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24 OCT 2019  
TREASURY, AGP

INDRP ARBITRATION

FE 058803

THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]

ADMINISTRATIVE PANEL DECISION

SOLE ARBITRATOR: ANKUR RAHEJA, FCS LLB MCA

Disputed Domain Name: chuckecheese.in

In the matter of:

**CEC Entertainment Concepts, L.P.**

**...Complainant**

1707 Market Place Blvd.,  
Suite 200, Irving, Texas 75063  
United States of America

**Versus**

**Samir Vasaya**

**...Respondent**

215 Collingwood Lane,  
Spartanburg, South Carolina 29301  
United States of America

A. Raheja  
10-Nov-19  
1

## **ARBITRATION AWARD**

### **Disputed Domain Name: chuckecheese.in**

#### **1. The Parties:**

1.1. The Complainant in this arbitration proceedings is: CEC Entertainment Concepts, L.P. at 1707 Market Place Blvd., Suite 200, Irving, Texas 75063, United States of America, represented by Lall & Sethi, D-17, South Extension-II, New Delhi - 110049.

1.2. The Respondent in this arbitration proceeding is Samir Vasaya, at 215 Collingwood Lane, Spartanburg, South Carolina, 29301, USA.

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

2.1. The Disputed Domain Name is <**chuckecheese.in**>, created on 15th January 2015.

2.2. Domain Registrar is Godaddy.com LLC.

#### **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 <**chuckecheese.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 09 October 2019 and Arbitrator received the hard copy of the Complaint along with Annexures the next day. The seat of Arbitral Tribunal is Agra, Uttar Pradesh, India.
- 3.3. These are mandatory arbitration proceedings in accordance with the IN Domain Name Dispute Resolution Policy ("INDRP") adopted by the National Internet Exchange of India ("NIXI"). The INDRP Rules of Procedure ("the Rules") were approved by NIXI on 28th June 2005 in accordance with the Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent gave its consent to the resolution of the domain name disputes pursuant to the IN Dispute Resolution Policy and Rules framed thereunder. Similarly, by filing of this Complaint, the Complainant gave its consent to the arbitration of the dispute.
- 3.4. Arbitral **Proceedings commenced on 12 October 2019** by issue of a notice by the Arbitrator to the Respondent, directing Respondent to file his response to the Complaint by 28th October 2019, which was successfully delivered on the WHOIS Email ID.
- 3.5. 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.
- 3.6. Relevant Dates are as follows:

<b>Sr No</b>	<b>Particulars</b>	<b>Date</b>
1	Date of Handover of Complaint by NIXI and service of soft copy of Complaint upon Respondent by Nixi	09 October 2019
2	Notice of Arbitration issued to the parties, also referred as date of commencement of Proceedings	12 October 2019
3	Second Notice to the Respondent	29 October 2019
4	Award Passed	10 November 2019

- 3.7. In accordance with INDRP read with INDRP Rules of procedure, notice of Arbitration was sent to the Respondent on 12th October 2019, with the instructions to file his reply / response by 28th October 2019.
- 3.8. That on failure of the Respondent to file any response to the first notice, another opportunity was provided to the Respondent on 29th October 2019 but he failed to comply with the same as well. Though a day after the second timeline, i.e. on 07/08th November night, Respondent sent an email, which has been admitted as response as no further communication was received.
- 3.9. 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 both hard and soft copy of the Complaint along with the Annexures. 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 is a leading family entertainment and dining company, focused on providing an exciting, fun-filled play and food experience for children and parents alike. The Complainant develops, operates and franchises family dining and entertainment centers under the names "Chuck E. Cheese's" and "Peter Piper Pizza."

4.2. Chuck E. Cheese was founded in 1977 and since its inception, the Complainant has continuously used the trade mark CHUCK E. CHEESE in connection with its goods and services. Chuck E. Cheese is a highly recognized brand that uniquely appeals to the Complainant's primary customer base of families with children between 2 and 12 years of age. Chuck E. Cheese's venues feature an open and bright setting, which creates an inviting atmosphere for kids and a good line of sight for parents. As of December 30, 2018, there were 606 Chuck E. Cheese's locations in 47 states and 13 foreign countries and territories, of which 515 are Company-operated. An overview of the Complainant's products and services, as obtained for the Complainant's website at the domain <https://www.chuckecheese.com>.



