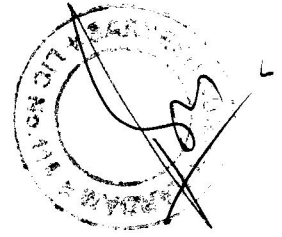




सत्यमेव जयते

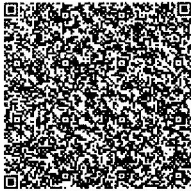
INDIA NON JUDICIAL

Government of Uttar Pradesh



e-Stamp

Certificate No. : IN-UP38385986710698U
Certificate Issued Date : 08-Mar-2022 02:18 PM
Account Reference : NEWIMPACC (SV)/ up14008104/ NOIDA/ UP-GBN
Unique Doc. Reference : SUBIN-UPUP1400810467635339421341U
Purchased by : PUNITA BHARGAVA
Description of Document : Article 12 Award
Property Description : Not Applicable
Consideration Price (Rs.) :
First Party : PUNITA BHARGAVA
Second Party : Not Applicable
Stamp Duty Paid By : PUNITA BHARGAVA
Stamp Duty Amount(Rs.) : 100
(One Hundred only)



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BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA
.IN REGISTRY

Arbitral Award in Case No. 1577
Ms. Punita Bhargava, Sole Arbitrator
Disputed domain name: < kohler.net.in >

Statutory Alert:

1. The authenticity of this Stamp certificate should be verified at 'www.shilestamp.com' or using e-Stamp Mobile App of Stock Holding. Any discrepancy in the details on this Certificate and as available on the website / Mobile App renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

In the matter of

Kohler Co.
444 Highland Drive
Kohler, Wisconsin 53044
United States of America

... Complainant

Vs.

Mahalaxmi Valves Pvt Ltd
3224 & 3227, Hakim Baka Street
Near Chaumukha Mandir
Delhi – 110052

...Respondent

1. The Parties

The Complainant in this proceeding is Kohler Co. of 444 Highland Drive, Kohler, Wisconsin 53044, United States of America. Its representative is Mr. Rahul Beruar of Beruar & Beruar LLP of D-155, 3rd Floor, Defence Colony, New Delhi 110024.

The Respondent in this proceeding is Mahalaxmi Valves Pvt Ltd of 3224 & 3227, Hakim Baka Street, Near Chaumukha Mandir, Delhi – 110052. Mr. Rajiv Jain is its Director. The Respondent is represented by Ms. Umang Srivastava of M/s Piyush Kumar & Associates.

2. Disputed Domain Name and Registrar

This dispute concerns the domain name <kohler.net.in> (the 'disputed domain name') registered on August 13, 2020. The Registrar with which it is registered is Godaddy.com LLC with IANA ID: 146.

3. Procedural History

This proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (Policy/INDRP), adopted by the National Internet Exchange of India (NIXI).

By its email of June 22, 2022 NIXI requested availability of Ms. Punita Bhargava to act as the Sole Arbitrator in the matter. The Arbitrator indicated her availability and submitted the Statement of Acceptance and Declaration of Impartiality and Independence in compliance with the .INDRP Rules of Procedure (Rules) on the same date. Thereafter, in accordance with the Rules, NIXI appointed the Arbitrator by email of June 22, 2022 and also notified the Respondent of the Complaint.

As the Arbitral Tribunal is properly constituted, the Arbitrator sent an email on June 22, 2022 informing all concerned of the commencement of the proceeding, asking the Complainant to comply with the service formalities and asking the Respondent to file its Reply by July 8, 2022.

The Complainant confirmed compliance of service formalities on June 28, 2022.

On July 8, 2022, counsel for Respondent requested for enlargement of time to file Reply on the ground that she has been recently appointed. By email of same date, the Arbitrator granted time till July 16, 2022. The Reply of the Respondent was received on this date and accordingly, the Arbitrator asked the Complainant to file its Rejoinder by July 23, 2022. The Complainant's counsel also requested for enlargement of time and was granted time till July 27, 2022 to file Rejoinder. The Complainant's Rejoinder was received on this date.

4. The Complaint and the case pleaded by the Complainant

The Complainant states it is a global leader in designing and manufacturing kitchen and bath products, engines and power generation systems, cabinetry, and home interiors under the brand KOHLER. Founded in 1873 by John Michael Kohler, Complainant was initially named Kohler & Silberzahn and adopted its present trading name in 1912 after undergoing structural changes and expanding its portfolio of products/services under the aegis and control of the Kohler family.

