



उत्तर प्रदेश UTTAR PRADESH

Dr. Bodhisatva Acharya
ARBITRATOR

(Appointed by .IN Registry-National Internet Exchange of India)

Case No. Of 2012

ARBITRATION AWARD: DISPUTED DOMAIN NAME :< www.pizzaexpress.in >

In the matter of:

PizzaExpress Limited

Hunton House,

Highbridge Estate Oxford Road,

Uxbridge UB8 1HU, England

United Kingdom

Filed by its authorized representative attorney -

Anand & Anand

Attn:Revanta Mathur/Twinky Rampal

First Channel, Plot No.17A

Sector 16A, Film City,Noida

Email-revanta@anandandanand.com

twinky@anandandanand.com

.....Complainant.

Vs.

M.C.Nolte
Letitring GmbH
Von B.Str.1
Nordrhein-Westfalen
46325 Germany

.....Respondent.

A W A R D

1. The Parties:

The complainant in this arbitration proceeding is PizzaExpress Limited, Hunton House, Highbridge Estate Oxford Road, Uxbridge UB8 1HU, England United Kingdom **filed by its authorized representative attorney** Anand & Anand, Attn: Revanta Mathur/Twinky Rampal, First Channel, Plot No.17A Sector 16A, Film City, Noida with Email-revanta@anandandanand.com & twinky@anandandanand.com

Respondent M.C.Nolte, Letitring GmbH, Von B.Str.1, Nordrhein-Westfalen, 46325 Germany

2. The Domain Name, Registrar & Registrant:

The disputed domain name is www.pizzaexpress.in



3. Procedural History:

The complainant, through its authorized representative, filed this complaint to NIXI regarding the disputed domain name www.pizzaexpress.in following the clause 4 of the policy of .IN Registry and .IN Registry appointed Dr. Bodhisatva Acharya (The Arbitrator) as Sole Arbitrator under clause 5 of the policy. The Arbitrator submitted his statement of acceptance and declaration of Impartiality and the Independence on May 30th, 2012 and the complaint was produced before the Arbitrator on June 18th, 2012 and the Arbitrator sent a notice, to the Respondent through his email for the Arbitration Proceeding on June 23rd, 2012, to submit his reply in 10 days but Respondent sent an e-mail on June 28th, 2012 with request to file the reply till July 9th, 2012 and Arbitrator allowed the request of Respondent and Respondent filed his reply on July 5th, 2012 with some attachments and in reply thereof Complainant again sent an e-mail on July 5th, 2012 with 7 attachments and again Respondent sent 13 attachments on July 20th, 2012 in reply of Complainant's documents then Arbitrator sent an e-mail to Complainant to file his any document in reply of Respondent's 13 attachments and again Complainant filed his documental response on July 24th, 2012 and to avoid the repetition of so many documents Arbitrator gave last opportunity through e-mail on July 26th, 2012 to file any document from the both sides and lastly on July 28th, 2012 Respondent sent an e-mail with 4 attachments. Hence on August 22nd, 2012 the Award has been declared.

4. Factual Background:

- (a) The Trademark PIZZA EXPRESS is used worldwide by the Complainant, in respect of providing food products that includes pizzas and pizza products, preparations for making pizzas, toppings, sources, spices and flavorings, pizza dough and pizza flour, pasta and pasta based meals, prepared meals and snacks, desserts and pudding, ice cream, cakes, tea, sugar, beverages with chocolate or coffee base, bread, garlic bread, spaghetti and related restaurant services.



