



INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

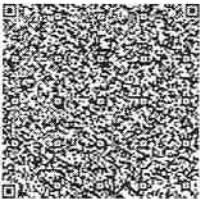
सत्यमेव जयते

₹100

e-Stamp

Certificate No.	: IN-DL08262588835923U
Certificate Issued Date	: 31-Oct-2022 04:08 PM
Account Reference	: SELFPRINT (PU)/ dl-self/ NEHRU/ DL-DLH
Unique Doc. Reference	: SUBIN-DL DL-SELF93768480042300U
Purchased by	: IRA LAW PREETIKA KASHYAP
Description of Document	: Article 12 Award
Property Description	: ARBITRATION AWARD
Consideration Price (Rs.)	: 0 (Zero)
First Party	: BINNY KALRA
Second Party	: BINNY KALRA
Stamp Duty Paid By	: BINNY KALRA
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)

₹100 ₹100 ₹100 ₹100



₹100

SELF PRINTED CERTIFICATE TO BE VERIFIED BY THE RECIPIENT AT WWW.SHCILESTAMP.COM

IN-DL08262588835923U

Please write or type below this line

**ARBITRATION AWARD
IN REGISTRY**

(C/O National Internet Exchange of India)

Before the Sole Arbitrator, Binny Kalra

Disputed domain name <PAULANDSHARK.IN>

INDRP Case No: 1604

In the matter of:

DAMA S.P.A.

Complainant

VS

Zhao Ke

Respondent

Statutory Alert:

1. The authenticity of this Stamp certificate should be verified at 'www.shcilestamp.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

Binny Kalra

**ARBITRATION AWARD
.IN REGISTRY**

(C/O NATIONAL INTERNET EXCHANGE OF India)

Before the Sole Arbitrator, Binny Kalra

Disputed domain name <**PAULANDSHARK.IN**>

In the matter of:

DAMA S.P.A.

Via Piemonte, 174,
21100 Varese (VA),
Italy

Complainant

Versus

Zhao Ke

Weihai Road 2001,
Shanghai,
200050,
China

Respondent

INDRP Case No: 1604

1. The Parties:

The Complainant DAMA S.P.A. is a company organised and existing under the laws of Italy, who is represented in these proceedings by an attorney, Mr. Michele Provera c/o Convey Srl, Via Sagra di San Michele, 27 10139 Torino, Italy. The Respondent is Zhao Ke, with a given address at Weihai Road 2001, Shanghai 200050, China. The Respondent is not represented in these proceedings.

2. The domain name, Registrar, and Policy:

The disputed domain name is www.paulandshark.in (hereinafter referred to as the "**Disputed Domain Name**"). The Registrar for the Disputed Domain Name is Endurance Digital Domain Technology LLP, having its address at Unit No. 501, 5th Floor, IT Building 3, Nesco IT Park Nesco Complex, Western Express Highway, Goregaon (E), Mumbai, Maharashtra 400063. The present arbitration is being conducted in accordance with the Arbitration and Conciliation Act, 1996, the .IN

Domain Name Dispute Resolution Policy ("**Policy**") and the INDRP Rules of Procedure ("**Rules**").

3. Procedural history:

- 31 August 2022: The .IN Registry transmitted information of appointment of the arbitrator and circulated the complaint and its annexures to the parties
- 1 September 2022: Statement of acceptance along with a declaration of impartiality and independence was sent by the arbitrator to the .IN Registry
- 3 September 2022: Notice of commencement of arbitration proceedings was sent by the Panel to the parties and a period of 15 days, until 19 September 2022, was given to the Respondent to submit a statement of defence
- 20 September 2022: The Panel wrote to the Parties and NIXI to record that no statement of defence or other communication was forthcoming from the Respondent by the due date therefore its right to file the statement of defence stood forfeited. The award was accordingly reserved.

4. Complainant's case:

The Complainant's submissions in the complaint are briefly summarized below:

- i. The Complainant is the registered proprietor of the various PAUL SHARK formative marks under several international registrations. It has been using the mark in connection with its ongoing business of luxury clothing. The Complainant has given details of its national and international trademark registrations (Annexure 4.1 – 4.19).
- ii. The Complainant traces its history to 1975 when it started a line of unique sportswear including pullovers etc. for sailors. The Complainant provides a range of smart casual and luxury sportswear and is famous for its quality of garments and high-performance technical material.