4.3. In addition to the above, since 1996, the Complainant has used the earlier well-known trade mark CHUCK E. CHEESE as part of its official domain name <https://www.chuckedcheese.com>. The aforementioned website was registered and used by the Complainant long before the Respondent's registration of the Disputed Domain Name. The Complainant's trade mark is featured throughout the website, and the Complainant specifically claims ownership of the trade mark CHUCK E. CHEESE on webpages of the aforementioned website.

4.4. The Complainant is the registered proprietor of the earlier well-known trade mark CHUCK E. CHEESE in India, particulars of which are as under:

CHUCK E. CHEESE'S - Number 2181391 - July 27, 2011

Classes 28, 41 & 43

CHUCK E. CHEESE'S - Number 2181390 - July 27, 2011

Classes: 28, 41 & 43

The aforementioned registrations are valid and subsisting on the Trade Marks Register. By virtue of the aforesaid registrations, the Complainant has the exclusive right to use the said trade marks. Additionally, by virtue of the registrations and by virtue of the provisions of Section 31 of the Trade Marks Act, 1999, the registrations are prima facie evidence of their validity.

4.5. In addition to the above, the Complaint has also attained registrations in several jurisdictions of the world, including but not limited to the United States of America, European Union (EUTM), Argentina,

Australia, Bahrain, Canada, Chile, China, Colombia, Costa Rica, Dominican Republic, Ecuador, Egypt, Guatemala, Honduras, Hong Kong, Indonesia, Japan, Jordan, Kuwait, Lebanon, Malaysia, Mexico, Oman, Panama, Peru, the Philippines, Qatar, Russian Federation, Saudi Arabia, Singapore, South Korea, Taiwan, Thailand, Trinidad & Tobago, Turkey, United Arab Emirates, Venezuela, the West Bank, and Yemen.

- 4.6. The Complainant has extensively advertised and marketed its earlier well-known trade mark. The Applicant has incurred huge advertising expenses for fiscal years 2018, 2017 and 2016. A printout of the annual reports for the years 2017 and 2018, evidencing the same are annexed. The Complainant also has extensive presence on social media platforms.
- 4.7. The Complainant's products and services under the earlier well-known trade mark has received numerous awards and recognition. The Complainant recently inducted into the Guinness World Records for setting the record for the Most people blowing party blowers simultaneously (multiple venues).
- 4.8. It is clear from the above that the Complainant alone has the exclusive rights in the earlier well-known trade mark and the Complainant alone has the exclusive right to use the earlier well-known trade mark CHUCK E. CHEESE as part of its domain name & company name and / or in any other manner whatsoever. The earlier well-known trade mark CHUCK E. CHEESE merits protection from a third party's act of cyber piracy and/or cybersquatting including that of the Respondent.

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 Disputed Domain Name is identical to Complainant's registered trademark, trade name and domain name. Based upon information and belief, the Respondent registered the Disputed Domain Name on January 15, 2015.

5.1.2. At the time the Respondent registered the Disputed Domain Name, the Complainant had not only been using its earlier well-known mark as a trademark/trade name and as part of its domain name but also had trade mark registrations in respect of the earlier well-known mark. Furthermore, at the time that the Respondent registered the Disputed Domain Name, the Complainant's earlier trademark had already acquired the status of a well-known mark.

5.1.3. The Respondent cannot claim or show any rights to the Disputed Domain Name that are superior to Complainant's rights, goodwill and reputation as established by way of documentary evidence which is being filed with the present Complaint.

5.1.4. Accordingly, the first condition that Respondent's domain name is identical or confusingly similar to a name, trademark



or service mark in which Complainant has rights, as per Paragraph 4 (i) of the Policy has been satisfied.

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

- 5.2.1. The Complaint's trademark CHUCK E. CHEESE is a highly distinctive and well-known trade mark, there can be no plausible justification for the adoption of the Disputed Domain Name. The Respondent can demonstrate no legitimate interest in the Disputed Domain Name. The Respondent registered the Disputed Domain Name after Complainant had established rights in the CHUCK E. CHEESE trademark / trade name through extensive use and registration in various countries. At the outset it should be noted that where, as here, the Complainant's trade marks are so well known and recognized, there can be no legitimate use by the Respondent.
- 5.2.2. Furthermore, there exists no relationship between the Complainant and the Respondent that would give rise to any license, permission, or authorization by which the Respondent could own or use the Disputed Domain Name, which is identical to the Complainant's trade mark. The Respondent is not commonly known by the Disputed Domain Name and is not making legitimate non-commercial or fair use of the Disputed Domain Name. The Respondent is clearly trying to associate himself with the Complainant with the mala fide intention to ride upon the immense goodwill and reputation of the Complainant's earlier well-known trade mark to gain undue

