

INDRP ARBITRATION CASE NO.1881
THE NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: AJAY GUPTA

GUANGDONG SKMEI WATCH MANUFACTURE CO. LTD.

VERSUS

T G Quality Products

DISPUTED DOMAIN NAME : "SKMEICO.IN"

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ADMINISTRATIVE PANEL DECISION
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GUANGDONG SKMEI WATCH MANUFACTURE CO. LTD.,
Floor 3, Block C6 Wanyang Zhongchuang Industrial Park,
41, Dawang Road, High-tech Zone,
Sihui City, Zhaoqing City, Guangdong,
Province China,
China Email : hkintelmark@hkindia.com

...Complainant

VERSUS

T G QUALITY PRODUCTS
C-1, 1st Cross Road,
Sanjeevini Nagar, Hegganahalli Cross
Bengaluru State: Karnataka
Email : tgqualityproducts@gmail.com

...Respondent

Disputed Domain Name: "SKMEICO.IN"

1. The Parties

- 1.1 The **Complainant** in this arbitration proceedings is GUANGDONG SKMEI WATCH MANUFACTURE CO. LTD. who is manufacturer of various type of Multifunctional Digital watches, Heart Rate watches, smart watches, smart bracelets, classic Gent watches, classic lady watches etc., under brand SKMEI, and its contact address is ; Floor 3, Block C6 Wanyang Zhongchuang Industrial Park, 41, Dawang Road, High-tech Zone, Sihui City, Zhaoqing City, Guangdong, Province China, China.
- 1.2 The Complainant in this administrative proceeding is represented by its **authorized representative**, Dr. Rajesh Kumar H. Acharya Advocate, Patent and Trade Marks Attorney and/or Ms. Harsha R. Acharya, Advocate and Trade Marks Attorney and/or Mr. Ketan G. Bhatt Advocate and Trade Marks Attorney, and/or Mr. Omkar R. Acharya Advocate and Trade Marks Attorney, and/or Ms. Pooja O. Acharya, Advocate and Trade Marks Attorney, and/or Ms. Sejal D. Shah, Trade Marks Agent and/or Ms. Dimple M. Dave, Trade Marks Agent of Law office of H K ACHARYA & COMPANY, Advocate, Patent and Trade Marks Attorney, HK Avenue, 19, Swastik Society, Navrangpura, Ahmedabad 380009 INDIA, Phone: 9586875302 Fax: +917926425263, E-mail: hkintelmark@hkindia.com.
- 1.3 The **Respondent**, in this arbitration proceeding, is, TG Quality Products, address at C-1, 1st Cross Road, Sanjeevini Nagar Hegganahalli Cross, Bengaluru State: Karnataka (tgqualityproducts@gmail.com) as per the details given by the WHOIS database maintained by the National Internet Exchange of India (NIXI).

The Domain Name and Registrar

- 1.4 The disputed domain name is "skmeico.in". The Registrar with which the disputed domain name is registered is GoDaddy.com.

2. Procedural History [Arbitration Proceedings]

- 2.1 This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy [INDRP], adopted by the National Internet Exchange of India(NIXI). The INDRP Rules of Procedure [the Rules] were approved by NIXI on 28th June 2005 in accordance with the Indian Arbitration and Conciliation Act,1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes pursuant to the IN Dispute Resolution Policy and Rules framed there under.

- 2.2 The history of this proceeding is as follows :

2.2.1 In accordance with the Rules 2(a) and 4(a), NIXI on 29.07.2024 formally notified the Respondent of the complaint, and appointed me as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, and the Rules framed there under, .IN Domain Resolution Policy and the Rules framed thereunder. I submitted the Statement of Acceptance and Declaration of Impartiality and Independence Dated 29.07.2024 vide mail Dated 29.07.2024, as required by NIXI.

2.2.2 That commencing the arbitration proceedings an Arbitration Notice Dated 30.07.2024 was sent to the Respondent by this panel under Rule 5(c) of INDRP Rules of Procedure with direction to file reply of the

complaint if any within 10 days. The copy of complaint was also emailed to Respondent by Complainant on the directions of this panel on 30.07.2024. The Complainant on 31.07.2024 also sent the hard copy of complaint to the Respondent through Registered post (AD) on address as mentioned in WHOIS details. The Complainant, via email dated 08.08.2024 informed this panel ,that the envelop containing the copy of the complaint returned back un served because of the reason "incomplete address". This panel however, on query from the complainant informed him that no more action is required from the complainant, to serve the hard copy of the complaint to the respondent since he has already received the soft copy of the arbitration notice as well as copy of the complaint with annexures, and has also replied via his email dated 30.07.2024 as stated below.

2.2.3 The Respondent on receipt of the arbitration notice dated 30.07.2024 of this panel via email dated 30.07.2024, revert back via email dated 30.07.2024 and asked **(Hello, What is this regarding?)**. This panel in response to query of the Respondent , informed him via email dated 30.07.2024 about the complaint filed by Complainant for transferring of the disputed domain name "skmeico.in" from Respondent to the complainant.

2.2.4 The Respondent in response to the above email of this panel replied via email dated 30.07.2024, which is reproduced as under :

"We don't do illegal business in India. We legally do business in India."

We directly purchase from the manufacturer and proofs are attached.

The domain we are using from past 2021 and we don't use SKMEI logo in it.