- iii. The trademark PAUL&SHARK was adopted by the Complainant in 1975. To further protect its brand, the Complainant registered its trademarks and various domain names including *inter alia* paulandshark.com, paulandshark.com.cn, paulandshark.it, etc.
- iv. The Complainant's merchandise is available in 73 countries throughout the world, including the United States, India, and China (Annex 2). The Complainant is also the sponsor of various sportspersons, including Alex Bellini, Roberto Mancini, Antonio Giovinazzi, Danilo Gallinari, etc. (Annex 3.1 – 3.4).
- v. The trademark PAUL&SHARK has acquired sufficient distinctiveness since its original launch in Italy in 1975.
- vi. The Complainant registered the domain name www.paulandshark.com on 12 December 1999.
- vii. PAUL&SHARK is neither a generic nor a descriptive English term and it has no meaning. The mark is an invented logo inspired by the sail of an 18th-century clipper, inscribed with the words "Paul & Shark" seen by the Complainant's founder on a visit to a small sailmaker's workshop in Maine. The mark is inherently distinctive and solely refers to the Complainant.
- viii. The Disputed Domain Name www.paulandshark.in wholly incorporating the Complainant's registered trademark PAUL&SHARK was registered by the Respondent on 22 May 2021 (Annex 1).
- ix. On becoming aware of the registration and use of the Disputed Domain Name, the Complainant instructed its representative to address a cease and desist letter to the registrant and notify the Respondent of the infringement of the Complainant's trademark rights, requesting the immediate cessation of any use, and the transfer of the Disputed Domain Name to the Complainant. A cease and desist letter was sent on 20 May 2022 to the Respondent's known email address (Annex 7) but the Respondent did not reply.

- x. The Respondent was never authorized by the Complainant to register and use the disputed domain name and the Respondent is neither the Complainant's representative nor an authorized licensee, neither a dealer nor a reseller. The Complainant has never had any business relationship with the Respondent and was never allowed to use its intellectual property rights. The Respondent has no lawful connection to the trademark PAUL&SHARK.
- xi. The Complainant could not find any evidence on which to ground the assumption that the Respondent is making a bona fide offering of goods or services related to the mark PAUL&SHARK.
- xii. According to the WHOIS information (Annex 1) the Respondent is not commonly known as PAUL&SHARK. There is also no evidence of active use of the domain name to indicate that the Respondent might reasonably be considered to have rights or legitimate interests in respect of the Disputed Domain Name.
- xiii. The Respondent was aware of the value of the Complainant's trademark and registered the Disputed Domain Name which was redirected to a page where it was offered for sale via Sedo and where the internet users could submit an offer (Annex 6). Following a cease and desist letter from the Complainant, the Respondent changed the page indicating the price of USD 9999 for the Disputed Domain Name (Annex 8). Therefore, the Respondent registered the disputed domain name primarily for the purpose of selling it to the Complainant for a sum disproportionate to the Respondent's out-of-pocket costs directly related to the disputed domain name. This is evidence of registration and use of the disputed domain name in bad faith according to paragraph 7(a) of the INDRP.
- xiv. The Respondent has registered an identical domain name to the Complainant's trademark to exploit and profit from the fame and reputation of the PAUL&SHARK trademark.

5. Respondent's case:

The Respondent, though duly served on its email address domainstore@163.com as provided in the WhoIs database, has not filed a statement of defense or participated in any manner in these domain name dispute proceedings.

6. Legal grounds:

Under Paragraph 4 of the Policy, the Complainant must establish the following three elements to succeed:

- (a) the Disputed Domain Name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and
- (b) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (c) the Disputed Domain Name has been registered or is being used in bad faith.

7. Discussion and findings:

The Panel has gone through the complaint and annexures submitted by the Complainant. Since the Respondent has not submitted a statement of defence in these proceedings, the Panel must proceed based on the Complainant's uncontroverted submissions in the complaint and an unbiased appreciation of the documents placed on record by the Complainant. It bears pointing out that the Complainant has omitted to file key documents showing its trademark registration in India and the list of its domain name registrations for PAUL&SHARK, stating that these will be provided if the Panel so requests, which is not a sound approach because the onus is on the Complainant to place on the record the relevant documents that demonstrate its rights and which it believes would help its case. Further, the bulk of the pleadings in the complaint and documents pertain to the Complainant's rights in China whereas the connection of the Complainant's trademark to the jurisdiction in which the complaint is filed and the impact of the Disputed Domain Name with a .in ccTLD for this jurisdiction is left to the imagination. It is correct that the country code top-level domain (ccTLD) name ".in" would not make the use or registration of a domain name lawful if the domain name imitates and violates a complainant's proprietary trademark. However, it would be a stretch to argue that a ccTLD is without legal significance

absent proprietary trademark rights or a reputation associated with the same in the jurisdiction corresponding to the ccTLD. The Complainant's contention that a ccTLD is required of domain name registrants appears incorrect because there is no such requirement, in the Panel's understanding.

