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BEFORE THE INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

ARBITRATOR : S. SRIDHARAN

Dated : 20th February 2009

G.A. Mode fine S.A
v

--- Complainant

Naveen Tiwari
trading as MKH&T

--- Respondent

Sridharan

Arbitrator

BEFORE THE INTERNET EXCHANGE OF INDIA

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ARBITRATOR: S.SRIDHARAN

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G.A. Modefine S.A.

Complainant

Versus

Naveen Tiwari trading as MKHOJ

Respondent

1. The Parties

1.1 The Complainant is G.A. Modefine S.A, a public limited company registered under the laws of Switzerland, having its office at Via Penate 4 Mendrisio 6850, represented by its counsel, Anju Agrawal of L.S.Davar & Co at 5/1, First Floor, Kalkaji Extension, New Delhi - 110 019.

1.2 Respondent is Naveen Tiwari trading as MKHOJ, at 1917, #2B, Raheja Classique, New Link Road, Andheri (W), Mumbai.

The Domain Name and Registrar

1.3 The disputed domain name **<armani.co.in>** is registered with Net4India.

2. Procedural History

2.1 On 27th January 2009, the Arbitrator sent an electronic version of the signed Statement of Acceptance and Declaration of Impartiality and Independence.



- 2.2 On 28th January 2009, the Arbitrator received hardcopy and soft copy of the Complaint along with Annexures.
- 2.3 On 28th January 2009, the Arbitrator issued by email a Notice to the Respondent setting forth the relief claimed in the Complaint and directing him to file his reply to the Complaint within 15 days. Arbitrator also sent an email about his appointment to arbitrate the complaint to the Complainant.
- 2.4 On 29th January 2009, the Complainant sought permission to submit case laws in support of her case. Arbitrator directed the Complainant to submit case laws.
- 2.5 On 12th February 2009, the Complainant submitted case laws by email. On 14th February 2009 Arbitrator received case laws by courier.
- 2.6 The Respondent has not entered appearance. He has not filed any reply to the Complaint of the Complainant.

3. **Factual Background**

A **Complainant**

- 3.1 One Mr. Giorgio Armani show cased his fashion collection in Italy first in 1974 under ARMANI trade mark. The Complainant Company was incorporated in Switzerland in the year 1988.
- 3.2 The Complainant has about 263 trade mark registrations for the mark ARMANI throughout the world, including India. Complainant is also the registered proprietor of the trade marks consisting of the word Armani as

an integrant part throughout the world including India. The Complainant has the following registrations in India:

S.No.	Trade Mark No.	Class	Trade Mark
1	758810	09	Emporio Armani
2	756807	03	Emporio Armani
3	756808	25	Emporio Armani
4	1041618	25	AX Armani Exchange
5	1341799	7, 11, 20, 35	Armani Casa
6	1008222	3	Emporio Armani
7	1008221	3	Emporio Armani
8	756811	18	Emporio Armani

3.3 The Complainant has about 650 domain names registered in its name throughout the world, all having ARMANI as a significant part thereof. In India, the Complainant has the following domain names.

S.No	Domain Name	Expiry Date
1.	<u>GIORGIOARMANI.CO.IN</u>	8 JUL 2016
2.	<u>EMPORIOARMANI.CO.IN</u>	23 JUL 2016

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3. ARMANIPRIVE.CO.IN 15JUN2011
4. ARMANIJUNIOR.IN 1 FEB 2013
5. ARMANIJUNIOR.CO.IN 1 FEB 2013
6. ARMANICOLLEZIONI.IN 1 FEB 2013
7. ARMANICOLLEZIONI.CO.IN 1 FEB 2013
8. ARMANICASA.IN 1 FEB 2013
9. ARMANICASA.CO.IN 1 FEB 2013

3.4 It is evidently clear from the above that the Complainant is the prior adopter and user of the word ARMANI as trade mark throughout the world, including INDIA.

3.5 The approximate international/ worldwide sales of the goods of the Complainant bearing the trade mark ARMANI for the past six years are as follows:

YEAR	Sales (in millions of EURO)
2002	2,503.67549438
2003	3,603,132,773.11
2004	3,082.42759642
2005	3,293.92361921
2006	2,755.99502859
2007	2,352.79270203

3.6 At all material times, the trade mark **ARMANI** when used on or in relation to the aforesaid goods has indicated and still indicates to purchasers and

intending purchasers as goods of the Complainant and none other. Complainant filed copies of some magazines and advertisement material of the mark ARMANI.

- 3.7 The goods sold and offered for sale by the Complainant under the trade mark ARMANI are of excellent quality and thus have acquired reputation and goodwill throughout the world, including India and intending purchasers identify and recognize goods of the Complainant by the trade mark ARMANI.
- 3.8 The Complaint is the exclusive proprietor of trade mark ARMANI.
- 3.9 The Complainant was the first to register the disputed domain name <armani.co.in> in its name. The registration was made on 8th Jul 2004 by C-Dac under the sunshine policy, which was intended to protect the registered proprietors of their respective trade marks. Subsequently the Domain name was transferred to Net 4 India.
- 3.10 The disputed domain name <armani.co.in> was renewed with effect from 8 July 2006 for a period of one year. The next renewal fell due on 8 July 2007. The Complainant applied for renewal. But the sponsoring registrar declined to renew the same. The Complainant issued legal notice to the registrar. The Registrar replied that disputed domain name <armani.co.in> was not timely renewed by the Complainant and refused to transfer the same to the Complainant.

