



उत्तर प्रदेश UTTAR PRADESH

ET 946134

INDRP ARBITRATION

THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

ADMINISTRATIVE PANEL DECISION

SOLE ARBITRATOR: ANKUR RAHEJA, FCS LLB MCA

Disputed Domain Name: aprilia.in

In the matter of:

PIAGGIO & C. S.p.A.

...Complainant

Viale Rinaldo Piaggio 25 - 56025

Pontedera, Pisa, Italy

Versus

Xu Xiantao

...Respondent

Zheda Road 38, Hangzhou

Zhejiang 310027 China

A. Raheja

ARBITRATION AWARD

Disputed Domain Name: *aprilia.in*

1. The Parties:

- 1.1. The Complainant in this arbitration proceedings is: PIAGGIO & Co. S.p.A., Viale Rinaldo Piaggio 25 - 56025 Pontedera, Pisa, Italy, represented by Mr Luca Barbero c/o Studio Barbero S.r.l., Torino, Italy.
- 1.2. The Respondent in this arbitration proceeding is Xu Xiantao, Zheda Road 38, Hangzhou, Zhejiang 310027 China.

2. The Domain Name and the Registrar:

- 2.1. The Disputed Domain Name is **<aprilia.in>**, created on 25th January 2013.
- 2.2. Domain Registrar is Endurance Domains Technology Pvt Ltd.

3. Procedural History:

- 3.1. Arbitrator received an email, inquiring if Nixi can avail of its services as an arbitrator for the dispute pertaining to the domain name **<aprilia.in>**. Arbitrator confirmed availability and sent the signed Statement of Acceptance and Declaration of Impartiality and independence as required by rules.

- 3.2. NIXI appointed Mr Ankur Raheja as the sole Arbitrator on 02 August 2019 and Arbitrator received the hard copy of the Complaint along with Annexures on 07th August, 2019.
- 3.3. Arbitral Proceedings commenced on 05 August 2019 by issue of a notice by the Arbitrator by email to the Respondent, directing Respondent to file his response to the Complaint by 20th August 2019, which was successfully delivered on the WHOIS Email ID.
- 3.4. In the meantime, Nixi served soft copy of the Complaint with Annexure, while the hard copy of the same was dispatched through courier to the WHOIS address of the Respondent.
- 3.5. Relevant Dates are as follows:

Sr No	Particulars	Date
1	Date of Handover of Complaint by NIXI and service of soft copy of Complaint upon Respondent by Nixi	02 August 2019
2	Notice of Arbitration issued to the parties, also referred as date of commencement of Proceedings	05 August 2019
3	Second Notice to the Respondent	22 August 2019
4	Award Passed	28 September 2019

- 3.6. In accordance with INDRP read with INDRP Rules of procedure, notice of Arbitration was sent to the Respondent on 5th August 2019, with the instructions to file his reply / response by 20th August 2019.
- 3.7. That on failure of the Respondent to file any response to the first notice, another opportunity was provided to the Respondent on 22 August 2019 but he failed to comply with the same as well.
- 3.8. The communication at various stages of proceedings through emails at the ID provided in the WHOIS information of the Disputed Domain was delivered successfully. NIXI had already delivered Soft Copy of the Complaint initially with the available Annexures, while the Complainant served upon the Respondent further Annexures on Arbitrator's request on 23rd August 2019. Though, the hard Copy of the Complaint remained undelivered due to incomplete address.
- 3.9. In the facts and circumstances of the case, an order for ex-parte proceedings were issued on 03 September 2019, as no response was received from the Respondent. In any case, the WHOIS info was the only contact information available for the Domain name owner as per the WHOIS records and which is assumed to be provided correctly and on which various notices were otherwise attempted to be served. Therefore, service of notice has deemed to have been complied with in accordance with Rule 2 of the INDRP Rules of Procedure.
- 3.10. No personal hearing was requested / granted / held.
- 3.11. The language of these proceedings is in English.

4. Factual Background:

- 4.1. The Complainant submits that it is a company founded in the year 1884, initially produced locomotives and railway carriages, in Sestri Ponente, Italy, having its head office at Pisa, Italy, The Complainant is an Italian motor vehicle manufacturer, which produces a range of two-wheeled motor vehicles and compact commercial vehicles under seven brands: PIAGGIO, VESPA, G1LERA, APRILIA, MOTO GUZZI, DERBI, AND SCARABEO. It has six research-and-development centers and operates in over 50 countries worldwide. The Complainant has reinforced its international presence with locations / additional offices / dealers in many countries worldwide, including all the European countries, Russia, Ukraine, Turkey, Georgia, Armenia, Azerbaijan, Bahrain, Cambodia, China, Hong Kong, India, Indonesia, Israel, Japan, Jordan, Lebanon, Malaysia, Oman, Philippines, Qatar, Saudi Arabia, Singapore, South Korea, Taiwan, Thailand, United Arab Emirates, Vietnam, Algeria, Angola, Gabon, Mauritius, Mayotte, Morocco, Reunion, Senegal, South Africa, Tunisia, Bermuda, Guadeloupe, Guatemala, Martinique, Canada, Mexico, USA, Australia, French Polynesia, New Caledonia, New Zealand, Tahiti, Argentina, Chile, Costa Rica, Ecuador, French Guiana and Uruguay.
- 4.2. As far as India is concerned, today the current number of Complainant's showroom is 250 but 100 new points of sales will be opened in India by the end of 2019. The Complainant sold 74,704 APRILIA and VESPA motorcycles in the period 2017-18 and has a manufacturing plant in Baramati Maharashtra, where it manufactures the iconic VESPA and APRILIA SR 150 motorcycles, as also attested by the article enclosed hereto. The Complainant is expanding in the