monetary benefit. Such adoption is against the Indian Domain Name Dispute Resolution Policy. Therefore, the Respondent does not have and / or cannot be permitted to own or even be considered to have any legitimate right or interest in the Disputed Domain Name as the same has been registered only to make unlawful monetary gains.

5.2.3. Such adoption and use of the domain is likely to confuse the members of trade and public services under the Disputed Domain Name are arising from the Complainant, which is not the case. Such adoption and use of the Disputed Domain Name is likely to dilute the brand equity of the earlier well-known trademark of the Complainant.

5.2.4. From all of the above it is amply clear that the Respondent has not made any legitimate or fair use of the Disputed Domain Name. The only interest of the Respondent is to earn undue monetary gains by such illegal adoption and use of the earlier well-known trade mark of the Complainant and to create an impression in the minds of members of trade and public that the Respondent is in some way affiliated or associated with the Complainant, when such is not the case. In fact, by such illegal adoption and use of the Disputed Domain Name, the Respondent is trying to create an impression to the customers of the Complainant that the services from the Dispute Domain Name originate from the Complainant. Therefore, the Respondent has no rights or legitimate interest in the Disputed Domain Name which contains the Complainant's earlier well-known trade mark in its entirety.

- 5.2.5. Given the fame of the Complainant's Mark as a trade mark, trade name and domain name, it is not possible to conceive any use by the Respondent of the Disputed Domain Name that would not constitute an infringement of the Complainant's rights in its TradeMark. See *Veuve Clicquot Ponsardin v. The Polygenix Group Co.*, WIPO Case No. D2000-0163 at Section 6. Mere registration by Respondent of the Disputed Domain Name is thus further evidence of Respondent's bad faith. See *Telstra Corporation Limited v. Nuclear Marshmallows*, Case No. WIPO D2000-0003.
- 5.2.6. Accordingly, the second condition that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, as per Paragraph 4 (ii) of the Policy has been satisfied.

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

- 5.3.1. The bad faith of the Respondent in registering the Disputed Domain Name can be simply established from the fact that the Respondent has registered the Disputed Domain Name by adopting the Complaint's earlier well-known trademark CHUCK E. CHEESE.
- 5.3.2. The Respondent has created a website with the intention of misleading the members of trade and public that the website under the Disputed Domain Name belongs to or created by the Complainant. Furthermore, the Complainant, through a

Demand Letter dated March 08, 2019, requested the Respondent to inter alia cease and desist from using the Disputed Domain Name and refrain from using the Complainant's earlier well-known trade mark and any mark or name confusingly similar to the Complainant's earlier well-known trade mark. In response to the Complainant's aforementioned Demand Letter, the Respondent informed the Complainant that "have no intention to use this domain name." Furthermore, the Respondent also informed the Complainant that he will think of selling the domain name to the Complainant if the Complainant makes "some big offer." This clearly evidences the fact that the Respondent registered the disputed domain name in "bad faith" with the intention of inter alia selling or otherwise transferring the domain name registration to the Complainant, who is the owner of the trademark, for valuable consideration in excess of the costs directly related to the domain name.

- 5.3.3. Registration of a well-known trademark by a party with no connection to the owner of the trademark and no authorization and no legitimate purpose to utilize the mark reveals bad faith, Caravan Club v Mrgsale NAF Decision FA 95314.
- 5.3.4. In Bennett Coleman & Co Ltd v. Steven S. Lalwani (Case No. D 2000-0014) and Bennett Coleman & Co Ltd v. Long Distance Telephone Company (Case No. D 2000-0015) decided by WIPO, the Complainant, publisher of the daily newspaper "The Economic Times" and "The Times of India" held domain names,

<economictimes.com> and <timesofmdia.com> for publication of their respective newspapers. The two respondents had registered the sites <theeconomictimes.com> and <thetimesofindia.com> and the Complainant contended that this was use of identical marks in which it had prior rights.