- (b) Complainant, PizzaExpress Limited, is an extremely well known and reputed company and is the proprietor of the trademark and trade name **PIZZA EXPRESS** having adopted and used the same since the year 1965 internationally at a time when no other party was using the same. The Complainant was established in the year 1965 by Peter Boizot in London when he started the first **PIZZA EXPRESS**. Over the years the **PIZZA EXPRESS** location spread across United Kingdom and thereafter the Complainant operates or has operated restaurants in several other countries worldwide including India since 1st December 1997. The complainant has won several awards and accolades for the goods and services under the trademark name **PIZZA EXPRESS**.
- (c) Presently the Complainant directly or through its related companies or its franchisees operates more than 300 **PIZZA EXPRESS** restaurants worldwide including in UK, Ireland, Jersey, Hong Kong, United Arab Emirates, Oman, Qatar, Kuwait, Gibraltar, Cyprus with several new stores scheduled to open in the coming years. In the past the Complainant has also operated restaurants in at least Russia, Saudi Arabia, Poland, France and India. The Petitioner has established a good market in UK and Ireland. In some countries the Complainant also operates as Milano, Pizza Milano and Pizza Marzano. In India, the Complainant entered into a master franchise agreement with the Modi group company, Lombard Street (Estates) Pvt. Ltd (LSEPL) and has set up restaurants under the trademark **PIZZA EXPRESS** in New Delhi in the past.
- (d) It is pertinent to note that the Complainant operates restaurants under the trademark **PIZZA EXPRESS** across the United Kingdom and its related companies or franchisees operate under the mark **PIZZA EXPRESS** in several countries worldwide including in India. In such a case, the members of trade and consuming public would believe that any party using a mark which is identical to the Complainant's trademark **PIZZA EXPRESS** could have some nexus, affiliation with the Complainant/its related company or is a franchisee of the complainant. All the goodwill and reputation accrued through

use of PIZZA EXPRESS by its related companies or its franchisees belongs to the Complainant.

- (e) The Complainant has expended a great amount of time, money and effort to promote and advertise the trademark **PIZZA EXPRESS** in all and every manner possible. As a result the complainant has been established an impeccable reputation and goodwill under its trademark **PIZZA EXPRESS** worldwide including in India. In India, a huge awareness for such products have also stemmed from widespread exposure and publicity of the PIZZA EXPRESS products and services, in magazines and newspapers having a widespread reach and circulation in India, exposure via the internet, exposure of consumers to PIZZA EXPRESS products and services overseas, word of mouth publicity and review articles appearing in various trade publications etc.
- (f) The Complainant is the owner of the top level domain name PIZZAEXPRESS.COM well as several other country code top level domain names. The domain name www.pizzaexpress.com leads to an active website.
- (g) The Complainant or its related companies are also the owner of several other country code top level domain name registrations that incorporate its reputed mark PIZZA EXPRESS such as www.pizzaexpress.com.hk, www.pizzaexpressuae.com,
www.pizzaexpress.com.om, www.pizzaexpressqib.com,
www.pizzaexpress.comcy etc.
- (h) Lastly the complainant filed this complaint for Arbitration proceeding and the complaint was produced before the Arbitrator on August 18th, 2012 and the Arbitrator sent a notice, to the Respondent through his email for the Arbitration Proceeding on August 19th, 2012, to submit his reply and Respondent submitted and filed many documents thru various e-mails on to Arbitrator and hence the AWARD is being declared on August 22nd, 2012.



5. Parties Contentions:

(a) Complainant contends that

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



(b) Respondent contends that

The respondent gave proper response and produced many documents.

6. Discussion & Findings:

- (i) The Complainant's reputed trademark PIZZA EXPRESS is a registered trademark in various countries around the world. These registrations or pending applications are either in its name or they have consented to applications/registrations being in the name of its related companies. With specific reference to India, it is submitted that the Complainant has registrations and pending applications for the mark PIZZA EXPRESS in class 30 and 43. The details of the same are as given below:-



Trademark	Registration/ Application No.	Class	Status
	781833	30	Registered Renewed up to 11/12/2017
PIZZA EXPRESS	2040035	30,43	Pending Registration
	2163974	43	Pending Registration

The Respondent in the present instance has registered the domain name PIZZAEXPRESS.IN (hereinafter referred to as "the impugned domain name") on July 14, 2009 which incorporates in it's entirely the Complainant's reputed mark PIZZA EXPRESS.

The Respondent's domain name is identical to the trading style and trademark in which the Complainant has prior rights. It is also pertinent to note that the Complainant already has several country code top level domain name registrations that incorporate its reputed mark PIZZA EXPRESS and thus the consumers and the members of the trade would get confused that the impugned domain name also belongs to the Complainant.

The Respondent domain name incorporates in its entirely the reputed mark PIZZA EXPRESS of the Complainant in which the complainant has statutory rights as well as under common law.