Indian market and is planning to launch new models in the country, including the APRILIA I50CC bikes in 2020 and APRILIA STORM 125 in April 2019. In India the Complainant is experiencing a particularly positive moment: in the first half of 2018 the overall market share of three-wheeler vehicles reached 22.8%, and in the single month of August 2018, the Indian subsidiary Piaggio Vehicles Pvt Ltd (Pvpl) sold 27,289 vehicles, i.e. an increase of 23% if compared to the 22,175 units sold in the same month of 2017. Both business lines made a positive contribution to this result: the two-wheeler increased of 31.1% compared to the previous year (10,034 two-wheeler vehicles compared to 7,652 in August 2017), while commercial vehicles recorded an increase in sales of 18.8% (17,255 units in August 2018 compared to 14,523 units sold in August 2017). In India the Complainant operates from 1960s, now through the subsidiary Piaggio Vehicles Pvt. Ltd. located in Pune. In addition, the Complainant has also a manufacturing plant located in Baramati, as mentioned above.

- 4.3. Furthermore, the Complainant operates in India, through the websites <http://piaggio.co.in> and <http://www.vespa.in/> whose respective domain names were created in 2002 and 2011, i.e. earlier than the disputed domain name, and related social media accounts dedicated to India on Youtube, Facebook and Twitter.
- 4.4. The Complainant submits that it is one of the European and world's leading manufacturers of 2-3 wheeled motor-vehicles and their accessories, engaged in the business of manufacturing, designing and supplying a wide range of these products across the globe including India for several years. Annexed and marketed is a sample catalogue including some of the products offered under the trademark APRILIA.

- 4.5. The Complainant submits that APRILIA was the name of a company founded after the Second World War by Alberto Beggio, as a bicycle production factory at Noale, Italy in the province of Venice which a few years later moved on to manufacture scooters and small-capacity motorcycles. APRILIA is today the real sporty flagship brand for the Complainant which acquired it in December 2004. With 294 Grand Prix races won in Road Racing World Championship, APRILIA holds the record for the most wins of any European manufacturer in the history of maximum motorcycle competition.
- 4.6. Every weekend, all over the world, APRILIA motorcycles take to the track on international and local circuits, holding high the honor of Italian and European motorcycling, feeding the biker's desire to race and raising up young riders destined to enter the world championship world. From when it was founded, during the immediate post- Second World War period, APRILIA was the name of a small artisan Italian factory whose products (at the beginning, bicycles)- which ranged from the components to the final product- obtained a good success.
- 4.7. The founder's son, Ivano Beggio, run the small company in 1968 and built the first APRILIA motorcycle, a fifty gold and blue, which experienced a great success. The first production Aprilia mopeds were named Colibri, Daniela and Paclid. APRILIA later produced a motocross bike in 1970 called the Scarabeu.
- 4.8. In ten years, the company grew considerably: from 1969 to 1979, the annual production of mopeds increased from 150 to 12,000 units, while for motorcycles in just four years production exceeded 2,000 units per

year. In 1977 Ivan Alborghetti from Milan, Italy won the Italian 125 and 250 cc motocross championships on APRILIA motorcycles. In the 1980s APRILIA added enduro, trials and road bikes of between 50 and 600 cc, becoming a laboratory of ideas and projects that would worldwide, including in India, highlights of Complainant's substantial investments in advertising, its marketing and sales worldwide, its consistent use of the trademark APRILIA for decades, APRILIA has become a well-known trademark worldwide.

- 4.9. Complainant also holds valid domain name registration for Aprilia.com since 1996. Disputed domain name was registered in 2013, well after registration of Complainant's .com domain name and Trademark registrations. At the time of filing of the Complainant, the Domain Name redirects to a web page featuring several sponsored links to third parties' commercial websites, some of them also related to the Complainant's Trademarks and Products.
- 4.10. In addition, through the link "Buy this domain" published on the right side of the home page of the current version of the website to which the domain name is pointed **<aprilia.in>**, users are redirected to the web page SEDO.com, where they are invited to submit an offer for the domain name.
- 4.11. In view of the above-described use of the Domain Name, identical to the trademark APRILIA, Complainant through an agency contacted Respondent in order to ascertain its real intention as to the Domain Name and acquire information on any possible legitimate interest related to it on January 10, 2018. Respondent replied to that communication on January 11, 2018 asking for \$9,500. The

Complainant also further communicated to reimburse out of pocket expenses but respondent did not accept the same.

4.12. Since the bad faith of Respondent as to the Domain Name had clearly emerged from such an exchange of communications, the IT agency reported the communications received to Complainant. Complainant then instructed its representatives to draft and send to the holder of the Domain Name a Cease and Desist letter, which was first addressed to Respondent on February 16, 2018 via registered mail and email to the addresses indicated in the Whois database, requesting that Respondent cease any use of the disputed Domain Name and transfer it to Complainant free of charge. But Respondent still made another demand of 6000 Euros for the transfer of the domain name.

4.13. In view of the Respondent's failure to comply with Complainant's requests and in view of the fact that Respondent, notwithstanding receipt of the representative's Cease and Desist letter and subsequent follow up correspondence, continues to use the disputed domain name containing the Complainant' registered trade mark by redirecting it to a pay-per-click landing page and offering it for sale, Complainant instructed its representatives to file the present Complaint which fall within the scope of the INDRP.