Also please be noted that SKMEI is not a registered trademark in India. The logo attached in the annexure is fake.

*Attached proofs for your ref.
Also why should we transfer the domain when it's registered by us".*

The Respondent along with his also attached emails and copy of the invoices of business transactions between the respondent and complainant."

- 2.3 That following the above reply of the Respondent, the complainant via email dated 09.08.2024 submitted his response to the respondent's reply which is reproduced as under:

"With reference to the previous mail by the respondent dated 30/7/2024 and in reply of complainant submission for the disputed domain name SKMEICO.IN; the complainant would like to inform you that the respondent has furnished the copy of retailer invoices and stated that respondent as a Retailer does the business in India legally and assured that the respondent directly purchase from the manufacturer (i.e complainant). **In regard to the reply of respondent; we have to state that the retailers are not supposed to use the domain name of the complainant directly without any consent and also Retailers are not supposed to use the privilege of Registered domain name of the complainant.**

The respondent has submitted that he didn't use the skmei logo in the invoices or any other business activities

The statement submitted by the respondent is false and in appropriate. If the respondent didn't use the skmei logo why respondent has enforced to file trademark application in the name skmei.org. The complainant submits that being a retailer respondent filed trademark application skmei logo in his name

in an unauthorized manner for that the complainant vigilantly and effectively filed opposition to restrict the application from being registered. We are enclosing herewith the Respondent trademark status report for your kind perusal.

Also please be noted that SKMEI is not a registered trademark in India. The logo attached in the annexure is fake.

In reply of the above contention of the respondent, the complainant holds the exclusive rights over the registered brand name skmei vide application no.2927619 in class 14 for which complainant is herein producing documentary evidence for your ready reference and the status report itself proves that the complainant is the registered proprietor of the mark SKMEI in India.

Also why should we transfer the domain when it's registered by us.

In reply of the above contention of the respondent; the complainant submits that the respondent being a retailer is a well aware of the facts that complainant has accomplished abundant goodwill and reputation for the trading channel watches manufactured under brand name skmei in all over India and worldwide. Therefore respondent has mischievously adopted the brand name skmei to mislead consumers of the complainant. The complainant further submits that the respondent is the retailer of the complainant and therefore respondent is only authorized to sell the product namely SKMEI of the complainant and not to intervene in the goodwill or reputation of the complainants intellectual property rights. Thus, the complainant has immediately taken action against the domain name as well as trademark application of the respondent.”

2.4 That this panel after receiving the above stated reply by the respondent and response of the same there after by the complainant, on 10.08.2024 reserved the matter for passing of the award.

3. Background of the Complainant and its statutory and common law rights Adoption :

3.1 The Complainant, in the present arbitration proceedings to support its case, has relied and placed on records documents as Exhibits and made the following submissions:

3.1.1 The Complainant submits that,"Guangzhou SKMEI watch co., Ltd" (predecessors) was established in 2010 in mainland China and it's Headquarters located in Guangzhou, covering an area of 16000 square meters, including production Department, sales Team Branch in Shenzhen with R & D Department, Market operator Team having more than 300 employees.The Complainant submits that proprietors famous brand "SKMEI" has been registered in more than 60 countries and Registered proprietor specialize in manufacturing various type of Multifunctional Digital watches, Heart Rate watches, smart watches, smart bracelets, classic Gent watches, classic lady watches.

3.1.2 It is submitted that to ensure that all the SKMEI watches are with high quality and water resistant, they are 100% QC inspected and 100% waterproof-tested by the most advance waterproof testing equipment and precision testing apparatus. It is further submitted that every month "SKMEI" produce more than 1 Million pieces watches distributed by the wholesale's to over 150 countries. "SKMEI" brand having more than 4000 SKU for distributors/wholesalers to choose, full with all kinds of series, such as sport style, classic gents & lady style, kids watch, smart band, and now exploring many automatic watches with good quality and High cost performance, everyone can choose a suitable and reliable watch from SKMEI. The Complainant submits that with excellent quality and popular designs, reasonable price and quality assurance, SKMEI watch is enjoyed by customer in many countries. The Complainant submits that the Registered proprietor focus on "precision, quality, innovation, customer and services, aim to be a leading watch manufacturer and global famous

brand with best products, best qualities, and best service. The said trademark of the applicant is which has been coined and adopted is always associated with the applicant only and none another. It is submitted that the Applicant invented a trademark SKMEI and using from last many years worldwide and from December 2013 in India openly, extensively and uninterruptedly in the market.

4. Information about the company name change of complainant

4.1 The Complainant submits that the "Guangzhou SKMEI Watch Co., Ltd" was the predecessors of the complainant. That the complainant has changed the name of company from "Guangzhou SKMEI Watch Co., Ltd" to "GUANGDONG SKMEI WATCH MANUFACTURE CO. LTD." on 11th October 2022. That the complainant has already filed amendment application to change the name in the applications.

