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INDRP CASE No. 1510

Disputed Domain Name: SAUCONY.IN

BEFORE THE SOLE ARBITRATOR: VAKUL SHARMA

DATED: May 02, 2022



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ARBITRATION AWARD

In the matter of:

Saucony, Inc.

500, Totten Pond Road,

Waltham, Massachusetts-02451,

United States of America

[Complainant]

-v-

DingDing

Organization: Dingcorp

Address: A3, JiaZhaoYe, JiangBei,

Huicheng District, HuiZhou,

GuangDong, China

[Respondent]

Disputed Domain Name:

<saucony.in>



INDRP CASE No. 1510**1. The Complainant**

The Complainant is a corporation based in Massachusetts, USA and sells branded shoes and apparel across multiple jurisdictions, including India.

2. The Respondent

Respondent [DingDing], DingCorp with email address as chromebooks@hotmail.com in this administrative proceeding is identified as per WHOIS records.

3. The Registrar

The Registrar with which the domain name is registered is: Dynadot LLC, USA.

4. Disputed Domain Name

<SAUCONY.IN>

5. Jurisdiction

The Complainant by filing the Complaint under the aforesaid INDRP Rules of Procedure [Rules] has accepted the subject matter jurisdiction of the .IN Domain Dispute Resolution Policy - .INDRP [Policy].

In view of the above, this domain name dispute is properly within the scope of the Policy. The registration agreement, pursuant to which the disputed domain name was registered, incorporates



the Policy. Disputes between Registrants, as they relate to domain name registrations, are governed by the Policy.

6. Procedural History

- (i) This Arbitration Proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (the "Policy"), adopted by the National Internet Exchange of India ("NIXI") and the INDRP Rules of Procedure (the "Rules"), which were approved on June 28, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By submitting to the Policy and the Rules, the Complainant agreed to the resolution of the disputes pursuant to the Policy and the Rules.
- (ii) Complaint was filed by the Complainant with NIXI against the Respondent. NIXI verified the Complaint and its annexures for conformity with the requirements of the Policy and the Rules.
- (iii) I submitted the statement of acceptance on February 26, 2022 and subsequently appointed by NIXI as an Arbitrator in the above matter [INDRP No. 1510] vide email dated February 26, 2022.
- (iv) Complainant submitted a Copy of the Complaint and Annexures to me as well as to the Respondent vide email dated February 28, 2022 from its email ID in accordance with the Rules.



- (v) Complainant has further vide email dated March 2, 2022 and March 7, 2022 has submitted the soft copy of the Complaint has been successfully delivered to the email ID of the Respondent [chromebooks@hotmail.com] as maintained by NIXI in its WHOIS database. It further submitted a hard copy of the Complaint has also been dispatched to the Respondent's address as per WHOIS. Complainant further submitted vide email dated March 8, 2022 Speed post tracking report.
- (vi) In view of the completion of procedures related to Service of Complaint as mandated under the Rules, I issued a Notice dated March 9, 2022 to the Respondent to submit its reply to the above said complaint within 15 days from the date of the Notice failing which the Complaint shall be decided on merit.
- (vii) I issued another notice dated March 28, 2022 informing the parties that in the interest of justice a final opportunity being given to the Respondent to submit its reply within next five days of the notice failing which the Complaint shall be decided *ex-parte* on the merits of the complaint.
- (viii) Despite giving a final opportunity, the Respondent has failed to submit any reply and hence vide notice dated April 2, 2022, I informed both the parties that "*the Respondent right to file Reply stands closed and the Complaint shall now be decided ex-parte on the basis of the merits of the Complaint.*"



- (ix) The Arbitration Award is now pronounced on this day, i.e., May 2, 2022 after considering the contentions of the Complainant, evidence on record and the Policy framework under my signatures. This is an *ex-parte* order as the Respondent has failed to file their Reply despite being given adequate opportunity.

7. Contentions of the Complainant

Complainant submits as follows:

- (i) The Complainant is a wholly owned subsidiary of Wolverine World Wide, Inc. ("Wolverine"), which is a leading designer and marketer of a broad range of quality casual footwear and apparel; performance outdoor and athletic footwear and apparel; kids' footwear; industrial work shoes, boots and apparel; and uniform shoes and boots. Wolverine's portfolio of owned and licensed brands includes Saucony®, Bates®, Cat 9® Footwear, Chaco®, Harley-Davidson® Footwear, Hush Puppies®, Hytest®, Keds®, Merrell®, Sperry®, Stride Rite® and Wolverine®. Reliance is placed on Annexure 6.
- (ii) Complainant's SAUCONY brand was founded in 1898 in the USA. Under the SAUCONY Mark, Complainant is one of the world's leading and well known sellers of high-quality footwear. Since its inception over more than a century ago, the Complainant has focused on meeting the functional needs of runners while delivering on their style needs for the footwears under the SAUCONY Mark. The Complainant is the prior adopter, sole owner, registered proprietor, and first and exclusive user across several countries worldwide, including in India, of the trademark SAUCONY

