

## **ADMINISTRATIVE PANEL DECISION**

Sonata Software Limited v. Narendra Ghimire, Deep Vision Architects  
Case No. DAI2023-0051

### **1. The Parties**

The Complainant is Sonata Software Limited, India, represented by Eshwars, Advocates- House of Corporate and IPR Laws, India.

The Respondent is Narendra Ghimire, Deep Vision Architects, United States of America (“United States”).

### **2. The Domain Name and Registrar**

The disputed domain name <sonata.ai> is registered with Dynadot Inc (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 29, 2023. On December 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 7, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 12, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on December 17, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 20, 2024. The Response was filed with the Center on January 19, 2024. On January 25, 2024, the Complainant submitted a Supplemental Filing to the Center. On January 25, 2024, the Respondent submitted an objection to the Complainant’s Supplemental Filing and requested a chance to file a Supplemental Filing, if the Complainant’s is to be considered by the Panel. The Panel issued Procedural Order No. 1 on February 21, 2024, admitting the Supplemental Filing in part,

and giving the Respondent an opportunity to respond to the admitted parts of the Supplemental Filing. The Respondent filed his response to the Supplemental Filing on February 24, 2024.

The Center appointed Jeremy Speres, Meera Chature Sankhari, and Andrew D. S. Lothian as panelists in this matter on February 19, 2024. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is an IT services provider, offering business intelligence and analytics, application development management, mobility, cloud, social media, testing, enterprise services, and infrastructure management services. The Complainant's SONATA mark was conceived in 1986 by its predecessor in title, and the Complainant, together with its predecessor and subsidiaries, has used the mark since then. The Complainant trades internationally, including, most relevant to this case, operating a subsidiary in the United States originally named "Offshore Digital Services Inc.", which later, at a date unspecified by the Complainant, was renamed "Sonata Software North America Inc."

The Complainant's SONATA mark is registered in various forms in various jurisdictions, including Indian Trade Mark Registration No. 1273878 SONATA in class 42, with a registration date of March 19, 2004; European Union Trade Mark Registration No. 005362711 SONATA in classes 9, 38, and 42, with a registration date of October 15, 2007; and United States Trade Mark Registration No. 7227995 SONATA in class 42, with a registration date of November 28, 2023, and a claimed first use in commerce date of January 1, 1986. The Complainant cited an earlier Indian trade mark registration, specifically, Indian Trade Mark Registration No. 462890 SONATA and device in class 9, with a registration date of November 11, 1986. That trade mark expired in 1993, as far as the Panel can tell, although nothing in this Decision turns on this.

The Complainant's primary website is located at <sonata-software.com>, a domain name which it has owned since 1995.

The Respondent, a domainer since 2013 who buys and sells domain names for profit, focuses on domain names comprising dictionary words.

The disputed domain name was acquired by the Respondent in an expired domain name auction on September 8, 2020, and presently resolves to a marketplace website indicating that the disputed domain name is for sale. The disputed domain name is listed on that marketplace with a minimum offer amount of USD 249,216.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name. Notably, the Complainant contends as follows:

Given that the Complainant has a global presence, including in the Respondent's country, and given that its SONATA mark is well-known, the Respondent must have been aware of the Complainant at the time of registering the disputed domain name.

As a domainer, the Respondent had an affirmative obligation under the doctrine of wilful blindness to avoid the registration of trade-mark-abusive domain names such as the disputed domain name, and ought to have taken steps to screen his registrations against readily available online databases.

The Respondent has exhibited a pattern of conduct of registering domain names that correspond to the trade marks of third parties.

The Respondent has been a respondent in three prior UDRP cases exhibiting very similar facts to the present case and was found to have acted in bad faith in one such case.

## **B. Respondent**

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name and has requested a finding of reverse domain name hijacking (“RDNH”). Notably, the Respondent contends as follows:

The SONATA mark is a dictionary term that is widely used by third parties, including as a trade mark, business name, place name, surname, and acronym. The Respondent has a legitimate interest in trading in domain names such as the disputed domain name for their semantic significance as opposed to any trade mark significance.

The Respondent first heard of the Complainant upon receipt of the Complaint, and the Respondent attests to this in a declaration made under penalty of perjury.

