



हरियाणा HARYANA

M 321679

ARBITRATION AWARD

BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA

In The Matter Between

**Ravinder Singhanian
Singhanian & Partners LLP
S&P House, H-186 Sector 63
Noida 201301
India**

Complainant

Versus.

**Hemant Kumar Goyal
Singhanian, Singhanian
New Delhi 110092
India**

Hemant Narayanan

Ashwin Rajan
Global Jurix LLP
Advocates and Solicitors
International Legal Consultants
S-191/School Block Shakarpur
New Delhi 110092, India

Pradeep Jain
Singhania & Co. LLP
83-C, Mittal Towers
Nariman Point
Mumbai - 400021
India

Respondents

1. The Parties

The Complainant is Ravinder Singhania of Singhania & Partners LLP, Noida, India.

The Respondents are Hemant Kumar Goyal, Ashwin Dorairajan from Delhi, and Pradeep Jain from Mumbai, India.

2. The Domain name, Registrar and Policy

The present Arbitration proceeding pertains to a dispute regarding the domain name <singhania.net.in>. The registrar for the disputed domain name is Go Daddy.com Inc.

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The Arbitration proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the .IN Domain Name Dispute Resolution Policy (the “INDRP Policy” or “Policy”), and the INDRP Rules of Procedure (the “Rules”).

3. Procedural History

The Complaint was filed with the .IN Registry in June 2012 and an arbitrator was appointed. While the Arbitration proceedings were being conducted, the Complainant by an email communication dated 31 May 2013, to the .IN Registry requested for a change of Arbitrator. The case was then transferred to the present Arbitrator for continuing the Arbitration proceedings. The arbitrator presently appointed in the case is Mrs. Harini Narayanswamy. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, in compliance with the Rules and received the case file from .IN registry on June 15, 2013. On going through the case file, the Arbitrator noted that the Complainant in a communication dated June 7, 2013, to the .IN Registry, had requested Mr. Pradeep Jain be included as a third Respondent in the proceedings as the disputed domain name has been transferred to him. The Arbitrator on going through the WHOIS record verified that the present registrant of the domain name is Mr. Pradeep Jain and included him in the proceedings. By an email communication to the Arbitrator dated June 21, 2013 the Complainant stated that the Complaint was pending since June 2012 and wished to continue with the arbitration proceedings. The arbitration proceedings under the present Arbitrator commenced on June 22, 2013.

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The Arbitrator sent an email notification of re-commencement of the arbitration proceedings to all the three Respondents on June 22, 2013. Under the INDRP Rules, copies of the said notification were sent to other interested parties to the dispute. The Respondents were given twenty-one days time from the date of the notification to file their response. The third Respondent, by an email communication dated June 24, 2013 mentioned that he had not been served with a copy of the case papers. By an email dated June 24, 2013 and a subsequent email dated June 26, 2013 the Arbitrator directed the Complainant to serve the case papers to the third Respondent, Mr. Pradeep Jain. On July 5, 2013 the First and Second Respondent's filed their reply. The third Respondent was granted further time and he filed his response along with supporting documents on July 31, 2013. The Complainant filed a rejoinder to the Response on Aug 5, 2013. The third Respondent filed reply to the rejoinder along with supporting documents on August 10, 2013. The Complainant by an email dated 14 August 2013 requested time to file additional submissions and was granted time till August 19, 2013. The Complainant and the first two Respondents sent their submissions by email on August 19, 2013 and on August 20, 2013 respectively. The third Respondent sent his final submission on August 24, 2013.

Factual Background

The Complainant is Mr. Ravinder Singhanian of the law firm Singhanian & Partners LLP and uses the service mark SINGHANIAN in connection with legal services. He owns a registered service mark for the SINGHANIAN

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mark bearing registration No. 1969255 dated May 21, 2010. The Complainant owns the domain names < singhania.in>, <singhania.co.in>.