The mark KOHLER was adopted and used by Complainant/ its predecessors in 1873. KOHLER holds immense conceptual significance and is identified with the Complainant alone and none else. As on date, the Complainant is one of the largest privately held companies in the United States. It employs more than 36,000 associates in six continents, operates plants/factories in 49 locations worldwide and dozens of sales offices globally. Complainant enjoys presence in several countries including USA, Canada, Mexico, Brazil, Algeria, Belgium, Egypt, France, Germany, Italy, Morocco, Netherlands, Russia, Slovakia, South Africa, Spain, Togo, China, India, Indonesia, Japan, Malaysia, Philippines, Singapore, South Korea, Thailand, UAE, UK, and Vietnam, among others.

In India, the Complainant operates through its wholly owned subsidiary, Kohler India Corporation Private Limited (KICPL) incorporated on September 20, 1999 with registered address at 26 A, Ring Road, Lajpat Nagar IV, New Delhi-110024. Complainant first used its well-known trademark KOHLER in India in 1994 preparing for launch of its business here. Complainant, through KICPL, has pan-India sales and business development teams, 4 regional offices and a nationwide after-sales service network. The Complainant works on a B2B system and has created a network of over 350 dealers, distributing partners and outlets in almost every city in India.

Complainant offers a wide range of innovative goods/services under the brand KOHLER such as bathroom fittings and accessories, furniture, kitchen fittings and accessories, engines and parts, generators and hospitality and recreational services including resorts and lodging, golf courses, spa services, restaurants, and dining, inter alia. Complainant has manufactured around 8000 products in the bathroom and kitchen fittings segment and these are available in India under KOHLER brand. It has invested substantial time, energy, and resources in designing products and has gained much popularity for exceptional quality, latest technology, innovative designs, and enduring craftsmanship.

The Complainant has generated revenue over 6 billion USD across the globe and over 100 million USD in India for business done under the KOHLER name and mark. It also has a rich tradition of advertising and has invested substantial resources of time, money, human intellect to promote KOHLER through campaigns, unique advertisements in print and digital media, social media platforms, endorsements by celebrities, product placement and advertisements on leading channels broadcasting popular prime time shows and sponsoring popular prime time shows.

KOHLER and its formatives are used prominently on Complainant's products, product packaging, stores, Kohler Experience Centres, official documents such as annual reports, letter heads, invoices, and promotional material including product brochures and catalogues, advertisements, accounts and handles on social media platforms and others. It has filed sampling of such promotional material with the Complainant.

The Complainant states that it is the exclusive owner of the word mark KOHLER which is registered in India under No. 643704 since October 21, 1994 in Class 11. The said registration valid and renewed till October 21, 2031. KOHLER is also declared as a well-known mark by the TM Office and is included in the list of well-known trade marks under Rule 124 of the Trade Marks Rules, 2017 as advertised in Trade Marks Journal No. 1942 dated February 24, 2020. The Complainant has other registrations in India for KOHLER and various formatives thereof for various goods and services in Classes 1, 2, 3, 7, 11, 12, 14, 16 18, 20, 21, 24, 25, 28 and 35. It has filed registration certificates and list of such marks.

The Complainant states that it secured the first registration for KOHLER in the United States vide Serial No. 71072289 and Registration No. 0094999 on January 20, 1914 with use claim asserted since 1873. It has filed registration certificate and affidavit of Mr. Walter J Kohler filed before the UPSTO in support of the use claim. The KOHLER mark and its formative are also registered in several jurisdictions including Australia, Bhutan, Botswana, Brunei, Cambodia, Canada, Chile, Costa Rica, Cuba, Estonia, European Union, France, Gambia, Germany, Indonesia, Israel, Italy, Jordan, Kenya, Madagascar, Malaysia, Mexico, Morocco, Mozambique, Namibia, New Zealand, North Macedonia, Philippine, Singapore, Switzerland, Tonga, United States, Uruguay, Vietnam, and Zimbabwe. It has filed a list of such registrations and copies of some corresponding registration certificates.

The Complainant owns top-level domains <kohler.com> and <kohlercompany.com> since November 8, 1994 and December 6, 2006 respectively and hosts corresponding sites which are accessible globally including in India. It is also owner of <kohler.co.in> since March 23, 2005 and hosts www.kohler.co.in. Whois details and extracts from the sites have been filed. The Complainant states it carries out a significant business as well as promotional activities through its websites.

The Complainant states it is diligent in protecting its rights and takes action against misuse of its intellectual property rights. Till date it has initiated and maintained around 596 trademark, patent, and design oppositions, issued more than 400 legal notices and initiated more than 500 infringement proceedings against third parties

attempting to misappropriate its intellectual property assets. Details of some actions are filed by it.

