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P 684563

ARBITRATION AWARD

**.IN REGISTRY - NATIONAL INTERNET EXCHANGE OF INDIA
.IN domain Name Dispute Resolution Policy
INDRP Rules of Procedure**

IN THE MATTER OF:

Diageo Brands B. V.
Molenwerf 10-12 1
1014 BG Amsterdam
The Netherlands

.....Complainant

VERSUS

Rocket Sales Corp.
Prabhloch Singh
2722, C Block,
Sushant Lok 1,
Gurgaon 122 002
India.

Respondent

1. **THE PARTIES:**

The Complainant in this administrative proceeding is Diageo Brands B. V., Molenwerf 10-12 1, 1014 BG Amsterdam, The Netherlands. Represented through Cecilia Borgenstam, Melbourne IT Digital Brand Services, Level 2, 120 King Street, Melbourne, 3000, Victoria, Australia.

The Respondent is Rocket Sales Corp. Prabhloch Singh, 2722, C Block, Sushant Lok 1, Gurgaon 122002, India.

2. **THE DOMAIN NAME AND REGISTRAR**

The disputed domain name <VAT69.CO.IN> has been registered by the Respondent. The Registrar with whom the disputed domain is registered is GoDaddy.com, Inc. 14455, North Hayden Rd Suite 226, Scottsdale, AZ 85260, United States.

3. **PROCEDURAL HISTORY**

The Complaint was filed with the .In Registry, National Internet Exchange of India (NIXI), against Rocket Sales Corp., Gurgaon. The NIXI verified that the Complaint together with the annexures to the Complaint and satisfied the formal requirements of the .in Domain Name Dispute Resolution Policy ("The Policy") and the Rules of Procedure ("The Rules").

3.1 In accordance with the Rules, Paragraph-2(a) and 4(a), NIXI formally notified the Respondent of the Complaint and appointed me as a Sole Arbitrator for adjudicating upon the dispute in accordance with The Arbitration and Conciliation Act, 1996, Rules framed there under, .In Dispute Resolution Policy and Rules framed there under on **July 11, 2011**. The parties were notified about the appointment of an Arbitrator on **July 11, 2011**,

3.2 The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as

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required by NIXI to ensure compliance with the Rules (paragraph-6). The arbitration proceedings commenced on **July 11, 2011**. In accordance with the rules, paragraph 5(c). The Respondent was notified by me about the commencement of arbitration proceedings and the due date for filing his response.

- 3.3 The Respondent by its e-mail dated July 12, 2011, submitted that it had not received any documents from NIXI since the proprietor Mr. Prabhloch Singh does not stay at the address mentioned in the email anymore. The respondent desired that the documents / complaint be sent to its present address i.e. Hno: C-40/1, 2nd Floor, C Block, Ardee City, Sector 52, Gurgaon.
- 3.4 The Registry i.e. NIXI, while replying to the email of the respondent dated July 12, 2011, forwarded the soft copy of the complaint to the respondent and confirmed that the courier was sent to the respondent's address as published in the WHOIS record / domain name.
- 3.5 The respondent by its email of 20th July 2011, did not take my issue of non service of the complaint, but took the plea of the disputed domain name having been transferred to Caffeine Integrated Solutions.
- 3.6 The panel considers that the respondent was duly served and provided with a fair opportunity to defend the proceedings.
- 3.7 The Panel considers that according to Paragraph-9 of the Rules, the language of the proceedings should be in English. In the facts and circumstances, in-person hearing was not considered necessary for deciding the Complaint and consequently, on the basis of the statements and documents submitted on record, the present award is passed.

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4. **FACTUAL BACKGROUND**

- 4.1 The Complainant in these administrative proceedings is Diageo Brands B. V., Molenwerf 10-12 1, 1014 BG Amsterdam, The Netherlands.
- 4.2 The Complainant is the world's leading premium alcoholic beverages company, with brands including GUINNESS, SMIRNOFF, JOHNNIE WALKER, CAPTAIN MORGAN, BAILEYS, J & B, TANQUERAY and VAT 69.
- 4.3 The Complainant owns numerous trademark registrations for VAT 69 including Indian trademark registration number 5926 for VAT 69 which matured into registration as early as 1942 in Class 33 for Whisky. The Complainant also attached the list of trademark registrations and pending applications in India and in other parts in the world in respect of the mark VAT 69.
- 4.4 VAT 69 is a Blended Scotch Whisky having first launched in 1882 with the first creation of VAT 69 blend. The Complainant is also the proprietor of additional domain names incorporating the mark VAT 69, for example: vat69.com and vat69.in.
- 4.5 The Respondent has registered the disputed domain name <VAT69.co.in> on **January 15, 2010** through the GoDaddy.com. Inc. 14455, North Hayden Rd Suite 226, Scottsdale, AZ 85260, United States.
- 4.6 The Respondent submitted its response to the panel's notice dated July 11, 2011 on July 20, 2011 stating that the disputed domain VAT69.CO.IN has already been transferred by him on November 30, 2010 to Caffeine Integrated Solutions.
- 4.7 The Panel drew the attention of the complainant to the response filed by the respondent on July 21, 2011 and directed the complainant to take appropriate steps as it



may deem fit as per the policy and provisions of law, as applicable.