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A circular blue ink stamp with the name 'VAKUL SHARMA' around the top inner edge and 'ARBITRATOR' around the bottom inner edge. There are small stars on either side of the word 'ARBITRATOR'.

and several other SAUCONY formative marks. The Complainant owns over 280 trademark registrations and applications for the SAUCONY Mark across numerous jurisdictions worldwide. In India, the Complainant owns trademark registrations for the SAUCONY Mark since 1995. Reliance is placed on Annexure 5.

- (iii) Apart from its product line, Complainant also uses the SAUCONY Mark as a prominent and essential part of its corporate name and trade name. Reliance is placed on Annexure 7 of the complaint.
- (iv) Complainant markets and sells its products worldwide, including in India, through physical retail stores as well as online retail stores, including various third-party e-commerce websites and platforms such as Amazon, Flipkart, and Myntra. Reliance is placed on Annexure 8 of the complaint. Further, the Complainant maintains a portfolio of over 200 domain names. Reliance is placed on Annexure 9 of the complaint.
- (v) The Complainant's rights in the SAUCONY Mark are exclusive and proprietary. The Complainant has expended considerable financial resources towards protection and enforcement of its rights in the SAUCONY Mark worldwide, including in India and has invested substantial sums of money in developing and marketing its goods and services under the SAUCONY Mark. The SAUCONY Mark has been and continues to be widely publicized through substantial advertising throughout the world, including in India. Reliance is placed on Annexures 10, 11 and 12 of the complaint.

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In the context of the above, Complainant in its complaint has made assertions to establish presence of each of the three elements required by paragraph 4 of the Policy.

I. Whether the domain name <saucony.in> is identical the SAUCONY mark in which the Complainant has rights?

The Complainant submits that:

- (a) The SAUCONY Mark is sufficiently distinctive, unique, famous, registered, and does not have any dictionary meaning. Complainant owns statutory rights in the SAUCONY Mark in India since at least 1995 and since it is a registered trademark, which constitutes prima facie evidence of the validity of trademark rights.
- (b) The disputed domain name is identical to the Complainant's SAUCONY Mark, which is incorporated fully, as is, with the ccTLD '.in'. It is submitted that the ccTLD element of a domain name has no distinguishing capability and should be disregarded while considering whether a domain name is identical or confusingly similar to a trademark. In fact, it is a well-established principle that the ccTLD suffix in a domain name (".in") should be disregarded for the purpose of comparison and similarity since it is a technical requirement of registration of domain names.



II. Whether The Respondent has no rights or legitimate interests in respect of the domain name <saucony.in>?

The Complainant submits that:

- (a) The Respondent has no rights or legitimate interest in either the trademark SAUCONY or in the disputed domain name. The Complainant has never authorized or licensed the Respondent to use the SAUCONY Mark in any way or for any purpose. The Respondent does not have any association or affiliation with the Complainant and neither the Complainant has any past dealing with the Respondent. The Respondent is not commonly known by the disputed domain name and, to the knowledge of the Complainant, has not acquired any trademark rights in the SAUCONY Mark.
- (b) The Complainant's SAUCONY Mark has garnered impeccable reputation and goodwill owing to its longstanding and continuing use of the SAUCONY Mark. Therefore, it is unlikely that the Registrant did not know about the Complainant's rights in its SAUCONY Mark. Registration of a domain name based on awareness of a Complainant's trademark rights is recognized as bad faith registration.



- (c) The disputed domain name has been made available for sale by the Respondent at the website hosted at the disputed domain, with the message "*The domain Saucony.in may be for sale. Click here to inquire about this domain..*" Also, the webpage hosted at the domain name appears to host listings/advertisements related to the Complainant's business. Moreover, the website hosted at the disputed domain name features a hyperlink to the Complainant's website hosted at www.sauconyindia.com amongst those of others. Reliance is placed on Annexure 18 of the complaint. It shows that the Respondent does not have any legitimate rights and interest in the disputed domain name and has evidently registered the same with the malafide intent of making illegitimate and undue commercial enrichment by attracting consumers to the domain name.

III. Whether the domain name <saucony.in> was registered or is being used in bad faith?

The Complainant submits that:

- (a) Respondent's particulars, including name and address provided in the WHOIS records appear to be fake, masked, and fictitious.