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3.11 Consequently the Complainant has submitted this matter for arbitration seeking *inter alia* transfer of the disputed domain name <armani.co.in> to the Complainant from the Respondent.

B Respondent

3.12 The Respondent has not filed any reply to the Complainant's Compliant.

4. Parties Contentions

A Complainant

4.1 The disputed domain name <armani.co.in> is identical to the well known and registered Trade Mark ARMANI of the Complainant.

4.2 The Respondent has no right or legitimate interest in respect of the impugned domain name. ARMANI is not the personal or surname name, trade/ service mark, trading name, of the Respondent. He has no reason whatsoever to adopt the disputed domain name <armani.co.in> wholly consisting of Complainant's well-known registered trade mark ARMANI. The Respondent is called upon to state why he adopted the disputed domain name <armani.co.in>. Further, it is pertinent to note that when a user types the domain name <armani.co.in> in the internet explorer he is directed to the principal domain of the Complainant www.armani.com.

4.3 The Respondent, to the best of the knowledge of the Complainant, has adopted the impugned domain name with dishonesty and bad faith with the mala-fide intention to trade upon the goodwill and reputation associated with the trade mark ARMANI of the Complainant, thereby



earning undue profits. This is evident from the fact that the registrant has linked his domain name to that of the Complainant. It is pertinent to note that when a user types the domain name **<armani.co.in>** in the internet explorer he is directed to the principal domain of the Complainant i.e. www.armani.com .

- 4.4 The Complainant was the first registrant of the disputed domain name **<armani.co.in>**. It was periodically renewed till 2007. When it applied for renewal in 2007, the sponsoring registrar declined to renew the same. The Complainant issued legal notice to the registrar. The Registrar replied that disputed domain name **<armani.co.in>** was not timely renewed by the Complainant. Therefore it was registered in the name of the Respondent and refused to transfer the same to the Complainant.
- 4.5 It is apparent that the Respondent has registered the disputed domain name for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who is the proprietor of the trade mark and trade name ARMANI, or to a "competitor of the Complainant, for a valuable consideration.
- 4.6 The Respondent has registered the impugned domain name in order to prevent the Complainant - the proprietor of the trademark and / or service mark ARMANI from reflecting the mark in a corresponding domain name.
- 4.7 By using the impugned domain name, the Registrant has intentionally attempted to attract Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the

Complainants' trade name or trade mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

B. Respondent

4.8 Respondent has not filed any reply to the Complainant's Complaint.

5. Discussion and Findings

5.1 The Complainant in order to succeed in the Complaint must establish under Paragraph 4 of .IN Domain Name Dispute Resolution Policy (INDRP) the following elements:

- (I) Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (II) Respondent has no rights or legitimate interests in respect of the domain name; and
- (III) Respondent's domain name has been registered or is being used in bad faith.

5.2 Each of the aforesaid three elements must be proved by a Complainant to warrant relief.

5.3 The Complainant has submitted the following case laws in support of her complaint.

(a) *Yahoo Inc v Akash Arora* 1999 PTC (19) 201 (Del)



(b) *Acqua Minerals Limited v Pramod Borse & Anr 2001 PTC 619 (Del)*

(c) *Satyam Infoway Ltd v. Sifynet Solutions Pvt Ltd 2004 (28) PTC 566 SC*

Disputed domain name is identical or confusingly similar to a trade mark of the Complainant

5.4 The Complainant is the proprietor of the mark ARMANI and has been using the mark ARMANI since 1974. The Complainant has about 263 trade mark registrations for the mark ARMANI throughout the world, including India. Complainant is also the registered proprietor of the trade marks consisting of the word ARMANI as an integrant part throughout the world including India.

5.5 The Complainant has about 650 domain names registered in its name throughout the world, all having ARMANI as a significant part thereof. In India, the Complainant has the following domain names.

www.qiorgioarmani.co.in

www.emporioarmani.co.in

www.armaniprivexo.in

www.armanijunior.in

www.armaniiunior.co.in

www.armanicoliezioni.in

www.armanicoilezionixoxo.in

www.armanicasa.in

www.armanicasaxo.in

5.6 The Complainant's trade mark was registered first in India in 1997. The Complainant first registered the disputed domain name <armani.co.in> in his name on 8th July 2004. The disputed domain name <armani.co.in> was registered by the Respondent only on 17th April 2007. The

Complainant is the prior adopter of the mark ARMANI, disputed domain name <armani.co.in> and other domain names incorporating the trade mark ARMANI. The above facts have established that the Complainant has both common law and statutory rights in respect of its trade mark ARMANI.