- 4.8 The complainant, vide its email dated July 21, 2011, replied that since as per the WHOIS record ownership of the disputed domain name at the time of filing of the complaint, was and still is in the name of Rocket Sales Corporation, it was not the obligation of the complainant to ensure recordal of change of ownership. The complainant further submitted that for the purpose of these proceedings, the respondent is Rocket Sales Corporation thus the complainant was required to take no further action. The Panel find that the disputed domain name is still in the name of the respondent as per the records and hence, appropriate order can be passed in the present proceedings. The so called assignee of the disputed domain name will be bound by the order in the present proceedings.

5. PARTIES CONTENTIONS

5A COMPLAINANT

5A(1) The Complainant owns numerous trademark registrations for VAT 69 including Indian trademark registration number 5926 for VAT 69 which matured into registration as early as 1942 in Class 33 for Whisky.

5A(2) VAT 69 is a Blended Scotch Whisky having first launched in 1882 with the first creation of VAT 69 blend.

5A(3) The Complainant is also the proprietor of additional domain names incorporating the mark VAT 69, for example: vat69.com and vat69.in.

B. RESPONDENT



5B (1)The Respondent was given opportunity to file its response to the Complaint by the panel by its notice dated **July 11, 2011**.

5B (2)The Respondent by its response dated July 20, 2011 submitted as under:

- a. "The domain was transferred on November 30, 2010. Since the transfer took place through a mediator, i.e. Sedo, it might have taken a couple of days more for the domain to actually get transferred to the new owner. The domain was transferred to:

Caffeine Integrated Solutions

Sangram Surve

Prabhadevi

400068 Mumbai

India

- b. We had requested them through the mediator to update the Whois details of the domain, however, the whois results still show me as the owner. I had the domain through Direct! but when the domain was transferred, it was transferred under GoDaddy. I have no control over the domain anymore and hence I cannot update the whois details myself.
- c. I had registered the domain after reading about VAT 69, i.e. Malaysia's Very Able Troopers. Trained by the British SAS, VAT69, Malaysia's elite commandos were formed in 1969 to combat the resurgent Communists. World politics **and** history has always been of great interest to me. Idea was to make a digital project/documentary/vwebsite/forum on them (which eventually didnt materialise due to time constraints). Since the domain was available and there was a promotion going on .co.in domain registrations, with which I managed to get this domain for little under \$2 for the first year, I registered the domain even before the site



could be ready, VAT 69, the elite force has been extensively covered on TV by History Channel, more information about which can be found here: <http://www.historyasia.com/searchdetail.aspx?libld=1235>

After receiving your email, I googled and found out that Caffeine Integrated Solutions, the company which had bought the domain from me/to which the domain was transferred either represents or is associated with Diageo in India. More information about this can be found at:

<http://www.eventfaqs.com/eventfaqs/wcms/en/home/news/Malay-Dikshit-Vat-69-story-1276490166857.html>.

A visit to this link suggests that Caffeine Integrated Solutions takes care of the marketing/advertising/promotion for Vat 69 Scotch.

- d. It seems like one of the representatives/associates/partners of Diageo in India bought the domain from me through a mediator and Diageo is not aware of it,

I don't own the domain anymore, I have no control over it. It should be the present Registrar's duty to ensure that the current owner has all the updated whois/ownership information."

6. **DISCUSSIONS AND FINDINGS**

- 6.1 The Complainant(s), while filing the Complaint, submitted to arbitration proceedings in accordance with the .In Dispute Resolution Policy and the Rules framed thereunder in terms of paragraph (3b) of the Rules and Procedure. The Respondent also submitted to the mandatory arbitration proceedings in terms of paragraph 4 of the policy, while seeking registration of the disputed domain name.



6.2 Paragraph 12 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and that there shall be no in-person hearing (including hearing by teleconference video conference, and web conference) unless, the Arbitrator, in his sole discretion and as an exceptional circumstance, otherwise determines that such a hearing is necessary for deciding the Complaint. I do not think that the present case is of exceptional nature where the determination cannot be made on the basis of material on record and without in-person hearing, Sub-Section 3 of Section 19 of The Arbitration & Conciliation Act also empowers the Arbitral Tribunal to conduct the proceedings in the manner it considers appropriate including the power to determine the admissibility, relevance, materiality and weight of any evidence.