5. **Complainant's Contentions under Para 4 of the INDRP Policy:**

5.1. **The Disputed Domain Name is identical or confusingly similar to the trademark of the Complainant in which the Complainant has statutory and/or common law rights**

- 5.1.1. The Complainant submits that the disputed Domain Name <aprilia.in> contains the Complainant's trademark APRILIA registered in India and other countries including China. The disputed domain name is visually and phonetically identical to the trademark of the trademark of the Complainant. Such registration by the Respondent amounts to a violation of Para 3 of the INDRP which states that a Registrant is solely responsible to ensure before the registration of the disputed domain name that such domain name registration does not violate the rights of any proprietor / brand owner.
- 5.1.2. The Complainant is the registered proprietor of the Trademark APRILIA in various countries and has been using it in connection with its on-going business. Complainant holds valid Trademark registrations for 'APRILIA' vide TM # 497950 and 497951 under class 9 and 20 respectively since 2009. Further trademark # 694999 under class 12 since 2016. Also trademarks are registered internationally with WIPO since 2006 and in China since 2010.
- 5.1.3. Further, the Complainant submits that upon perusal of the Respondent's website <aprilia.in>, it seems that the Respondent, besides redirecting the Domain Name to a web page featuring several sponsored links to other commercial web sites, is also attempting to sell it through a link published on the site where the disputed Domain Name resolves. Furthermore Respondent, even after having received a Cease and Desist letter from Complainant's representatives, requested an amount

well beyond the out of pocket costs for the transfer of the disputed Domain Name to Complainant.

- 5.1.4. The Complainant refers to and rely on the case Perfetti Van Melle Benelux BV v. Jing Zi Xin [INDRP/665] wherein it has been held that the domain name wholly incorporating a Complainant's registered trademark may be sufficient to establish identity or confusing similarity, despite the addition of other words to such marks. Also in La Roche-Posay Laboratoire Pharmaceutique v. Eac International CO., Limited [INDRP/457]; it was held that when a disputed domain name contains the trade mark in its entirety, the domain name is identical and confusingly similar, as also recently confirmed in Shenzhen Yi Si Lang E-Commerce Co Ltd v. Salim M [INDRP/1046], See along the same lines Clarins v. Liheng [INDRP/739]; Calvin Klein Inc. v. M/s Hangzhou Gougou Internet Co. Ltd [INDRP/704] and Perfetti Van Melle Benelux BV v. Jing Zi Xin (supra), where the Arbitrator found that "(..) complainant already has several top level and country level domains that incorporate the said style and marks. And it is apparent that the Respondent's Domain Name entirely contains the Complainant's trademark. Indeed, numerous courts and UDRP panels have recognized that "if a well-known trademark is incorporated in its entirety, it may be sufficient to establish that a domain name is identical or confusingly similar to Complainant's registered mark." [ITC Limited V Travel India qNDRP Case No. 065"]; Boehringer Ingelheim Pharma GmbH & Co. KG v Philana Dhimkana (WIPO Case No. D2006-1594); Allied DOMECCQ Spirits and Wine Limited v Roberto Ferrari, (INDRP Case No. 071); Philip Morris

USA Inc. v Doug Nedwin/SRSPlus Private Registration (WIPO Case No. 02014-0339)¹. Further, it has been held in the matter of Disney Enterprises, Inc. v. John Zuccarini, Cupcake City and Cupcake Patrol [WIPO Case No. D2QO1-0489] that "domain names that incorporate well-known trademarks can be readily confused with those marks".

5.1.5. As a last remark on the confusing similarity issue, Complainant points also out that, as stated in *CLarins v. Liheng* [INDRP/739] (supra) "the presence or absence of spaces, punctuation marks between words or indicators for Top Level Domains, such as '.com', '.us', '.co.in' etc. are irrelevant to the consideration of identity or confusing similarity between a trademark and a disputed domain name." This was also confirmed in *Shenzhen Yi Si Lang E-Commerce Co Ltd v. Salim M* [INDRP/1046], (supra), where it was held that "the '.IN' suffixes should not be taken into account while comparing the Complainant's trademark, and the Disputed Domain Name". Therefore, also in the present case, the mere addition of the Top Level ".IN" to the disputed Domain Name does nothing to exclude confusing similarity of the disputed Domain Name with the Complainant's APR1L1A trademark.

5.1.6. In light of the above, it is clear that the Domain Name is identical to the prior registered trademark in which Complainant has rights.

5.2. The Respondent has no legitimate interests in respect of the disputed domain name

- 5.2.1. TThe Complainant submits that it has legitimate interest in the "APRILIA" trademark in India as it registered the said mark since 2009, and has been openly, continuously and extensively using it in said Country for several years. Moreover, by virtue of long and extensive use and advertising, the "APRILIA" trademark has become well-known mark.
- 5.2.2. Further, the Complainant submits that it has registered the domain name <aprilia.com> on 20/07/1996 whereas the disputed Domain Name <aprilia.in> was registered by the Respondent on 25/01/2013. Hence, such subsequent adoption and registration of the disputed Domain Name shows that the Respondent has no right or legitimate interest in the domain name <aprilia.in>.
- 5.2.3. in The Complainant submits that the Respondent is not a licensee, an authorized agent of Complainant, or in any other way authorized to use Complainant's trademark APRILIA. As stated in, inter alia, Pharmacia & Upjohn Company v. Moreonline, Case No. P2000-0134, "the mere registration, or earlier registration does not establish rights or legitimate interests in the Domain Name." See also along these lines Pcrfetti Van Melle Benelux BV v. Jing Zi Xin (supra) where, in a case similar to the present one, the Arbitrator held that "(..) It has been held that merely registering the domain name is not sufficient to establish a right or legitimate interests. [Vestel Elektronik Sanayi ve Ticaret Av. Mehmet Kahveci, WIPO Case No. 02000-1244]."

