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24 AUG 2012

D. SARAVANAN
Advocate, Arbitrator & Mediator
"Orient Chambers" No.90 (Old No.73),
4th & 8th Floor, Armentan Street,
Chennai - 600 001.
Phone: 044 - 4206 3051

AK 336962

RS. SHANMUGA SATHYANARAYANA
STAMP VENDOR,
L No. B4 100 / 32
HIGH COURT CAMPUS,
CHENNAI-600 034 (PALE FIELD)

BEFORE THE SOLE ARBITRATOR MR.D.SARAVANAN
.IN REGISTRY
(C/o. NATIONAL INTERNET EXCHANGE OF INDIA)

Disputed Domain Name: <www.liebert.in>

Liebert Corporation,
1050 Dearborn drive,
Colombus,
Ohio 43085-1544,
United States of America,
Represented by Sudhir D.Ahuja,
(litigation@dpahuja.com)

...

Complainant

Vs.

Jang He Lee,
705-907,
Seoul 139-737,
Korea.
U0202@lycos.co.kr

...

Respondent

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D. SARAVANAN
Advocate, Arbitrator & Mediator
"Orient Chambers" No.80 (Old No.73),
4th & 5th Floor, Armentien Street,
Chennai - 600 001.
Phone: 044 - 4205 3061

R.S. SHANMUGA SUNDARAM,
STAMP VENDOR,
L No B4 / 109 / 88
HIGH COURT CAMPUS,
CHENNAI-600 104 (TAMIL NADU)

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1. The Parties :

The Complainant is Liebert Corporation, having their address at 1050 Dearborn drive, Columbus, Ohio 43085-1544, United States of America, represented by Mr.Sudhir D.Ahuja.

The Respondent is Jang He Lee, having his address at 705-907, Seoul 139-737, Korea.

2. The Domain Name and Registrar:

The disputed domain name is <liebert.in>

The domain name has been registered with .IN REGISTRY.

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3. Procedural History:

- July 17, 2012 : The .IN REGISTRY appointed D.SARAVANAN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.
- July 17, 2012 : Consent of the Arbitrator was given to the .IN REGISTRY according to the INDRP Rules of Procedure.
- August 03, 2012 : Notice was sent to the Respondent by e-mail directing him to file his response within 10 days, marking a copy of the same to the Complainant's representative and .IN Registry.
- August 16, 2012 : Notice of default was sent to the respondent notifying his failure in filing the response, a copy of which was marked to the Complainant's representative and .IN Registry.

4. Factual Background:

4.1 The Complainant:

The Complainant is Liebert Corporation, having its office at 1050 Dearborn drive, Columbus, Ohio 43085-1544, United States of America, represented by Mr.Sudhir D.Ahuja, Constituted Attorney of Complainant.

4.2 Complainant's Activities:

The Liebert Corporation is a Company founded by Ralph C Liebert in 1965. In 1987, Emerson Electric Company acquired Liebert Corporation which later became part of Emerson Network Power platform, a division of Emerson Electric Company. The Complainant is a global manufacturer of power, precision cooling and infra-structure management systems for main frame computers, server racks and critical process systems under the liebert brand. The Complainant employs more than 1800 people across 12 manufacturing plants worldwide. As part of the Emerson network power platform, Liebert and Liebert services business also offer comprehensive professional



services. Liebert service was formed in 1985, a business unit of Liebert Corporation, and specializes in network reliability programs including design, engineering, installation, project management and total onsite operations management, preventive maintenance and energy consumption monitoring for data centers, telecom centers and other mission critical applications. The Services business currently employs over 350 customer engineers to support more than 35,000 clients in 70 countries.

4.3 Complainant's Trademark :

The Complainant's Liebert brand enjoys tremendous popularity and global recognition and has become exclusively associated and identified with complainant and its products and service alone. In India, Complainant has been using the Liebert mark since 1985. Use of "LIBERT" trademark or name by any entity, on any product or related service, would lead people to believe that such product/service either originated from or is somehow associated with the Complainant.

4.4 Respondent's Identity and activities:

The Respondent is the registrant of the Domain Name <liebert.in> which is registered with .IN REGISTRY, National Internet Exchange of India, New Delhi. The name of the registrant is referred to as Jang He Lee addressed at 705-907, Seoul 139-737, Korea.

