



தமிழ்நாடு தமில்நாடு TAMILNADU

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11/1/12

S. Sridharan
Chennai.

Rs 100/-

AD 149478
R. RAGUPATHI

STAMP VENDOR, L/No. C3/4839/83
No. 37, VILLAGE ROAD, NOW KNOWN AS
No. 79/91, VALLUVARKOTTAM HIGH ROAD
NUNGAMBAKKAM, CHENNAI-600 034
PHONE: 28274419

BEFORE THE INTERNET EXCHANGE OF INDIA
ARBITRATION AWARD

ARBITRATOR: S. SRIDHARAN

Dated: 14th January 2012

Henry Schein Inc
V

Zhaojian Trading Co

Sanjana Superior Food (Holdings) Ltd

--- Complainant

--- Respondent

Sidhanand
Arbitrator

BEFORE THE INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

ARBITRATOR: S.SRIDHARAN

DATED: 14th January 2012

Henry Schein, Inc

...

Complainant

Versus

Zhaojian

Trading as

San'an Superior Food (Holdings) Limited

...

Respondent

1. The Parties

1.1 The complainant is Henry Schein Inc, an entity organized and existing under the laws of USA and having its principle place of business at 135 Duryea Road, Melville, NY 11747 represented by Mr Raghav Malik of Lall and Sethi Advocates, at D-17, South Extension – II, New Delhi – 110 049.

1.2 Respondent is Mr. Zhaojian trading as San'an Superior Food (Holdings) Limited, at A511, SEG Technology Park3, San'an North Road, Hong Kong.

The Domain Name and Registrar

1.3 The disputed domain name henryschein.co.in is registered with PublicDomainRegistry.com (R5-AFIN).

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2. Procedural History

- 2.1 On 21st September 2011, NIXI asked me about my availability and consent to take up the Complaint for arbitration. On 21st September 2011, I informed my availability and consent. I also informed NIXI that I had no conflict of interest with either of the parties and could act independently and impartially.
- 2.2 On 3rd October 2011, I received hardcopy of the Complaint along with Annexures.
- 2.3 On 6th October 2011, I issued by email a Notice to the Respondent setting forth the relief claimed in the Complaint and directing him to file his reply to the Complaint within 15 days. I also sent an email about my appointment to arbitrate the complaint to the Complainant and asked the Complainant to send a soft copy of the complaint to me.
- 2.4 On 6th October 2011, Respondent informed me by mail that the disputed domain henryschein.co.in was for sale, and it could be sold to the Complainant at a low price.
- 2.5 On 14th September 2011, I received a soft copy of the complaint from the Complainant.
- 2.6 On 12th October 2011, the Complainant sought a personal hearing. The hearing was held on 12th January 2012 at the premises of NIXI. Complainant's counsel attended the hearing. Respondent did not attend the hearing.

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2.7 Email is the medium of communication of this arbitration and each email is copied to all, Complainant, Respondent and NIXI.

3. Factual Background

A Complainant

3.1 The Complainant is the owner of the trade mark and service mark HENRY SCHEIN, and other trademarks and service marks containing HENRY SCHEIN as a prominent part. The Complainant is also incorporated and trading under the name HENRY SCHEIN. The Complainant has the exclusive rights to use the aforesaid trade marks *inter alia* in respect of the goods/ services for which the said trade marks are registered.

3.2 The Complainant is the registered proprietor of the Henry Schien trade marks in the US under registration Nos. 1612595 since September 11, 1990 & 2075549 since 1st July 1997. Copies of registration certificates are attached at **Annexure D**. These registrations are valid, and subsisting. The Complainant's trademarks, trade name and domain name were used and applied for registration long before the Respondents' registration of the disputed domain name <henryschein.co.in>.

3.3 Complainant has its trade mark registered in 53 countries around the world including Australia, Singapore and in the European Community (OHIM, which covers 27 jurisdictions). Copies of registrations certificates in these countries are attached at **Annexure E**.