- 5.2.4. Further, the Respondent is neither commonly / popularly known in the public nor has applied for any registration of the mark "APRILIA" or any similar mark or has registered his business under the said name with the Ministry of Corporate Affairs, India. To the contrary, Respondent's name, according to the official Whois database, is "Xu Xiantao".
- 5.2.5. The Respondent has not provided Complainant with any evidence of its use of, or demonstrable preparations to use the Domain Name in connection with a bona fide offering of goods or services before any notice of the dispute. The Complainant submits that the disputed Domain Name was in fact intentionally created by the Respondent for commercial gain to misleadingly divert consumers or traders of the Complainant to the disputed Domain Name, which has been and currently is redirected to a web page featuring several sponsored links to other commercial web sites, and where there is a link redirecting to a website where the Domain Name itself is offered for sale.
- 5.2.6. The above circumstances lead to the conclusion that the Respondent is not using, nor demonstrated any preparation to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services. To the contrary, as also stated in the Panel decision *Paris Hilton v. Deepak Kumar*, WIPO Case No. D201Q-1364. if the owner of the domain name is using it in order "...to unfairly capitalise upon or otherwise take advantage of a similarity with another's mark then such use would not

provide the registrant with a right or a legitimate interest in the domain name.

- 5.2.7. The Respondent's choice of the Domain Name seems to be a clear attempt to unfairly capitalise on or otherwise take advantage of the Complainants' trademarks and resulting goodwill." This was also confirmed in *Fiskars Corporation v. Lina / tioubletist Limited* [INDRP/1067] where, in an analogous case, it was held that "The respondent's use of the disputed domain name is merely intended to divert customers to respondent's website, which provides multiple pay-per-click links. Hence, it cannot be considered a bona fide offering of goods and services nor a legitimate non-commercial or fair use. The complainant has made out a prima facie case that the respondent has no rights or legitimate interests in the disputed domain name and as such the burden of proof shifts to the Respondent". Amongst the decisions addressing similar situations where respondent used a domain name corresponding to a trademark to attract users to its website for its own commercial gain, and, at the same time, advertised also the sales of products of competitors, see, inter alia, *Luigi Lavazza S.p.A. v. Flying, Stingrays Lid*, WIPO Case No, D2012-1391 and also *Lancome Parfums et Beaulé & Compagnie v. D Nigam, Privacy Protection Services / Pluto Domains Services Private Limited*, WIPO Case No. D20Q9-0728 ("Respondent is operating a website at the disputed domain name that simply links to websites selling Complainant's products and to oilier companies selling cosmetics in direct competition with Complainant. In this Panel's

view, Respondent is clearly attempting to confuse Internet users by use of Complainant's widely-known trademark in the domain name to lure Internet users to the website, and thereby benefit commercially from "click-through" advertising fees. Such use does not constitute a bona fide, legitimate use of the domain name").

5.2.8. Furthermore, both during the confidential phase and even after having been formally notified of the Complainant's rights in the trademark APRILIA, the Respondent requested a consideration well in excess of the out of pocket costs, further demonstrating that it is not making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue, v From the above circumstances, it is clear that the Respondent has failed to comply with Para 7 of INDRP wherein the onus is on the Registrant to prove that he has a right and legitimate interest in the domain name.

5.2.9. As a final remark on the issue of rights or legitimate interest, it is a consolidated principle that the burden of proof lies on Complainant, However, satisfying the burden of proving a lack of Respondent's rights or legitimate interests in respect of the domain name according to Rule 4 (a) of the Policy is quite onerous, since proving a negative circumstance is always more difficult than establishing a positive one. Accordingly, it is sufficient that Complainant shows a prima facie evidence in order to shift the burden of production on Respondent (see *La., Croatia Airlines d.d. v. Modern Empire Internet Ltd.* WIPO Case

No. D2Q03-Q455, Belupv d.d. v. WACHEMd.o.o. WIPO Case No. D2QQ4-0110. Sampo pic v. Tom Staver WIPQ Case No. D20Q6-1135. Audi AG v. Dr. Alireza Fahimipour WIPO Case No. DIR2006-0003).

- 5.2.10. Complainant, therefore, concludes that Respondent has no rights or legitimate interests in respect of the Domain Name.

5.3. The disputed Domain Name has been registered or is being used in Bad Faith

- 5.3.1. The Complainant submits that the Respondent was aware of the Complainant's exclusive trademark rights at the time of registration and that it has been using the Domain Name in bad faith, as it was put on notice of the infringement of the Complainant's rights via Complainant's cease and desist letter sent on February 16, 2018 and subsequent correspondence but failed to comply with the Complainant's demands and continued its use of the Domain Name in an infringing manner.
- 5.3.2. Furthermore, as highlighted supra, the trademark APRILIA has been extensively used since as early as the 1960s in connection with Complainant's advertising and sales of APRILIA products worldwide, including in Respondent's country, has been widely publicized globally and constantly featured throughout the Internet.
- 5.3.3. Complainant points also out that, in the light of the well-known character of the trademark APRILIA, the Respondent could not

have possibly ignored the existence of Complainant's well-known trademark when it registered the Domain Name <aprilia.in>. Several UDRP decisions confirmed that the well-known character of a trademark incorporated in a disputed domain name is a relevant circumstance in the assessment of bad faith registration. See i.a. *Accor v. Jiangyun*, WIPO Case No. D2011-2277. See also *Perfetti Van Melle Benelux BV v. Jing Zi Xin* (supra).

5.3.4. Therefore, the circumstances of the case suggest that Respondent's purpose in registering the Domain Name, which encompasses Complainant's mark APRILIA in its entirety, was to capitalize on the reputation of Complainant's mark by diverting Internet users seeking products under APRILIA mark to its own website and to the websites linked thereto, for commercial gain. See, along these lines, *Sparkol Limited v. Mr. Shripal [INDRP/1069]* (supra) where it was held that "In light of the respondent's presumed knowledge of the complainant's rights, it is reasonable to infer that the respondent registered the disputed domain name without any intention of using it for genuine business or commercial activities. The respondent must have the intention to sell it for financial gain or misuse the dispute domain name, as the impugned domain name has no functional website.