- (b) There is also no instance where the Respondent has made (or has made preparations for) a bona fide offering of goods/services under the mark/name SAUCONY or through hosting at the disputed domain name <saucony.in>.
- (c) Respondent appears hosts listings/advertisements to competitors' websites as well as a hyperlink to the Complainant's own website.
- (d) The Complainant is the Registrant of the domain name, among many other domain names that incorporate the SAUCONY Mark as the significant part of the domain along with different Top Level Country Codes. This is bound to give rise to consumer confusion as to whether the impugned domain name is associated with the Complainant.

8. Respondent's Contentions

Despite given adequate opportunities, Respondent has failed to submit any Reply.

9. Discussion and Findings

The Respondent has not filed any Reply to the Complaint. However, the Respondent's default does not automatically result in a decision in favour of the Complainant. The Complainant has to still establish each of the three elements required by Paragraph 4 of the Policy:



Under the Paragraph 4 clauses (a) – (c) of the Policy, the Complainant must prove that:

- (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;
- (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.

The Complaint has to be decided on the basis of the provisions of INDRP, pleadings, including documentary evidence presented before me. The Complainant in order to succeed must satisfy the conditions laid down in Paragraph 4, clauses (a) – (c) of the Policy.

I have considered the Complainant's pleadings, documentary evidence and conditions as laid down in the aforesaid Policy. My opinion is as follows:

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

The Complainant has placed on record details of its 'SAUCONY' under different classes of trademark and formative mark registrations worldwide, including India [Annexure 5] and also submitted webpages related to availability of the Complainant's products on (i) various



e-retailer websites [Annexure 8], (ii) own website <sauconyindia.com> and (iii) Search results on third party search engines [Annexure 13] as documentary evidence to highlight that 'SAUCONY' name, as a trade name, corporate name, and domain name is distinct identifying the Complainant, its products and services. There is no document on record to suggest that the Respondent has ever been given a license, or distribution rights or authorization to incorporate the 'SAUCONY' trademark in the disputed domain name: <SAUCONY.IN> to use it worldwide or specific geographical location. To strengthen the arguments, the Complainant has given references to certain ccTLDs registered by it, namely: <SAUCONY.FR>, <SAUCONY.CO.KR>, <SAUCONY.CO.UK> and <SAUCONY.RU> alongwith WHOIS record of domain names incorporating <SAUCONY> trademark [Annexure 9] as a *bonafide* proof that its interest in the disputed domain name is legitimate and to maintain and protect its exclusive and proprietary hold over its mark.

I consider that there is a force in the arguments of the Complainant that the words <SAUCONY> is legally associated with Complainant's company and it constitutes a prominent and essential part of its corporate and trade name. Furthermore, the Respondent has failed to observe the legal obligations as laid down in Paragraph 3 [Registrant's Representations] of the INDRP, which provides:

By applying to register a domain name, or by asking a Registrar to maintain or renew a domain name registration, the Registrant hereby represents and warrants that:

(a) the credentials furnished by the Registrant for registration of Domain Name are complete and accurate;



(b) to the knowledge of registrant, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;

(c) the Registrant is not registering the domain name for an unlawful and malafide purpose; and

(d) the Registrant will not knowingly use the domain name in violation or abuse of any applicable laws or regulations.

In my opinion, the Respondent has knowingly registered the Complainant's mark in the form of an identical name <SAUCONY>, which is followed by a *suffix*, .IN [ccTLD] to complete the domain name string <SAUCONY.IN>. I am inclined to accept the Complainant's submission that the Respondent's registration of an identical name SAUCONY as <SAUCONY.IN> which is sufficiently distinctive, unique, famous, registered, and does not have any dictionary meaning is an attempt on the Respondent to derive substantial benefits from the Complainant's impeccable reputation and goodwill. I am of the opinion that the Respondent by a deliberate design, mischievously chose to register the disputed domain name which is identical to the Complainant's mark with the sole purpose of commercial enrichment, which is very much evident of the message posted by the Respondent on <SAUCONY.IN> website stating "*The domain Saucony.in may be for sale. Click here to inquire about this domain.*" It only suggests that Respondent was aware of the brand value of disputed domain name when it registered the domain name <SAUCONY.IN>. Further, in order to attract users, it has made available not only hyperlinks to the Complainant's official website but also third party websites [Annexure 18]. In my opinion, it is not an attempt to confuse the genuine buyer but a crude attempt to force the Complainant to buy the disputed domain name at a premium price. By hosting "skeletal" website with

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identical name <SAUCONY.IN> the message from the Respondent is very clear “buy it” or “continue to face dilution of reputation and goodwill”. It is to be noted that the Respondent has failed to deny the said evidence relied upon by the Complainant despite being given ample opportunities. I am of the opinion that the benefit under the circumstances lies with the Complainant. It is thus very clear that the Respondent violated the conditions as laid down in the Paragraph 3(a) – (d) of the policy as mentioned above. In view of the above, the requirement of the Policy as stated in Paragraph 4(a) is satisfied.