- 5.3.5. Moreover, the site <thetimesofindia.com> redirected traffic to the site <indiaheadlines.com> while the site <theeconomictimes.com> redirected traffic to <ifindyourperfectmate.com> without having any legitimate interests in respect of the domain names. Hence, the Complainant alleged that the respective respondent's registration and use of the domain names was in "bad faith" in the sense that their use amounted to an attempt to intentionally attract, for commercial gain, internet users to their websites by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation or endorsement of those websites and the services offered therein. The Administrative Panel held that it is not a sufficient answer to suggest that the defendant will dispel any misleading first impression by use of a different design of the web site. The Panel further held that the necessary implication is that the domains were specifically selected in order to take advantage of the Complainant's considerable reputation in the two titles of its publications by misleading internet users into believing that the respondent's sites came from or were associated with the Complainant. The Panel ordered that the two domain names be transferred to the Complainant.

- 5.3.6. In *Playboy Enterprises International, Inc. v. Hector Rodriguez*, WIPO Case No. D2000-1016 (playboychannel.com and playboynetwork.com), it was said that "People, who manifest an intent to traffic in domain names that incorporate well-known or famous trademarks, as the Respondent does here, simply do not expend their efforts with the sole intention of relinquishing those domain names for just their out-of-pocket registration costs. The goal of their efforts, simply put, is an expectation of receiving an adequate reward, i.e. sufficient profit, from this trafficking." transfer awarded). Consequently, the Complainant submits that bad faith use of the Disputed Domain Name is quite clear in this case, given the intent to sell the Disputed Domain Name.
- 5.3.7. It is also submitted that the Respondent has registered the domain name in order to prevent the Complainant, who is the owner of the earlier well-known mark, from reflecting the mark in a corresponding domain name.
- 5.3.8. Such activities show the bad faith and mala fide intention on the part of the Respondent to cause prejudice not only to the Complainant but the public at large and therefore, the Disputed Domain Name merits cancellation on this ground alone.
- 5.3.9. In the case of *SATYAM INFOWAY LTD. vs. SIFYNET SOLUTIONS PVT. LTD.*[2004 Supp (2) SCR 465], wherein the Appellant was the registrant of the domain names www.sifynet.com, www.sifymall.com, www.sifyrealestate.com. etc. since the year



1999. The Respondents subsequently adopted the domain names www.siffynet.net and www.sifynet.com in the year 2001. The Supreme Court of India while allowing the Appeal, held the following:

*"11. Analysing and cumulatively paraphrasing the relevant parts of the aforesaid definitions, the question which is apposite is whether a domain name can be said to be a word or name which is capable of distinguishing the subject of trade or service made available to potential users of the internet? "*

*"12. The original role of a domain name was no doubt to provide an address for computers on the internet. But the internet has developed from a mere means of communication to a mode of carrying on commercial activity. With the increase of commercial activity on the internet, a domain name is also used as a business identifier. Therefore, the domain name not only serves as an address for internet communication but also identifies the specific internet site. In the commercial field, each domain name owner provides information/services which are associated with such domain name. Thus a domain name may pertain to provision of services within the meaning of Section 2(z). A domain name is easy to remember and use, and is chosen as an instrument of commercial enterprise not only because it facilitates the ability of consumers to navigate the Internet to find websites they are looking for, but also at the same time, serves to identify and distinguish the business itself, or its goods or services, and to specify its corresponding online Internet location. Consequently a domain name as an*

*address must, of necessity, be peculiar and unique and where a domain name is used in connection with a business, the value of maintaining an exclusive identity becomes critical. "As more and more commercial enterprises trade or advertise their presence on the web, domain names have become more and more valuable and the potential for dispute is high. Whereas a large number of trademarks containing the same name can comfortably co-exist because they are associated with different products, belong to business in different jurisdictions etc, the distinctive nature of the domain name providing global exclusivity is much sought after. The fact that many consumers searching for a particular site are likely, in the first place, to try and guess its domain name has further enhanced this value". The answer to the question posed in the preceding paragraph is therefore an affirmative. "*

*"16. The use of the same or similar domain name may lead to a diversion of users which could result from such users mistakenly accessing one domain name instead of another. This may occur in e-commerce with its rapid progress and instant (and theoretically limitless) accessibility to users and potential customers and particularly so in areas of specific overlap. Ordinary consumers/users seeking to locate the functions available under one domain name may be confused if they accidentally arrived at a different but similar web site which offers no such services. Such users could well conclude that the first domain name owner had mis-represented its goods or services through its promotional activities and the first domain owner would thereby lose their custom. It is*