5.3.5. Furthermore, it would be extremely difficult, if not impossible, for the respondent to use the disputed domain name as the name of any business, product or service for which it would be commercially useful without violating complainant's rights. Thus,

the disputed domain name was registered in bad faith (see also *The Ritz Carlton Hotel Company LLC v. Nclton! Brands Jnc*, [INDRP/250])

- 5.3.6. The Complainant submits that by using the disputed Domain Name the Respondent has intentionally attempted to attract Internet users to its website by creating a likelihood of confusion with the Complainant's name or mark as to the source or sponsorship or affiliation or endorsement of the Respondent's website or the products or services offered/available on the Respondent's website thereby violating Para 6 (iii) of INDRP.
- 5.3.7. As highlighted above, the disputed Domain Name has been and currently is redirected to a web page featuring several sponsored links to other commercial web sites, and on which there is a link redirecting to a page where the Domain Name itself is offered for sale, which cannot be considered, by any means, a bona fide use, since the Respondent, besides attempting to obtain commercial benefit from the sale of the Domain Name, has also clearly attempted to gain money through the pay per click system, free-riding the well-known character of APRILIA trademark. See along these lines the previous case *Calvin Klein Inc. v. M/s Ilangzhou Gougou Internet Co. Ltd.* (supra) "The domain name is registered without any authority, agreement or arrangement between the Complainant and the Registrant.
- 5.3.8. The webpage included several links to third parties in respect of various products including those of the Complainant. Thus the

Registrant has been making money illegally by using the name and fame of the Complainant."). See also, along the same lines, Perfetti Van Melle Benelux BV v. Jing Zi Xin (supra) "It was held in the matter of L'Oreal, Biotherm, Lancome Parfums et Beaute & Cie v. Unasi, Inc, [WIPO Case No. D2005-0623]. exploitation of the reputation of trademarks to obtain click-through commissions from the diversion of Internet users is a common example of use in bad faith as referred to in paragraph 4(b)(iv) of the Policy and identified in many previous decisions: see e.g Future Brands LLC v. Mario Dolzer, WIPO Case No. D20Q4-Q718; ACCOR v. Mr. Young Gyoon Nah, WIPO Case No. D2004^0681 and Deloitte Touche Tohmatsu v. Henry Chan, WIPO Case No. 02003^0584."

- 5.3.9. It should also be noted that, as additional evidence of its bad faith, before in the confidential phase reported above and even after receipt of the Cease and Desist letter, the Respondent requested Complainant to correspond an amount of money well in excess of the out of pocket costs for transferring the Domain Name (namely 9,500 USD in the initial phase and 6,000 Euros after the Cease and Desist letter). Such a conduct clearly demonstrates that the Respondent 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 and 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, thereby violating also Para 6 (i) of 1NDRP.

See *la. INDRP/115 Dispute Decision* related to <armamexchange.in> decided on October 01, 2009, finding that "The Respondent's bad faith is further exemplified by them asking for compensation to transfer the domain name". Along these lines, see also *Fiskars Corporation v. Lin a / Doublefist Limited [INDRP/10671 (supra)]* where a request of 2,500 Euro for the transfer of the disputed domain name was considered in excess of the expenses incurred by the respondent and thus proving without any reasonable doubt its bad faith.

- 5.3.10. As an additional circumstance evidencing bad faith, Respondent is certainly familiar with the registration of domain names corresponding to registered and well-known trademarks. Respondent is, for instance, also the owner of the domain name <vespa.co.in>, incorporating another well-known Complainant's trademark, i.e. VESPA, and pointed to a similar parking page publishing sponsoring links to third parties' websites.
- 5.3.11. A pattern of conduct is therefore clearly apparent with regard to the Respondent of the present case. As stated in *Telstra Corporation Limited v. Ozurls WIPO Case No. D2001-0046*. "A 'pattern of conduct' as required in Paragraph 4.b.(ii) typically involves multiple domain names directed against multiple Complainants, but may involve multiple domain names directed against a single Complainant". In the present case, the first definition applies. According to Complainant's verifications, Respondent in fact appears to be the owner of several domain names consisting of well-known third-parties' trademarks, such as inter alia <vespa.co.in>, <sony-mobile.in>,

<samsungpay.at>. Previous panels have considered the registration of domain names consisting of third parties trademark by Respondents is prima-facie evidence so as to satisfy sub paragraph 4(b)(ii) of the Policy (see Mar-IKEA Systems BV v. Technology Education Center, WIPO Case No D2QOO-Q522, Volvo Trademark Holding AB v. Cup International Limited, WIPO Case No 2000-0338. In addition, the Respondent was involved in another INDRP Proceedings SOPRA STERIA GROUP v. XU XIANTAO where it was, similarly found to have registered in bad faith the domain name <soprabanking.in> which was then transferred to the Complainant.

- 5.3.12. Furthermore, the Complainant submits that the Respondent has deliberately registered the disputed domain name with the intention of preventing the Complainant who is the owner of the trademark APRILIA from reflecting the sad trademark in its domain name in India.

6. Respondent's Contentions

- 6.1. Respondent did not file any formal Response.
- 6.2. The WHOIS information has been provided wrongly and as a result hard copy of the Complaint could not be delivered to the Respondent.

7. Discussions and Findings

- 7.1. The Arbitrator has reviewed all the documents placed before it by the Complainant and the Respondent respectively. The Complainant in its complaint has invoked Para 4 of the INDRP, wherein the Complainant is supposed to satisfy all three conditions provided under Para 4 of the INDRP Policy.
- 7.2. The Complainant was founded in 1884 is an Italian vehicle manufacturer, which produces two/three wheeled and compact commercial vehicles under different brands including **APRILIA**, which forms part of the disputed domain name. It operates in over 50 worldwide locations including China and India and is one of the world's leading manufacturers of 2-3 wheeled motor-vehicles.
- 7.3. Complainant adopted the brand **APRILIA** in the late 1960s, and it's first Trademark Registration application filed in various jurisdictions in 1988 including India and while with WIPO in 2006 including China. Complainant has been openly, continuously and extensively using the mark **APRILIA** as its trade name, corporate name, business name, trade mark worldwide since then. In *Living Media, Limited v. India Services, D2000-0973*, it has been held that "trademark registration is itself prima facie evidence that the mark is distinctive".
- 7.4. In India, Complainant has a manufacturing unit located in Baramati, Maharashtra and over 250 showrooms spread all over India. It is doing well in Indian market and has already made sale of approx 75,000 **APRILIA** and Vespa two wheeled vehicles in 2017-18. The Complainant operates in India, through the websites www.piaggio.co.in and www.vespa.in since 2002 and 2011 respectively. While it recently

got favorable decision in the INDRP/1134 matter of www.vespa.co.in on 30 August 2019.

