



தமிழ்நாடு TAMILNADU

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AK 659365
PS. SHANMUGA SHANMUGAM,
STAMP VENDOR,
L No. 88 / 100 / 88
HIGH COURT CAMPUS,
CHENNAI-600 004 TAMIL NADU

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

Disputed Domain Name: < pierrehardy.in>

Mr. Pierre Hardy
20, rue de Saintonge
75003 Paris- France

....Complainant

Versus

BharatDNS Pvt Ltd
92 Appar Street,
Thiruvalluvar Nagar
Thirumangalam
Chennai- 600 040
Tamil Nadu

....Respondent

...2/



भारतीय गैर न्यायिक

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पचास
रुपये
रु.50



FIFTY
RUPEES
Rs.50

INDIA NON JUDICIAL

தமிழ்நாடு தமில்நாடு TAMILNADU

AD 121097

D. SARAVANAN
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P.S. SHANMUGA SUNDARAM,
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L No B4 / 109 / 88
HIGH COURT CAMPUS,
CHENNAI-600 104 (TAMIL NADU)

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1. The Parties:

The Complainant is a French National, having his office at 20, rue de Saintonge, 75003 Paris- France.

The Respondent is BharatDNS Pvt. Ltd. having its address at No.92, Appar Street, Thiruvalluvar Nagar, Thirumangalam, Chennai- 600 040, Tamil Nadu.

2. The Domain Name and Registrar:

The disputed domain name : <pierrehardy.in>

The disputed domain name is registered with National Internet Exchange of India (NIXI).

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3. Procedural History:

| | |
|-------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| October 08, 2012 | The .IN REGISTRY appointed D.SARAVANAN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure. |
| October 08, 2012 | Consent of the Arbitrator was given to the .IN REGISTRY according to the INDRP Rules of Procedure. |
| October 29, 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. |
| November 09, 2012 | Due date for filing response. |
| November 12, 2012 | Notice of default was sent to the respondent notifying its 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 states that he is a French National and a well-known designer in the world of fashion having his principal office at 20, rue de Saintonge, 75003 Paris- France. The complainant's authorized representative in these proceedings is Mr. Hemant Singh having office at INTTL ADVOCARE, D-22, Panchsheel Enclave, New Delhi- 110017.

4.2 Complainant's Activities:

The Complainant states inter-alia that:

- (i) The Complainant is in the business of designing fashion accessories such as inventive jewellery, shoes and bags. The creation of the Complainant is a potent



mix of historical knowledge and ultra- contemporary art to provide such goods a modern design of the twenty first century.

(ii) The Complainant initially started his designing career in 1987, when he designed the Women Shoe collection for Christian Dior. He began to design for high fashion house, namely Hermes, France, in 1990. It was in the year 1990 when the Complainant launched his namesake brand **PIERRE HARDY** with the Spring Summer Women's Shoes collection in France, Paris. In the year 2000, the Complainant in collaboration with another famous designer named Mr. Nicolas Ghesquiere, developed both women's and men's shoes collections for another high fashion house, namely Balenciaga.

(iii) In 2002, the Complainant launched yet another **PIERRE HARDY** winter season men's shoe and bag's collection in France. The Complainant has also in 2007 designed the capsule shoe collection for GAP Design Edition. The Complainant in the year 2010, as the Hermes Creative Director of Fine Jewellery division, introduced the "Haute Bijouterie" collection where he interalia designed a Fouet Riding Whip Necklaces, the platinum version of which is studded with 3,669 diamonds and costs \$ 890,000.

(iv) The Complainant's famous stack- Heel Platforms, Lace- Up Ankle Boots, Skyline Sandals, Sci- Fi Lego Shoe has made **PIERRE HARDY** become a famous shoe brand. The Complainant has customers all over the world including Hollywood stars.

(v) The popularity of complainant and it brand **PIERRE HARDY** is also evident from the fact that the Complainant's website name pierrehardy.com has been extensively visited by 400793 world wide web users and surfers since the year 2005.

4.3 Complainant's Activities in India

- i. Foreign published magazines bearing advertisement of **PIERRE HARDY** merchandise are extensively circulated all over India.



- ii. The Complainant's merchandise are also published in Indian fashion magazines namely Vogue India, Harper's Bazaar.
- iii. Use of trade mark in such magazines and publications circulated in India, constitute use of trade mark **PIERRE HARDY** in India. The complainant is therefore claims the proprietor of the said trade mark in India.