The three Respondents in the case have been associated with Singhania &Co., a law firm allegedly established by Mr. D.C. Singhania, and is stated to be the father of the Complainant. The first two Respondents, who were members of the law firm Singhania & Co., it appears, have left the firm in 2011, while the third Respondent evidently continues to be a member of the said firm. The Singhania & Co. group owns the trademarks SINGHANIA &Co., bearing number 1406092 under class 42, with a priority date December 14, 2005, and device mark SINGHANIA &Co., bearing number 1406091 for consultancy services under class 42, dated Dec 14, 2005.

The disputed domain name was registered on October 31, 2007 and the print out from the WHOIS database filed with the Complaint shows the registration was initially in the name of “Hemant Hemant” and the Admin organization name was “singhania.net.in” at the time the Complaint was filed in June 2012. Shortly thereafter, on July 16, 2012, the name of the Registrant was changed to Pradeep Jain and the name of the Admin organization under the current registrant of the disputed domain name is shown as “ Singhania & Co. LLP” in the WHOIS records.

The Parties Contentions

A. Complainant's Submissions

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The Complainant submits that the disputed domain name is confusingly similar to the SINGHANIAS mark in which he has rights and asserts that the Respondents have no rights or legitimate interests in the disputed domain name as Respondents do not have trademark rights, license or authorization to use the Complainant's trademark. Further, the Respondents are not commonly known by the name "Singhania" and can make no claim of rights established through usage.

The Complainant argues that the disputed domain name was registered and is being used in bad faith as the Respondents are using the disputed domain name to attract persons looking for Complainant's law firm and then offers legal services from another law firm called Global Jurix LLP. The Complainant has offered by way of evidence a decoy email that was sent to hemant @singhania.net.in and of having received a reply to the email signed by the second Respondent from a firm called Global Jurix LLP. The Complainant contends that the Respondent's bad faith can be garnered from the circumstances described. The Complainant claims that the Respondents are using the email id hemant@singhania.net.in under the disputed domain name to attract Internet users looking for the Complainant and then offers legal services. The Complainant therefore for the reasons submitted requests for the remedy of transfer of the disputed domain name.

B. First and Second Respondent's Submissions

The first and second Respondents have submitted a joint reply to the Complaint, which is an undated document filed before the previous Arbitrator. In their reply, the first two Respondents state that the

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Complainant has no *locus standi* to file the present Complaint, as he is not the absolute owner of the trademark SINGHANIA. In support of their contentions they have submitted copies of registered trademarks for SINGHANIA variant trademarks owned by other third parties. They further urge that the Complaint is without a cause of action as the Complainant is not the owner of the disputed domain name. The First Respondent states he was a partner of the law Firm Singhanian & Co till March 2011 and adds that the Complainant was also a member of the law firm Singhanian & Co. till 2003. As evidence of this fact, the Annual Report of the Indian Council of Arbitration for the year 2003-2004 has been filed that shows the Complainant is from the law firm Singhanian & Co.

The first Respondent alleges that he had implemented the email system for Singhanian & Co. and that every office of the law firm benefitted from his hard work. Upon leaving Singhanian & Co., he states that he handed over all details available with him including domain control rights of the domain name <singhanian.net.in> and the email id hemant@singhanian.net.in to Mr. Pradeep Jain, Partner of Singhanian & Co. Mumbai office, however inadvertently the change in name was not made in the domain registry. Therefore the first Respondent's name was reflected in the records when the present Complaint was filed. The first Respondent states that he has no ownership of the disputed domain name <singhanian.net.in> and that there was no fraudulent intention on the part of the first and second Respondent replying to the decoy email sent by the Complainant as they were acting on behalf of the Singhanian & Co. This is because the third Respondent and the first Respondent often refer legal matters to each other based on their area of expertise. In view of this, they urge that they are not proper parties to these

proceedings as they are not owners of the disputed domain name and the Complainant ought to initiate proceedings against Singhanian & Co. LLP, the owner of the disputed domain name.

