



ARBITRATION AWARD

BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA

In The Matter

Yash Raj Films Private Limited

Complainant

Versus.

Himansu Dase

Respondent

1. The Parties

The Complainant is Yash Raj Films Private Limited of 5 Shah Industrial Estate, Veera Desai Road, Andheri (West) Mumbai 400053, represented in these proceedings by Brain League IP Counsels of Bangalore, India.

The Respondent is Himansu Dase of J-8 Sector -1 Avanti Vihar, Telebandha, Raipur 492006 Chhattisgarh, India.

Himansu Narayan

2. The Domain name, Registrar and Policy

This Arbitration pertains to a dispute regarding the domain name <yashraj.in>. The registrar for the disputed domain name is Transecute Solutions Pvt. Ltd.

The Arbitration Proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the .IN Domain Name Dispute Resolution Policy (the “INDRP Policy” or “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 January 11, 2012 and on January 12, 2012 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 a 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 an Indian movie production house established in the year 1970. The Complainant owns the trademark YASH RAJ and has provided a list of its trademark registrations in India under classes 41, 25, 9, 16. In particular the Complainant has provided details of its Indian trademark registration for the trademark YASH RAJ bearing registration number 1291863 under class 9, YASH RAJ (device) mark bearing number 1291864 under class 16, YASH RAJ trademark registration number 1291865 under class 25, YASH RAJ trademark registration number 1291866 under class 41.

The Complainant also owns the trademark YASH RAJ FILMS bearing registration number 1037881 under class 9, registration number 1037822 under class 16 and registration number 1037883 under class 25 for the said mark.

The Respondent registered the disputed domain name <yashraj.in> on February 22, 2011.

4. Parties contentions

A. Complainant's Submissions

The Complainant states it is a leading film production house that adopted the trademark YASH RAJ in the year 1973. It contends that the trademark has been used continuously since 1973 in connection with its business of movie

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production and for related areas like music production. The Complainant states it has extensively marketed its products under the mark and acquired worldwide popularity, goodwill and reputation due to its long-term usage of the mark. The Complainant states it has an enviable film catalogue and Hollywood Reporter lists it as the number one film distribution house in India and twenty- seventh in the world in 2004. The Complainant states its works are the subject of multiple licenses in various media and that it has produced fifty films till date.

The Complainant states its trademark is derived from the name of its founder chairman Yash Raj Chopra and contends the mark has become a famous household name in India. The Complainant states YASH RAJ is also part of its corporate and trading name and the disputed domain name that contains the YASH RAJ mark is phonetically and visually identical or confusingly similar to its mark.

The Complainant argues that the Respondent has no rights and legitimate interests in the disputed domain name, as the Respondent is not known by the name nor is it the Respondent's personal name. The Complainant believes the Respondent is not engaged in any business or commerce using the said name and therefore the Respondent does not use the disputed domain name in connection with a *bona fide* offering of goods or services and as the Respondent's website has no content, it also indicates the Respondent's lack of rights and legitimate interests alleges the Complainant.

The Complainant states the disputed domain name was registered and is being used in bad faith as the Respondent seeks to exploit its famous mark to

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divert Internet users by creating a false impression of association with the Complainant's mark. The Complainant asserts that the Respondent knew of the famous mark and the registration of a name that is obviously connected with the Complainant shows the Respondent's opportunistic bad faith. The Complainant therefore requests for the transfer of the disputed domain name.

Respondent's Submissions

The Respondent did not respond in these proceedings

Discussion and Findings

Under the .IN Policy, the registrant of the domain name is required to submit to a mandatory arbitration proceeding in the event that a complaint is filed in the .IN Registry, in compliance with the .IN Policy and the INDRP Rules.

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.

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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.

It is well established, that trademark registration is recognized as *prima facie* evidence of rights in a mark. The Complainant has provided details of its registered trademarks that establish its rights in the trademark YASH RAJ. The disputed domain name incorporates the YASH RAJ mark in its entirety; A domain name that entirely incorporates the Complainant's mark is sufficient to establish the confusing similarity of the disputed domain name with the mark. See *The Hershey Company v. Rimi Sen, Corporate Domains*, INDRP case 289 <hersheys.co.in>. The country code top-level domain “.in” (cc TLD) suffix does not lessen the confusing similarity of the domain name with the trademark. *The Hershey Company v. Rimi Sen, Corporate Domains* [supra].