The Complainant filed the Complaint shortly after launching an artificial intelligence (“AI”) offering, thus the inference should be drawn that the Complainant filed the Complaint in order to acquire a domain name that had, subsequent to registration of the disputed domain name, become relevant to its business. This is an ulterior purpose deserving of a finding of RDNH.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trade mark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.7.

The Complainant has shown rights in respect of a trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the Policy has been established.

### **B. Rights or Legitimate Interests**

Given the Panel’s findings in relation to bad faith, it is not necessary to consider the second element of the Policy.

### **C. Registered and Used in Bad Faith**

The Complainant has not met its burden of proof in respect of bad faith for the following reasons.

“Sonata” is a dictionary word that is widely used by parties unconnected to the Complainant, including as registered and unregistered trade marks, and for its semantic value denoting a musical composition, amongst numerous other non-infringing uses.

The Complainant claims that its mark is well-known, but its evidence is not sufficient to convince the Panel that the mark is well-known outside of India, and in particular, not in the United States where the Respondent

is based. Thus, no presumption can be made about the Respondent's awareness of the Complainant's mark based on the mark being well-known.

The SONATA mark is thus not unique to the Complainant, and it appears to the Panel that if the Complainant is well-known, it is more widely recognised as SONATA SOFTWARE than as SONATA alone, such as has been its trading style. It is therefore quite plausible that the Respondent registered the disputed domain name for its semantic value as opposed to any brand value attaching to the Complainant.

That the disputed domain name is capable of being used in good faith, without targeting the Complainant, is apparent from the fact that it was used, from 2018 to 2020, by an unrelated cryptocurrency exchange.

The Complainant is a business-to-business trader, so it is plausible that the Respondent, being an individual domainer, had not come across the Complainant prior to registering the disputed domain name, as the Respondent indeed claims under penalty of perjury in his declaration.

The Respondent owned the disputed domain name for over three years prior to receiving the Complaint, and, in that time, did nothing to overtly target the Complainant. Importantly, he did not approach the Complainant with a view to selling the disputed domain name to it. Thus, there is no direct evidence of targeting. All that the Respondent has positively done is to list the disputed domain name for sale, and it is widely accepted that acquiring domain names consisting of dictionary terms for resale is not *per se* illegitimate. [WIPO Overview 3.0](#), section 2.1.

The Respondent has been a respondent in three prior UDRP cases. Specifically, *Virtuoso, Ltd. v. Narendra Ghimire, Deep Vision Architects*, WIPO Case No. [DIO2022-0049](#) ("*Virtuoso*"); *Amadeus IT Group, S.A. v. Domains By Proxy, LLC / Narendra Ghimire, Deep Vision Architects*, WIPO Case No. [DCO2022-0040](#) ("*Amadeus*"); and *Sage Global Services Limited v. Narendra Ghimire, Deep Vision Architects*, WIPO Case No. [DAI2023-0010](#). The Respondent was unsuccessful in *Virtuoso*. He did not submit a formal response in that case but did file a Federal lawsuit in the United States against the complainant, which, based on publicly available court and Whois records, appears to have been withdrawn by joint stipulation, with the Respondent retaining the domain name concerned to date. The Respondent was successful in the other two UDRP decisions, with a dissenting opinion being delivered against him in *Amadeus*.

What is clear from these prior decisions is that the Respondent does, as he claims under penalty of perjury, focus on domain names comprising dictionary words, and he does so on a large scale. The Complainant claims to have run a reverse Whois search for all domain names registered using the Respondent's email address and claims to have unearthed "more than 70 random domain names", with some of them being, allegedly, trade mark abusive. Tellingly, the Complainant does not provide the list of such domain names, nor does it indicate which domain names within that list are abusive.

It is also worth noting that in two of the prior UDRP cases involving the Respondent, he had registered domain names with a connection to music, as in this case. All three domain names were registered in 2020 or 2021. This shows a general interest by the Respondent in music-themed domain names at that time, which points away from trade mark targeting here.