The Complainant states it is the bona fide, prior adopter and exclusive proprietor of the trade name and trademark KOHLER and its formatives globally and in India and the same is exclusively identified with it on account of longstanding use. It enjoys exceptional goodwill, high brand recognition, retention and recall. It is also a well-known trademark and has been recognized as such.

In view of the above, with regard to the elements under the Policy, the Complaint states as under:

- The disputed domain name registered by the Respondent is identical to and comprises in entirety the Complainant's trade name and trademark KOHLER. The disputed domain name is also identical and confusingly similar to Complainant's domains <kohler.com>, <kohlercompany.com> and <kohler.co.in>. ".net.in" is not the distinguishing element and is merely indicative of the domain name being a India-specific top-level domain and ought to be disregarded while comparing the disputed domain name with Complainant's well-known trademark KOHLER.

The Respondent is registrant of the domain name <rnvalves.com> and hosts www.mvalves.com. Per the site, Respondent is engaged in offering bathroom solutions to customers in India and manufactures/trades in bath accessories, diverter and spouts, faucets, hoses, showers, etc. which are same/similar and overlapping with goods/services of the Complainant under KOHLER.

The Respondent is in the same industry and Complainant's customers/intended customers who come across the disputed domain name are likely to assume some connection between the Respondent and the Complainant when in actuality no such association or connection exists. The disputed domain name held by the Respondent is bound to deceive and cause confusion in the minds of the general public. Accordingly, Respondent's registration of the disputed domain name adversely affects the exclusive, prior, and superior statutory and common law rights of the Complainant in the well-known trade name, and trademark KOHLER and the domain names.

- The Complainant submits that the Respondent is neither known by the name KOHLER nor carries on any legitimate trade under the same in any industry, much less in the kitchen and bath fixtures industry. This is evident from the website www.mvalves.com. The Complainant has not granted the Respondent any license, permission, consent, or authorization to secure and continue to hold the registration of the disputed domain name. Given the prior statutory and common law rights of the Complainant in KOHLER, the Respondent cannot have any cogent reason or justification for adopting the disputed domain name in respect of any business, much less for bath accessories and cognate goods. The Respondent registered the disputed domain name on August 13, 2020 decades after the Complainant adopted, used and secured registrations of KOHLER. The

Respondent has not created and does not host any website corresponding to the disputed domain name and does not conduct any bona fide trade through it – the corresponding website shows and a 404 error on being accessed. The Respondent has no bona fide trademark rights in Kohler and has no rights or legitimate interests in the disputed domain name as it has never used any name/mark in connection with any bona fide offering of goods/services. The Respondent is not carrying out any genuine trade or business under the disputed domain name.

- The Complainant states that it is settled law that registration of identical or confusingly similar domain name that is patently connected with a particular trademark owned by an entity with no connection with the trademark owner is indicative of bad faith under the Policy. It further states that the disputed domain name was registered and is being used by the Respondent in bad faith to unfairly gain from the well-known reputation enjoyed by the Complainant in its KOHLER brand and/or cause confusion and mislead the general public including the Complainant's genuine customers, existing as well as future, to dilute the reputation enjoyed by the Complainant in KOHLER as well as cause colossal loss and damage to Complainant's business under KOHLER. Use of disputed domain name is likely to lead to diversion of users. The Respondent has deliberately registered the disputed domain name in 2020 despite being well-aware of Complainant's rights in KOHLER with mala fide to attract internet users who mistakenly believe that the Respondent/ its website is related to Complainant or its products/services. Conduct of the Respondent in deliberately registering the disputed domain name without posting any genuine content clearly evidences bad faith registration and hoarding of the disputed domain name. An existing or intended customer looking up the Complainant by KOHLER on a search engine can accidentally come across or be directed to the domain name.

The Respondent has registered <kohler.org.in> against which a complaint is filed. It had also registered other domain names comprising KOHLER such as <kohler.center>, <kohler.company>, <kohler.email>, <kohler.marketing>, <kohler.network>, <kohlerreal.com>, <kohler.support>, <kohler.work, and <kohler.zone> against which the Complainant filed complaint at WIPO Arbitration and Medication Center. By decision dated November 24, 2020 in Kohler Co. v. Rajeev Jain, Mahalaxmi Valves Pvt Ltd, the WIPO Panel held that the three elements under UDRP were satisfied and directed transfer of domain names in question. The Complainant has filed copy of said WIPO Panel Decision.

The Complainant's request to the Respondent for transfer of the disputed domain name after the WIPO Panel Decision have remained unanswered.

