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ARBITRATION AWARD

Before the Sole Arbitrator, Dr. Karnika Seth

IN INDRP Case No. 1498

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.IN REGISTRY
(NATIONAL INTERNET EXCHANGE OF INDIA)
.IN Domain Name Dispute Resolution Policy (INDRP)

Disputed Domain Name: www.ferrero.in

Dated: 24 February 2022

IN THE MATTER OF:

FERRERO S.p.A.

Piazzale Pietro Ferrero n.1

12051, ALBA (Cuneo)

Italy

...Complainant

Vs.

Doublefist Limited (Contact us: ymgroup@msn.com)

Feifei

A3, JiaZhaoYe, JiangBei, Huicheng District

HuiZhou City, GuangDong Province, China

HuiZhou

Wisconsin, 516000, US

...Respondent

1. Parties

- 1.1 The Complainant in the arbitration proceeding is Ferrero S.p.A, having address at Piazzale Pietro Ferrero n.1 12051, ALBA (CN) Italy. The Complainant's authorised representative is Mr. Luca Barbero c/o Studio Barbero S.p.A.

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1.2 The Respondent in this administrative proceeding as per 'Whois' record is Double first Limited (Contact us: ymgroup@msn.com), having address at Wisconsin, US (as per **Annexure 1.1** of the Complaint). Upon enquiry from NIXI made by the Complainant, the email address of the Respondent was found to be ymgroup@msn.com.

2. **The Dispute-** The domain name in dispute is "www.ferrero.in" registered by the Respondent on 6th August, 2012. According to the .IN 'Whois' search, the Registrar of the disputed domain name is Dynadot LLC.

3. **Important Dates**

S. No	Particulars	Dates (All Communication done in electronic mode)
1.	Date on which NIXI's email was received seeking consent for appointment as Arbitrator.	8 February 2022
2.	Date on which consent was given to act as an Arbitrator in the case.	8 February 2022
3.	Date of Appointment as Arbitrator.	8 February 2022
4.	Soft Copy of complaint and annexures were received from NIXI through email.	8 February 2022
5.	Date on which notice was issued to the Respondent	8 February 2022

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6.	Date on which Complainant filed proof of completed service of complaint on Respondent	9 February 2022
7.	Date on which Award passed	24 February 2022

4. Procedural History

- 4.1 This is a mandatory arbitration proceeding 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. The updated rules are available on <https://www.registry.in/INDRP%20Rules%20of%20Procedure>. By registering the disputed domain name accredited Registrar of NIXI, the Respondent agreed to the resolution of the dispute pursuant to the .IN Dispute Resolution Policy and Rules framed thereunder.
- 4.2 In accordance with the Rules 2(a) and 4(a) of INDRP Rules, NIXI formally notified the Respondent of the complaint and appointed Dr. Karnika Seth as a sole arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996 and the rules framed thereunder. The Arbitrator submitted the statement of Acceptance and Declaration of impartiality and independence, as required by NIXI.
- 4.3 The complaint was filed in accordance with the requirements of the .IN Domain Name Dispute Resolution.
- 4.4 The Arbitrator issued notice to the Respondent on 9 February 2022 at the email address of the Respondent ymgroup@msn.com calling upon the Respondent to submit his reply to the complaint within fifteen (15)

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days of receipt of the Arbitrator's email. The Complainant also filed proof of completed service of the complaint upon Respondent on 9 February 2022.

- 4.5 Despite the notice, the Respondent failed to file any reply. Therefore, in accordance with the Rule 12 of INDRP Rules, the Arbitration proceedings were conducted ex-parte and the Award is passed which is binding on both parties herein.

5. Factual Background

- 5.1 The Complainant, trading as Ferrero S.p.A. is an Italian manufacturer of chocolates and confectionaries, incorporated under the laws of Italy. The Complainant through its trademark 'Ferrero' rapidly expanded its business throughout Europe and established trading companies and production plants in Belgium, Holland, Austria, Switzerland, Sweden, the United Kingdom, Ireland and Spain. Founded in 1946 in Alba, Italy it became popular and a well-known mark in Italy and various parts of the world. Presently, the Complainant claims to promote and sell its chocolates and confectionaries worldwide in over 160 countries.
- 5.2 The Complainant claims to be using its trademark 'Ferrero' since 1973 and registered its domain name 'www.ferrero.com' in 1998 (Annexure 4.1,4.2). The Complainant registered its trademark 'Ferrero' in India on 14th August 2003 when the registration was granted under Class 30 with registration number 827501. The complainant claims to do business in India through its website www.ferreroindia.com. (Annexure 9) The Complainant is the owner of the trademark 'Ferrero' in several other countries as well. Copies of the registration certificates for the mark 'Ferrero' in India and other countries are filed by the Complainant (as

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per **Annexure 2.1, 3.1, 3.2, 3.3, 3.4, 3.5, 3.6, 3.7 and 3.8** of the Complaint).