5. Parties contentions:

A. Complainant:

(a) The Domain Name is identical or confusingly similar to a Trademark or service mark of the Complainant has rights:



(i) The Complainant states that his mark Liebert is well known in India and around the world in connection with power, precision cooling and infra-structure management systems for main frame computers, server racks and critical process systems. The Complainant claims that the disputed domain name <liebert.in> is identical and confusingly similar to the Complainant's registered mark "LIEBERT".

(ii) The Complainant states that the disputed domain name is entirely comprised of Complainant's registered mark "LIEBERT". The Complainant relies upon the decisions [ITC Ltd v. Travel India Case No. L2/5/R4; Boehringer Ingelheim Pharma GmbH & Co. KG vs. Philana Dhimkana, (WIPO Case NO.2006-1594); HSBC Holdings plc vs. Hooman Esmail Zadeh, Case No. L-2/5/R2; Allied DOMEQ Spirits and Wine Ltd vs. Roberto Ferrari, INDRP Case No.070, September 27, 2008] where in it was stated that "if a well known trade mark is incorporated in its entirety, it is sufficient to establish that a domain name is identical or confusingly similar to Complainant's registered mark "

(iii) The Complainant further claims that the internet user is likely to get confused and believe that the website accessible by the URL [http:// www.libert.in/](http://www.libert.in/) is affiliated with or endorsed by the Complainant.

(b) Respondent has no right or legitimate interest in the disputed domain name.

(i) The Complainant states that the Respondent does not use the mark Liebert as his business name/Corporate name or otherwise in course of trade, neither does he use the said name/mark for any legitimate commercial purpose. The Complainant has neither licensed nor otherwise permitted the Respondent to use Complainant's mark, or to apply for or use any domain name incorporating those marks. Further the website address www.liebert.in redirects visitors to www.apc.com, a website of American Power Corporation, a direct competitor of Complainant. The Complainant states that to the best of their knowledge and information, the Respondent is not the owner or an employee, or otherwise associated with American Power Conversion Corporation.



(ii) The Complainant states that the Respondent has made no use of the said disputed domain name in connection with any bona fide offering of goods or services, and that he is holding the domain name for a dishonest purpose. The Complainant relies upon the decision given in *Ciccone v. Parisi*, (WIPO Case No. D2000-0847) where it has been concluded that the use which intentionally trades on the frame of another cannot constitute a "bona fide" offering of goods or services.

(iii) The Complainant claims that since the disputed domain name <liebert.in> takes the users to the active website of the complainant's direct competitor, there exists clear evidence of their mala fide intention.

(iv) The Complainant further states that the Respondent did not arrive at the domain name "liebert.in" on his own as Liebert Corporation is named after its founder Ralph C. Liebert. The word Liebert has no meaning other than to identify Ralph Liebert and his Corporation.

(c) Respondent registered the domain name in bad faith:

(i) The Complainant states that he has a strong reputation and a very high-profile presence in the network power industry globally including India and is the subject of substantial consumer recognition and good will and that, the Respondent couldn't not have been unaware of the Complainant's mark before registering the <liebert.in> domain name. The Complainant relied on *Northwest Airline, Inc. v. Mario Koch* NAF Case No. FA9000095688; where it observed that "selection of the domain name which entirely incorporates the name of the world's fourth largest airline could not have been done in good faith".

(ii) The Complainant states that they have substantial reputation in the mark LIEBERT such that consumers and public in general invariably associate the use and application of the word "LIEBERT" with Complainant's corporate identity, business and services. The Complainant relied upon *ITC Ltd v. Travel India* Case No.L2/5/R4



(April 15, 2008) where it has been held that "The registration of a domain name with actual knowledge of a trade mark holder's rights in a mark is strong evidence that the domain name is registered in bad faith.

(iii) The Complainant states that by diverting traffic to the website of Complainant's direct competitor, Respondent is making use of the disputed domain name for obvious dishonest and illegal purposes. The Complainant submits that the Respondent has adopted the expression 'Liebert' and held on to the subject domain name purely to sell the domain name to the Complainant, or its competitor for a hefty competition. The Complainant further states that it is fair inference that the Respondents act in redirecting the site to the competitor to put pressure on the Complainant to purchase the domain name.