It has further been argued that the Complainant's trademark SINGHANIAS cannot be the basis of the present dispute because: (i) There are several law firms in India that have the word "Singhanian" as part of their name such as Singhanian & Co. founded by D.C Singhanian, KG Singhanian & Co. (founded by brother of the Complainant), and Singhanian Foundation Education Trust of the Singhanian & Co. group, owns the registered trademark SINGHANIAN & CO. (ii) Singhanian & Co. has used the domain name <singhanian.com> since 1996 whereas the Complainant has use the disputed domain name <singhanian.net > from 2003, and the domain name <singhanian.co.in> is owned by a private limited company Singhanian & Partners Private Limited and not by the Complainant as submitted in the Complaint as a company and its directors are separate entities (iii) The Complainant cannot have exclusive rights in the trademark SINGHANIAN, as Singhanian & Co. is much older than Singhanian and Partners LLP. (iv) The word "Singhanian" originates from a town in Rajasthan and people belonging to the place have the surname Singhanian, therefore Complainant cannot claim monopoly over the name.

The first and second Respondents have filed further submissions before the present Arbitrator on July 5, 2013 and on August 20, 2013. In their July 5, 2013 submission, the first two Respondents argue that as their names are not reflected as registrants of the disputed domain name after the present Arbitrator re-commenced the arbitration proceedings, they are not proper

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parties to the dispute. A copy of the WHOIS report dated May 15, 2013 has been filed to establish that Mr. Pradeep Jain is the current registrant of the disputed domain name. Further, referring to the provisions under the INDRP Policy they argue that as they are not registrants of the disputed domain name any relief ordered by the Arbitrator cannot be implemented against them. They go on to state that they have no objection to disputed domain name being given to the Complainant, as they are not owners of the domain name but add that this statement is not binding on the third Respondent Mr. Pradeep Jain as the Respondents and Singhanian & Co. are different legal entities. It has been urged that the Complaint has been filed to harass the first two Respondents and request their names be deleted as parties in the case. In the email dated August 20, 2013, they again reiterate what has been previously submitted and in the closing paragraph request that if the Arbitrator does not agree to remove their names as parties in the case that no unwarranted or defamatory statements are made against them in the Arbitration Award.

C. Third Respondent's Submissions

The Third Respondent Mr. Pradeep Jain filed a response on July 31, 2013 and prior to that, email submissions dated July 17, 2013, July 18, 2013, and July 19, 2013. He has stated that he is a partner of Singhanian & Co., a firm established by Mr. D.C Singhanian, and that he joined the firm in 2003 and was elevated as partner in 2004. That he has been working in the Mumbai office and is also a director of Singhanian & Co. Private Limited. There are other entities in the group including the entity Singhanian & Co. LLP that is registered under the laws of United Kingdom. He states that the disputed

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domain name was registered in the year 2007 in the name of Singhanian & Co., for purpose of the Singhanian & Co. group and requests that Singhanian and Co., be made a party to the proceedings. Third Respondent further asserts that the Singhanian & Co. group owns registered rights in the trademark SINGHANIAN & Co., bearing number 1406092 under class 42, dated Dec 14, 2005, and device mark for SINGHANIAN & Co., bearing number 1406091 for consultancy services under class 42, dated Dec 14, 2005 and owns the domain name <singhanian.com>. He has strenuously urged that the Respondent's organization has registered trademark rights that pre date the Complainant's registered rights and based on its rights would approach the Trademark registry for removal of the Complainant's mark. The Respondent further states that the present Complaint is filed due to business competition and that Complainant is one of the two sons of Mr. D.C. Singhanian who believes in peaceful co-existence and requests for rejection of the Complaint.

By an email communication dated July 31, 2013 the Arbitrator made two queries to the third Respondent and these were: 1) Whether the first and second Respondents were members of the law firm Singhanian & Co. and 2) Whether the firm allows use of its domain name after its members leave the firm. The Third Respondent in reply to the two queries stated that he was aware that the first two Respondents were part of the law firm Singhanian & Co. although the dates of their tenure was not known to him. He states that the first Respondent was handling website and domain related work and was instrumental in registering the disputed domain name. He adds that he has not interacted with the second Respondent but heard that he was in the Delhi office handling trademark matters. In reply to second query he replied that

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after leaving the firm, erstwhile members are not allowed the use the firm's domain name or email.

