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BEFORE THE .IN REGISTRY OF INDIA
INDRP CASE NO. 1578
IN THE MATTER OF AN ARBITRATION UNDER THE .IN DOMAIN NAME DISPUTE RESOLUTION POLICY; THE INDRP RULES OF PROCEDURE AND THE ARBITRATION AND CONCILIATION ACT, 1996

FINAL AWARD

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BEFORE THE .IN REGISTRY OF INDIA

INDRP CASE NO. 1578

IN THE MATTER OF AN ARBITRATION UNDER THE .IN DOMAIN NAME DISPUTE RESOLUTION POLICY THE INDRP RULES OF PROCEDURE AND THE ARBITRATION AND CONCILIATION ACT, 1996

IN THE MATTER OF

Subway IP Inc.
8400 NW 36th Street,
Doral, FL 33166, United States of America
Email: domains@subway.com

...**Complainant**

Versus

Shanti Lal Mali
Marine Chamber,
Room No.110, 1st Floor
New Marine Line, Mumbai-400020

...**Respondent**

AND

IN THE MATTER OF

A DISPUTE RELATING TO THE DOMAIN NAME SubwayFranchise.in

FINAL AWARD

Dated: 12th July 2022
Venue: New Delhi, India

ROBIN RATNAKAR DAVID
SOLE ARBITRATOR

Table of Contents

I. PARTIES TO THE ARBITRATION 4

II. APPLICABLE LAW AND JURISDICTION 4

III. THE DOMAIN NAME, REGISTRAR & REGISTRANT 5

IV. PROCEDURAL HISTORY 6

V. PARTIES' CONTENTIONS 6

VI. DISCUSSIONS AND FINDINGS 9

VII. DISPOSITIONS 13

I. PARTIES TO THE ARBITRATION

1. The Complainant

The Complainant is Subway IP Inc., having its registered business address at 8400 NW 36th Street, Doral, FL 33166, United States of America. The Complainant is represented by Steven M. Levy of FairWinds Partners LLC, 1000 Potomac Street, N.W. Washington, D.C. 20007, United States of America.

2. The Respondent

The Respondent is Shanti Lal Mali, having its registered business in Marine Chamber, Room No.110, 1st Floor, New Marine Line, Mumbai-400020.

II. APPLICABLE LAW AND JURISDICTION

The .IN Domain Name Dispute Resolution Policy

1. The present arbitration proceeding is under and in accordance with the .IN Domain Name Dispute Resolution Policy (the Policy) which was adopted by the National Internet Exchange of India (NIXI) and sets out the legal framework for resolution of disputes between a domain name registrant and a complainant arising out of the registration and use of an .IN Domain Name. By registering the domain name SubwayFranchise.in with the NIXI accredited Registrar, the Respondent has agreed to the resolution of disputes under the .IN Dispute Resolution Policy and Rules framed thereunder. The Policy and the .IN Domain Name Dispute Resolution Rules of Procedure posted on 16 September 2020 (the Rules) were approved by NIXI in accordance with the Arbitration and Conciliation Act, 1996.

Filing of the Complaint and Constitution of the Arbitral Tribunal

2. The Complainant filed the Complaint under the.IN Domain Name Dispute Resolution Policy against the Respondent, seeking the transfer of Domain Name SubwayFranchise.in to the Complainant. On 22 June 2022, the .IN Registry sought the consent of Mr. Robin Ratnakar David (the undersigned), who is a listed .IN Dispute Resolution Arbitrator under Rule 5 (a) of the Rules, to act as Arbitrator in the said matter. On 22 June 2022, Mr. David gave his consent along with the signed Statement of Acceptance and Declaration of Impartiality and Independence to act in the matter as Arbitrator in compliance with the Arbitration and Conciliation Act, 1996.

3. On 22 June 2022, the Arbitral Tribunal comprising of the said Mr. Robin Ratnakar David, Sole Arbitrator was constituted under Rule 5(b) of the Rules in respect of the Complaint filed by Subway IP Inc. against Shanti Lal Mali, the Respondent.

4. On 24 June 2022, the Arbitral Tribunal issued the Notice of Arbitration under Rule 5 (c) of the Rules.

5. The Arbitral Tribunal has been constituted properly and in accordance with the Arbitration and Conciliation Act, 1996, the INDRP Policy and the Rules as amended from time to time. No party has objected to the constitution and jurisdiction of the Arbitral Tribunal and to the arbitrability of the dispute.