4.4 Complainant's Trading Name:

- (i) The Complainant holds trade mark **PIERRE HARDY** under registration no. 98 755 626 dated October 20, 1998 in classes 03, 18 and 25.
- (ii) The Complainant also holds and has applied for registration for trade mark **PIERRE HARDY** in goods falling in class 03, 14, 18 and 25 in various jurisdictions such as Brazil, Canada, Malaysia, UAE, etc. The protection list comprising of the details of the trade mark **PIERRE HARDY** is attached as Exhibit CW-1/5

LIST OF REGISTERED TRADE MARK

| S.No. | Trade Mark | Registration No. | Date | Class | Country |
|-------|--------------|------------------|------------|--------------|----------------|
| 1. | PIERRE HARDY | 98755626 | 20.10.1998 | 3,28,25 | France |
| 2. | PIERRE HARDY | 003057081 | 17.02.203 | 3,9,14,18,25 | European Union |
| 3. | PIERRE HARDY | 073528156 | 02.10.2007 | 14,18,25 | France |
| 4. | PIERRE HARDY | 78570 | 30.01.2008 | 14 | Kuwait |
| 5. | PIERRE HARDY | 78571 | 30.01.2008 | 18 | Kuwait |
| 6. | PIERRE HARDY | 78572 | 30.01.2008 | 25 | Kuwait |
| 7. | PIERRE HARDY | 200802440 | 11.02.2008 | 25 | Malaysia |
| 8. | PIERRE HARDY | 200802441 | 11.02.2008 | 18 | Malaysia |
| 9. | PIERRE HARDY | 200802442 | 11.02.2008 | 14 | Malaysia |
| 10. | PIERRE HARDY | 106998 | 12.02.2008 | 18 | U.A.E |



| | | | | | |
|-----|--------------|---------------|------------|----------|-------------------------|
| 11. | PIERRE HARDY | 106999 | 12.02.2008 | 25 | U.A.E |
| 12. | PIERRE HARDY | 49529 | 03.03.2008 | 14 | Qatar |
| 13. | PIERRE HARDY | 49530 | 03.03.2008 | 18 | Qatar |
| 14. | PIERRE HARDY | 49531 | 03.03.2008 | 25 | Qatar |
| 15. | PIERRE HARDY | 49532 | 03.03.2008 | 18 | Qatar |
| 16. | PIERRE HARDY | 49533 | 03.03.2008 | 25 | Qatar |
| 17. | PIERRE HARDY | 992959 | 07.03.2008 | 14,18,25 | International Procedure |
| 18. | PIERRE HARDY | TM303856 | 24.03.2008 | 25 | Thailand |
| 19. | PIERRE HARDY | TM297197 | 24.03.2008 | 18 | Thailand |
| 20. | PIERRE HARDY | D002008011558 | 02.04.2008 | 14,18,25 | Indonesia |
| 21. | PIERRE HARDY | D002008015892 | 02.05.2008 | 18,25 | Indonesia |
| 22. | PIERRE HARDY | 301098946 | 21.04.2008 | 14,18,25 | Hong Kong |
| 23. | PIERRE HARDY | 1036/31 | 14.01.2009 | 14 | Saudi Arabia |
| 24. | PIERRE HARDY | 1036/30 | 14.01.2009 | 25 | Saudi Arabia |
| 25. | PIERRE HARDY | 1061/68 | 20.04.2009 | 18 | Saudi Arabia |
| 26. | PIERRE HARDY | 01363428 | 16.05.2009 | 14,18,25 | Taiwan |
| 27. | PIERRE HARDY | 223513 | 10.09.2009 | 18 | Israel |
| 28. | PIERRE HARDY | 223501 | 10.09.2009 | 25 | Israel |
| 29. | PIERRE HARDY | 178239 | 31.12.2009 | 14,18,25 | Dominican Republic |
| 30. | PIERRE HARDY | EE100680 | 26.03.2010 | 14,18,25 | Tunisia |
| 31. | PIERRE HARDY | 829609474 | 27.07.2010 | 18 | Brazil |
| 32. | PIERRE HARDY | 829609458 | 27.07.2010 | 25 | Brazil |



(iii) The domain name, namely **pierrehardy.com**, is also registered in favour of the Complainant since the year 2000. The Complainant has extensively used his domain name **pierrehardy.com** for showcasing his designs on the said website since it started.