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

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.

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The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name, as the Respondent is not known by the name nor is it the Respondent's personal name, further the Respondent is not engaged in any business or commerce using the said domain name for a *bona fide* offering of goods and services. Under Paragraph 7 of the Policy, a Respondent or a registrant of a domain name 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 materials that show rights in the disputed domain name. The Arbitrator finds the material on record does not show the Respondent is commonly known by the disputed domain name. If the Respondent does not put forward any evidence that it is known by the disputed domain name, there is a strong basis to infer that the Respondent lacks rights. See *Starbucks Corporation v. Mohan Raj* INDRP case 118, (<starbucks.co.in> November 26, 2009). Further, there is no indication from the material on record that the Respondent is using the disputed domain name for a *bona fide* offering of goods or services or for any legitimate noncommercial fair use purposes.

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The use of the Complainant's mark in the disputed domain name in the Arbitrator's view is likely to mislead the public and Internet users that the disputed domain name may refer to the Complainant. Misleading users by incorporating others trademarks in a domain name gives a false impression to users. Under the circumstances the lack of content, as argued by the Complainant, also indicates the Respondent has no rights or legitimate interests.

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 and has satisfied the second element under paragraph 4 of the Policy.

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 asserted that the Respondent has registered the disputed domain name in bad faith for the reasons: that the Complainant has established rights in the trademark YASH RAJ, 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; The Complainant's prior adoption of the mark predates the Respondent's domain name registration. The registration of a name that is obviously connected with the Complainant indicates the Respondent's opportunistic bad faith and the passive holding of the disputed domain name containing the Complainant's mark indicates bad faith use.

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The Arbitrator finds the Complainant has filed documents that establish its prior adoption and use of the YASH RAJ mark. Further, the Complainant's trademark applications were made much before the disputed domain name was registered. The evidence on record shows the Complainant's trademark is well known and it is therefore unlikely that the Respondent was unaware of the Complainant's prior rights in the mark at the time of registration of the disputed domain name. The choice of the domain name therefore appears to be a deliberate use of a well-recognized mark, which is recognized as bad faith registration under the Policy. See *Lego Juris v. Robert Martin*, INDRP / 125, February 14, 2010. (Registration of a domain name, based on awareness of a complainant's trademark rights is indicative of bad faith registration under the Policy.)

The Registration of a domain name that is confusingly similar or identical to a famous mark by an entity that has no relationship to the mark is evidence of bad faith registration and use and suggests Respondent's opportunistic bad faith. See *The Ritz-Carlton Hotel Company LLC v. Netlon*, INDRP Case 250, Dec 30 2011, <ritzcarlton.in>. (Where the domain name is so obviously connected to the complainant, the registration and use by the respondent suggests opportunistic bad faith, citing *Pavillion Agency v. Greenhouse Agency Ltd.* WIPO Case 2000-1221).

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

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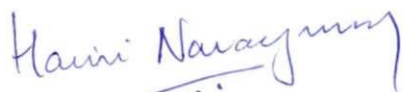
faith. The Arbitrator finds the circumstances here suggest that there is no reasonable explanations for the registration and use of the disputed domain name except that the Respondent seeks to exploit the reputation and goodwill associated with the Complainant's mark in the manner mentioned under Paragraph 6 (iii) of the Policy to mislead customers, which is considered bad faith registration and use of the disputed domain name.

The Respondent in the present case is found to have registered the disputed domain name to get undue advantage of the goodwill associated with the Complainant's trademark, and is found to have registered and used of the disputed domain name in bad faith, as understood under the INDRP Policy.

Decision

The Complainant has established the disputed domain name is identical or confusingly similar to a mark in which it has rights, 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. The Complainant has successfully established the three grounds required under the Policy to succeed in these proceedings.

For the reasons discussed, it is ordered that the disputed domain name: <yashraj.in> be transferred to the Complainant.



Harini Narayanswamy (Arbitrator)

Date: March 10, 2012