5. Adoption and Use of the marks of Complainant

5.1 The Complainant states that the Complainant engaged in the business of well established and reputable company involved in the manufacturing and trading of products under the mark SKMEI including, but not limited to wristwatches; clocks and watches, electric watches; clocks; movements for clocks and watches; presentation boxes for watches; chronometers; Ornaments (jewelry); works of art of precious metal; watch bands; watch straps; watch chains; watch bag (set); stopwatches; chronometric instruments. It is submitted that the coined and distinctive mark and its variants (hereinafter referred to as the "said SKMEI marks") have been bona-fidely adopted and have been used internationally since at least 2010. Further, since December Complainant has been using the mark 13, 2013 in India. It is submitted that the Complainant's goods under the mark are exported

to all over The Globe including but not limited to 152 countries. It is submitted that Complainant's products under the said SKMEI marks are available in several jurisdictions. The Complainant submits that it has distributors in several countries around the world for its products under the said SKMEI marks. The Complainant states that due to long and extensive use and excellent quality of products, the said marks/labels have a very good reputation and goodwill in the Indian as well as in the International market. It is submitted that the Complainant's said trademark/label is identified and recognized by the traders, consumers and the general public as the SKMEI and it has become solely associated with the Complainant's products.

- 5.2 The Complainant states that the Complainant has spent considerable amount of time, money and efforts towards the marketing and promotional activities and that due to the said efforts, the Complainant's products/services under the said trademarks/labels have very good demand and sales of the Complainant's products/services are increasing time to time. The said marks/labels have acquired goodwill and reputation to the extent that any reference of the said trademark or any similar mark if referred in the market, it will lead people to believe that the said reference is in respect of the Complainant and its products/services and none else. Thus, the said trademarks/labels have become well reputed in the market and therefore, the turnover of the Complainant's company has increased from time to time. It is submitted that the Complainant company has sales Approx 57,00,000 no. of unit in varieties of wristwatch in world wide.

6. **Details About the Brand of Complainant**

6.1 The Complainant submits that to ensure that all the products under the brand SKMEI are with high quality and water resistant, they are 100% QC inspected and 100% waterproof-tested by the most advanced waterproof testing equipment and precision testing apparatus. It is further submitted by the complainant that, the products under the said SKMEI marks have also received various certifications and conform to several standards, and owing to the excellent quality, popular designs, reasonable price and quality assurance, the products under the said SKMEI marks are enjoyed by customers in numerous countries around the world. It is submitted that over the years, the Complainant has been selling numerous goods under the mark "SKMEI" and its variants in India.

7. **Applications of India and other countries of Complainant**

7.1 The Complainant submits that, it has sought for/secured registration of the said SKMEI marks in India and has submitted details and evidence in support of this, and in addition to this, the complainant has also submitted documentary evidence relating to Foreign Registration of the said SKMEI marks. The Complainant submits that the said registrations are renewed from time to time and are valid and subsisting till today. The Complainant submits that, thus the Complainant is the registered proprietor of the said trademarks/labels and has exclusive rights to use the said marks/labels and to restrain others from using any identical or deceptively similar mark in the market. The Complainant further submits that it has acquired the common law right to use its trademark/label as well as to getting registration for any identical or deceptively similar trademark/label in the market. The Complainant submits that it has nominate Digjay Pravinbhai Mangukiya B/3, Saurashtra township, Sudama Chowk, Mota

Varachha, Surat as one and only Exclusive Registered User in INDIA for the entire territory of India and has also submitted details about the agreement in this regard.

7.2 The Complainant submits that each brand is created keeping in mind the varied parameters of consumers style and with superior quality, distinct aroma and rich look, each watch variant of the Complainant is surging ahead in becoming the final choice of Wristwatches lovers. The complainant submits that, it strives at introducing new products or Wristwatches into the store frequently and keeping them in the loop of mature growth stage of market. It is submitted that the Complainants are amongst the largest traders in India and proud of serving millions of Wristwatches lovers across the globe. The Complainant states that the products of the Complainant's Company enjoy high reputation and immense goodwill in the market. The complainant submits that the details of its products, achievements and other information regarding complainant's company can be obtained from the website: <http://www.skmei.com>.

8. Official Websites

8.1 The Complainant submits that the official website of Complainants, i.e. <https://skmei.com/> showcases the said SKMEI marks extensively. Further, complainant also has a website catering to Indians specifically i.e. <http://www.skmeindia.com/>. It is submitted that these websites are accessible to people across the globe, including India and provide a platform for consumers to receive information about complainant; its products sold under the said SKMEI marks and as a result the said SKMEI marks enjoy tremendous reputation worldwide, including in India. Further, the domain name <skmei.com> has been registered since April 22, 2010 and the domain name <skmeindia.com> has been registered

since April 1, 2023 which comprises complainant's mark SKMEI in its entirety.

9. Social Media Presence

9.1 **The Complainant submits that it** also has strong presence over social media websites such as Facebook, Twitter, etc. wherein Complainant's said SKMEI marks have been extensively showcased. The Complainant submits that it is pertinent to note that as of January 10, 2024 complainant's Facebook page has garnered over 1,28,000 likes and 1,33,000 followers. This popularity on social media sites evidences that the general public has come to be familiar with the said SKMEI marks and associate the same with complainant exclusively.

10. Advertisement and Promotion

10.1 The Complainant submits that SKMEI marks have been advertised and promoted around the world and the same has led to the public at large being familiarized with the said SKMEI marks of Complainant and consequently, the said goods provided by Complainant are being identified, distinguished, demanded, provided, and rendered under Complainant's said SKMEI marks.