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- 3.4 In India, the mark Henry Schein has been registered under registration No. 1518687 since January 08, 2007 in classes 5, 10 and 35. A copy of registration certificate is attached at **Annexure F**.
- 3.5 The Complainant's use of their well-known and prior trade mark/trade name has been extensive, exclusive and continuous all across the world. Given the nature of the Complainant's use of its trade mark, anyone with access to a computer and the internet, has access to the Complainant's web site wherein the Complainant's trademarks are featured throughout the web site.
- 3.6 As a result of the Complainant's marketing and promotion of its goods and/or services under its trade mark/trade name HENRY SCHIEN, the trade mark HENRY SCHIEN has gained worldwide recognition and goodwill and has become very well-known. Moreover, the Complainant's trade mark/trade name has firmly been associated with the Complainant prior to the Respondent's registration of the disputed domain name <henryschein.co.in>.
- 3.7 The Complainant maintains websites at the domain <http://www.henryschein.com> (a copy of the home page of that website is attached at **Annexure G**) and the said website has been in use and was registered long before the Respondents' registration of the disputed domain name <henryschein.co.in>. The Complainant's trademarks are featured throughout the website, and the Complainant clearly claims ownership of

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the trademark thereon, at its "Terms & Conditions" page attached as **Annexure H**.

3.8 The trade mark HENRY SCHEIN has been extensively advertised and promoted on the internet *inter alia* through the Complainants website <http://www.henryschein.com> and besides various others regional websites for other countries of the world. The said websites contain extensive information about the Complainant and the products marketed and sold under the trade mark HENRY SCHEIN. This information is accessible by any person from anywhere in the world. Prints out from these web sites are attached at **Annexure I**. Needless to add, the said websites can be accessed and are accessible from India also.

3.9 It is evident that the Complainant has strong and prior rights in its trade mark, trade name and domain name, and is entitled to get protection from third party's act of cyber piracy/cyber squatting, including from that of the Respondents.

3.10 During the hearing the complainant demonstrated that his web site www.henryschein.com is accessible from India and one may place orders for the complainant's products through net.

3.11 Respondent registered the disputed domain name on April 25, 2011.

B Respondent

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3.12 The Respondent in his reply informed that he was ready to sell the disputed domain name <henryschein.co.in> at a lower price to the complainant. He did not submit anything further.

4. Parties Contentions

A Complainant

4.1 The disputed domain name <henryschein.co.in> is identical to the Complainant's trademarks, trade name and domain name. The dominant and distinctive feature of the disputed domain name is the incorporation of the Complainant's trademarks and trade name.

4.2 At the time Respondent registered the disputed domain name <henryschein.co.in> the Complainant had already been using HENRY SCHEIN as their registered trademark, part of the trade name and also as a part of their domain name and had firmly established rights in their above-mentioned trademark. Furthermore, at the time Respondent registered the disputed domain name <henryschein.co.in> the Complainant's HENRY SCHEIN marks had become a well-known trademark. The Respondent cannot claim or show any rights to the disputed domain name <henryschein.co.in> that are superior to Complainant's rights in its HENRY SCHEIN marks. Neither can Respondent demonstrate that he was unaware of Complainant's mark at the time the disputed domain name <henryschein.co.in> was registered. Since the Complainant's mark is well-known and the Respondent has no rights in this mark, the only reason Respondent could have wanted to register a domain name that so

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prominently features the Complainant's HENRY SCHEIN mark was with the intention to trade upon the fame of the Complainant's mark by selling the disputed domain name <henryschein.co.in> for substantial commercial gain, in violation of Section 4(b) of the Policy. The Complainant has adduced sufficient proof by way of cogent documentary evidence to substantiate its prior rights.

4.3 In one of the earliest cases, **Yahoo! Inc. v. Akash Arora & Anr.** (1999 PTC (19)210 Delhi), a single judge of Delhi High Court granted relief on the Yahoo! Inc. petition seeking injunctive relief against the defendants who were attempting to use the domain name 'yahooindia.com' for internet related services. Yahoo! Inc., which was the owner of the trade mark "Yahoo" as well as the domain name <yahoo.com>, contended that by adopting the deceptively similar domain name, the defendants had copied the source code of the plaintiff's prior created website. Moreover, the defendant's domain name could be perceived as being another one of the Plaintiff's.

