



ఆంధ్రప్రదేశ్ రాష్ట్రం ANDHRA PRADESH

43179 12/9/2011

to: Haini Narayan Swamy

1/o./W/o./D/o: N. Narayan Swamy

Address: Spt. No. 548, Road No. 86, J. Ethics Ltd

K. Rama Chandravathi
AN 792857

K. RAMA CHANDRAVATHI
Licenced Stamp Vendor
LIC No.16-11-27/1999
REN.No.16-11-5/2011

H.No.6-3-387 Near Himalaya Book World
Beside Petrol Pump Punjagutta
HYDERABAD (SOUTH) DISTRICT
Phone No 23351799 9392490025

BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA
ARBITRATION AWARD

In The Matter Between

MHP Metro Group Intellectual Property GmbH and Co. KG

Complainant

Versus.

Vijay Bardola

Respondent

Haini Narayan Swamy

1. The Parties

The Complainant is MIP Metro Group Intellectual Property GmbH and Co. KG of **Germany**, represented in these proceedings by Anand and Anand of Delhi, India.

The Respondent is Vijay Badola of India Mart Intermesh Limited, Dehradun, Uttar Pradesh 201301, India.

2. The Domain name, Registrar and Policy

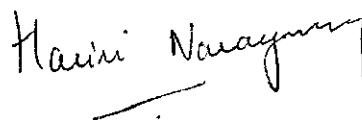
This Arbitration pertains to a dispute regarding the domain name <metrogroups.in>. The registrar for the disputed domain name is Directi Webservices Pvt. Ltd.

The Arbitration Proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the current .IN Domain Name Dispute Resolution Policy (the “INDRP Policy”), and the INDRP Rules of Procedure (the “Rules”).

3. Procedural History

The sole arbitrator appointed in the case is Mrs. Harini Narayanswamy. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, in compliance with the Rules.

The Arbitrator received the Complaint from the .IN registry on August 5, 2011 and on August 6, 2011 transmitted by email a notification of commencement of the arbitration proceedings to the Respondent. Under the INDRP Rules, copies of the said notification were sent to other interested parties to the dispute. The Respondent was given twenty-one days time from the date of the notification to file a response. The Respondent did not reply to the notification or file any response in these proceedings. Based on the material on record the Arbitrator now proceeds to determine the case on its merits.



Factual Background

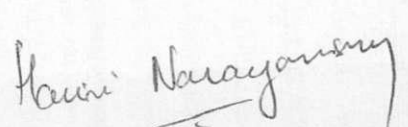
The Complainant is MIP Metro Group Intellectual Property GmbH and Co. KG. METRO and METRO GROUP are registered trademarks of Complainant, used in connection with the Complainant's business of chain stores, hyper marts and related services.

The Complainant has provided documents of its Indian trademark registrations for its METRO device mark bearing registration numbers 1078158 dated February 04, 2002 class 29, registration number 1078145 Feb 4 2002 class 1, registration number 1078146 dated February 04, 2002 in class 2, registration number 1078148 in class 4, registration number 1078149 in class 5, registration number 1078151 in class 7, registration number 1078152 in class 8, registration number 1078155 in class 16, registration number 1078156 in class 21, registration numbers 1078157 in class 25, registration number 1078162 in class 30, registration number 1078163, class 31, registration numbers 1078164, 1078165, 1078166 in classes 32, 33, 34.

Trademark registrations for the METRO word mark are: 676424 August 11, 1995 in class 9, 676423 August 11, 1995 in class 32, 1237123, September 16, 2003, 1237124, September 16, 2003, 1237123 September 16, 2003 in class 39, METRO word mark 1237124 in class 38, METRO word mark 1237126 in class 35, September 16, 2003 METRO word mark 1237125 in class 36, September 16, 2003. METRO word mark 1237120 in class 42, METRO LINK word mark 1274509 March 23, 2004 in classes 9, 37, 38 and 42.

The Complainant also owns Germany trademark registrations for trademark METRO GROUP bearing No. 30231063 with a priority date of June 26, 2002 and No. 30238957 with priority of August 8, 2002 and Community trademark application No. 2853471 with a priority September 16, 2002.

The Respondent registered the disputed domain name <metrogroups.in> on July 30, 2010.


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Parties contentions

A. Complainant's Submissions

The Complainant states it is affiliated to Metro AG group and is responsible for the Intellectual Property issues of the group. The METRO Group runs an internationally well-known business of retail and wholesale chain stores, hyper marts and department stores including specialty stores for home improvement and consumer electronics. The Complainant states its group of companies is a single economic entity. The METRO group has about 300,000 employees from 150 nations working in about 2200 outlets in 32 countries in Europe, Africa and Asia with a sales turnover of almost EUR 68 billion in the year 2008. Its business is divided into four groups, Cash and Carry, Food Retailing, Non-food Specialty stores and Department stores.