- 7.5. The details of registration of trade marks secured in various classes have been produced along with the complaint. The Indian Trademark Registry website also evidences that Complainant had applied for some of its first Trademark applications under class 9 and 25, way back in 1988 in India. It has been long held that internet users/consumers seeking to locate the products/services available under one domain name may be confused, if they accidentally arrived at a different but similar web site which offers no such products/services. Mainly, as the Complainant is the owner of approx 500 domain names, including approx 50 domain names with the word **APRILIA**.
- 7.6. The Complainant has an official website at www.aprilia.com, whose registration date appears as 19 July 1996. Further Complainant over time, has also obtained registration for several country and region specific domain names or ccTLDs bearing the word **APRILIA** and/or its derivatives such as APRILIA.cn, APRILIA.it, APRILIA.be, APRILIA.ch, APRILIA.fr, APRILIA.eu and so on.
- 7.7. The products / services provided by the Complainant under the **APRILIA** mark since the last many decades enjoy worldwide reputation and goodwill. The disputed domain name registered by the Respondent is identical / confusingly similar to the well-known trademark **APRILIA** which has been owned and used by Complainant continuously and openly since last many decades.

- 7.8. With such extensive, continuous, open and uninterrupted use of the **APRILIA** trademark and trade name by the Complainants, throughout the world the **APRILIA** trademark has become distinctive and indicative of the goods of the Complainants alone and none else. Hence, any individual coming across the parked page of disputed domain name **<aprilia.in>** will assume it to be the Complainant's website for India and instantly associate the same with the Complainants. That is, the disputed domain name **<aprilia.in>** is confusingly similar to the registered trademark of the Complainant - **APRILIA**, which incorporates the same almost in its entirety.
- 7.9. The domain name **<aprilia.in>** is identical to Complainant's registered mark **APRILIA**. As numerous UDRP panels have held in so many decisions [Farouk Systems, Inc. v. Yishi Case No. D2010-0006; Havells India Limited, QRG Enterprises Limited v. Whois Foundation D2016-1775] that a domain name which wholly incorporates Complainant's registered mark may be sufficient to establish identicalness or confusing similarity, despite the addition of other words to such marks. In eAuto, LLC v. Triple S Auto Parts, D2000-0047, the Panel decided that when a domain name wholly incorporates Complainant's registered mark, that is sufficient to establish identity or confusing similarity for purposes of the Policy. In the current matter the disputed domain name **<aprilia.in>** wholly incorporates Complainant's mark.
- 7.10. The Complainants have brought conclusive evidence that it owns trademark rights in the name **APRILIA** in many jurisdictions. The registration and the use of the identical/confusingly similar disputed domain is a direct infringement of the legitimate rights held by the

Complainant of the mark **APRILIA**. In the matter of F. Hoffmann-La Roche AG v. Relish Enterprises, [WIPO Case No D2007-1629], where it was held - “if the Complainant owns a registered Trademark then it satisfies the threshold requirement of having the Trademark rights and the Domain name is confusingly similar to Complainant’s Trademark because disputed Domain Name looks and reads like Complainant’s Trademark”.

- 7.11. In the matter of Nikon, Inc. v. Technilab, Inc, [WIPO Case No D2000-1774] and Magnum Piering, Inc. v. Mudjackers & Wilson, [WIPO Case No D2000-1525], it was held that holding that confusing similarity under the Policy is decided upon the inclusion of a trademark in the domain name. That is, The registration and the use of the confusingly similar impugned domain is a direct infringement of the legitimate rights held by the Complainant of the mark **APRILIA**.
- 7.12. For the clause (ii) of Paragraph 4 of the INDRP Policy as to legitimate interest, Para 7 of the INDRP policy provides for the circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purposes of Paragraph 4.
- 7.13. The Respondent registered the Domain Name in 2013, with WHOIS name as Xu Xiantao. Complaint submits that the Respondent is neither known by the name **APRILIA** nor carries any trade or business under the said trademark. Further, the Complainants have not authorized the Respondent to secure and continue to hold such domain name registration. In the matter of Rohtas Goel And Anr. vs Somay Nayak

And Ors. on 29 October, 2010 [CS(OS) 1108/2006], Hon'ble Delhi High Court laid down that "A person is well within his right to sell his goods or render services using any trade name for the purpose. With the passage of time the goods sold or the services rendered by him, as the case may be, may acquire certain reputation or goodwill in the market which becomes the property of that person and needs to be protected by the court. It is not permissible for any other person to start selling goods or rendering services either using the same name or imitating that name so as to cause injury to that person and enrich himself at the cost of the person who had already been using that name and had acquired a certain reputation with the passage of time and on account of the quality of the goods sold or services rendered by him. Any attempt on the part of a person to enrich upon the goodwill generated by any other person needs to be curbed by the court whenever approached by the aggrieved party in this regard."