- 5.3 The Complainant claims to have accumulated a 6% share of the Indian chocolate market (as per **Annexure 6** of the complaint) and launched a market for premium chocolates in India, rolling out Rocher chocolates nationwide and later Kinder Joy, Nutella and Tic Tac in 2009. In 2021, Complainant launched in the Indian market “Kinder Creamy”. Complainant has made India its hub for Asia and exports half its local production to China, Middle East & South East Asia.
- 5.4 The Complainant, apart from promoting and selling chocolates and confectionaries, is also involved in numerous sustainability initiatives. In 2014, the “Pietro Ferrero Kindergarten”, a world class childcare facility, has been inaugurated near the Ferrero plant at Baramati, followed by the launch of the “Kinder Joy of Moving” CSR program, an international Ferrero Group Social Responsibility project dedicated to children in 2015 (as per **Annexure 7** of the complaint). The Complainant also has extensive presence and following of its trademark ‘Ferrero’ on social media i.e., on Facebook and Instagram.
- 5.5 The Respondent in this administrative proceeding as per ‘Whois’ database is Double first Limited (Contact us: ymgroup@msn.com) having address at Wisconsin, US (as per **Annexure 1.1** of the complaint). Upon enquiry from NIXI made by the Complainant, the email address of the Respondent was found to be ymgroup@msn.com.

6. Parties Contention

6.1 Complainant’s Submissions

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- 6.1.1 The Complainant operating as 'Ferrero' is a world-renowned chocolate and confectionaries manufacturer. The Complainant claims that it has been using its mark continuously for its products, not only in India but across various countries. Due to its established reputation worldwide including India, the word 'Ferrero' has been exclusively associated with the Complainant and no one else.
- 6.1.2 The Complainant submits that the use of the word 'Ferrero' by the Respondent is made without authorization or consent by the Complainant and use of the disputed domain name by the Respondent is clearly subsequent to the use and registration of the Complainant's trademark 'Ferrero'. The Complainant also has presence on popular social media pages which uses Complainant's trademark 'Ferrero'.
- 6.1.3 The Complainant submitted that the disputed domain name 'www.Ferrero.in' entirely reproduces Complainant's trademark 'Ferrero' and is also phonetically identical to Complainant's trademark. The Complainant claims that it has been using its mark continuously for its products not only in India but across various countries. Due to its established reputation worldwide including in India, the word 'Ferrero' has been exclusively associated with the Complainant and no one else. The Complainant claims to have gained popularity, reputation and is widely known through use of its trademark 'Ferrero'.
- 6.1.4 The Complainant submits that the Complainant has rights and legitimate interest in the registered trademark 'Ferrero'. The Complainant claims that after usage of its trademark 'Ferrero' continuously and extensively worldwide including in India for several years, the said trademark has become a well-known trademark.

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- 6.1.5 The Complainant also submits that the Respondent is neither a licensee, nor an authorized agent of Complainant, or in any other way authorised to use Complainant's trademark 'Ferrero'. The Respondent has intentionally created the disputed domain name for making illegal commercial gains and to mislead the public in order to divert the public searching for the Complainant's website to its competitor websites. The same is evident from the pay per click model adopted by the Respondent on disputed domain name.
- 6.1.6 The Complainant submits that the choice of disputed domain name is a clear attempt to unfairly capitalize on the Complainant's trademark and resulting goodwill. Respondent is not making a legitimate non-commercial or fair use of the disputed domain name by demanding exorbitant sum of money, 2800 Euros (annexure 12.2) for transferring the disputed domain name.
- 6.1.7 The Complainant submitted the Respondent has registered the disputed domain name in bad faith which is evident from his unreasonable demand of exorbitant sum of money to transfer domain. The Complainant submits Respondent has in bad faith made infringing registration and used Ferrero mark on the disputed domain name to unfairly divert customers to complainant's competitor websites.

6.2 Respondent's Defence

- 6.2.1 Despite the service of notice by email, the Respondent failed to reply to the notice within the stipulated time.
- 6.2.2 The INDRP Rules of Procedure require under Rule 8(b) that the arbitrator must ensure that each party is given a fair opportunity to present the case. Rule 8(b) reads as follows:

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"The Arbitrator shall at all times treat the parties with equality and provide each one of them with a fair opportunity to present their case."