Further the impugned domain name attempts to associate itself to the Complainant's business under the mark PIZZA EXPRESS by incorporating the name of the business in full, thereby causing loss of the Complaint's prime domain name. The malicious intention of the Respondent is evident from the blatant misappropriation of the Complainant's trademark PIZZA EXPRESS. It is submitted that in the present instance, any Indian user searching for the Complainant's



business online as PIZZA EXPRESS will be taken to the Respondent's domain name, which enhances the possibility of confusion and/or deception.

The addition of the country code ".in" (INDIA) to the Complainant's trademark PIZZA EXPRESS makes the resulting domain name www.pizzaexpress.com, thereby diluting the trademark of the Complainant and causing harm to its reputation. In case SAS Institute Inc. v. Farzad Bahreini, FA0207000115038 (Nat. Arb. Forum, August 26, 2001) (domain name < sasinstitute.us> held confusingly similar to mark SAS INSTITUTE; panel held that the addition of a top level country-code such as ".us" does not create a distinct mark capable of overcoming a claim of identical or confusing similarity). The incorporating of a trademark in its entirety (and with no additional words) in a domain name is sufficient in establishing confusing similarity as stated by numerous INDRP decisions such as **Taco Bell Co. vs. West Masters Casino**. Mentioned decisions are annexed as Annexure-I.

Hence, it is apparent that the Respondent's domain name wholly contains the Complainant's trademark PIZZA EXPRESS and is identical to the trademark in which the Complainant has statutory rights as well as common law rights. Such unauthorized use of Complainant's domain name by the Respondent amounts to fraud that is done to the faithful customers of the Complainant.

- (ii) Since the disputed domain name comprises the reputed trademark PIZZA EXPRESS in which the Complainant has sole and exclusive interests, it is evident that the Respondent cannot have any rights or legitimate interest in domain name.

The Respondent's choice of the Complainant's reputed trademark PIZZA EXPRESS as part of its domain name is totally unnecessary and the Complainant submits that the sole purpose of carrying on business through the use of the disputed domain name incorporating the Complainant's reputed trademark is to cause confusion as to the source, sponsorship,

affiliation, or endorsement of the activity being carried on through the website.

PIZZA EXPRESS is not the Respondent's personal name, neither is the Respondent commonly known by the domain name and Respondent is not known to the public under the name PIZZA EXPRESS. Respondent has not been engaged in any such activity to show that it has legitimate rights or interest in the impugned domain name. Given that the disputed domain name was only registered on July 14, 2009 it is inconceivable that the Respondent was unaware of the existence of the complainant at the time of registration.

Hence the Respondent has no rights or legitimate interest in the domain name. Further it is apparent that the sole purpose of registering the domain name is to misappropriate the reputation associated with the Complainant's trademarks and extort money from the Complainant.

- (iii) The disputed domain name PIZZAEXPRESS.IN incorporates the Complainant's reputed mark PIZZA EXPRESS it is evident that the Respondent have no rights or legitimate interest in the domain name.

Complainant's PIZZA EXPRESS mark is reputed and the Respondent is presumed to have knowledge of the Complainant's mark at the time it registered the confusingly similar domain name. This knowledge indicates Respondent's bad faith use and registration. Therefore, the Respondent is bound to have had prior knowledge of the fame and reputation of the Complainant's reputed trademark PIZZA EXPRESS.

The disputed domain name has been registered and is being used in bad faith.

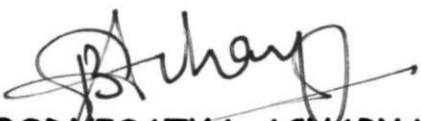
- (iv) The Complainant thus has satisfied the Arbitrator on all the parameters as mentioned in the Paragraph 4 of the Policy (INDRP).



7. Decision:

Hence the Arbitrator decides, the Disputed Domain Name www.pizzaexpress.in is identical or confusingly similar to registered trademark of the Complainant and Respondent has no right to use the disputed domain name and the Respondent domain name has been registered in bad faith.

The Arbitrator further decides and orders that the domain name www.pizzaexpress.in shall be transferred to the Complainant with immediate effect.


Dr. BODHISATVA ACHARYA
SOLE ARBITRATOR
NIXI 22/08/2012

DATED: August 22nd, 2012,
PLACE: NEW DELHI,
INDIA.