11. Sale through online retail stores

11.1 **The Complainant submits that** the complainant's goods bearing the said mark "SKMEI" and its variants are available for sale through major online retail stores like Paytm, Alibaba, SnapDeal, Amazon, Bonzeal etc. Thus, the goods under the mark "SKMEI" and its variants are easily available for the relevant public in India to purchase and view. Hence, the relevant public in India has come to associate the said mark and its variants with the Complainant exclusively. The Complainant further submits that the extensive sale of

products bearing the said SKMEI marks has further strengthened the formidable reputation of the said SKMEI marks of Complainant in India.

12. **Complainant's marks being Well-Known marks**

12.1 The Complainant submits that owing to the long use, advertisement, popularity, and recognition amongst the relevant public, the said SKMEI marks have acquired the status of well known marks within the meaning of S. 2 (1) (zg) of the Trade Marks Act, 1999 and have acquired immense reputation. The said SKMEI marks have become so popular worldwide, with respect to the said goods that the very mention of them recalls Complainants and its goods. It is submitted that the said SKMEI marks have created an exclusive place for themselves in the market as well as in the minds of the consumers, who associate the said SKMEI marks with Complainant's and its superior quality goods. It is submitted that Section 11(6) and 11(7) of the Act provide for the relevant factors that ought to be taken into account in order to determine a mark as being well-known. It is submitted that the said SKMEI marks have been used over a wide geographical area and the products thereunder have been sold in numerous jurisdictions (including in India) via online sale platforms as well as through direct sellers. The Complainant further submits, that with a production capacity of over 2,50,000 digital watches in a month, Complainant has achieved tremendous sale of its goods worldwide. Thus, the said SKMEI marks are well-known marks within the meaning of Sections 11(6) and 11(7) and deserve to be protected under Section 11(10) of the Act.

13. **MARK FORMING PART OF THE TRADE NAME OF COMPLAINANT**

13.1 It is submitted that the mark "SKMEI" also forms part of the trade name of Complainant i.e. "Guangdong Skmei Watch Manufacture Co. Ltd." and is therefore, entitled to even further protection under Article 8 of the Paris Convention for the Protection of Industrial Property, to which India is a signatory. [Article 8 reads, "A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark."] It is submitted that the complainant's domain name "skmei.com/skmeindia.com" is the part of complainant's company name. That the uses trade mark/trade name/ trading style as well as domain name "skmei" has been expanding across the globe gradually. Along with the expansion of worldwide use of the domain name; the said domain name "skmei.com/skmeindia.com" attained extensive Trans border reputation and huge goodwill.

14. THE COMPLAINANT' SUBMISSIONS ABOUT THE RESPONDENT

14.1 The Complainant submits that it has recently come across that the respondent is selling products under the brand "SKMEI" and that respondent have a website <http://www.skmeico.in>. It has also come to know that respondent do not have any registered trademark by the name of "skmei" in respect of the products for which complainant is registered proprietor as well as prior user. That the application no.4155426 in class 14 of the respondent is opposed and that too the opposition filed by the complainant i.e. GUANGDONG SKMEI WATCH MANUFACTURE CO. LTD. Thus, the complainant submits that the application of the respondent is insubstantial position and on the contrary complainant is using the trademark/ domain name SKMEI since the year 2013 in India and the respondent have initiated to file application in the year 2019

and therefore complainant is the prior user of the trademark SKMEI as well as domain www.skmei.com. It is further submitted that the respondents are mischievously using complainant's trademark/domain "skmei" as brand-name which amounts to a imitation/substantial reproduction of complainant's trademark/domain. It is evident that Respondent have systematically copied complainants marks/domain in a way to mislead the public and have sought to imitate complainant's products dishonestly and fraudulently with a view to pass off the products as those of complainant and to cause confusion. It is evident that such unauthorized use is deliberate, systematic and with a view to ride upon the reputation and goodwill of complainant in the said mark to make unlawful gains.

14.2 It is submitted that the respondents have registered the website <http://www.skmeico.in>. (the "Domain Name") with a malafide intention and to cause a commercial loss to complainant's. It is further submitted that the Complainant's website is www.skmei.com and www.skmeindia.com. The WebPages of the respondent itself establishes that the respondent has in bad faith adopted the mark/domain SKMEI as respondent has deliberately and to divert the customer mentioned the information of the complainant in their website. That web page attached herewith in evidence of the fact that this domain name has been taken only to mislead the public.

15. The issues involved in the dispute

15.1 The Complainant in its complaint has invoked paragraph 4 of the INDRP, which reads :

"Types of Disputes

Any person who considers that a registered domain name conflicts with his legitimate rights

or interests may file a Complaint to the .IN Registry on the following premises :-

The disputed domain name is identical or confusing similar to a trademark in which the Complainant has statutory /common law rights.

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

The disputed domain name has been registered or is/are being used in bad faith."

- 15.2 The above mentioned 3 essential elements of a domain name dispute are being discussed hereunder in the light of the facts and circumstances of this case.
- 15.3 This panel has made observations after going through the reply of the respondent to the complaint, and response of the complainant to the respondent's reply.