DOMAIN NAME REGISTRATIONS

| S.No. | Domain Name | Date of creation |
|-------|-------------------|------------------|
| 1. | pierrehardy.com | 19.04.2000 |
| 2. | pierrehardy.net | 19.04.2000 |
| 3. | pierrehardy.org | 19.04.2000 |
| 4. | pierrehardy.fr | 09.03.2004 |
| 5. | pierre-hardy.com | 21.11.2007 |
| 6. | pierre-hardy.fr | 21.11.2007 |
| 7. | pierre-hardy.net | 21.11.2007 |
| 8. | pierre-hardy.org | 21.11.2007 |
| 9. | pierrehardyny.com | 03.12.2010 |
| 10. | pierrehardy.xxx | 01.12.2011 |

5. Respondent's Identity and activities:

The Respondent in its administrative proceedings is BharatDNS Pvt. Ltd. having its address at 92 Appar Street, Thiruvalluvar Nagar, Thirumangalam, Chennai- 600 040, Tamil Nadu.

6. Dispute

The dispute arose in the last week of January, 2012 when the complainant through random search on Whois database came to know about the impugned domain name **pierrehardy.in** which is blatant imitation of the Complainant's trade mark **PIERRE HARDY** and domain name **pierrehardy.com**. The details of impugned website obtained from "Whois" database is attached as Exhibit CW-1/12. As per Whois



database, the impugned domain name is registered in favour of the Respondent at 92 Appar Street, Thiruvalluvar Nagar, Thirumangalam, Chennai- 600 040, Tamil Nadu. Therefore, the Complainant immediately issued a legal notice dated 06.02.2012 to the Respondent on the said address, seeking to transfer the impugned domain name in the favour of the Complainant. The copy of said legal notice is attached as Exhibit CW-1/13. The above said legal notice was received back by the Complainant's Counsel with remark "NO SUCH COMPANY". The copy of cover and acknowledgement card is attached as Exhibit CW-1/14. Thereafter, the counsel for Complainant made search on the official website of the Registrar of Companies, Ministry of Company Affairs, India namely www.mca.gov.in and found that there is no such company registered under the name of Bharat DNS Pvt. Ltd. Therefore, the Complainant emailed the said legal notice on info@bharatdns.com on 16.02.2012 but the Respondent has not replied yet.

7. Parties contentions:

A. Complainant:

(a) The impugned domain name is identical to the Complainant's personal name and distinctive trade mark PIERRE HARDY:

i) The Respondent has recently adopted the impugned domain name in November, 2011 to derive benefit from the goodwill and reputation of the Complainant's brand and mislead the members of public into believing that the impugned website belongs to the Complainant or is licensed by the Complainant having same origin and association.

ii) The Complainant has acquired common law rights in the undisturbed and exclusive use of the said trade mark.

iii) The Respondent's conduct also constitutes criminal offence of "falsification" and "false trade description" under the provisions of Section 102 and 103 of The Trade Marks Act, 1999.

iv) This act of Respondent will also inevitably lead to dilution and erosion of uniqueness and exclusivity associated with the Complainant's trade mark.



(b) The Respondent has no rights or legitimate interests in respect of the domain name:

- i) The impugned domain name was registered by the Respondent on 10.11.2011. At this time, the Complainant had a very considerable trans- border reputation in the trade mark **PIERRE HARDY** in India as well as internationally.
- ii) The Respondent is not known by the name **PIERRE HARDY**.
- iii) The impugned domain name is parked with the company namely Sedo GmbH, Germany for the purpose of sale of the impugned domain name.
- iv) The Respondent's registration and use of the impugned domain name is a clear case of cyber- squatting.

(c) The domain name was registered, has been used and continues to be used in bad faith for the following reasons:

- i. The Respondent has registered the impugned domain name in order to prevent the Complainant from registering the Domain name **PIERRE HARDY** in India under country code top level domain name ".in".
- ii. The Respondent has attempted to attract internet users to Respondent's website 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 service on the Respondent's website or location.
- iii. The Complainant has not authorized, licensed or otherwise consented to the Respondent's use of the impugned domain name.
- iv. The Complainant has been conscious about his intellectual property rights and has taken steps from time to time to protect the same.
- v. The Complainant cites an incidence where a party had sought registration of complainant's trade mark, the Complainant had opposed the same before Korean Intellectual Property Office and the said opposition was allowed. The relevant portion of the award is "*We conclude that the trade mark at issue in this case was*



9. Decision:

For all the foregoing reasons, in accordance with paragraph 10 of the Policy, the Arbitral Tribunal finds that the trade mark PIERRE HARDY constitutes a valuable intellectual property right owned by Complainant, which is entitled to protection in law against misuse, misappropriation as well as dilution and thus this Tribunal orders that the disputed domain name < pierrehardy.in > be transferred to the Complainant.

Dated at Chennai (India) on this 3rd December, 2012.



(D.SARAVANAN)
Sole Arbitrator