The Respondent has succeeded more often than he has failed in UDRP cases. In the one case in which he failed, he ended up retaining the domain name after filing a Federal lawsuit. The Panel does not view the single *Virtuoso* case as suggestive of a pattern of abusive conduct. Regardless, each case must be assessed on its own merits.

The Complainant argues that the disputed domain name is within the .ai top-level domain, denoting use for AI, which in turn suggests targeting of the Complainant given the Complainant's AI offerings. However, at the time the Respondent registered the disputed domain name in 2020, the Complainant was not overtly offering AI related services on its website, thus this argument is not as compelling as it may at first blush appear.

The Complainant argues that the Respondent, as a domainer, had a positive obligation to conduct searches to ensure the disputed domain name was not abusive, under the doctrine of wilful blindness. It is not necessary for the Panel to consider whether this doctrine should be applied to the facts of this case, although the Panel has its doubts about the appropriateness of applying the doctrine to purely dictionary word domain names that are not well-known (as a trade mark) in a respondent's jurisdiction in all cases. Nevertheless, assuming that the Respondent was under an obligation to take proactive steps to avoid abusing third party rights, as the [WIPO Overview 3.0](#), section 3.2.3, states:

"Noting the possibility of co-existence of trademarks across jurisdictions and classes of goods and services, and the fact that trademarks which may be inherently distinctive in one context may be generic in another, the mere fact of certain domain names proving identical or confusingly similar to third-party trademarks pursuant to a search does not however mean that such registrations cannot as such be undertaken or would automatically be considered to be in bad faith."

Even if the Respondent had conducted appropriate searches, he would not necessarily have been led to the conclusion that the disputed domain name would abuse the Complainant's rights. As discussed above, the term "sonata" is used by many third parties, both in a dictionary word sense and as a trade mark (including registered trade marks), and the disputed domain name is perfectly suited to good faith use. The burden of proof rests with the Complainant to show on a balance of probabilities that the Respondent has targeted it and/or its rights unfairly via the registration of the disputed domain name, and it has not succeeded in doing so here.

Moreover, and as indicated above, acquiring domain names consisting of dictionary terms for resale is not *per se* illegitimate. If a domainer makes a trade out of registering dictionary word domain names on a large scale, it is inevitable that they will, as a matter of course, end up registering domain names that correspond to trade marks. This does not, in and of itself, mean that the domainer registered those domain names with the relevant trade mark in mind and/or with intent to target the same unfairly. They might have, but without more, they equally might not have.

Taking all of this into consideration, at the very least the Respondent's version is equally as probable as the Complainant's version, and the Complaint must therefore fail on a balance of probabilities.

The Panel finds the third element of the Policy has not been established.

#### **D. Reverse Domain Name Hijacking**

Paragraph 15(e) of the Policy provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. The mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking. [WIPO Overview 3.0](#), section 4.16.

The Complainant's SONATA trade mark was registered before the disputed domain name, at least in a number of jurisdictions outside of the United States, and used in trade for over 30 years prior to registration of the disputed domain name. The Complainant's mark was reputed, at least within India within its industry, for some time prior to registration of the disputed domain name. The disputed domain name targets an industry - AI - in which the Complainant is involved. The Respondent has been found to have registered a domain name in bad faith under the Policy previously. In *Amadeus*, the complainant cited seven domain names registered by the Respondent, which the complainant argued were, on their face, indicative of cybersquatting. Although the majority in that case did not find accordingly, the Panel *prima facie* has its doubts about two of those, specifically <waterai.com> and <deepbluetechology.com>. These domain names are fairly unique and more likely to have been deliberately selected with the corresponding trade marks in mind.

On balance, it is not implausible that the Complainant formed a sincere view that the disputed domain name constituted cybersquatting. It cannot be said that it is more likely than not that the Complainant acted with

some ulterior purpose in mind, rather than genuinely believing the disputed domain name to constitute cybersquatting.

The Panel denies the request for a finding of RDNH.

## **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/Jeremy Speres/*  
**Jeremy Speres**  
Presiding Panelist

*/Meera Chature Sankhari/*  
**Meera Chature Sankhari**  
Panelist

*/Andrew D. S. Lothian/*  
**Andrew D. S. Lothian**  
Panelist  
Date: March 11, 2024