III. THE DOMAIN NAME, REGISTRAR & REGISTRANT

- Domain ID: D638AD31FE62B4C0681C3E00001359B66-IN
- Creation Date: 2022-03-08T18:21:17Z
- Expiration Date: 2023-03-08T18:21:17Z
- Registrar Name: NameCheap, Inc
- Registrant Name: Shanti Lal Mali
- Registrant Address: Marine Chamber, Room No. 110, 1st Floor, New Marine Lines, Mumbai- 400020
- Registrant Phone: +1.9903426960
- Registrant Email: subwayindia001@gmail.com
- Registrant ID: C385216BAB145475A9657CDFC1AA64CE3-IN

IV. PROCEDURAL HISTORY

1. On 24 June 2022, the Arbitral Tribunal issued the Notice of Arbitration to the Respondent by email with the Complaint and Annexures enclosed. The Respondent was given an opportunity to file a Response in writing in opposition to the Complaint, if any, along with evidence in support of its stand or contention on or before 30 June 2022. The Complaint (including annexures) was sent to the email address of the Respondent shown in the WHOIS details, accordingly, the service on the Respondent was done in accordance with Rule 2 of the Rules.

2. As the Respondent did not respond to the Notice of Arbitration, the Tribunal on 1 July 2022, in the interest of justice, granted a second and final opportunity to the Respondent by email with the Complaint and Annexures enclosed. The Respondent was given an opportunity to file a Response in writing in opposition to the Complaint, if any, along with evidence in support of its stand or contention on or before 8 July 2022. The Complaint (including annexures) was sent a second time to the email address of the Respondent shown in the WHOIS details, accordingly, the service on the Respondent was done in accordance with Rule 2 of the Rules.

3. All emails from the Arbitral Tribunal were copied to the Complainant and Respondent as well as NIXI.

V. PARTIES' CONTENTIONS

COMPLAINANT

1. The Complainant, Subway IP Inc., is the owner of the trademark SUBWAY and corresponding logos ["**SUBWAY Marks**"] in India and globally. The Complainant was founded in 1965 and promotes the SUBWAY Marks through print, web, television, and trade show advertising. The Complainant generates significant sales revenue as a result of the advertising and marketing it conducts on its various websites including www.Subway.com.
2. The Complaint claims that the Disputed Domain Name <SubwayFranchise.in> is identical or confusingly similar to the

Complainant's registered and distinctive trademark as the disputed domain name was adopted long after the Subway Marks became globally famous. Further, even if users eventually realise, they are not on one of the Complainant's websites, the appearance of the famous SUBWAY Mark in the Disputed Domain Name will lead them to believe that the Complainant has endorsed, sponsored, or affiliated itself with the domain name and any services offered at the resolving website, which is not the case. Furthermore, relying on the case of *Nike Inc. and Nike Innovative C.V. v. Zhaxia*, the addition of the ".in" does not alleviate the confusion between the Subway Mark and the Disputed Domain name.

3. The Complainant avers that the Respondent's actions are not a bona fide offering of goods and services under Policy Para 6(a), the <SubwayFranchise.in> domain name resolves to a page that impersonates the Complainant and invites users to "Apply Online and Become the Owner" of a SUBWAY franchise. The page even displays a false copyright notice at the bottom "Copyright © 2002 Subway." After clicking the "Franchising" link at the top of the home page, the user is brought to a page filled with grammatical errors and titled "Demand of Subway Franchise".

4. The Complainant states that in accordance with Policy Paragraph 6(b), Complainant has never assigned, granted, licenced, sold, transferred, or otherwise authorised Respondent to register or use the Disputed Domain Name or the SUBWAY Mark. Furthermore, the Respondent's identity is solely identified as "REDACTED FOR PRIVACY" in the public WHOIS record for the Disputed Domain Names. Moreover, Respondent is not commonly known by the Disputed Domain Name or the name "SUBWAY" nor does Respondent operate a legitimate business or other organization under the SUBWAY Mark.

5. The Complainant avers that the content of Respondent's website referring to Complainant and its franchising opportunities, the Disputed Domain Name is not being used for any generic or descriptive meaning of the words therein. Rather, Respondent uses the Disputed Domain Name to confuse and misleadingly divert consumers, or to tarnish the well-known SUBWAY Mark. This shows that the Respondent is not making a legitimate non-

commercial or fair use of the domain name thereby his actions do not fall into the Policy Paragraph 6(c).

6. The Complainant avers that the Respondent's use of the SUBWAY Mark in association with a website that attempts to divert the users seeking information on purchasing a SUBWAY franchise has diminished the public's capacity to associate the SUBWAY Mark with the quality products and services offered under the Mark by Complainant. Further, the Respondent's usage creates a situation in which the Complainant's trademark is connected with fraudulent acts over which the Complainant has no control.