D. Complainant's Rejoinder

In the Rejoinder filed by the Complainant on August 5, 2013, the Complainant submits that Mr. Pradeep Jain is not the owner of the law firm Singhania & Co. LLP but is merely a partner. He further argues that to establish that he is a partner of the firm, documents and evidence are required. The Complainant submits that Mr. Pradeep Jain is showing his name as the registrant of the disputed domain name in exclusion of others in the firm including Mr. D.C. Singhania. The Complainant argues that it is with the intention of diverting clients of the Complainant's firm to the Respondent's firm and that the Respondents are conniving with each other to deprive the Complainant and Singhania & Co. LLP of the domain name. Furthermore, the third Respondent is not an equity partner of the Law firm Singhania & Co. and has not shown any proof of being a partner and therefore has no authority from the firm asserts the Complainant.

The Complainant further states that the emails of the third Respondent shows the name of Pradeep Jain as Pradeep Singhania, which is further wrongful use of Singhania name as the third Respondent is projecting himself as part of the Singhania family / group for wrongful gains. The Complainant further accuses the first and third Respondent of being hand in glove with each other for creating email ids that are not known to the Singhania & Co. The decoy mail sent by the Complainant was received by

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Global Jurix LLP directly and was not referred to Singhania & Co. contends the Complainant.

The Complainant further states that Pradeep Jain is making inconsistent statements and is being evasive and if he were in fact the owner or a partner he would not have to get authorizations and this fact establishes that he has no authority to act on behalf of the firm. The Complainant then goes on to state if Singhania & Co. was interested in being impleaded they would have, but as they have not, it shows that Singhania & Co. are not concerned. He therefore requests that the reply of Mr. Pradeep Jain be rejected and requests for the transfer of the disputed domain name.

E. Third Respondent's Reply to the Rejoinder and further submissions:

The third Respondent, Mr. Pradeep Jain in his reply vehemently denies all adverse allegations made by the Complainant in the rejoinder. He submits that the Complainant has not furnished proof in what capacity he is claiming rights over the disputed domain name and further states that he does not have any practice in India. He contends that although Ravinder Singhania has filed the Complaint, emails are sent by Ravi Singhania and puts forward several questions that in the Arbitrator's view are extraneous and unrelated to the dispute. The third Respondent asserts that he is a partner of the law firm Singhania and Co. and has filed evidence of old emails sent to clients and a copy of his business card. In reply to the Complainant's statements expressing doubts on existence of the entity Singhania & Co. LLP, the third Respondent states it is an LLP firm registered in London and has provided details of the registration of the firm under U.K. laws. The Respondent has

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filed his email communications with Mr. D.C. Singhania as evidence in defense to the Complainant's accusations of "wrongdoings" without the knowledge of the founding partner. The rest of the contents in the third Respondent's submissions are to counter various personal allegations leveled against him by the Complainant in the rejoinder. The Arbitrator is constrained to observe here that these submissions made by the Complainant and the third Respondent are accusations and attacks against each other personally and needs no further deliberation as these are neither relevant or germane to the issues in the present dispute.

The Complainant counters the third Respondent's allegations by an email dated August 19, 2013, and states that a business card is not proof of partnership and that the emails relied on by the third Respondent as evidence are from other domain names and this fortifies the Complainant's argument that the third Respondent does not own the disputed domain name. The Complainant states that if the Respondent is a partner of the law firm Singhania & Co. LLP that is in U.K he ought to have no rights to practice in India and further the annual filings by the said LLP does not disclose that Mr. Jain is a partner or authorized officer of the entity. Finally the Complainant states that the disputed domain name is deceptively similar to his domain name and clarifies that Ravi Singhania and Ravinder Singhania are one and the same person.

In reply the third Respondent sent an email dated August 24, 2013 and has reiterated his earlier stand and has countered point by point the allegations made by the Complainant. The third Respondent has further stated that Singhania & Co. have been using the disputed domain name and has filed

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entries of the firm Singhanian & Co. in Legal 500 for the years 2008 and 2009 as evidence. He states that the disputed domain name is the property of Singhanian & Co. and he has no objection to replacing his name with Singhanian & Co. as registrant, and asserts that the Complainant has no rights to the disputed domain name.