- 7.14. Though Complainant contends that if not impossible, for the respondent to use the disputed domain name as the name of any business, product or service for which it would be commercially useful without violating complainant's rights. This cannot be upheld perse, given the fact **APRILIA** is a first name for individuals around the world as is evident from social media, that could have granted legitimate rights to the Respondent in certain circumstances. But here the disputed domain name **<aprilia.in>** at present has been parked by the Respondent to display PPC links of companies like **APRILIA** Scooter, Moped Scooter, Honda Moto Scooter, Honda Racing and so on. That there is a likelihood that an actual or potential visitors to the web page of the disputed Domain Name will be induced to believe that the Complainant has licenced trademarks to the Respondent or has

authorized the Respondent to make use of the disputed domain name or the Respondent has some connection with the Complainant in terms of a direct nexus or affiliation with the Complainant, which indicates bad faith and no legitimate purpose on behalf of the Respondent can be proved. In the INDRP matter of BASF V GaoGou, it was held that the registration of a domain name that is confusingly similar or identical to a famous trademark by an entity that has no relationship to the mark is sufficient evidence of bad faith registration and use. Internet users may believe that the Respondent's domain name is being operated or endorsed by the Complainants [INDRP/752 - basf.co.in].

- 7.15. In the matter of InterGlobe Aviation Limited v. Domain Admin, Privacy Protect, LLC [WIPO Case No. D2018-1809] it was held that the disputed domain name has been used for a parking page with links to flight services, which compete with those supplied by the Complainant. Such use of the disputed domain name could not of itself confer rights or legitimate interests. See section 2.9 of the WIPO Overview 3.0, which states that use of a domain name to host a parked page comprising pay-per-click ("PPC") links does not represent a bona fide offering where such links compete with or capitalise on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users.
- 7.16. The Respondent is not making a legitimate non-commercial or fair use of the domain name, but has an intention for commercial gain to misleadingly divert consumers and tarnish the trademark or service mark at issue. In the WIPO matter of Paris Hilton v. Deepak Kumar, [WIPO Case No. D2010-1364], if the owner of the domain name is using it in order "...to unfairly capitalise upon or otherwise take

advantage of a similarity with another's mark then such use would not provide the registrant with a right or legitimate interest in the domain name. The Respondent's choice of the Domain Name here seems to be a clear attempt to unfairly capitalise on or otherwise take advantage of the Complainants' trademarks and resulting goodwill.”

- 7.17. Given the long and widespread reputation of the Complainant's mark, the compelling conclusion is that the Respondent, by choosing to register and use a domain name which is not only confusingly similar to the Complainant's widely known and distinctive mark but identical, intended to ride on the goodwill of the Complainant's trademark in an attempt to exploit, for commercial gain, Internet traffic destined for the Complainant. Potential partners and end users are led to believe that the website is either the Complainant's site, especially made up for the bearings, or the site of official authorized partners of the Complainant, while in fact it is neither of these [Viacom International Inc., and MTV Networks Europe v. Webmaster, WIPO Case No. D2005-0321 – mtvbase.com].
- 7.18. Complainant submits that there is no showing that 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. Rather, the website associated with the disputed domain name is not being used for any bonafide / legitimate purposes, but leads to a parking page displaying PPC (pay per click) advertising links. The Respondent seems to have simply registered the disputed domain name in order to benefit from the Complainant's goodwill and deceive the visitors by registering a domain name that entirely

incorporates the Complainant's trademark without including any distinguishing features. This is further evident by the fact that Respondent has already been party as a Respondent in previous two INDRP proceedings and bad faith has been proved against him, namely -

- a) INDRP/1134 - **Vespa.co.in**, decided on August, 30 2019.
- b) INDRP/796 - **Soprabanking.in**, decided on June 9, 2016.

7.19. Under the second clause, a complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. But the Respondent has not filed any response to the said INDRP complaint, while Complainant has made out a prima-facie case.

7.20. The disputed domain **<aprilia.in>** does not have a proper website on the date of filing of the complaint but only a parking page with infringing links. Moreover, the WHOIS information provided is incorrect. The case made out by the Complainant, given the strong trademark, prima-facie proves that Respondent has no legitimate rights or interest in the Domain Name. Above all, it is quite evident that neither any legitimate, noncommercial or fair use of the disputed domain name being made, but the Respondent seems to have intentionally registered the disputed domain name, which reproduces Complainant's well-known trademark **APRILIA**, in order to capitalize / profit from the goodwill associated with the famous mark.

- 7.21. Further, there is no indication that Respondent is commonly known by that name or carrying on business under the name, corresponding to the disputed domain name or has any intellectual property rights over the term **APRILIA**. Further, obviously neither Complainant has assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to use the distinctive mark **APRILIA** or to register the disputed domain name.
- 7.22. Respondent's domain name contains the Complainant's mark in its entirety, and the domain is resolving to a parking page with links to Complainant's business and its competitors. Therefore, cannot be said to be making a bonafide or fair use of the domain name. The use of the disputed domain name <**aprilia.in**> by the Respondent will most likely deceive the general public into believing that the disputed domain name, registered by the Respondent, is associated with or endorsed by the Complainants in some way. Such registration and ownership of the disputed domain name by the Respondent restricts the Complainant's rights to use the said domain to its benefit and advantage and in no case prove any legitimate rights or interests in favor of the Respondent.
- 7.23. For the purposes of clause (iii) of Paragraph 4 of the INDRP Policy as to Bad Faith, the circumstances provided therein, 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.
- 7.24. INDRP casts a duty upon the Domain Registrant/Respondent in terms of clause 3(b) of the INDRP Policy as well, to do a research before registering a domain name so that it does not infringe upon or

otherwise violate the rights of any third party. A simple google search can reveal that the **APRILIA** brand is associated with the Complainant and is being used by them in their trade and business.