The Complainant alleges it has been operating its chain of stores since 1964 and has used the trademark METRO and its variants continuously and extensively. The Complainant states it commenced operations in India in 2003 with two distribution centers in Bangalore. The Complainant claims exclusive rights in the METRO mark and its variants due to prior adoption long use in India and in other countries. The Complainant has provided figures of its group sales turnover for the period 2000 to 2010.

The Complainant refers to its various trademark registrations and decisions where its rights has been recognized, such as in *Metro Group Intellectual Property GmbH & Co. KG v Upcastle*, WIPO Case D2008-1573 (<metrogruppe.com>) where it was found to infringe the Complainant's trademark METRO and METRO GROUPS and also in *MIP Metro Group Intellectual Property GmbH & Co. KG v Wanda Henson* WIPO Case No.2005-1008. The Complainant states it is the owner of several ccTLD domain names such as: <metro.in>, <metro.co.in> , <metro-cc.in> <metrogroup.in> < metro-group.in> , <metro-group.co.in> and owns numerous other country code domain names and registrations, including <metrogroup.de>.

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The Complainant argues that the Respondent has registered the disputed domain name that incorporates in its entirety the Complainant's well-known mark and is identical and confusingly similar to the name and mark in which the Complainant has rights. The Complainant owns the domain name <metrogroup.in> and therefore by merely adding letter "s" the Respondent's disputed domain name cannot be distinguished from the Complainant's domain name. The Complainant refers to WIPO cases: *MasterCard International Incorporated v. Global Access*, WIPO Case D2008-1940 where the use of a mark in entirety with an 's' added was found identical or confusingly similar to the mark.

The Complainant alleges that the Respondent offers frozen fruits on the website linked to the disputed domain name and as these goods are identical to the goods offered by Complainant it is bound to cause confusion in the minds of the public. The Complainant further argues that the public may falsely believe that the Respondent has a trade connection with Complainant.

The Complainant argues the Respondent lacks rights and legitimate interest in the disputed domain name, as the Respondent's case does not fall within paragraph 7 of the INDRP. The goods offered by the Respondent being similar to those sold by the Complainant that include vitamins mineral and dietary supplements shows it is direct competition with the Complainant. The disputed domain name is also redirecting users to another site, Folksgroup.com that offers other goods in competing with the Complainant and is therefore not a *bona fide* offering of goods and services by the Respondent. The Complainant believes that the Respondent is not commonly known by the name Metro Groups and use of the name by the Respondent is only to free ride on reputation and goodwill associated with the Complainant's mark. Further the Respondent is not licensed or authorized by the Complainant to use its marks.

The Complainant contends that the disputed domain name has been registered and is used by the Respondent in bad faith for the purpose of misappropriating its mark for obtaining illegal gains by opportunistic registration. When a registrant has no relation to the mark, the registration of a domain name that is confusingly similar to the mark, is considered

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sufficient evidence of bad faith registration states the Complainant. The Complainant further argues that the Respondent has provided a false address as there is no house number or street address, further the pin code does not correspond to the city of Dehradun. The Complainant's communications with the previous registrant, of the disputed domain name, yielded little response; although there was a reply from the counsel dated July 31, 2009 no action has been taken. An actual or potential visitor to the Respondent's future webpage is likely to believe that the disputed domain name belongs to the Complainant due to the Complainant's immense presence and market share in India for identical goods. The Complainant states that as the Respondent has no connection with its business the disputed domain name is transfer to it with costs.

Respondent's Submissions

The Respondent did not respond in these proceedings.

Discussion and Findings

The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:

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

Identical or Confusingly Similar

The first element requires the Complainant to prove that the domain name registered by the Respondent is identical or confusingly similar to a mark in which the Complainant has rights.

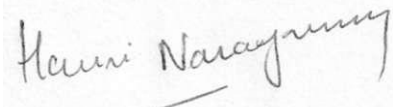
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The Arbitrator finds that the Complainant has submitted numerous documents showing its registered rights in the trademarks METRO and METRO GROUP. In particular, the Complainant has submitted documents that establish the Complainant's statutory rights in its trademarks in India and in other jurisdictions. Based on this evidence, the Arbitrator is convinced that the Complainant and its group have extensively used the marks METRO and METRO GROUP in commerce for its services and that the Complainant has established its exclusive rights in the said marks.

The Arbitrator finds the disputed domain name, entirely incorporates the Complainant's well-known trademark METRO GROUP and is confusingly similar the mark. If a well-known trademark is the distinctive part of the domain name in question, it has been found in innumerable cases that under such circumstances, the registration is a deliberate attempt to make the disputed domain name confusingly similar to the mark. See *DHL v. DHL Packers*, WIPO Case No. D2008-1694. The Complainant in the present case has established that it has extensive worldwide business for its products and numerous trademark registrations in several countries. The use of a known mark by an entity that has no connection with the mark leads to the inference that the mark is used in the disputed domain name for its confusingly similarity. *E. Remy Martin & Co and CLS Remy Contreu SAS v. Ke Zhao*, WIPO Case No D2011-0523. The Arbitrator finds merit in the Complainant's argument that adding the letter 's' to the trademark METRO GROUP does not lessen the confusing similarity of the disputed domain name to the mark.