7. The Complainant states that the Respondent used the famous SUBWAY Mark without the consent of the Complainant. Respondent was aware of Complainant's rights in its well-known Mark due to Complainant's extensive use of the Mark, which predated the date on which Respondent acquired the Disputed Domain Name.

8. Relying on *Subway IP Inc. v. Cetinje S.R.O.*, the Complainant asserted that Respondent intentionally registered and used the Disputed Domain with knowledge of, and in violation of Complainant's trademark rights.

9. The Complainant states that the Respondent's creation of a website that seeks to impersonate the Complainant alone constitutes bad faith as it disrupts Complainant's business and seeks to capitalize on confusion with the SUBWAY Mark. This fulfils the requirement to classify as bad faith under Policy Paragraph 7(c) and 7(d) which states that the bad faith may be found where the Respondent by using a domain name, intentionally attempts to attract, commercial gains.

10. The Complainant states that the Respondent's impersonation of Complainant's SUBWAY franchise marketing web pages at the www.Subway.com site demonstrates its intention to deceive users for commercial benefit and to harm Complainant's business by redirecting people to the infringing SubwayFranchise.in> website. The fact that visitors to Respondent's site can enter their personal information and Subway login credentials indicates that Respondent is attempting to harvest all of this information to extract information and funds from users, as well as possibly

engaging in identity theft and other cyber-crimes. The fact that Respondent duplicates copyright copyright-protected components for use on its site (e.g., the SUBWAY logo, images of Complainant's restaurants) shows that it is attempting to deceive the public and is pursuing commercial gain in bad faith.

THE RESPONDENT

The Respondent has not filed any response to the Notice of Arbitration dated 24 June 2022. The Respondent did not respond to the second and final notice of arbitration of the Tribunal dated 1 July 2022. The Respondent has not replied to the contentions of the Complainant even though the Respondent has been served as required by the Rules. The emails of service sent to the Respondent were not returned undelivered. However, the Respondent's default would not automatically result in a decision in favour of the Complainant. The Supreme Court in Sudha Agrawal v X Additional District Judge and others (1996) 6 SCC 332 held that even in an uncontested matter the petitioner's case must stand on its own legs and it cannot derive any advantage by the absence of the defendants. Therefore, the Complainant must still establish each of the three elements required by paragraph 4 of the Policy.

VI. DISCUSSIONS AND FINDINGS

1. Paragraph 4 of the Policy requires that the in order to obtain the transfer of the disputed domain name, the Complainant will have to prove that the Respondent's domain name is identical or confusingly similar to a name or trademark in which the Complainant has rights; the Respondent has no rights in respect of the domain name; and the Respondents' domain name has been registered and is being used in bad faith.
2. The Complainant must still establish each of the three elements required by Paragraph 4 of the Policy.
3. A Complainant who alleges that the disputed domain name conflicts with its legitimate rights or interests must establish the following three elements required by Paragraph 4 of the Policy[1] namely:

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[1] 4. Class of Disputes

4. Class of Disputes: Any Person who considers that a registered domain name conflicts with his/her legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

a) The Respondent's domain name is identical and confusingly similar to the trademark or service mark in which the Complainant has rights.

b) The Respondent has no rights or legitimate interests in respect of the domain name; and

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

4. Accordingly, the Arbitral Tribunal shall deal with each of the elements as under:

a) Whether the Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights?

(i) The Complainant provided evidence to establish that the Disputed Domain name <SubwayFranchise.in> is identical or confusingly similar to the Complainant's registered and distinctive trademark since the disputed domain name by the Respondent was acquired long after the Subway Marks were globally recognised.

(ii) The Complainant holds 'SUBWAY' trademark registrations in India and globally. Because of the extensive use and promotion of the Subway Marks, the brand has gained worldwide recognition. A perusal of the trademark registration certificates and WHOIS records shows Complainant is the owner of several trademark registrations in India and across the world.

(iii) The Arbitral Tribunal notes the Panel's decision in the case of *Nike Inc. and Nike Innovative C.V. v. Zhaxia*, the addition of the ".in" does not alleviate the confusion between the Subway Mark and the Disputed Domain name. Moreover, Disputed Domain Name will lead them to believe that the Complainant

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(a) the Registrant's domain name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and

(b) the Registrant has no rights or legitimate interests in respect of the domain name; and

(c) the Registrant's domain name has been registered or is being used in bad faith.

has endorsed, sponsored, or affiliated itself with the domain name and any services offered by the Complainant.

