



महाराष्ट्र MAHARASHTRA

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VK 327244

प्रधान मुद्रांक कार्यालय, मुंबई  
प.म.वि.क्र. ८००००९०  
- 5 JUL 2019  
सक्षिप्त अधिकारी

BEFORE THE SOLE ARBITRATOR DIPAK G. PARMAR  
.IN REGISTRY  
(C/o NATIONAL INTERNET EXCHANGE OF INDIA)

श्री राजाराम म. परब

Corners House Ice Creams Pvt. Ltd.

...Complainant

v/s

Chandan

...Respondent

In the matter of Disputed Domain Name <cornerhouse.in>

**1 The Parties**

The Complainant is Corners House Ice Creams Pvt. Ltd. No. 3283, 12<sup>th</sup> Main, 8<sup>th</sup> Cross, Indiranagar, 2<sup>nd</sup> Stage, Bangalore – 560038, Karnataka by Ira Law.

The Respondent is Chandan, Bangalore – 560061, Karnataka.

*Dipak Parmar*

## 2 Procedural History

- 2.1 A Complaint dated August 20, 2019 has been filed with the National Internet Exchange of India (hereinafter referred to as the "Exchange"). The Complainant has made the registrar verification in connection with the domain name at issue. It is confirmed that presently the Respondent is listed as the registrant and provided the contact details for the administrative, billing and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (hereinafter referred to as the "INDRP") and the Rules framed thereunder.
- 2.2 The Exchange appointed Dipak G. Parmar, Advocate as the sole arbitrator in this matter. The Arbitrator finds that he was properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.
- 2.3 On September 17, 2019, the Arbitrator had directed the Respondent to file his reply to the Complaint on or before October 1, 2019. On October 2, 2019, the Arbitrator had sent the final reminder to the Respondent with direction to file reply on or before October 8, 2019. On October 9, 2019, the Respondent submitted his reply.
- 2.4 Email is the mode of communication of this arbitration and each email is copied to the Complainant, the Respondent and the Exchange.

## 3 Factual Background

The Arbitrator has found the following facts are undisputed:

- 3.1 The complainant, through its predecessor-in-interest and title, adopted the mark "Corner House" more than 35 years ago in year 1982, as not only its trademark but also its corporate name and trading style.
- 3.2 The Complainant is a premier manufacturer of, inter alia, ice cream and milk shakes. Due to long, continuous and uninterrupted use of the trade mark "Corner House" exclusively by the Complainant and owing to its unique flavour of ice cream, the Complainant has recorded turnover of approximately INR 22 crore in the financial year 2016-17 and INR 23 crore in the year 2017-18.
- 3.3 The Complainant is the registered proprietor of two device marks "Corner House Ice Cream" in class 30 in India. The Complainant had registered mycornerhouse.in and cornerhouseicecreams.in
- 3.4 The Complainant was the prior registrant of the Disputed Domain Name <cornerhouse.in>, which was actively used by the Complainant to provide information about the Complainant's goods and services, location of its outlets etc. under its trade mark "Corner House". But the Complainant failed to renew the same in 2016.
- 3.5 The Complainant has been continuously and uninterruptedly using the trademark "Corner House" since its inception 1982 whereas the Disputed Domain Name <cornerhouse.in> was registered on January 31, 2017.



#### 4 Parties' Contentions

##### 4.1 Complainant

The Complainant contends that the Disputed Domain Name is identical or confusingly similar to its trademark "Corner House"; the Respondent has no rights or legitimate interests in the Disputed Domain Name; and the Disputed Domain Name has been registered or is being used in bad faith.

##### 4.2 Respondent

The Respondent's reply to the Complaint is as under:

The domain CornerHouse.in we purchased for a Real estate portal. But due to my other personal problems we could not develop our several sites .  
As we are not into business icecream related things I strongly believe its not trademark infringement. As their trademark is "cornerhouse icecreams".

#### 5. Discussion and Findings

5.1 According to the INDRP, the Complainant must prove that:

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in the Disputed Domain Name; and
- (iii) the Disputed Domain Name has been registered or is being used in bad faith.

##### 5.2 Identical or Confusingly Similar

The Complainant has been continuously and uninterruptedly using the trademark "Corner House" since its inception 1982. Due to long, continuous and uninterrupted use of the trade mark "Corner House" exclusively by the Complainant and owing to its unique flavour of ice cream, the Complainant has acquired common law rights over the trademark "Corner House". Prior Uniform Dispute Resolution Policy ("UDRP") panels have held that it is possible to obtain unregistered trademark rights to a trade name sufficient to satisfy the requirements of paragraph 4(a)(i) of the UDRP<sup>1</sup>. Further, prior UDRP panels have found the use of a term in connection with specific products can give rise to unregistered trademark rights<sup>2</sup>. The Complainant's trademarks "Corner House Ice Cream" (device mark) is a registered trademark in India. The Arbitrator does not agree with the Complainant that the Disputed Domain Name is identical to their registered trademark. As the Respondent rightly points out, the registered trademark is "Corner House Ice

1 G. Bellentani 1821 S.p.A. v. Stanley Filoramo, WIPO Case No. D2003-0783 (reasoning that "it is possible to obtain unregistered trademark and/or service mark rights to a trade name and unregistered trademark and/or service mark rights are sufficient for the purposes of paragraph 4(a)(i) of the Policy"); see also Nu Mark LLC v. Bui, Long, WIPO Case No. D2013-1785 (finding complainant's trade name "Nu Mark" had become a distinctive identifier associated with its business and products on its website and thus demonstrated complainant's unregistered trademark rights).