Discussion and Findings

Under the .IN Policy, the registrant of the domain name is required to submit to a mandatory arbitration proceeding in the event that a complaint is filed in the .IN Registry, in compliance with the .IN Policy and the INDRP Rules. The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:

- (i) The domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights, and
- (ii) The Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) The Respondent's domain name has been registered or is being used in bad faith.

Identical or Confusingly Similar

The first element requires the Complainant to prove that the domain name registered by the Respondent is identical or confusingly similar to a mark in which the Complainant has rights.

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It is well established in domain name cases that trademark registration establishes *prima facie* rights in a mark. The Complainant has filed a copy of trademark registration certificate, bearing registration number 1969255 dated May 21, 2010 to establish his rights in the SINGHANIAS mark. The Arbitrator has verified from the online Trademark Register (available at <http://www.ipindia.nic.in/tmr>) that the said mark has been filed as a “proposed to be used” application and no earlier date of use has been mentioned in the trademark application. Based on the evidence it is found that the Complainant has proven rights in the mark at best from the date of filing the trademark application, which is from May 21, 2010, as no earlier date of use has been mentioned in the registration document.

Under the INDRP, common law rights in a mark are recognized as valid rights in a mark. To establish common law rights the Complainant has to file evidence of use of the mark in course of trade or commerce, such as statements or figures showing turnover or revenue generated under the mark, media and third party recognition of the mark and proof of the mark having become a distinctive identifier of the services offered by the Complainant. The Complainant has not furnished any such documents as evidence to show that his mark had acquired distinctiveness by October 31, 2007, the date on which the disputed domain name was registered.

The question of confusing similarity of the disputed domain name with the mark of the Complainant can arise only if the Complainant has established his rights in the mark by or before the date of the disputed domain name registration. If the Complainant’s mark did not exist on the date of

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registering the disputed domain name, the question of confusing similarity with a non-existing mark will not arise. However as the first element under the Policy requires the Complainant to establish present rights in a mark, the disputed domain name is accordingly found confusingly similar to a mark in which the Complainant has rights. Top-level domain extensions such as “.com”, “.net” , “.co.in” or “.net.in”, do not affect the confusing similarity of the domain name with the trademark and can be disregarded in the analysis of confusing similarity in domain name cases. See *Emirates v. Chella Goundappan*, INDRP Case No. 372 dated August 13, 2012. (<emirates.in>)

For the reasons discussed, the Arbitrator finds that the Complainant has satisfied the first element under paragraph 4 of the Policy.

Rights and Legitimate Interests

The second element requires the Complainant to show that the Respondent lacks rights and legitimate interests in the disputed domain name. It is sufficient for the Complainant to put forward a *prima facie* case regarding the Respondent’s lack of rights and legitimate interests.

The Arbitrator notes that the trademark SINGHANIA & Co. are owned by the Respondent’s firm and the record shows the said mark predates the Complainant’s registered mark. The trademark SINGHANIA &Co., bearing

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number 1406092 under class 42, is dated Dec 14, 2005, and device mark for SINGHANIA & Co., bearing number 1406091 for consultancy services under class 42, is dated Dec 14, 2005. The record also shows that the firm Singhania & Co. owns the domain name <singhania.com> from a date earlier than the Complainant's domain names. This however does not establish that the Respondent's have rights in the disputed domain name. The disputed domain name was initially registered in the name of Hemant Hemant, and on July 16, 2012 the domain name was transferred to Mr. Pradeep Jain. The Arbitrator notes that the name of organization is mentioned as Singhania & Co. in the WHOIS registration details. The Arbitrator further notes that the three Respondents have consistently admitted in their pleadings that they have no ownership rights in the disputed domain name and that the rightful owner of the disputed domain name is the firm Singhania & Co.

Although it has been emphatically urged by the Respondents that the disputed domain name is for the benefit of the firm Singhania and Co., there is no cogent evidence on record that shows the firm Singhania & Co. has authorized any of the Respondent's to register the disputed domain name in their personal names. Furthermore, the use of the disputed domain name in connection with firm Global Jurix LLP by the first two Respondents does not appear to be in line with the policy of the firm. The third Respondent has admitted this fact in his email where he has stated that the firm does not allow usage of the firm's domain names subsequent to its members leaving the firm. Based on these circumstances it is found that the Respondent's have not been able to establish legitimate rights or interests in the disputed

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domain name. In any event the Respondents themselves have admitted that the owner of the disputed domain name is Singhanian & Co.