Based on the unchallenged submissions made by the Complainant, the Panel finds the disputed domain name is almost identical and confusingly similar to the Complainant's mark. The country code top-level domain (cc TLD) suffix does not lessen the confusing similarity of the domain name with the trademark. See for instance *Morgan Stanley v. Bharat Jain*, INDRP Case No. 156 dated October 27, 2010.

For the reasons discussed, the Arbitrator finds that the Complainant has satisfied the first element under paragraph 4 of the Policy.


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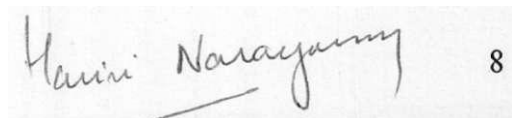
Rights and Legitimate Interests

The second element requires the Complainant to show that the Respondent has no rights and legitimate interests in the disputed domain name.

The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name, as the Respondent has not been given any authorization to use the Complainant's mark. Paragraph 7 of the Policy states a Respondent or a registrant can establish rights in the domain name, if (i) before notice of the dispute, the registrant had used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services or (ii) the registrant (as an individual, business organization) has been commonly known by the domain name, or (iii) The registrant is making legitimate, non commercial or fair use of the domain name without intent for commercial gain.

The Respondent has not responded in these proceedings and has not provided any material to show rights in the disputed domain name. The material on record does not show that the Respondent is commonly known by the disputed domain name or is making any legitimate noncommercial fair use of the disputed domain name.

In the Arbitrator's view, the use of the Complainant's mark in the disputed domain name is likely to mislead the public and Internet users that the disputed domain name may refer to the Complainant and its products. Internet users may falsely believe that the Respondent's domain name and website are being operated or endorsed by the Complainant. Misleading users by incorporating others trademarks in a domain name gives a false impression to users and does not constitute a *bona fide* offering of goods and services under the Policy. This view has been upheld in several prior decisions including UDRP cases. See for instance, *Zurich American Insurance Company v. Administrator, Domain*, WIPO Case No.D2007-0481 (Use of a confusingly similar or identical domain name to divert Internet users is not a *bona fide* offering of goods and services).

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The Arbitrator finds the Complainant has made a *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name.

Bad Faith

Under the INDRP Policy the Complainant is required to establish that the domain name was registered or is being used in bad faith.

The Complainant has extended the following arguments that the Respondent has registered the disputed domain name in bad faith and uses it in bad faith. First, the Complainant has prior rights in the well-known trademark METRO GROUP. Second, the Respondent has intentionally attempted to attract users by creating a likelihood of confusion with the Complainant's mark as to source of endorsement and affiliation; Third, the Respondent has misappropriated its mark to gain from the goodwill and reputation attached to the Complainant's mark. Four, the Respondent has provided false and incomplete address and contact details to the registrar. All these facts indicate bad faith registration and use according to the Complainant.

The Complainant has filed documents that establish its prior adoption and extensive use of the METRO GROUP and related marks. The Complainant's trademark applications were made much before the disputed domain name registration. The Complainant's trademark is undoubtedly well known and it is unlikely that the Respondent did not know of the Complainant's prior rights in the mark when he registered the disputed domain name. The very choice of the domain name is not a mere coincidence but is a deliberate use of a well-recognized mark to attract unsuspecting users to the Respondent's site. Registration of a domain name, based on awareness of a complainant's trademark rights is recognized as bad faith registration under the Policy, See for instance *Lego Juris v. Robert Martin*, INDRP / 125, February 14, 2010. Also see similar decisions under the UDRP *Vanguard Trademark Holdings USA, LLC v. True Energy Ventures LLC* WIPO Case No.DCO2011-0040.

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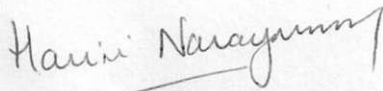
Based on the preponderance of the evidence on record and the facts and circumstance in the present case, the Arbitrator finds the Respondent registered the disputed domain name for creating a likelihood of confusion with the complainant's trademark as to the source of endorsements. Under Paragraph 6 (iii) of the Policy, if the registrant of the domain name in dispute, has used the domain name to intentionally attract Internet users to the Registrant's website or other online location by creating a likelihood of confusion with the trademark of another, it is considered evidence of bad faith.

The circumstances here suggest that there is no reasonable explanations for the registration and use of the disputed domain name except that the Respondent seeks to exploit the reputation and goodwill associated with the Complainant's mark and to mislead customers to believe that the Complainant is in some way associated with the Respondent's website. The registration and use of a domain name that exploits the goodwill of another's trademark is considered bad faith under the INDRP Policy. See *Eli Lilly and Company v Andrew Yan*, INDRP Case 195, dated February 16, 2011.

The Arbitrator therefore finds the disputed domain name has been registered and used in bad faith under the Policy.

Decision

For all the reasons discussed, the Arbitrator orders that the disputed domain name <metrogroups.in> be transferred to the Complainant.



Harini Narayanswamy (Arbitrator)

Date: September 12, 2011