16. Parties Contentions

- 16.1 **The disputed domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights.**

Complainant

- 16.2 The Complainant submits that the word SKMEI is the forming part of the trade name of the complainant's company, i.e., GUANGDONG SKMEI WATCH MANUFACTURE CO. LTD., which was established in the year 2010 in Mainland China and the complainant has started to use the trademark SKMEI since the year 2013 in INDIA and since then complainant is using the said trademark as well as domain www.skmei.com/www.skmeindia.com continuously and openly in the trade segment. It is submitted that the

respondent has adopted the identical and/or ditto to ditto domain www.skmeico.in in the year 2021 and the Respondent has knowingly obtained registration of identical and/or ditto to ditto same/similar domain www.skmeico.in to create confusion and deception in the trade segment as well as in ecommerce websites. It is further submitted that due to such deceptively similar domain name; by searching the product of the complainant on google; respondent's website namely www.skmeico.in appears. It is submitted that the respondent is selling the identical product i.e. watches under the name of "skmei" in such a way that the Webpages of the Respondent itself establishes that the Respondent has in bad faith adopted the mark/domain SKMEI as respondent has deliberately and to divert the customer mentioned the information of the complainant in their website. The complainant has acquired the highest rating and reviews for their every products prominently listed in online shopping. The complainant has always maintained quality standards of the said goods under the domain "www.skmei.com/www.skmeindia.com" in the respective market. It is submitted that the respondent has slavishly copied and used the domain www.skmeico.in since the year 2021 with the prior knowledge of the complainant's first existence in the market. It is submitted that the registration of any domain www.skmeico.in which is ditto to ditto similar for the identical goods and in the same trade course can lead the complainant to monetary loss as the domain of the complainant is prior and the respondent is subsequent in user. It is further submitted that as the impugned domain www.skmeico.in is identically and/or ditto to ditto similar and/or confusingly similar, it is contrary to public interest and likely to have terrible and harmful consequences. It is submitted that there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the domain www.skmei.com/www.skmeindia.com of the

complainant. The goods of the respondent and the complainant are also same and/or similar for the products/goods covered under the respective trademarks/domain. Therefore, there is a clear chance of confusion and/or deception. It is submitted that the impugned domain would take unfair advantage of or be detrimental to the distinctive character and repute of the earlier domain. It is submitted that the complainant is using the trademark/trade name as well as domain "skmei" since the year 2013 in India and therefore complainant is the prior user, prior adopter, proprietor/registered proprietor of the trademark/domain "SKMEI" in India. That complainant has submitted the comparison of domain names as well as of trademarks which is as below :-

COMPLAINANT'S DOMAIN

RESPONDENT'S DOMAIN

www.skmei.com

www.skmeico.in

registered on 22/04/2010

registered on 14/06/2021

www.skmeindia.com

registered on 01/04/2023

COMPLAINANT'S MARK DISPLAYD IN WEBSITE SKMEI.COM



RESPONDENT'S MARK DISPLAYD IN WEBSITE SKMEICO.IN



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Handwritten signature

16.3 The Complainant submits that the above mentioned comparison of trademark as well as domain name itself proves that the respondent has copied the trademark and domain name identically/artistically as well as with identical color combination. Thus, It is submitted that the disputed domain name contains i.e. "skmei" of the respondent is identical and confusingly similar to a name, trademark "skmei" in which the complainant has rights.

16.4 It is submitted that there is a visible prominent feature of the logo



which is displayed only in domain name or website pages. It is further submitted that nowhere in the social media or online platform has such logo's existence on the products i.e. watches which is identical with the complainant's trading channel to be found. As such visible prominent logo of the respondent is identical to their domain name could ease to identify the consumers in the online platform and social media from its original source of the respective respondent. The complainant submits that the respondents has raised all the invoices and promoted in the online platform and social media while using the identical or ditto to ditto similar mark as compared to the Complainant/on



MEI

SKMEI

their products. It is submitted that the domain name 'skmeico.in' wholly incorporates the Complainant's registered brand 'skmei' which clearly refers to a key element of the

complainant's business i.e. watches. Therefore, this domain is identical/confusingly similar to the Complainant's 'skmei' brand. The Complainant submits that in the similar scenario it was observed by the - Hon'ble High Court of Delhi in the matter of Thoughtworks Inc. Vs. Super Software Pvt. Ltd. & Ors (MANU/DE/0064/2017) that "with the domain name taking up the entire name of the petitioner, there could be no doubt that the use of such domain name by the Respondent would be deceptively confusing and erroneously indicate a connection of Respondent No 1 with the Petitioner where there is none".

- 16.5 The Complainant submits that the registration and use of a identical/ confusingly similar domain name as that of trademark of the Complainant is a direct infringement and it was also observed in the matter of F Hoffman-La Roche AG vs Relish Enterprises (WIPO) D2007-1629, which states that –

"If the Complainant owns a registered trademark, then it satisfies the threshold requirement of having the trademark rights and the domain name is confusingly similar to Complainant's trademark because the disputed domain name looks and reads like Complainant's trademark".

- 16.6 It is submitted that in case of trademarks with well-built goodwill, reputation & wide spread presence on internet, any re-arrangement with substantial similarity was to encash the goodwill of the reputed trademarks by creating closer imitation. It was observed in the matter of Forest Laboratories Inc Vs Natural Products Solutions LLC Case No. D2011-1032.; Forest Laboratories Inc. Vs Clark Grace Case No. D2011-1006 (WIPO) that –

"Typosquatting involves the intentional rearrangement or change of a few letters in the mark to make a nonsensical but close imitation deliberately intended to catch a tired or careless typist's search for the mark wonder's website. Usually, the added or substituted letter or addition involves a character immediately adjacent to the replaced one" - [Eg. Amazon.com Vs Steven Newman Aka Jill Waserstein AKA Pluto Newman (WIPO)J,"

Respondent

16.7 The Respondent has not specifically replied to the above contentions of the complainant but has generally replied to the contents of complaint via his mail dated 30.07.2024 , and which have been duly considered by this panel.