6.3 It is therefore appropriate to examine the issues in the light of statements and documents submitted as evidence as per Policy, Rules and the provisions of the Act.

6.4 The Complainant has filed evidence by way of **Annexures-'1' to '12'** with the Complaint.

The Respondent did not dispute any contentions raised by the Complainant in the Complaint. The Respondent, however, submitted that he has already transferred the domain of the 3rd party on 30.11.2010 and he does not have any control over the said domain name.

The Respondent did not file any evidence in support of his claims.

6.5 The complainant in reply submitted that since the WHOIS record still shows the name and address of the current respondent. The proceedings against the respondent should continue and the complainant is not obliged to take any further steps in light thereof. The Panel find substance, in the submission made by the

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complainant in this regard and hold that proceedings against the respondent have properly been instituted and are maintained.

6.6 The onus of proof is on the Complainant(s). As the proceeding is of a civil nature, the standard of proof is on the balance of probabilities. The material facts pleaded in the Complaint concerning the Complainant's legitimate right, interest and title in the trade mark, trade name and domain name <VAT69.co.in> and the reputation accrued thereto have neither been dealt with nor disputed or specifically denied by the Respondent. The Respondent has not also denied the correctness and genuineness of any of the Annexures/Exhibits filed by the Complainant along with the Complaint.

A. **IDENTICAL OR CONFUSINGLY SIMILAR**

6A.1 The Complainant contends that the disputed Domain Name is identical or confusingly similar to a trade mark in which the Complainant has rights.

6A.2 The Complainant further submits that the trademark is famous in India as well as in other major jurisdictions such as Australia and New Zealand. The domain name incorporates the Complainant's trademark VAT 69 in its entirety.

6A.3 The Panel find that the disputed domain name is identical to the Complainant's trade mark except for the country code top level domain (cc TLD) ".co.in" identifier. The ccTLD can be disregarded for **purposes of assessing similarity** of the domain name to the trademark.

6A.4 There is every possibility and likelihood that the consumers looking for VAT 69 may instead reach the Respondent's **website. Therefore the domain name is confusingly similar** to the Complainant's trade mark.

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6A.5 The Respondent has not disputed any contentions raised by the Complainant. The respondent submits that the disputed domain name VAT69 was registered by it after reading in about VAT69 i.e. Malaysia's Very Able Troopers. Trained by the British SAS, VAT69, Malaysia's elite commandos were formed in 1969 to combat the resurgent communists. It was further submitted that since world politics and history has always been of great interest to it, so it had the idea to make a digital project / documentary/ website/ forum on them (which eventually did not materialized due to time constrained). It was further submitted that since the domain was available and there was a promotion going on .co.in domain registrations, it managed to get this domain for little under \$2 for the first year. However, the respondent did not submit any evidence to support its contention raised in reply dated 20.07.2011.

6A.6 Since no evidence has been filed by the respondent to substantiate its claim, the panel is not satisfied with contention of the respondent that the disputed domain name VAT69.CO.IN was registered by the respondent and is not infringing upon the marks of the complainant by indulging himself into such acts.

6A.6 The Panel therefore find and hold that the disputed Domain Name <VAT69.co.in> is identical and/or deceptively similar to the registered trade marks and Domain Names of the Complainant.

B. RIGHTS OR LEGITIMATE INTERESTS

6B.1 The Respondent has no rights or legitimate interests in respect of the domain name.

6B.2 Paragraph 7 of the Policy lists the following three non-existence methods for determining whether the Respondent has rights or **legitimate interests in a disputed** domain name:

6B.3 The Complainant submits that the respondent has no rights or legitimate interest in the domain name, as the respondent has



not been given any authorization to use the Complainant's mark.

6B.4 The respondent is not known by the domain name and has no trade mark rights in the name. The Respondent has not used or made demonstrable preparations to use the domain name in connection with a bonafide offering of goods or services and is into making legitimate, non commercial or fair use of the domain name. The Respondent has not rebutted the Complainant's rights in the domain name and has not produced any documents or submissions to show his interest in protecting his own right and interest in the domain name. Thus, it is clear that the Respondent has no right or legitimate interest in respect of the domain name.

6B.5 The complainant's mark "VAT 69" is a famous and well known mark and is registered in many countries including the country of the Respondent, it is unlikely that the Respondent did not know about the Complainant's rights in the mark or the domain name. The Complainant registered the domain name vat69.in on December 9, 2010 which is prior to when the domain name in question was registered by the Respondent. It could not be a mere coincidence that both names were registered within the same time frame.

6B.6 The complainant has not licensed nor otherwise permitted the Respondent to use its name or trademark or to apply for or use the domain name incorporating VAT 69.