2 See Uitgeverij Crux v. W. Frederic Isler, WIPO Case No. D2000-0575 (finding that complainant demonstrated unregistered trademark rights in a term based on evidence that complainant had been using the mark in association with its business for years prior to the registration of the domain name in dispute); see also Endeavors Technology, Inc. v. Dick In Jar, WIPO Case No. D2001-0770 (finding that complainant's use of a term as a trade name in connection with its product on its website was sufficient evidence that complainant had tied its business name to its product in advertising and promotion and, consequently, was sufficient evidence of complainant's rights in the trade name as an unregistered trademark).

Cream". In the case of Finter Bank Zurich v. Gianluca Olivieri, Case No. D2000-0091 it was found that the complainant had rights in the mark FINTER notwithstanding that the complainant had registered only the trademark FINTER BANK ZURICH. The panel went on to hold that BANK merely indicated the area of business activity of the complainant and ZURICH the geographic location of the head offices. As a consequence the panel went on to find that "finter.com" and "finter.org" were confusingly similar with FINTER BANK ZURICH. Similarly, in the present Complaint, "Ice Cream" merely indicates the products of Complainant. The Disputed Domain Name <cornerhouse.in> incorporates "Corner House" in which complainant has rights. Hence, contrary to the Respondent's submission, the Arbitrator is satisfied that the Disputed Domain Name is confusingly similar to the Complainant's trademarks, wherein the words "Corner House" are a dominant and essential part of its registered trademark and an Internet user familiar with the Complainant's trademarks would reasonably suppose that the Disputed Domain Name is connected with the Complainant<sup>3</sup>.

#### 5.4. Rights or Legitimate Interests

The Respondent is not commonly known by the Disputed Domain Name nor conducted legitimate business under such name. The Complainant asserts that it has not licensed, authorized, or permitted the Respondent to use the trademark "Corner House". The Respondent has not uploaded any website on the Disputed Domain Name and has parked the same for sale by featuring message "This domain name cornerhouse.in is for sale!" on the Disputed Domain Name. The Respondent claims that the Disputed Domain Name was purchased for a Real estate portal but the same was not developed due to personal problems. Thus, the Respondent is not using, nor demonstrated any preparation to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services. The Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name, and as such the burden of proof shifts to the Respondent<sup>4</sup>. There is no evidence before the Arbitrator to support any position contrary to these allegations, and therefore the Arbitrator accepts these arguments. Consequently, the Arbitrator concludes that the Respondent has no rights or legitimate interests in the Disputed Domain Name <cornerhouse.in>.

#### 5.5 Registered and Used in Bad Faith

At the time of registration of the Disputed Domain Name, the Complainant was using the trademark "Corner House" and the prior registrant of the Disputed Domain Name. The Respondent knew, or at least should have known, of the existence of the Complainant's trademark "Corner House". The Respondent has incorporated the Complainant's trademark "Corner House" in its entirety to attract Internet users to the Disputed Domain Name by creating a likelihood of confusion with the Complainant's trademark with an intent of trading on the goodwill and reputation associated with the Complainant's trademark "Corner House" for illegal profits.<sup>5</sup> The Respondent is passively holding the Disputed Domain Name as the same does not resolve to a website or other online presence<sup>6</sup>. The Respondent has deliberately provided incorrect contact details while the Disputed

3. See Mentor ADI Recruitment Ltd (trading as Mentor Group) v. Teaching Driving Ltd WIPO Case No. D2003-0654

4. See Altria Group, Inc. v. Steven Company, WIPO Case No. D2010-1762

5. See Weny's LLC v. Apex Limited, INDRP Case no. 737. In this case the domain name <wendys.co.in> was found to be registered with the intention of trading on the goodwill and reputation associated with Wendy's trademark and was held to be registered and use of domain name in bad faith.

6. See Telstra Corporation Limited v Nuclear Marshmallow, Case No. D2000-0003 and Accenture Global Services v Mr. Upendra Singh INDRP/829



Domain Name and has thus, taken active steps to ensure that its true identity cannot be determined and communication with it cannot be made. The concealment of true identity by the Respondent at the time of registration of domain name has considered as determining factor of the Respondent's bad faith by the UDRP in Telstra Corporation Limited v Nuclear Marshmallow, WIPO Case No. D2000-0003. These facts supports the inference that the Respondent deliberately registered the Disputed Domain Name using the Complainant's trademark with the intention to exploit it. This proves beyond reasonable doubt his malafide intent behind registration of the Disputed Domain Name. Accordingly, the Arbitrator finds on balance that the Disputed Domain Name has been registered and is being used in bad faith.

6. **Decision**

In light of the foregoing reasons, the Arbitrator orders that the Disputed Domain Name <cornerhouse.in> be transferred to the Complainant.

  
Dipak G. Parmar  
Sole Arbitrator

Date: October 13, 2019