17. Panel Observations

17.1 This Panel on pursuing the documents and records submitted by Complainant observe that the Complainant's famous brand "SKMEI" has been registered in many countries and is the Registered proprietor, which is specialize in manufacturing various type of Multifunctional Digital watches, Heart Rate watches, smart watches, smart bracelets, classic Gent watches, classic lady watches. It is observed by this panel that word SKMEI is the forming part of the trade name of the Complainant's company i.e. GUANGDONG SKMEI WATCH MANUFACTURE CO. LTD.and the mark SKMEI, is popularly known exclusively in relation to the Complainant. It is also observed by this panel that the Complainant has successfully secured registrations for the SKMEI marks India since 2013 and also in other countries.

17.2 The respondent in his reply has alleged that **"Also please be noted that SKMEI is not a registered trademark in India. The logo attached in the annexure is fake"**, this panel however, observed that the same is not correct as the

complainant in support of his submissions has attached as exhibits the certificates of Registration of trade mark of complainant's Mark "SKMEI" in India. The Complainant in response to the respondent's reply has also submitted that the complainant holds the exclusive rights over the registered brand name skmei vide application no.2927619 in class 14 for which complainant has produced documentary evidence and the status report , which also proves that the complainant is the registered proprietor of the mark SKMEI in India.

- 17.3 This panel further observe the fact that Disputed domain "www.skmeico.in" comprises the Complaint's trademarks "SKMEI" in their entirety and has the potential to cause consumer confusion and will cause the user into mistakenly believe that it originates from, is associated with or is sponsored by the Complainant, and further the addition of "co" after "skmei" mark of the complainant and suffix "in" is not sufficient to escape the finding that the domain is confusingly similar to Complainant's trademark.
- 17.4 Therefore, the panel is of opinion that disputed domain name "SKMEI.IN" being identical/confusingly similar to the trade mark of Complainant will mislead the public and will cause unfair advantage to Respondent. The Panel is of the view that there is likelihood of confusion between the disputed domain name and the Complainant, its trademark and the domain names associated. The disputed domain name registered by the Respondent is confusingly similar to the trademark "SKMEI" of the Complainant.
- 17.5 It has to be noted that the paragraph No.4 of the INDRP policy starts with following words :

"Any person who considers that a registered domain name conflicts with his legitimate rights or interest

may file complaint to the registry on the following premises."This is a positive assertion and sentence. Further pragraph 4(i) also constitutes a positive assertion and sentence. The above clearly indicates that the onus of proving the contents of para 4(i) is upon Complainant. To succeed he must prove them."

- 17.6 It has been proved by the Complainant that it has trademark rights and other rights in the mark "SKMEI" by submitting substantial documents in support of it. This panel while following the rule of law is of the opinion that while considering the trademark "SKMEI" in its entirety, the disputed domain name "skmeico.in" is confusingly similar to the trade mark of Complainant.
- 17.7 Paragraph 3 of the INDRP states that, it is the responsibility of the Respondent to find out before registration that the domain name he is going to register does not violate the rights of any proprietor/brand owner. It is observed by this panel that the Respondent in his reply has stated that "**We directly purchase from the manufacturer and proofs are attached**" and in support of his contentions the respondent has attached mail dated September 18,20219 between himself and the complainant, which itself proves that Respondent was aware of the complainant's mark "SKMEI" It is pertinent to note that the disputed domain was registered by the Respondent on 14.06.2021, which is much after the business transactions between the Respondent and Complainant as shown invoices submitted by the respondent.
- 17.8 This Panel therefore, in light of the contentions raised by the Complainant comes to the conclusion that the disputed domain name is confusingly similar to the Complainant marks. Accordingly, the Panel concludes that the Complainant has

satisfied the first element required by Paragraph 4(i) of the INDR Policy.

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

Complainant

18.1 The Complainant submits that the respondent has well within knowledge of the complainant's trademark as well as domain as the complainant is using the said trademark/ domain "skmei" since the year 2010 globally and since the year 2013 in India. It is submitted that the uses of trade mark/trade name/trading style as well as domain name "skmei" has been expanding across the globe gradually. Thus, it is submitted that the respondent does not have rights or legitimate interest in respect of domain name as respondent has no registered trade mark of the said domain name. It is further submitted that, the complainant being a registered proprietor has exclusive rights over the mark/ domain SKMEI vide registered trademark application number IRDI No.2927619. Therefore Complainant has initiated opposition procedure to restrict from getting registration of Respondent's trademark being a prior user and adopter. It is submitted that the respondent is seeking advantage of the well- known trademark/domain of the Complainant and is thereby tarnishing the reputation and trademark at issue. The trademark of the Complainant is well known, enjoys international reputation and trade name is known across the globe and the Respondent creates a deceptive domain name, the Respondent cannot be said to have a right or legitimate interest. The Complainant submits that it was also observed in the matter of Wockhardt Ltd vs Kishore Tarachandani: (INDRP Dispute Case No: INDRP/382)

"The Respondent cannot have a right or legitimate interest in the disputed domain name when it incorporates the entire mark of the Complainant Clear case of abusive registration of a well-known mark."