(iv) The Complainant points out the rules of procedure of INDRP which clearly state that, at the time of application for a domain name, the registrant must accurately represent that to the registrants knowledge, the registration of domain name will not infringe upon or otherwise violate the rights of any third party. The Complainant states that the Respondent, despite being fully aware of the Complainant's right over the mark LIEBERT, is guilty of misrepresentation and/or providing inaccurate/incorrect information to the registry.

(v) As evidence, the Complainant has provided the cease and desist letter which they had e-mailed and air-mailed to the Respondent on 9th May, 2012, wherein the Complainant had demanded the transfer of the disputed domain name to them. In absence of any reply, the letter was resent by e-mail on 16th May, 2012, to which also there was no reply.

(vi) The Complainant believes that Respondent knew of, and knowingly exploited the Complainant's mark and its substantial accompany goodwill. He relied upon ITC Ltd v. Travel India, Case No.L-2/5/R-4 where it was observed that "Only a person who is familiar with Complainant's mark could have registered domain name that is confusingly similar".



(vii) Section 6 of INDRP states that the following circumstances, 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:

(i) circumstances indicating that the Registrant 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 or 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; or

(ii) the Registrant 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 the Registrant has engaged in a pattern of such conduct; or

(iii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant'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 Registrant's website or location or of a product or service on the Registrant's website or location.

(viii) The Complainant states the all the above mentioned elements have been proved.

B. Respondent:

The Respondent did not submit any response.

6. Discussion and Findings:



(i) Under paragraph 4 of the IN Domain Name Dispute Resolution Policy (INDRP), the Complainant must prove each of the following three elements of its case:

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

(ii) The Respondent has failed to file any reply to the Complaint and has not rebutted the submissions put forth by the Complainant, and the evidence filed by him. Rule 8(b) of the INDRP Rules of Procedure provides that "In all cases, the arbitrator shall ensure that the parties are treated with equality and that each Party is given a fair opportunity to present its case".

(iii) As mentioned above the fair opportunity has been given to the Respondent to file the reply but no response has been received from his side. Therefore the Arbitration, proceedings have been conducted exparte. Rule 12(a) of the INDRP Rules of Procedure provided that "An Arbitrator shall decide a Complaint on the basis of the statements and documents submitted to it and in accordance with the Arbitration and Conciliation Act, 1996, Dispute Resolution Policy, the Rules of Procedure and any bye laws, rules and guidelines framed there under, and any law that the Arbitrator deems to be applicable".

(iv) In the present circumstances, the decision of the Arbitrator is based upon the Complainant's contentions and evidence and conclusion drawn from the Respondent's failure to reply.

(a) Identical or confusing similarity:

(i) The Complainant has furnished enough evidence to establish that their registered trade mark is well known across India and abroad. The disputed domain name is entirely comprised of Complainant's registered mark "LIEBERT". It has been



established in the following decisions [ITC Ltd V. Travel India Case No. L2/5/R4; Boehringer Ingelheim Pharma GmbH & Co. KG vs. Philana Bhimkana, (WIPO Case NO.2006-1594); HSBC Holdings plc vs. Hooman Esmail Zadeh, Case No. L-2/5/R2; Allied DOMEQ Spirits and Wine Ltd vs. Roberto Ferrari, INDRP Case No.070, September 27, 2008] that "if a well known trade mark is incorporated in its entirety, it is sufficient to establish that a domain name is identical or confusingly similar to Complainant's registered mark".

(ii) It is noted that the internet user is likely to get confused and believe that the website accessible by the URL [http:// www.libert.in/](http://www.libert.in/) is affiliated with or endorsed by the Complainant.

(iii) Thus, this Arbitral Tribunal comes to the irresistible conclusion that the disputed domain name <liebert.in> is confusingly similar or identical to the Complainant's marks.

(iv) The Arbitral Tribunal concludes that the Complainant has established paragraph 4(i) of the IN Domain Name Dispute Resolution Policy.