It has thus filed the present Complaint and requests transfer of the disputed domain name.

5. Reply of the Respondent

The Respondent states that it is a company incorporated under The Companies Act, 2013 and is a law-abiding business entity. In the normal course of business, it enquired about the availability of various domain names and following due process,

purchased the disputed domain name for valuable consideration in good faith. GoDaddy.com LLC, after due verification that the name did not infringe upon anyone's right and that the same was available, allotted the same to the Respondent. The disputed domain name was obtained in good faith, without any ulterior motive and the fact that it is not used depicts complete absence of malafide on Respondent's part.

The Respondent has generally denied the contents of the Complaint on account of lack of knowledge and had not commented on matters of fact or record. It has denied allegations of bad faith or that it registered the disputed domain name to unfairly gain from Complaint's products/ services or to cause loss to the Complainant's business. It states the WIPO Panel Decision was passed behind its back ex-parte and is bad in law. It asks for the Complaint to be dismissed but for sake of promoting healthy business relations, has offered to transfer the disputed domain name to the Complainant upon receiving cost incurred in purchasing and maintaining the same and any other costs that may have been incurred.

6. Rejoinder of the Complainant

Denying the contentions of the Respondent, the Complainant states that GoDaddy.com LLC is not an authority to verify infringement and/or monitor trademarks and Respondent's averments qua verification by GoDaddy.com LLC of the disputed domain name are devoid of merit. The Complainant states that it is not "normal course of business" to purchase domain names consisting of a competitor's trademarks and hoard them for no reason. The Respondent is in the same industry as the Complainant and lack of use of disputed domain name or corresponding website evidences the Respondent's bad faith rather than the contrary.

The Complainant denies the Respondent's contention that the WIPO Panel Decision is bad in law because it was passed ex-parte. It states that the Respondent was informed of the proceedings before WIPO Center and it chose not to contest and/or respond to the complaint. It has also not responded to INDRP Case No. 1576 qua domain name 'kohler.org.in'. Having chosen not to respond, the Respondent cannot state the Awards against it are bad in law being ex-parte.

The Complainant has also reiterated its contentions from the Complaint and provided its para-wise reply to the Respondent's Reply. It states that the Respondent has failed provide any cogent reason for registration of the disputed domain name which is nothing but the Complainant's well-known KOHLER mark along with the generic 'net.in' suffix. It has prayed for transfer of the disputed domain name.

7. Discussion and Findings

The Arbitrator has reviewed the pleadings and documents placed on record.

Clause 4 of the Policy requires that the Complainant must establish three elements *viz.* (a) the Registrant's domain name is identical 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. These are discussed below:

(i) Identical or Confusingly Similar

As regards this the first element, the Complainant has established that it has rights in KOHLER. The Complainant or its predecessors have been using KOHLER since 1873 for kitchen and bath products and other products which are sold world over. The Complainant first used KOHLER in India in 1994 and has a wholly owned subsidiary Kohler India Corporation Private Limited since 1999 through which it conducts its business here. Complainant's revenue under KOHLER and variants is in billions of dollars and it has also spent substantial sums in advertising and promoting its business under KOHLER. It has also enforced its rights in KOHLER by way of oppositions, legal notices, infringement actions and other available means.

The KOHLER name and mark and its variants are registered in numerous countries around the world. The first KOHLER registration in India under no. 643704 in class 11 dates back to 1994. The Complainant also has other registrations here under nos. 1606598, 791295, 791296, 1433917 and others in various classes. KOHLER is also recognized to be a well-known mark by the Indian Trade Marks Office. The Complainant owns <kohler.com> and <kohlercompany.com> since November 8, 1994 and December 6, 2006 respectively as also <kohler.co.in> and operates corresponding websites.

There is no dispute that the Complainant has rights in the trade name and registered trademark KOHLER.

The Arbitrator notes that the dominant part of the disputed domain name is KOHLER i.e., the disputed domain name wholly incorporates the Complainant's KOHLER name and mark and this is also the distinctive part of the same. The Respondent has simply taken the Complainant's KOHLER name and mark and has combined it with .NET.IN but this is not sufficient to escape a finding of confusing similarity under the first element. .NET per se is descriptive and does not serve to distinguish the disputed domain name from the Complainant's KOHLER name and mark in any way. It has been routinely held that the mere addition of a descriptive term or a non-significant element does not prevent a finding of confusing similarity. See Starbucks Corporation v. Registration Private, Domains by Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico, WIPO Case No. D2019-1991. It has also been held that when a domain name wholly incorporates a complainant's registered mark, this is sufficient to establish identity or confusing similarity. See Swarovski Aktiengesellschaft v. mei xudong, WIPO Case No. D2013-0150; Wal-Mart Stores, Inc. v. Domains by Proxy, LLC / UFCW International Union, WIPO Case No. D2013-1304.