6B.7 The Respondent has no legitimate right to use the word "VAT 69". The Complainant has not permitted the Respondent to use the word "VAT 69".

6B.8 The respondent submitted that the domain was transferred by it to Caffeine Integrated Solutions on 30.11.2010 and it does not have any control over disputed domain name. The respondent further submitted that it should be the present Registrar's duty to ensure that the current owner updated the WHOIS ownership information.

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6B.9 Since no evidence has been provided by the respondent to substantiate any of its claims, the panel is satisfied that the respondent does not have any right or legitimate interest in the disputed domain name. Furthermore, the panels decision is made more conclusive from the point that the respondent himself has submitted that he does not owns the domain which is indication of respondent's lack of legitimate interest in the disputed domain name.

6B,10The Panel therefore holds that the circumstances listed above clearly demonstrate the rights of the Complainant **in** the disputed domain name. The Panel, therefore, holds that the Respondent has no right or legitimate interest in respect of the disputed domain name.

C Registered and used in Bad Faith

6C.1 For a Complainant to succeed, the Panel must be satisfied that a domain name has been registered and is being used in bad faith.

6C.2 Paragraph 6 of the Policy states circumstances which, if found shall be evidence of the registration and use of a domain name in bad faith:

6C.3 According to the whois, the domain name was initially registered on January 15, 2010. **At** this time the **registrant** of the domain name was different from the current Registrant. The Registrant was a company called NetPrabhu Web Services.

6C.4 Around November 25, 2010 the domain name was transferred to the Respondent.

6C.5 On December 2, 2010, a letter was sent, by registered mail as well as an email with a cease and desist letter to the Registrant of the domain name. In the cease and desist letter, the Respondent was advised that the unauthorized use of the trademark VAT 69 within the domain name violated the rights

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in the Complainant's trade mark. Cease of use and immediate transfer of the domain name was requested. No response to the letter or e-mail was received.

6C.6 On December 12, 2010 a reminder was sent. Shortly thereafter the respondent replied via email stating that he did not own the domain name anymore. The complainant attached a whois extract in the follow up email which showed that a Mr. Singh Prabhloch was registered as the administrative contact. The complainant asked what his relation was with the company Rocket Sales Corp. which was listed as the owner. Mr. Singh Prabhloch said he would advise the Registrant to update the whois details. The Complainant did regular checks and Rocket Sales Corp remained as owner of the domain name. The Complainant encouraged Mr. Singh Prabhloch to contact the Registrant and have the whois updated if this was the case.

6C.7 On January 7, 2011 the whois details had still not changed and the complainant advised Mr. Singh Prabhloch that an administrative proceeding was about to commence.

6C.8 It is clear that the respondent registered the domain name in order to profit from the VAT 69 brand, by pretending that the respondent is related to the trade mark holder and/or to direct traffic to the website. It is therefore obvious that the Respondent has registered and used the domain name in bad faith. The cease and desist letter was not replied. The Respondent has not shown that they are using the domain name for the bonafide use of products or services.

6C.9 The disputed domain name is currently connected to a parked website and the respondent is using the domain name to intentionally create a likelihood of confusion with the Complainant's mark as to the source. The badge of origin is the brand VAT 69.

6C.10 There is no connection between the respondent and the complainant and the respondent has registered and is using the domain name in bad faith. By using the domain name, the

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Respondent is not making a legitimate non commercial or fair use without intent for commercial gain but is misleadingly diverting consumers for his own commercial gain. Further, the respondent is preventing the complainant from reflecting the mark in a corresponding domain name. The respondent has not shown any evidence of use of the domain name in a legitimate manner and retaining the domain name in these circumstances constitutes a bad faith use.

6C.11 The Respondent reiterated the same stand taken by it in its response to the complainant's notice dated 12.12.2010 and submitted that the respondent does not own the domain any more but has failed to act upon the conditions of the notice so as to get the WHOIS details of the domain name updated by the Registrar and/or the new Registrar in his name.

In the light of the above, the panel concludes that the respondent did not act in good faith so as to get the registration details of the disputed domain name updated and no evidence whatsoever has been provided by him to substantiate that the domain has already been transferred to Caffeine Integrated Solutions as alleged by him in his response dated 21.07.2011.

6C.12 The panel accepts the contentions of the Complainant as have been raised by them and holds that the registration of the domain name on part of the Respondent is in bad faith.

7. **DECISION**

In view of the fact that all the elements of Paragraphs 6 and 7 of the policy have been satisfied and in the facts and circumstances of the case, the panel directs the

A. Transfer of the domain name <VAT69.co.in> to the Complainant.


AMARJIT SINGH
Sole Arbitrator

Dated: 3rd August, 2011