5.7 The Complainant's ARMANI mark is well known throughout the world including India. It is clearly seen that the disputed domain name <armani.co.in> wholly incorporates ARMANI, the prior registered trade mark of the Complainant.

5.8 I, therefore, find that:

- (a) The Complaint has both common law and statutory rights in respect of its trade mark ARMANI.
- (b) The disputed domain name <armani.co.in> is confusingly similar to the Complainant's prior registered trade mark ARMANI.

Respondent has no rights or legitimate interests in respect of the disputed domain name

5.9 It is already seen that the Complainant is the prior adopter and user of the mark ARMANI. The Complainant's mark ARMANI is well known in many countries across the globe including India.

5.10 The Complainant's trade mark was registered first in India in 1997. The Complainant first registered the disputed domain name <armani.co.in> in



his name on 8th July 2004. The disputed domain name **<armani.co.in>** was registered by the Respondent only on 17th April 2007.

5.11 The Respondent has not filed any reply and has not come up with any reason for adopting the disputed domain name **<armani.co.in>**.

5.12 The Respondent has no right or legitimate interest in respect of the impugned domain name. ARMANI is not the personal or surname name, trade/ service mark, trading name, of the Respondent. Further, it is pertinent to note that when a user types the domain name **<armani.co.in>** in the internet explorer he is directed to the principal domain of the Complainant www.armani.com.

5.13 I tried to visit the web site under the disputed domain name **<armani.co.in>**. I typed the disputed domain name **<armani.co.in>**. But it did not resolve into any web site. I was informed that server was not found. It appears that the Respondent has stopped, after filing of the Complaint, using the disputed domain name **armani.co.in>**. But, according to WHOIS data base, the Respondent still is the registrant of the disputed domain name **armani.co.in>**

5.14 For the reasons, namely (a) Respondent has not filed any reply and has not come up with any reason for adopting the disputed domain name **<armani.co.in>**, (b) Respondent directed the web site under the disputed domain name **<armani.co.in>**, to the official web site of the Complainant till the filing of the Complaint, and (c) Respondent has stopped using the disputed domain name **<armani.co.in>**. after filing of the Complaint, I

conclude that the Respondent has no right or legitimate interest in respect of the disputed domain name <armani.co.in>.

Respondent's domain name has been registered or is being used in bad faith.

5.15 The Complainant's well known trade mark ARMANI was adopted in the year 1974. The Complainant was first registered the disputed domain name <armani.co.in> in his name in 2004. It was renewed from time to time. I gather from the records that the Complainant failed to renew the same on 30th January 2007 and the disputed domain name <armani.co.in> was freely available to third parties for registration. The Respondent got registered it on 17th April 2007. The Complainant issued a legal notice to the sponsoring registrar on 18th January 2008 for transfer the disputed domain name <armani.co.in> to the Complainant. But the sponsoring registrar by his letter dated 1st February 2008 refused to oblige the Complainant. Thereafter, the Complainant filed this Complaint in January 2009.

5.16 Mere non-renewal of disputed domain name <armani.co,in> in 2007 by the Complainant does not entitle the Respondent to adopt the same. Even in the absence of prior adoption of disputed domain name <armani.co.in> the Complainant is entitled to take action against the Respondent. It is because the disputed domain name <armani.co.in> wholly incorporates the prior registered well known trade mark ARMANI of the Complainant. Further, the Respondent has not come up with any

reason for adoption of the disputed domain name **<armani.co.in>**. Respondent directed the web site under the disputed domain name **<armani.co.in>** to the official web site of the Complainant.

- 5.17 It is apparent that the Respondent has registered the disputed domain **<armani.co.in>** name for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who is the proprietor of the trade mark and trade name **ARMANI**, or to a competitor of the Complainant, for a valuable consideration.
- 5.18 The Respondent has registered the impugned domain name in order to prevent the Complainant - the proprietor of the trademark and / or service mark **ARMANI** from reflecting the mark in a corresponding domain name.
- 5.19 By using the disputed domain name **<armani.co.in>**, the Respondent has intentionally attempted to attract internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainants' trade name or trade mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.
- 5.20 The above facts have clearly established the bad faith registration of the disputed domain name **<armani.co.in>** by the Respondent.



5.21 The actions of the Respondent should not be encouraged and should not be allowed to continue. The conduct of the Respondent has necessitated me to award costs of the Complaint to and in favour of the Complainant.

6. Decision

6.1 For all the foregoing reasons, the Complaint is allowed as prayed for in the Complaint.

6.2 It is hereby ordered that the registration of disputed domain name **<armani.co.in>** in the name of the Respondent be cancelled.

6.3 It is hereby ordered that the disputed domain name **<armani.co.in>** be transferred to the Complainant.

6.4 Respondent is ordered to pay the Complainant a sum of Rs.5,00,000/- (Rupees five lakhs only) towards costs of the proceedings.



S.Sridharan
Arbitrator