*apparent therefore that a domain name may have all the characteristics of a trademark and could found an action for passing off. "*

*"18. However, there is a distinction between a trademark and a domain name which is not relevant to the nature of the right of an owner in connection with the domain name, but is material to the scope of the protection available to the right. The distinction lies in the manner in which the two operate. A trademark is protected by the laws of a country where such trademark may be registered. Consequently, a trade mark may have multiple registrations in many countries throughout the world. On the other hand, since the internet allows for access without any geographical limitation, a domain name is potentially accessible irrespective of the geographical location of the consumers. The outcome of this potential for universal connectivity is not only that a domain name would require world wide exclusivity but also that national laws might be inadequate to effectively protect a domain name. The lacuna necessitated international regulation of the domain name system (DNS). This international regulation was effected through WIPO and ICANN. India is one of the 171 states of the world which are members of WIPO. WIPO was established as a vehicle for promoting the protection, dissemination and use of intellectual property throughout the world. Services provided by WIPO to its member states include the provision of a forum for the development and implementation of intellectual property policies internationally through treaties and other policy instruments. "*

5.3.10. The activities of Respondent rise to the level of a bad faith usurpation of the recognition and fame of Complainant's Mark to improperly benefit the Respondent financially, in violation of applicable trademark and unfair competition laws. Moreover, these activities demonstrate bad faith registration and use of the Disputed Domain Name in violation of the Policy under paragraph 6 which promulgates that bad faith can be found where there is evidence of:

- a. circumstances indicating that [Respondent has] registered or [Respondent has] acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of [Respondent's] documented out-of-pocket costs directly related to the domain name; or
- b. [Respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [Respondent] has engaged in a pattern of such conduct; or
- c. by using the domain name, the [Respondent has] intentionally attempted to attract Internet users to the [Respondent 's] website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source,

sponsorship, affiliation, or endorsement of the [Respondent's] website or location or of a product or service on the Registrant's website or location.

## 6. Respondent's Contentions

- 6.1. Respondent did not file any formal Response within the timeline.
- 6.2. Though on 07th November as per US time, he emailed citing health issues, willing to accept an offer for sale and lastly issued a legal threat to the Arbitrator as follows:

*Hello Sir*

*REF: SAMIR VASAYA*

*domain : chuckecheese.in*

*I have NOT diverted , NOT infringed, or used this domain name for any commercial use till date*

*have NOT made a single penny yet from this domain name as of today*

*This domain name is DEAD for me right now , I have reserved this name*

*And made zero dollars yet*

*I have NO intention yet to use this domain name , but my brother in India is in food business who deals in CHEESE*

*So I have some plans after 2-3 years or maybe NOT - I don't know at this stage*

*I have Not even thought of selling this domain at all and don't want to sell But if you have something in your mind I will think on it.*

*Secondly please do NOT  
EMAIL - (ALREADY DONE)  
THREAT (ALREADY DONE)  
SEND MAIL OR COURIER - (ALREADY DONE)  
HARRAS (ALREADY DONE)*

*I am going through tons of pain and I have to go through my Kidney (Medical) issues with all daily routines also if I have to fight doing NO Wrong, I will do it and hire an ATTORNEY in INDIA and file a case against you guys for simply making my life HELL.*

*Thanks  
Samir Vasaya*

The said email was sent to the Arbitrator, ICANN and the Complainant only. But within a few hours, said email was circulated by the Arbitrator to all concerned and taken on record.

## **7. Discussions and Findings**

- 7.1. The Arbitrator has reviewed all the submissions and 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 founded in 1977 develops, operates and franchises family dining and entertainment centers under the names "Chuck E. Cheese's" and "Peter Piper Pizza." The Complainant is using the Trademark **Chuck E. Cheese** since its inception. The Complainant has main website at **www.CHUCKECHEESE.com** since 1996.
- 7.3. The Complainant is the registered owner of the trademark CHUCK E. CHEESE'S in India (*since 2011*), CHUCK E. CHEESE in the USA (*since 1979, showing use since 1977*) and similar trademarks in more than 35 other jurisdictions. 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. 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 28, 41 and 43, in 2011 in India, while it already possesses Trademark in USA since last four decades. Complainant submits that at the time that the Respondent registered the Disputed Domain Name, the Complainant's earlier trademark had already acquired the status of a well-known mark. Further, the popularity of Complainant services is also evident from social media pages and the number of followers. In case of famous brands, it has been long held that Internet users seeking to locate the products/services available under a specific brand 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 **www.chuckecheese.com**.

