRP Rules, as agreed to by the parties. The INDRP Rules strictly govern the procedure for filing and service of a complaint (Rule 3), appointment of arbitrator and the procedure to be followed during the arbitral proceedings. Section 21 of the A& C Act itself accords primacy to these rules, which are applicable by virtue of the agreement between the parties.

59. The judgment in the case of *Alupro Building Systems Pvt. Ltd. v. Ozone Overseas Pvt. Ltd. vs. Ozone Overseas Pvt. Ltd.*²¹, relied upon by the petitioner was rendered in the context of a situation where there was no agreement between the parties as to the manner of commencement of the arbitral proceedings. As such, the reliance sought to be placed thereon is misconceived.

60. Equally untenable are the contentions of the petitioner to the effect that the arbitrator failed to mention the place of arbitration as envisaged under Section 34 of the A&C Act or that the INDRP decision was not published online on the .IN Registry website.

61. Rule 5 (f) of INDRP Rules expressly provides as under:

“.....

f. The Arbitrator shall communicate the pronouncement of award vide email to all parties including NIXI. However, original hard copy of such award along with the respective invoice shall be sent to NIXI.”

62. It is not the petitioner’s case that pronouncement of the award was not communicated to the petitioner. As such, no infirmity can be inferred in the impugned arbitral award on that basis. Further, it is equally untenable to contend that the impugned arbitral award fails to mention the place of

²¹MANU/DE/0495/2017



arbitration as per Section 31 (4) of the A&C Act. Rule 23 of the INDRP Rules expressly provides that the seat of arbitration shall be in office of NIXI at Delhi or as notified by NIXI Delhi (India). There is no controversy between the parties that the seat of arbitration was at Delhi. It is on that basis that the petitioner has invoked the jurisdiction of this Court. As such, the objection is completely frivolous.

63. The contentions raised by the petitioner to the effect that the impugned award is “one sided” or that it mechanically reproduced the submissions of the respondent no.1 is also thoroughly misconceived.

64. Besides the fact that the scope of these proceedings does not extend to embarking upon a merit base review of the impugned award, a perusal of the impugned award reveals no infirmity whatsoever.

65. The impugned award decides the complaint as per the three conditions specified in the INDRP *i.e.*, whether *a) The Registrant’s domain name is identical and/ or confusingly similar to a Name, Trademark or Service Mark etc. in which the Complainant has rights; and b) the Registrant has no rights or legitimate interests in respect of the domain name; and c) the Registrant’s domain name has been registered or is being used either in bad faith or for illegal/unlawful purpose.*

66. Elaborate findings, based on cogent reading, have been rendered in the impugned award on the aforesaid aspects and no infirmity can be found in the said findings in the impugned award.

67. As regards the contention that the disputed domain name “tek.in” was registered by the petitioner many years prior to the date of registration of the trademark TEK in favour of the respondent no.1, it has been held in ***Stephen Koenig vs. Arbitrator, National Internet Exchange of India (NIXI)***(supra)



that for the purpose of clause 4(a) of the relevant INDRP, it was more than sufficient for the complainant to be a registered proprietor of the trademark in question, in order to show that the complainant has a right in the mark and that a mark cannot be held to be generic if the same is registered. Also, in *Jigar Vikamsey* (supra) it has been squarely held that delay in filing an application for trademark registration in India does not permit any third party to “grab and use” a coined word for a domain name in bad faith.

68. The impugned award rightly infers bad faith on the basis that the disputed domain name had been put up for sale by the petitioner.

69. In any case, in view of the limited scope of the present proceedings, as reiterated in the catena of judgments referred to hereinabove, it would be unwarranted for this Court to embark upon a factual re-appreciation or re-adjudication in the manner suggested by the petitioner.

70. In the circumstances, there is no merit in the present petition and the same is accordingly, dismissed.

71. The pending application also stands disposed of.

SACHIN DATTA, J

DECEMBER 12, 2023

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