4.4 In light of the foregoing, Internet users are likely to believe that the disputed domain name <henryschein.co.in> is related to, associated with, or authorized by the Complainant. Considering the Complainant already uses the site www.henryschein.com, print outs of which are attached as **Annexure J**, the internet users would be confused into thinking that the Respondent enjoys authorization of the Complainant to do business in India or is in fact their Indian website considering that the country code top-level domain

name in the disputed domain name is “.CO.IN”. It is precisely because of this association with Complainant's Mark that Respondent saw the value in the disputed domain name <henryschein.co.in> and registered it. As such, Complainant respectfully submits that it has satisfied the first ground of the Policy, that the Disputed Domain Name is identical or confusingly similar to Complainant's Mark.

4.5 The Respondent registered the disputed domain name <henryschein.co.in> after Complainant had established rights in the HENRY SCHEIN trademarks / trade name through extensive use and registration. At the outset it should be noted that where, as here, Complainant's trademarks are so well known and recognized, there can be no legitimate use by Respondent. In Guerlain S.A. v. PeiKang, WIPO Case No. D2000-0055; see also Veuve Clicquot Ponsardin v. The Polygenix Group Co., WIPO Case No. D2000-0163 it was held that bad faith is found where a domain name “is so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith”. In Charles Jourdan Holding AG v. AAIM, WIPO Case No. D2000-0403 it was held that “...given the relative notoriety of the Complainant's mark as well as the ease for any user of the Internet to assess on its own whether or not the registration and use of a domain name is likely to encroach on another's rights, the Panel is of the opinion that Respondent acquired the disputed domain name <henryschein.co.in> primarily for the purpose of selling, renting, or otherwise transferring the

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disputed domain name <henryschein.co.in> registration to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of his out-of-pocket costs directly related to the disputed domain name <henryschein.co.in>, an act which constitutes bad faith pursuant to paragraph 6 (i) of the Policy”.

4.6 Furthermore, there exists no relationship between Complainant and Respondent that would give rise to any license, permission, or authorization by which Respondent could own or use the disputed domain name <henryschein.co.in> which is identical or confusingly similar to Complainant's Mark. The Respondent is not commonly known by the disputed domain name <henryschein.co.in> and is not making legitimate non-commercial or fair use of the disputed domain name <henryschein.co.in>. Indeed, the web site at the disputed domain name <henryschein.co.in> prominently proclaims at the very top of the page the Complainant's trademark/ trade name HENRY SCHEIN.

4.7 It is therefore clear that Respondent's only purpose in registering the disputed domain name <henryschein.co.in> was to offer to sell the disputed domain name <henryschein.co.in> for commercial gain. See The Caravan Club v. Mrgsale, NAF Claim Number: FA0007000095314 (thecaravanclub.com; 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); CBS Broadcasting Inc. v. Worldwide Webs, Inc., WIPO Case No. D2000-0834

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(ILOVELUCY.COM; Respondent sought to profit from the mere registration of the Complainant's trademark and service mark as a domain name, which constituted bad faith within the meaning of paragraph 6(i) of the policy; domain name transferred).

4.8 It is apparent that both at the time of registration and continuing to the present, the Respondent has sought to profit from an unauthorized association with the Complainant's mark. It is clear upon viewing the content of the web site at the disputed domain name <henryschein.co.in> that the Respondent registered the disputed domain name <henryschein.co.in> for purposes of selling it; this offer for sale is indisputable evidence that Respondent registered and is using the disputed domain name <henryschein.co.in> in bad faith.

4.9 Moreover, before filing the present complaint, a notice was sent to the Respondent asking him to stop such use as the Complainant has prior rights on Henry Schein and transfer the disputed domain name <henryschein.co.in> to the Complainant. However, the Respondent responded by asking for money for the same to be transferred to the complainant, who legally has prior rights over the trademark HENRY SCHEIN. This, coupled with the above-mentioned submissions, proves the bad faith on the part of the Respondent to procure undue monetary benefits. Please find the above-mentioned correspondence attached at Annexure K

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4.10 In *Playboy Enterprises International, Inc. v. Hector Rodriguez*, WIPO Case No. D2000-1016 (playboychannel.com and playboynetwork.com, "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 <henryschein.co.in> is quite clear in this case, given the content on the Respondent's web site and his intent to sell disputed domain name <henryschein.co.in> to the highest bidder.

4.11 Given the fame of the Complainant's Mark as a trademark, trade name and domain name, it is not possible to conceive of a use by Respondent of the disputed domain name <henryschein.co.in> that would not constitute an infringement of Complainant's rights in its Trade Mark. 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.