(iv) After taking into consideration the facts of the present case and the settled law on the issue, it can be said that the disputed domain name registered by the Respondent establishes a likelihood of confusion with the Complaint's trademarks and this could mislead the internet users as it is confusingly identical. Accordingly, the Arbitral Tribunal holds that the requirement of the first element in the INDRP Policy Paragraph 4(a) is the <SubwayFranchise.in> domain name is confusingly similar, to Complainant's registered and distinctive SUBWAY Mark.

b) Whether the Registrant has no rights or legitimate interests in respect of the domain name?

(i) To pass muster under paragraph 4(b) of the Policy, the Complainant has to show that the Respondent has no rights to and legitimate interests in the disputed domain name under paragraph 6 of the Policy.

(ii) Respondent is not affiliated with Complainant in any way and was never been authorised or licenced by Complainant to use or register its trademarks, or to seek registration of any domain name incorporating the trademark in question. Furthermore, the Respondent is not commonly known by the Disputed Domain Name or the name "SUBWAY" nor does the Respondent operate a legitimate business or other organization under the SUBWAY Mark. Additionally, the Subway marks were registered years before the disputed domain name was registered.

(iii) Evidence was provided by the Complainant to show that the Respondent's actions are most certainly not a bona fide offering of goods and services under Policy Para 6(a), the <SubwayFranchise.in> domain name impersonates Complainant and the page even displays a copyright notice at the bottom "Copyright © 2002 Subway." Furthermore, the website seeks to elicit certain personal and business information and gather specific personal and business information from users in the guise of their inquiry about perhaps operating one of

Complainant's franchise shops. This is targeted at stealing both sensitive information and funds from the users.

(iv) Accordingly, the Arbitral Tribunal finds that the Complainant has made out a *prima facie* case that the Respondent has no rights and legitimate interests in respect of the disputed domain name SubwayFranchise.in as Complainant has never assigned, granted, licenced, sold, transferred, or otherwise authorised Respondent to register or use the Disputed Domain Name or the SUBWAY Mark as it was not for making legitimate non-commercial use. Thus, it satisfies the second element under paragraph 4 (b) of the Policy.

c) Whether the Registrant's domain name has been registered or is being used in bad faith?

(i) The Complainant is a well-known fast-food chain worldwide. The Complainant provided the following reasons to show that the Respondent acquired the disputed domain name in bad faith—

a. Firstly, the Respondent intentionally used the famous SUBWAY Mark without consent from Complainant.

b. Secondly, Respondent was aware of Complainant's rights in its well-known Mark as a consequence of Complainant's substantial use of the Mark which long predates before the Respondent acquired the domain name.

c. It fulfils the requirement to classify as bad faith under Policy Para 7(c) and 7(d) which states that the bad faith may be found where the Respondent by using a domain name, intentionally attempts to attract, commercial gains as It disrupts Complainant's business and seeks to capitalize on confusion with the SUBWAY Mark.

d. The Respondent impersonated the Complainant's SUBWAY franchise marketing web pages at the www.Subway.com site, which demonstrates its purpose to deceive users for commercial benefit and to harm Complainant's business by redirecting people to the infringing <SubwayFranchise.in>website.

e. The fact that visitors to Respondent's site can enter their personal information and Subway login credentials clearly

indicates that Respondent is attempting to collect all of this information to extract information and funds from users, as well as possibly engaging in identity theft and other cyber-crimes.

f. The fact that Respondent duplicates some copyright-protected components for use on its site (e.g., the SUBWAY logo, images of Complainant's restaurants) supports the conclusion that it is attempting to deceive the public and is pursuing commercial gain in bad faith.

(ii) Considering the findings above, Arbitral Tribunal holds that the Respondent's domain name SubwayFranchise.in has been registered with an opportunistic intention and is being used in bad faith. Therefore, the third element in paragraph 4(c) of the Policy has been satisfied.

VII. DISPOSITIONS

The Arbitral Tribunal holds that the Respondent's domain name **SubwayFranchise.in** is identical and confusingly similar to the name, trademark and brand name Subway owned by the Complainant. The Respondent has no rights or legitimate interests in the domain name SubwayFranchise.in and the same has been registered in bad faith. The three elements set out in paragraph 4 of the INDRP Policy have been established by the Complainant.

The Arbitral Tribunal directs that the disputed domain name SubwayFranchise.in be transferred to the Complainant, Subway IP Inc., having its registered business address 8400 NW 36th Street, Doral, FL 33166, United States of America.

Place of Arbitration: New Delhi, India
Date: 12th July 2022

Robin Ratnakar David
Sole Arbitrator
The Arbitral Tribunal