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

As discussed above, the Respondent has knowingly registered the Complainant’s mark in the form of an identical name <SAUCONY>, which is followed by a *suffix*, .IN [ccTLD] to complete the domain name string <SAUCONY.IN>, this clearly demonstrates lack of legitimate interests on the part of the Respondent to own the domain name <SAUCONY.IN>.

Also, Paragraph 6 of the INDRP provides:

6. Registrant's Rights and Legitimate Interests in the Domain Name

Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purposes of Clause 4 (b) :



(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;

(b) the Registrant (as an individual, business, or other organization) 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.

I have evaluated the evidence on record and came to a conclusion that none of the aforesaid limbs as highlighted in the Paragraph 6 of the Policy above have been present to give the Respondent/Registrant any rights and legitimate interests in the disputed domain name. The Complainant has never authorized or licensed the Respondent to use the SAUCONY Mark in any way or for any purpose. The Respondent does not have any association or affiliation with the Complainant and neither the Complainant has any past dealing with the Respondent. I accept the Complainant's contention that the registration of the disputed domain name by the Respondent lacks bonafide. Complainant has been able to establish a *prime facie* case of Respondent's lack of legitimate rights and interests in the domain name thus shifting the burden on the Respondent to show rights or legitimate interests [Emirates of Emirates Group v. Zhan Yun . INDRP/606]. There is not an *iota of evidence* to show that SAUCONY Mark are exclusive and proprietary to the Respondent. It is to be noted that the Respondent has failed to counter or deny assertion made by the Complainant. I, therefore, found merit in the Complainant's submission that by offering to sell the disputed domain name, the Respondent has no legitimate purpose to register the disputed domain names,

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other than to illegally sell these domain names for commercial enrichment. The *malafide* intent of the Respondent is quite evident from webpages hosted by the Respondent [Annexure 18] and thus clearly establishing the fact that the Respondent actions are neither *bonafide* nor fall in the category of legitimate non-commercial or fair use of domain name. In view of the above, the requirement of the Policy as stated in Paragraph 4(b) is satisfied.

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

As discussed above, use of the disputed domain name by the Respondent, when it has no legal rights to register the disputed domain name in the absence of any legal arrangement with the Complainant – only proves *malafide* intent on the part of the Respondent.

Further, Paragraph 7 of the policy provides:

7. Evidence of Registration and use of Domain Name in Bad Faith

For the purposes of Clause 4(c), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and 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.

The documentary evidence place on record by the Complainant clearly shows that the Respondent has indeed taken advantage of the Complainant's reputation and goodwill by registering the disputed domain name <SAUCONY.IN> primarily for the purpose of selling only. The *malafide* intent is clear from the screenshots/webpages annexed [Annexure 18] by the Complainant in its complaint. The evidence in the form of screenshots/webpages placed on record show crude attempt on the part of the Respondent to play with the Complainant's reputation and goodwill. There is no denial of said webpages [Annexure 18] on the part of the Respondent. I agree with the assertion made by the Complainant that the hosted webpage gives reference to the Complainant's website <sauconyindia.com>, which clearly shows that the Respondent was well-aware of the Complainant's SAUCONY Mark and rights therein. Furthermore, the fact remain is that SAUCONY Mark is sufficiently distinctive, unique, famous, registered, and does not have any dictionary meaning. The Complainant has been able to demonstrate that the said mark is only associated with the Complainant. Therefore, adoption of the said mark by the Respondent is dishonest and in bad faith.

Accordingly, having regard to the circumstances of this particular case, I hold that the Complainant has been able to prove that the Registrant's registered the disputed domain name



in bad faith. In view of the above, the requirement of the Policy as stated in Paragraph 4(c) is satisfied.

10. Decision

For the foregoing reasons, in accordance with the Policy and Rules, I direct NIXI to transfer the disputed domain name <SAUCONY.IN> to the Complainant.

There is no order as to costs.

The original copy of the Award is being sent alongwith the records of the proceedings to the National Internet Exchange of India (NIXI) for its record and a copy of the Award are being sent to both the parties thru email for their information and record.

Vakul Sharma
Vakul Sharma

Vakul Sharma
(Sole Arbitrator)



Dated: May 2, 2022