4.12 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 Respondent financially, in violation of applicable trademark and unfair

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competition laws. Moreover, these activities demonstrate bad faith registration and use of the disputed domain name <henryschein.co.in> 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 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.

4.13 The facts provided above make it clear that Respondent was and is taking advantage of the goodwill and fame of Complainant's well-known trademark/ trade name for its own substantial commercial profit and gain.

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4.14 Respondent registered and has used the disputed domain name <henryschein.co.in> in bad faith as defined under paragraph 6(iii) of the Policy. When internet users log onto the disputed domain name <henryschein.co.in> clicking anywhere on the site leads them to a totally different page which does not reflect and nowhere closely relates to the Complainant's marks or the site. This clearly evidences the fact that Respondent is using the disputed domain name <henryschein.co.in> in "bad faith" with the intention of diverting traffic by attracting internet users for commercial gain to its website by creating a likelihood of confusion with the Complainant's well-known mark as to the source, sponsorship, affiliation or endorsement of its websites and the services on them.

4.15 In addition to the above the Complainant's corporate name and trademark is being advertised on the Respondent's website. Moreover, everything the Complainant deals in or is related to has been mentioned on the homepage of the Respondent's website, which clearly shows that the Respondent is trying to ride on the goodwill of the Complainant and pass off the disputed domain name <henryschein.co.in> as that of the Complainant and take undue gains from the same, screen shoots of the same have been attached at Annexure L. Also, on searching about the medical devices of the Complainant on the disputed domain name, the website shows different links which are not related to the Complainant, the screen shot showing the same has been attached at Annexure M. Such blatant misuse of the Complainant's trademark/trade name will not only dilute the Complainant's

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trademark/trade name but will destroy the immense reputation and goodwill earned by the Complainant over the years.

4.16 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 <timesofindia.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. 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 respondents' registrations 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 thereon. The Administrative Panel held that it is not a sufficient answer to suggest that 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

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is that the domains were specifically selected in order to take advantage of the Complainant's very 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. Copies of all the above mentioned cases are marked as Annexure N.

4.17 Based upon all of the forgoing considerations, it is evident that Complainant has met the requirements of the Policy, by demonstrating not only its own legitimate interest in its trade mark being part of the trade name and domain name as evidenced by its use of such marks and the fame associated therewith, but also that Respondent's sole interest in the disputed domain name <henryschein.co.in> is to unlawfully profit from it. Accordingly, the Complainant believes that it is entitled to the remedy requested below.

B Respondent

4.18 Respondent has not filed any response on merits. He indicated his intention to sell the disputed domain name <henryschein.co.in> to the Complainant.

5. Discussion and Findings

5.1 The Complainant in order to succeed in the Complaint must establish under Paragraph 4 of .IN Domain Name Dispute Resolution Policy (INDRP) the following elements:

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

5.2 Each of the aforesaid three elements must be proved by a Complainant to warrant relief.

Disputed domain name is identical or confusingly similar to a trade mark of the Complainant.

5.3 The Complainant is the proprietor of the mark HENRY SCHIEN. Complainant has been using the HENRY SCHIEN mark in commerce continuously since 1932 in the US. The Complainant has registrations for the mark HENRY SCHIEN all over the world including India. The Complainant first registration in the US was in the year 1990. Complainant's first registration in India dates back to 2007. In 2002, the Complainant registered the domain www.henryschein.com. The disputed domain name **<henryschein.co.in>** was registered on 25th April 2011. Obviously, the Complainant is the prior adopter and registrant of the mark HENRY SCHIEN. The above facts have established that the Complainant has both common law and statutory rights in respect of its trade mark HENRY SCHIEN.

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5.4 The Complainant's HENRY SCHIEN marks are famous and well known throughout the world including India. It is clearly seen that the disputed domain name <henryschein.co.in> wholly incorporates HENRY SCHIEN, the prior registered trade mark of the Complainant. The disputed domain name <henryschein.co.in> is similar to the Complainant's domain name www.henryschein.com. HENRY SCHIEN is the distinguishing feature in the disputed domain name <henryschein.co.in> of the Respondent and www.henryschein.com of the Complainant.