Respondent

18.2 The Respondent has not specifically replied to the above contentions of the complainant but has generally replied to the contents of complaint via his mail dated 30.07.2024 , and which have been duly considered by this panel.

19. Panel Observations

19.1 This Panel holds that the second element that the Complainant needs to prove and as is required by paragraph 4(ii) of the INDRP is that the Respondent has no legitimate right or interests in the disputed domain name.

19.2 This panel observes that the Complainant by placing documents/records along with complaint has been able to prove that Complainant is using the said trademark/domain "skmei" since the year 2010 globally and since the year 2013 in India, and the trade mark / trade name / trading style as well as domain name "skmei" is used globally.

19.3 The Respondent in his reply has submitted that **"We don't do illegal business in India. We legally do business in India. We directly purchase from the manufacturer and proofs are attached."** It is observed by this panel that the proofs so attached by the Respondent are the mails and Invoices between the business transactions of the Complainant and Respondent , which does not prove that Respondent has any rights or legitimate interests in respect of the disputed domain name. It rather proves that the Respondent was well aware of Complainant's right prior to the registration of the disputed domain name.

19.4 This panel observe that the complainant in his response to the respondent's reply has rightly submitted that that the

respondent is the retailer of the complainant and therefore respondent is only authorized to sell the product namely SKMEI of the complainant and not to intervene in the goodwill or reputation of the complainants intellectual property rights.

- 19.5 The Respondent thus, has failed to rebut the allegations of the Complainant that the respondent does not have rights or legitimate interest in respect of domain name.
- 19.6 Once the Complainant makes a prime facie case showing that the Respondent does not have any rights or legitimate interest in the domain name, the burden to give evidence shifts to the Respondent to rebut the contention by providing evidence of its rights or interests in the domain name. The Respondent has failed to give any evidence, showing its rights or interests in the domain name.
- 19.7 For these reasons, the Panel holds that the Complainant has proved that the Respondent does not have any rights or legitimate interests in the disputed domain name.
- 20. The disputed domain name has been registered or is being used in bad faith.**

Complainant

- 20.1 **The Complainant submits** that the domain name is registered by the respondent and is used in bad faith. It is further submitted that the WebPages of the respondent itself establishes that the respondent has in bad faith adopted the mark/domain SKMEI as respondent has deliberately and to divert the customers mentioned the information of the complainant in their website. It is submitted that the respondent is misleading potential customers to their website and the intention of the respondent could create a likelihood of confusion with the

complainant's company name, and trademark and therefore the respondent has registered the disputed domain name in bad faith also the contentions mentioned in the webpages – About us of the respondent regarding the establishment of complainant as a factory produce is just to deliberately divert the consumers of the complainant with the malafide-intention to interrupt the goodwill and reputation of the complainant.

- 20.2 It is submitted that the respondent's intention is not to act in good faith but has got registered the disputed domain name in bad faith. It is further submitted that as the trademarks/ trade names of the Complainant is so famous & also distinctive that the Respondent must have had actual knowledge of the trademark prior to registering the disputed domain name. There is a visible prominent feature of the



logo is displayed only in domain name or website pages. It is submitted that nowhere in the social media or online platform has such logo's existence on the products i.e watches which is identical with the complainant's trading channel be found. As such visible prominent logo of the respondent is identical to their domain name could ease to identify the consumers in the online platform and social media from its original source of the respective respondent. The complainant submits that the respondent has raised all the invoices and promoted in the online platform and social

media while using the identical or ditto to ditto similar mark as compared to the complainant/on their products. The



domain name 'skmeico.in' wholly incorporates the Complainant's registered brand 'skmei' which clearly refers to a key element of the complainant's business i.e. watches. It is therefore submitted that this domain is identical/confusingly similar to the Complainant's 'skmei' brand. The complainant has produced the sales invoices and online platform promotions in the name of respondent since the year 2019 dated 23/05/2019 for the brand SKMEI watch. The Complainant submits that it is pertinent to note that the extract copy taken from the evidences submitted by the respondent while filed for user claim in the trademark application No.4155426 for which its status report reveals that it was opposed by the respondent to restrict the registration of the said mark. The complainant submits that due to the high reputation of the trademark "skmei", the public will automatically recognize the contested domain name and will associate this domain name with the Complainant. It is further submitted that the internet users will have the false impression that the corresponding addresses www.skmeico.in is an official internet address of the Complainant. It is submitted that by registering the disputed domain name with actual knowledge of the Complainant's trademark, the Respondent acted in bad faith by breaching its service agreement with the Registrar because the Respondent registered a domain name that infringes upon the intellectual property rights of another entity.

20.3 The Complainant has relied upon the decision in case of Viacom International Inc & MTV Networks Europe vs Web Master (Case No. D2005-0321-WIPO) where it was held that

"Given long and widespread reputation of the Complainant's mark, the compelling conclusion is that the Respondent, by choosing to register and use a domain name which is not only confusingly similar to the Complainant's widely known and distinctive mark but identical thereto, intended to ride on the goodwill of the Complainant's trademark in an attempt to exploit, for commercial gain, Internet traffic destined for the complainant. Potential partners and end users are led to believe that the website is either the Complainant's site, especially made up for bearings, or the site of the official authorized partners of the Complainant, while, in fact, it is neither of these".