Accordingly, for the reasons discussed, the Arbitrator finds the Complainant has made a *prima facie* case that the Respondents lacks rights and legitimate interests in the disputed domain name.

Bad Faith

Under the INDRP Policy the Complainant is required to establish that the domain name was registered or is being used in bad faith.

As discussed, the Complainant has not established in these proceedings that he had trademark rights in his mark on the date of the disputed domain name registration. Therefore the question of the domain name being registered in bad faith with the intention of targeting the Complainant's mark does not arise under the circumstances. Further, given the fact that the first Respondent was a member of the firm Singhanian & Co. when he registered the disputed domain name, circumstances indicate that he had most likely registered the disputed domain name to reflect the name of the firm Singhanian & Co. and not the Complainant's firm Singhanian & Partners. In the Arbitrator's view no inference can be reasonably be drawn that the Respondents has the Complainant's mark in mind while registering the disputed domain name.

The Arbitrator is inclined to agree with the first two Respondent's submissions that several entities and law firms are presently using the

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SINGHANIA mark and therefore the onus of proving exclusive rights is on the Complainant. In view of multiple rights in the SINGHANIA mark and its variants, it becomes all the more necessary for the Complainant to establish that the disputed domain name was targeting his mark. The burden of establishing his rights in the mark around the time of registration of the disputed domain name and the Respondents having targeted his mark lies heavily on the Complainant. The Complainant has however failed to discharge this burden in the proceedings and has not put forward sufficient evidence that the disputed domain name has been confused with his mark.

Under Paragraph 6 (iii) of the Policy, if the registrant of the domain name in dispute, has used the domain name to intentionally attract Internet users to the Registrant's website or other online location by creating a likelihood of confusion with the Complainant's mark it is considered evidence of bad faith. The Complainant has argued that the disputed domain name was registered and is being used in bad faith as the Respondents are using the disputed domain name to attract persons looking for Complainant's law firm and then offers legal services from another law firm called Global Jurix LLP. The Complainant has put forward no evidence that the disputed domain name has been confused with the Complainant's services, or any evidence that show customers looking for the Complainant's law firm have been misled by the disputed domain name. Given the circumstances in the present case, with numerous third party rights in the SINGHANIA mark and there being several variants of the mark, such evidence is very crucial to establish that there was such wrongful use of the disputed domain name as contemplated under paragraph 6 (iii) of the Policy. The Complainant has not filed any evidence of its clients or potential clients having mistaken the

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disputed domain name for the Complainant or services he offers under his mark.

The Complainant has submitted that if the firm Singhania and Co. were interested in being impleaded as a party to the dispute they would have, but as they have not and this shows that Singhania & Co. are not concerned. The Complainant has not shown any connection with the Respondent's firm in his pleadings but appears to have taken it upon himself to be a spokesperson for Singhania and Co. The Arbitrator however does agree with the Complainant to the extent that there appears to be a lack of concern on the part of Singhania & Co. and such lack of concern on the part of Singhania & Co. could be on account of other reasons such as tacit acquiescence in the Respondent's registering the disputed domain name in their individual names. However, Singhania & Co.'s lack of concern does not necessarily imply that the Complainant has rights in the disputed domain name unless he has established or proven such rights in these proceedings. In what manner the firm Singhania & Co. chooses to have is internal arrangements for the registration of its domain names is not relevant here, neither can the Complainant take it upon himself to be the spokes person for Singhania & Co. under such circumstances.

The Arbitrator finds the material on record shows the Complainant has acquired trademark rights three years after the disputed domain name was registered. Therefore the arguments of bad faith registration of the disputed domain name by the Complainant are untenable. Under the circumstance, in the absence of evidence the Arbitrator is unable to conclusively find that the disputed domain name has been registered or used in bad faith.

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