- 7.5. The Respondent has registered the Disputed Domain Name **<chuckecheese.in>** on 15 January 2015, it entirely comprised of Complainant's mark **Chuck E Cheese** (*registered in US*) and **Chuck E. Cheese's** (*registered in India*). The Complainant has an official website at **www.chuckecheese.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 **CHUCKECHEESE** such as CHUCKECHEESE.ca, CHUCKECHEESE.us and so on.
- 7.6. The products / services provided by the Complainant under the **CHUCKECHEESE** mark since the last many decades enjoy worldwide reputation and goodwill. The disputed domain name registered by the Respondent **<chuckecheese.in>** is identical / confusingly similar to the well-known trademark **CHUCKECHEESE** which has been owned and used by Complainant continuously and openly since last many decades. 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 **<chuckecheese.in>** wholly incorporates Complainant's mark.
- 7.7. With such extensive, continuous, open and uninterrupted use of the **CHUCKECHEESE** trademark and trade name by the Complainants, throughout the world the **CHUCKECHEESE** 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 <**chuckecheese.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 <**chuckecheese.in**> is confusingly similar to the registered trademark of the Complainant - **CHUCKECHEESE**, which incorporates the same almost in its entirety.

- 7.8. The Complainants have brought conclusive evidence that it owns trademark rights in the name **CHUCKECHEESE** 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 **CHUCKECHEESE**. 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".
- 7.9. 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.

- 7.10. The Complainant contends that the Complaint's trademark **CHUCK E. CHEESE** is a highly distinctive and well-known trade mark, there can be no plausible justification for the adoption of the Disputed Domain Name. Furthermore, there exists no relationship between the Complainant and the Respondent that would give rise to any license, permission, or authorization by which the Respondent could own or use the Disputed Domain Name, which is identical to the Complainant's trade mark. The Respondent is not commonly known by the Disputed Domain Name and is not making legitimate non-commercial or fair use of the Disputed Domain Name. The Respondent is clearly trying to associate himself with the Complainant with the mala fide intention to ride upon the immense goodwill and reputation of the Complainant's earlier well-known trade mark to gain undue monetary benefit.
- 7.11. Rightly, 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 cannot be made, without violating the complainant's rights. 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."

7.12. The Respondent is not making a legitimate use of the domain name, but has a domain registrar's parking page and has an intention for commercial gain from its future use in brother's food business that can only misleadingly divert consumers and tarnish the trademark or service mark at issue. Any such use of the disputed domain name <**chuckecheese.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 and in no case prove any legitimate rights or interests in favor of the Respondent. 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."

7.13. 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].

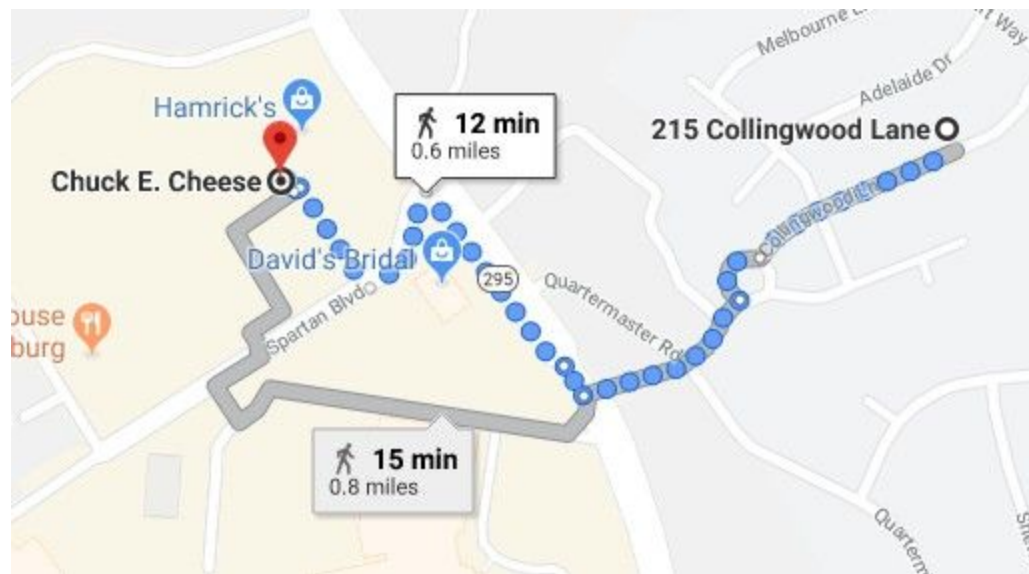
- 7.14. Under the second clause, a complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights 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.
- 7.15. The disputed domain **<chuckecheese.in>** does not have a proper website on the date of filing of the complaint but only a parking page. 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 **CHUCKECHEESE**, in order to