(b) Respondent's Rights or Legitimate Interests:

i) The Complainant contends that the Respondent has no legitimate interest in the disputed domain name. Paragraph 7 of the IN Dispute Resolution Policy sets out three elements, any of which shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name for the purposes of paragraph 4(ii) of the Policy. The Respondent had been given the opportunity to respond and to present evidence in support of the elements in paragraph 7 of the INDRP. The Respondent has not chosen to do so and has not filed any response in these proceedings to establish any circumstances that could assist it in demonstrating, any rights or legitimate interests in the disputed domain name. Although, the Complainant is not entitled to relief simply by default of the Respondent to submit a Response, the Arbitral Tribunal can however and does draw evidentiary inferences from the failure of the Respondent to respond. The



Complainant has established a prima facie case of lack of rights and legitimate interest as the Respondent does not use the mark Liebert as his business name/corporate name or otherwise in course of trade and neither does he use the said name/mark for any legitimate commercial purpose. The Complainant has neither licensed nor otherwise permitted the Respondent to use Complainant's mark, or to apply for or use any domain name incorporating those marks. The Respondent has failed to rebut the presumption of absence of rights or legitimate interests.

ii) Based on the record, the Respondent does not have rights or legitimate interests in the disputed domain name as the Respondent's current use is neither an example of a bona fide offering of goods or services as required under paragraph 7(i) of the Policy nor is there any legitimate non-commercial or fair use of the disputed domain name and as such there is no evidence that paragraphs 7(ii) or 7(iii) of the Policy apply. The Complainant asserts that they have not licensed or otherwise authorized the Respondent to use their trademark.

iii) The Complainant further states that the Respondent did not arrive at the domain name <liebert.in> on his own as Liebert Corporation is named after its founder Ralph C. Liebert. The word Liebert has no meaning other than to identify 'Ralph Liebert' and his Company.

iv) The Arbitral Tribunal is satisfied that the Respondent has no rights or legitimate interests in respect of the disputed domain name and, accordingly paragraph 4(ii) of the Policy is satisfied.

(c) Registration and Use in Bad faith:

i) Paragraph 6 of the Policy provides the circumstances evidencing registration and use of a domain name in bad faith, the Respondent has engaged in a pattern of such conduct so as to intentionally attract the relevant provisions. In this specific case the Respondent's activity of diverting traffic to the website of Complainant's direct competitor, shows that the Respondent is making use of the disputed domain name for obvious dishonest and illegal purposes. It can be said that the fair inference of the



Respondents act in redirecting the site to the competitor to put pressure on the Complainant to purchase the domain name is with a clear intention to use the domain name with bad faith.

ii) The Respondent has registered the domain name which appears to have been selected precisely for the reason that it is identical or confusingly similar to registered trademarks and trade names of the Complainant. The Respondent has no affiliation with the Complainant. Registration of a domain name that is confusingly similar or identical to a famous trademark by any entity, which has no relationship to that mark, is itself sufficient evidence of bad faith registration and use.

iii) In view of the submitted evidence and in the specific circumstances of this case, this Arbitral Tribunal draws the legal inference that Respondent's purpose of registering the domain name was in bad faith within the meaning of the Policy. The Respondent has no legitimate rights or interests in the disputed domain name and by diverting traffic to the website of Complainant's direct competitor, Respondent is making use of the disputed domain name for obvious dishonest and illegal purposes. As has been pointed out by the Complainant it is clear that the Respondent has adopted the expression 'Liebert' and held on to the subject domain name purely to sell the domain name to the Complainant, or its competitor for a hefty competition. It is fair inference that the Respondents act in redirecting the site to the competitor was to put pressure on the Complainant to purchase the domain name.

iv) In the light of the above, this Arbitral Tribunal finds that the Complainant has established that the disputed domain name was registered and is being used in bad faith.

7. Decision :

In view of the above facts and circumstances, it is clear that the Complainant has succeeded in his complaint. In the facts and the circumstances of the case it can be legally inferred that the only purpose for the registration of the disputed domain



name by the Respondent was to capitalize on the fame and reputation of the Complainant and to make monetary benefits. The Respondent has got registered and used the disputed domain name in bad faith. Hence the .IN Registry of the NIXI is hereby directed to transfer the domain name i.e.<www.liebert.in> to the Complainant in accordance with Paragraph 10 of the INDRP rules.

Dated at Chennai (India) on this 25th August, 2012.



(D.SARAVANAN)
Sole Arbitrator