Be that as it may, the below discussion analyzes whether the Complainant has established the presence of the aforesaid three elements in this case to succeed in the Domain Name Dispute.

A. Whether the Disputed Domain Name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights:

The Panel notes that the Complainant has the following rights:

- i. international trademark registration no. 1295724, pertaining to the logo PAUL &



SHARK yachting represented as . This international registration designating India has a broad coverage since it encompasses class 1 to class 45;

- ii. international trademark registration no. 1296858;
- iii. European Union registration no. 011338101;
- iv. international trademark registration no. 496286;
- v. the operation of the website at www.paulandshark.com which is accessible in India and a Facebook page of Paul & Shark India confirms the online presence of the Complainant's products.
- vi. The trademark PAUL&SHARK is replicated in entirety in the Disputed Domain Name <paul&shark.in> and is indistinguishable from the domain name www.paulandshark.com, which is the website address of the Complainant.

The registrations granted to the Complainant's trademark PAUL&SHARK in various jurisdictions, including a registration in India with broad coverage, confirms that it has enforceable rights in the said mark. The Complainant's social media presence under the trademark Paul & Shark suggests that it enjoys a reputation in the relevant market.

For the above reasons, the Panel finds that the Disputed Domain Name is identical to the trademark PAUL&SHARK in which the Complainant has a right.

B. Whether the Respondent has any rights or legitimate interests in respect of the Disputed Domain Name:

The Panel assesses the claims made by the Complainant to be tenable for the following reasons:

- i. The Disputed Domain Name <www.paulandshark.in> wholly contains the words 'Paul & Shark' which forms the entirety of the mark PAUL & SHARK in which the Complainant has rights.
- ii. The Respondent was put to notice of the Complainant's legal rights in the trademark and domain name PAUL & SHARK but it failed to respond to this notice.
- iii. There appears to be no bona fide / non-commercial use of the Disputed Domain Name by the Respondent and there is no evidence to suggest that the Respondent is known by the name PAUL & SHARK.
- iv. Since the Complainant's case is uncontroverted by the Respondent, and basis the material filed with the complaint and seen by the Panel, there is no justification to conclude that the Respondent had independent rights or legitimate interest in the disputed domain name.
- v. The Respondent's unresponsiveness to the communications from the Panel in these proceedings and its abstention by non-filing of a statement of defence is also a factor that weighs against it.

The Panel notes that the Respondent does not make any bonafide or legitimate use of the Disputed Domain Name as the same is available for sale.

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

C. Whether the Disputed Domain Name has been registered or is being used in bad faith

The following factors establish to the Panel's satisfaction that the disputed domain name was registered in bad faith:

- i. the Respondent has acquired the Disputed Domain Name for the purpose of selling it to the highest bidder (Annex 6 and Annex 8). The Disputed Domain Name was on sale prior to the cease and desist letter by the Complainant, and after the receipt of the said letter by the Respondent, the Disputed Domain Name is shown as available for sale at a high price of USD 9999;
- ii. the Disputed Domain Name is identical to the Complainant's trademark which is an unusual combination of English words and is therefore distinctive. This also suggests that the Respondent was aware of the Complainant's reputation in the PAUL&SHARK trademark and registered the Disputed Domain Name to exploit and profit from the fame thereof.
- iii. the Respondent did not make a search to ensure that the registration of the Disputed Domain Name was not in violation of any third party rights. Reliance has been placed by the Complainant on the decision in INDRP/1262 pertaining to De' Longhi Appliances v. Ye Genrong: *"the Respondent 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's rights. The Respondent should have exercised reasonable efforts to ensure there was no encroachment on any third party rights"*.

The Respondent has a duty of care which is clearly stipulated in the INDRP and it clearly did not exercise this when it applied to register the Disputed Domain Name. In the opinion of the Panel, the Respondent did not comply with any part of Section 3 and has also failed to furnish complete and accurate credentials for registration of the Disputed Domain Name. The Panel also notes that there have been earlier awards in different domain name dispute proceedings that involved the same registrant having the email address domainstore@163.com albeit with different aliases. The Panel does not consider the evidence sufficient to come to a finding that the Respondent is a cyber-squatter.

In this background, the Panel cannot find any mitigating factor in the Respondent's favour and the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith.

Decision:

In the facts and circumstances, and for the reasons discussed above, the Panel finds that the Complainant has satisfied all three elements required under Paragraph 4 of the Policy to obtain the remedy of transfer of the Disputed Domain Name. Therefore, the Arbitrator directs that the Disputed Domain Name <WWW.PAULANDSHARK.IN> be transferred to the Complainant.

No order is made as to costs.

Signed:



(Binny Kalra)

Arbitrator

Date: 1 November 2022