capitalize / profit from the goodwill associated with the famous mark, as is further evident from the following paras.

- 7.16. 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.
- 7.17. 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. Therefore, given the distinctiveness of the Complainant's mark, any such registration could have been done only with the knowledge of registered Trademark, given the of the said mark. Further, the Respondent's claim of his intention to use the disputed domain name for his brother's food/cheese business cannot be accepted. As any use of the said domain name can only be at the cost of violation of Complainant's Trademark rights.
- 7.18. The disputed domain name <**chuckecheese.in**> registration date is 15 January 2015. The Trademark Application date in India is 2011, while the registration date in India is 1 October 2016. That is, at the time when the Domain Name was registered Indian Trademark Applications were pending. But it is irrelevant, as the Respondent WHOIS address is that of the USA, where the Trademark has been registered since 1979.

- 7.19. The jurisdiction matters in case of Domain Name Dispute, it is necessary for the Complainant to prove the knowledge of the Trademark on the part of the Respondent. In the said matter the WHOIS address is of Spartanburg, South Carolina, USA, whereas the Complainant has its one of the stores at the following address: Chuck E. Cheese 660 Spartan Blvd., Ste. 250 Spartanburg, SC 29301 as depicted with red marker in the following Google Map:



- 7.20. The said Google Map clearly proves that one of the stores of the Complainant is at walking distance from Respondent's WHOIS address. Otherwise also Chuck E. Cheese has been in operation in the USA since 1977 and the knowledge as to the same on the part of the Respondent cannot be ignored. That is, it can be easily concluded that the Domain Name has been registered in bad faith.
- 7.21. The complainant contends that the Complainants use of mark goes back to the late 1979 and has acquired immense goodwill and popularity over the last many decades. As of December 30, 2018,

there were 606 Chuck E. Cheese's locations in 47 states and 13 foreign countries and territories, of which 515 are Company-operated. 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."

- 7.22. The Bad Faith use on the part of the Respondent is further proved by the fact that in response to the Cease and Desist Notice issued on behalf of the Complainant on March 08 2019, the Respondent communicated that he will think of selling the domain name to the Complainant if the Complainant makes "some big offer." This clearly evidences the fact that the Respondent registered the disputed domain name in "bad faith" with the intention of inter alia selling or otherwise transferring the domain name registration to the Complainant, who is the owner of the trademark, for valuable consideration in excess of the costs directly related to the domain name.
- 7.23. The similar communication has been made by the Respondent during these Arbitration proceedings as well. Therefore, Bad Faith use is evident as well in the circumstances of the case. Otherwise also, the Respondent's future plans for the disputed domain name **<chuckecheese.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 **CHUCKECHEESE**.
- 7.24. 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]. 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].

- 7.25. 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 **CHUCKECHEESE**; 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 **<chuckecheese.in>** be transferred to the Complainant.
- 8.3. Though such cases where disrespect is shown towards INDRP proceedings and threat is issued to the Arbitrator, costs need to be imposed, as previously held in the matter of **Gie Milipol V. Dana (INDRP/511)** but given the fact that this is the first INDRP Proceedings against the Respondent and also considering the health conditions of the Respondent, no costs are being imposed.



A handwritten signature of Ankur Raheja is written over a circular stamp. The stamp contains the text "ANKUR RAHEJA, MCA, FCS, LLB" around the perimeter, "Arbitrator" in the center, and "NIXI" below it.

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**Ankur Raheja, MCA FCS LLB**  
**Sole Arbitrator, NIXI, India**  
**Date: 10th November 2019**  
**Place: Agra, U.P. India**