.NET.IN indicates that the domain is an India specific top-level domain. It is well settled that for the purpose of comparing a trademark with a disputed domain name, the TLD or ccTLD can be excluded.

The Arbitrator accordingly finds that the first element is satisfied and that the disputed domain name is identical to the Complainant's registered mark.

(ii) Rights or Legitimate Interests

As regards this second element, a Complainant must establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name. With respect to this requirement, a complainant is generally required to make a prima facie case that a respondent lacks rights or legitimate interests and once such prima facie case is made, the burden of proof shifts to the respondent to come forward with evidence demonstrating rights or legitimate interests in the disputed domain name. Clause 6 of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

- (a) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (b) the Registrant has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or
- (c) the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Based on the contentions made by the Complainant as stated above, it has made a prima facie case that none of these circumstances are found in the case at hand and therefore, the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent, on the other hand, has not addressed this element at all. There is also no merit in its contentions that it registered the disputed domain name in the normal course of business, following due process or that the Registrar of the disputed domain name conducted any verification. A domain Registrar has mandate to verify rights or infringement of rights; the Arbitrator agrees with the Complainant in this regard.

The Respondent registered the disputed domain name on August 13, 2020 and has admittedly not put it to any real use. The Complainant has not given the Respondent any license or authorization of any kind to register or use the disputed domain name. It is also settled that mere registration of a domain name does not vest any right or legitimate interest in it.

Accordingly, the Arbitrator finds that the Respondent has no rights or legitimate interests in the disputed domain name.

(iii) Registered or Used in Bad Faith

The final criterion of the Policy requires the Complainant to show that the domain name was registered or used in bad faith. Clause 7 sets out the

circumstances without limitation which, if present, constitute evidence of registration or use of a domain name in bad faith:

- (a) circumstances indicating that the Registrant has registered or 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 Registrant's documented out-of-pocket costs directly related to the domain name; or
- (b) the Registrant 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 Registrant has engaged in a pattern of such conduct; or
- (c) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

In the present case, the Arbitrator finds that 7(b) above applies. The facts presented establish that the Respondent has engaged in a pattern of bad faith registration of domain names with the KOHLER designation. The WIPO Panel in *Kohler Co. v. Rajeev Jain, Mahalaxmi Valves Pvt Ltd, Case No. D2020-2495* also found this element against the Respondent. The Arbitrator agrees with the Complainant that this WIPO Panel Decision cannot be considered bad in law as the Respondent would have chosen not to participate in the proceeding.

It is also settled law that registration of a domain name that is identical or confusingly similar to a trade mark of an entity that has no relationship to that mark is sufficient in itself for a finding of bad faith.

Further, based on the contentions of the Complainant describing its extensive registrations of the KOHLER mark, long standing use thereof and associated business, the Arbitrator accepts that KOHLER is indeed well-known and exclusively associated with the Complainant. It's rights significantly predate the registration of the disputed domain name by the Respondent. The Respondent is also in the same business as the Complainant. Therefore, it is the view of the Arbitrator that the Respondent was clearly aware of the Complainant's KOHLER name and mark at the time of registration of the disputed domain name (and others with the Kohler designation) and its conduct is in bad faith. The Arbitrator also accepts the Complainant's contention that an average Internet user coming across a website corresponding to the disputed domain name will believe it is owned by the Complainant and relates to sale of its goods in India. In addition, the disputed domain name is held passively and such use does not prevent a

finding of bad faith. See *Volkswagen AG v. Nowack Auto und Sport – Oliver Nowack WIPO Case No. D2015-0070*.

The Respondent's assertions that the disputed domain name was obtained in good faith, without any ulterior motive and lack of use thereof shows absence of malafide are not credible and there is nothing filed to help the Arbitrator hold otherwise.

Thus, the Arbitrator concludes that the Respondent registered the disputed domain name in bad faith and that there is no way in which it could use the disputed domain name without violating the Policy.

Accordingly, the Arbitrator finds that the Complainant has established all three elements as required by the Policy.

8. Decision

For all the foregoing reasons, the Complaint is allowed and it is hereby ordered in accordance with paragraph 10 of the Policy that the disputed domain name be transferred to the Complainant. There is no order as to costs.

This award has been passed within the statutory deadline of 60 days from the date of commencement of arbitration proceeding.



Punita Bhargava

Sole Arbitrator

Date: August 12, 2022