20.4 The Complainant submits that the Hon'ble High Court in the matter of ITC Ltd vs Travel India (Case No, L-2/5/R4 OF 2008 - NIXI), held that –

"Registration of domain name which is identical to trademark, with actual knowledge of the trademark holder's rights is strong evidence that the domain name was registered in bad faith"

Respondent

20.5 The Respondent has not specifically replied to the above contentions of the complainant but has generally replied to the contents of complaint via his mail dated 30.07.2024 , and which have been duly considered by this panel.

21. Panel Observation

21.1 Paragraph 7 of the INDRP provides that the following circumstances are deemed to be evidence that Respondent has registered and used a domain name in bad faith :

"Circumstances indicating that the Respondent has registered or has acquired the domain

name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrar's documented out of pocket costs directly related to the domain name; or

the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or

by using the domain name, the Respondent has intentionally attempted to attract internet user to its website or other on -line location, by creating a likelihood of confusion with the Complainant's mark as to the source , sponsorship, affiliation or endorsement of its Website or location or of a product or services on its website or location."

- 21.2 It is observed by this panel that the Respondent by attaching the copies of emails, sales invoices between himself and the complainant along with his reply dated 30.07.2024, has himself proved that the respondent was the purchaser of the Complainant since 2019 much prior to the registration of disputed domain name www.skmeico.in by the Respondent in year 2021.
- 21.3 It is thus, very clear that Respondent before registering the domain name skmeico.in had full knowledge of Complainant's rights in the trade mark SKMEI, which evidences bad faith. The registration of disputed domain name "skmeico.in" by the Respondent incorporating a well known mark of the Complainant in its entirety, is also evidence of bad faith.

- 21.4 This panel observes that the Complainant has successfully secured trademark registrations for the SKMEI mark in many other countries including India, and by using the disputed domain name, the Respondent has intentionally attempted to attract, internet users to the disputed domain's website by creating a likelihood of confusion with the Complainant's SKMEI mark.
- 21.5 By registering the disputed domain name with actual knowledge of the Complainant's trademark "SKMEI", the Respondent acted in bad faith by breaching its service agreement with the registrar, because the Respondent registered a domain name that infringes upon the intellectual Property rights of another entity, which in the present case is the Complainant Guangdong Skmei Watch Manufacture Co. Ltd.
- 21.6 The Respondent's registration of the domain name meets the bad faith elements set forth in the INDRP. Therefore the panel comes to the conclusion that the registration by Respondent is in bad faith. Consequently it is established that the disputed domain name was registered in bad faith or used in bad faith.

22. Remedies Requested

- 22.1 The Complainant has prayed to this Administrative Panel that the disputed domain <www.skmeico.in> be transferred to the Complainant and grant of cost.

23. Decision

- 23.1 The following circumstances are material to the issue in the present case :
- 23.1.1 The Complainant through its contentions based on documents/ records and evidence has been able to establish that the Complainant is the manufacturer of

different variety of the watches , which are famous by its brand name SKMEI all over the world including in India. The mark SKMEI, which is the Complainant's very trade name, is popularly known exclusively in relation to the Complainant. It is observed by this panel that the Complainant owns and operates the domain name www.skmei.com and www.skmeindia.com of the complainant, which incorporates the registered SKMEI mark and prominently feature the same and the website hosted on the domain is accessible all over the world, including India.

23.1.2 The Complainant has also been able to establish that, the Complainant has statutory rights in the Mark SKMEI through registration in many countries including India. The Respondent however, has failed to provide any evidence that it has any rights or legitimate interests in respect of the domain name . The Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed Domain Name.

23.1.3 Taking into account the nature of the disputed domain name and in particular , the addition of "co" and the ".in" extension alongside the Complainant's mark and name SKMEI in its entirety which is confusingly similar, which would inevitably associate the disputed domain name closely with the Complainant's group of domains in the minds of consumers, all plausible actual or contemplated active use of disputed Domain Name by the Respondent is and would be illegitimate.

23.1.4 The Respondent also failed to comply with Para 3 of the INDRP, which requires that it is the responsibility of the Respondent to ensure before the registration of the impugned domain name by him that

the domain name registration does not infringe or violate someone else rights. The Respondent in this case was well aware of the Complainant's SKMEI mark, as he himself was the retailer/purchaser of the complainant's watches as evident from the invoices attached by the Respondent himself with his reply.

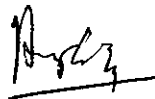
23.1.5 The Complainant has given sufficient evidence to prove extensive trademark rights on the disputed domain name. Whereas, the Respondent's adoption and registration of the disputed domain name is dishonest and done in bad faith.

23.2 This panel is of the view that it is for the Complainant to make out a prime facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, Respondent carries the burden of demonstrating rights or legitimate interests in the domain name but the Respondent has miserably failed to do that. Thus it is clear that the Respondent's registration and use of the domain name [skmeico.in] is in bad faith. The Respondent has no rights or legitimate interests in respect of the domain name and also the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

RELIEF

In accordance with Policy and Rules, the Panel directs that the disputed domain name [skmeico.in] be transferred from the Respondent to the Complainant; with a request to NIXI to monitor the transfer.

New Delhi, India
Dated: August 12, 2024


AJAY GUPTA
Sole Arbitrator