- 7.25. The complainant contends that the Complainants use of mark goes back to the late 1960s and has acquired immense goodwill and popularity over the last many decades. In the matter of *The Caravan Club v. Mrgsale*, FA 95314 it was held: “registration of a well-known trademark by a party with no connection to the owner of the trademark and no authorization or legitimate purpose to utilize the mark reveals bad faith.” Further, the Complainant owns many country specific ccTLDs like APRILIA.it for Italy, APRILIA.fr for France, APRILIA.cn for China and so on.
- 7.26. The Complainant further submits that it contacted the Respondent through an agent offering to buy the domain name on 10 January 2018, without disclosing it’s identity as a Trademark holder. In response the Respondent demanded \$9,500 and therefore alleges Bad Faith on the part of the Respondent. But given the fact **APRILIA** is also a first name for individuals around the world, it has been held in the matter of *N2COM v. Whois Privacy Services / Domain Admin, Xedoc Holding SA*, D2017-1220 (WIPO September 7, 2017) (<babyboom.com>): “It appears that it was the Complainant who contacted the Respondent’s broker concerning the name in July 2012 and a number of the subsequent communications refer to the Complainant having enquired about the name. In any event, for the reasons advanced by the Respondent, it is not of itself illegitimate to offer to sell a generic domain name at a high price and the Complainant appears to have engaged in a negotiation for the

purchase of the disputed domain name without complaint (at that time at least) that the Respondent's use of the name was infringing.”

- 7.27. The above facts cannot perse prove bad faith when the identity of the Complainant was never disclosed to the Respondent and also it was the Complainant to have approached the Respondent in the first place but it is the later part, wherein the Complainant officially served the Respondent with the Cease and Desist letter and still Respondent quoted Euro 6,000 for the transfer of domain name, as at this moment he was well aware of the Trademark rights of the Complainant and there was no offer for purchase from the Complainant. This proves bad faith on behalf of the Respondent as it was an attempt to sell the domain name to the Trademark owner in excess of documented out-of-pocket costs.
- 7.28. The Respondent's ownership of the disputed domain name **<aprilia.in>** further shows the malafide intent on its part to earn undue advantage by capitalizing on the goodwill and reputation of the Complainant's well-known mark **APRILIA**. As the disputed domain name directs towards a parking page displaying sponsored links does not constitute a bona fide offering of goods but only Bad Faith. Under the Policy, it is evidence of bad faith registration and use that by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement or your web site or location of a product or service on your web-site or location. The overriding objective of the Policy is “to curb the abusive registration of domain names in the circumstances where the registrant

is seeking to profit from and exploit the trademark of another”
Match.com, LP v. Bill Zag and NWLAWS.ORG, WIPO Case No.
D2004-0230. [National Bedding Company L.L.C. v. Back To Bed, Inc.,
WIPO Case No. D2010-0106]

- 7.29. Clearly, the disputed domain name **<aprilia.in>** incorporates the said Complainant’s mark in it’s entirely, and carries links to Complainant & it’s competitors. Hon’ble Delhi High Court in 2017, held: “With the domain name taking up the entire name of the Petitioner, there could be no doubt that the use of such domain name by the Respondent would be deceptively confusing and erroneously indicate a connection of Respondent No. 1 with the Petitioner, when there is none.” [Thoughtworks Inc vs Super Software Pvt Ltd. & Anr on 12 January, 2017 - O.M.P. 530/2015]
- 7.30. That is, the mark ‘**APRILIA**’ is not otherwise a dictionary word but an inventive term by the Complainant, who may have been the first to coin the same. But in case it was a generic word, say APRIL, the case would have been different as there is a difference between Cybersquatting and Speculating in domain names. As speculating in generic domain name has been held to be a legitimate business under UDRP and claims were denied in the following matters for various reasons. See *Aurelon B.V. v. Abdul Basit Makrani*, [WIPO # D2017-1679; <printfactory.com>], *Vulf Records LLC v. Domain Admin* [NAF # FA1802001771089; <vulf.com>], *Fresenius Kabi S.A. v. Domain Manager* [WIPO # D2018-0491; <nutrihome.com>]. But the said matter is more of cybersquatting, where the disputed domain name directs towards a parking page displaying sponsored links and Complainant has produced more evidence as to pattern of such

conduct on behalf of the Respondent, by citing INDRP matter of soprabanking.in [INDRP/796] and Arbitrator takes note of recent matter of vespa.co.in [INDRP/1134].

7.31. Further, given the Complainant's mark / brand popularity, the use of substantially similar or identical mark, the Respondent has intentionally attempted to attract Internet users to the said website, by creating a likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation, or endorsement of the said domain name. In the INDRP matter of Lego Juris V Robert Martin, it has been held that "where a domain name is found to have been registered with an intention to attract Internet users by exploiting the fame of a well-known trademark, it constitutes bad faith registration" [INDRP/125 - lego.co.in].

7.32. Even where the domain name has not been used to identify a web site, Panels have held that the ICANN Policy 'use in bad faith' requirement is met by registering a domain name that will ultimately result in consumer confusion. In the matter of CBS Broadcasting, Inc. v. LA-Twilight-Zone, [WIPO Case no D2000-0397] - finding bad faith where Respondent failed to provide any evidence to controvert Complainant's allegation that it registered the domain name in bad faith and where any future use of the domain name would do nothing but cause confusion with the Complainant's mark, except in a few limited noncommercial or fair use situations, which were not present.

8. Decision:

- 8.1. Therefore, the Arbitrator concludes that the Complainant has established all the three essential elements to maintain its complaint being that the disputed domain name is identical or confusingly similar to its Trademark **APRILIA**; the Respondent has no rights or legitimate interests in respect of the disputed domain name; the Disputed Domain Name was registered or is being used in bad faith.
- 8.2. Consequently the Arbitrator orders that in accordance with INDRP policy that the disputed domain name **<aprilia.in>** be transferred to the Complainant.



Ankur Raheja, MCA FCS LLB
Sole Arbitrator, NIXI, India
Date: 28th September 2019
Place: Agra, U.P. India