5.5 I, therefore, find that:

- (a) The Complaint has both common law and statutory rights in respect of its trade mark HENRY SCHIEN.
- (b) The disputed domain name <henryschein.co.in> is:
 - (i) Identical to the Complainant's prior registered trade mark HENRY SCHIEN, and
 - (ii) Similar to the Complainant's domain name www.henryschein.com

Respondent has no rights or legitimate interests in respect of the disputed domain name

5.6 It is already seen that:

- (a) The Complainant is the prior adopter and user of the mark HENRY SCHIEN. The Complainant's mark HENRY SCHIEN is well known in many countries across the globe including India.

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(b) The Complainant's trade mark was adopted in the US in 1932. It was first registered in India in 2007. The disputed domain name <henryschein.co.in> was registered by the Respondent only on 25th April 2011.

5.7 Respondent did not register the disputed domain name <henryschein.co.in> until 2011. As such, chances are remote that Respondent was unaware of the famous HENRY SCHIEN mark and Complainant's rights thereto prior to registering the disputed domain name in <henryschein.co.in> 2011.

5.8 The Respondent has not come forward with any reason for the adoption of the disputed domain name <henryschein.co.in>. Respondent responded two times, one to the Complainant directly before filing the Complaint and another to the arbitrator in response to the Complaint. In both the occasions his response was identical. He was ready to sell the disputed domain name <henryschein.co.in> to the Complainant. Therefore, it is evident from the reply of Respondent, that his only purpose in registering the disputed domain name <henryschein.co.in> was to offer to sell the disputed domain name <henryschein.co.in> for commercial gain.

5.9 In the absence of any reply on merits from the Respondent, I further agree with the contentions of the Complainant that there is no relationship between Complainant and Respondent. The complainant has not granted any license, permission, or authorization to the Respondent to use the disputed domain name. The Respondent is not commonly known by the

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disputed domain name <henryschein.co.in> and is not making legitimate non-commercial or fair use of the disputed domain name <henryschein.co.in>.

5.10 Therefore, I have no hesitation to hold, for the above reasons that the Respondent has no right or legitimate interest in respect of the disputed domain name <henryschein.co.in>.

Respondent's domain name has been registered or is being used in bad faith.

5.11 The Complainant is the proprietor of the mark HENRY SCHIEN. The Complainant is the proprietor of the mark HENRY SCHIEN. Complainant has been using the HENRY SCHIEN mark in commerce continuously since 1932 in the US. The Complainant has registrations for the mark HENRY SCHIEN all over the world including India. In 2002, the Complainant registered the domain www.henryschein.com. The disputed domain name <henryschein.co.in> was registered on 25th April 2011. Obviously, Complainant's rights in the HENRY SCHIEN trademark pre-dates Respondent's registration of the disputed domain name <henryschein.co.in>. The Respondent could not have ignored, rather actually influenced by, the well-known trade mark HENRY SCHIEN of the Complainant at the time he acquired the disputed domain name <henryschein.co.in>.

5.12 As seen above, Respondent registered the disputed domain name <henryschein.co.in> solely with an intention to gain money from the

complainant for transferring the disputed domain name <henryschein.co.in> to the complainant. Respondent never intended to use the disputed domain name <henryschein.co.in> to carry on his legitimate business. His only business is buying and selling domain names similar to the trademarks of reputed companies.

- 5.13 When internet users log onto the disputed domain name <henryschein.co.in> clicking anywhere on the site leads them to a totally different page which does not reflect and nowhere closely relates to the Complainant's marks or the site. This clearly evidences the fact that Respondent is using the disputed domain name <henryschein.co.in> in "bad faith" with the intention of diverting traffic by attracting internet users for commercial gain to its website by creating a likelihood of confusion with the Complainant's well-known mark as to the source, sponsorship, affiliation or endorsement of its websites and the services on them.
- 5.14 It is clearly established that Respondent registered the disputed domain name <henryschein.co.in> in bad faith.
- 5.15 The actions of the Respondent should not be encouraged and should not be allowed to continue. Respondent never intended to put the disputed domain name <henryschein.co.in> into any fair/useful purpose. The conduct of the Respondent has necessitated me to award costs of the Complaint to and in favour of the Complainant.

A handwritten signature in cursive script, appearing to read "Shankarans", is located in the bottom right corner of the page.