6.2.3 Further the INDRP Rules of Procedure empowers the Arbitrator to proceed with arbitration proceedings ex-parte and decide arbitration in case any party does not comply with the stipulated time limit to file its response. Rule 12 reads as follows:

"In event any party breaches the provisions of INDRP rules and/or directions of the arbitrator, the matter can be decided ex-parte by the Arbitrator and such arbitral award shall be binding in accordance to law."

6.2.4 In present arbitration, the Respondent has failed to file any reply to the Complaint and has not sought any further time to answer the Complainant's assertions, contentions or evidences in any manner. The Arbitrator thus finds that the Respondent has been given a fair chance to present its case. Since the Respondent has failed to reply to Notice to submit its response, Arbitration has been conducted ex-parte in accordance with Rule 12 of the INDRP rules and decided on merits ex-parte.

7. Discussions and Finding

7.1 The .IN Domain Name Dispute Resolution Policy in para 4 requires Complainant to establish the following three requisite conditions: -

- a) The disputed domain name is identical or confusingly similar to the trademark in which Complainant has right;
- b) The Respondent has no rights or legitimate interest in the domain name; and

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

7.2 The Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights (Paragraph 4(a))

The Complainant submitted that it owns various trademark registrations using the word 'Ferrero' in many jurisdictions throughout the world including India and has filed documents of its registered trademark in India to prove its right in the trademark 'Ferrero' (as per **Annexure 2.1**). The Complainant submitted that the disputed domain name 'www.Ferrero.in' entirely reproduces Complainant's trademark 'Ferrero' and is also visually and phonetically identical to Complainant's trademark.

The Arbitrator finds that the disputed domain name 'www.Ferrero.in' is clearly identical to Complainant's trademark in which the Complainant has exclusive trademark rights and the Complainant has submitted enough documentary evidence to prove its rights and ownership in 'Ferrero' mark in India and other countries. A cursory glance at the disputed domain name 'www.Ferrero.com' makes it obvious that the Respondent has exactly incorporated the essential elements of the Complainant's 'Ferrero' mark and thus the disputed domain name is identical/ deceptively similar to the Complainant's mark.

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As per WIPO Synopsis 3.0, while each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to the mark for the purposes of UDRP standing. (*Dell Inc. v George Dell & Dell Netsolutions*, case no. D2004-0512 (WIPO Aug 24, 2004), *Busybody Inc. v Fitness Outlet Inc.* D 2000-0127 (WIPO April 22, 2000)).

The disputed domain name consists of 'Ferrero', the Complainant's trademark in entirety and the ccTLD ".in" which is likely to deceive and confuse consumers as to its source and ownership. It is well recognized that incorporating a trademark in its entirety, particularly if the mark is internationally well recognized mark, is sufficient to establish that the domain name is identical or confusingly similar to the Complainant's registered mark. (*LEGO Juris A/S v. Robert Martin*, INDRP/125(2010); *Viacom International Inc. v. MTV ALBUMS-Mega Top Video Albums Peter Miadshi*, WIPO case No. D2002-0196 (April 16, 2002); *Wal Mart Stores Inc. v. Kuchora Kal*, WIPO case no. D2006-0033 (March 10, 2006)).

The Complainant has cited numerous decisions of INDRP and WIPO panel regarding registration of domain names similar to the domain registered by the Respondent. The Complainant has relied on *PUMA SE v. Christian Schmidt* [INDRP/956], *FMTM Distribution Ltd. v. Bel Arbor* [INDRP/681], *Perfetti Van Melle Benelux BV v. Jing Zi Xin*

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[INDRP/665], Disney Enterprises, Inc. v. John Zuccarini, Cupcake City and Cupcake Patrol [WIPO Case No. D20010489].

As the Respondent's disputed domain name incorporates entire mark of Complainant's trademark 'Ferrero', the Arbitrator finds that the Respondent's domain name is identical or confusingly similar to Complainant's registered trademark and is likely to deceive the customers.

7.3 The Registrant has no rights or legitimate interest in respect of the domain name (Para 4(b))

Under para 6 of the INDRP policy, a Respondent can prove rights or legitimate interest in the domain name. The Complainant submits that Respondent has not applied for any registration of the trademark 'Ferrero' in India nor has any legitimate interests in the mark. There is neither any evidence of use nor preparations to use the said mark fairly for a bonafide business. To the contrary, he is making illegal commercial gains through using the mark on the disputed domain name, diverting its customers and tarnishing its image. The Complainant has filed sufficient evidence to prove that the disputed domain name is identical to 'Ferrero' trademark, in which the Complainant enjoys substantial reputation and goodwill and registration of trademark in India and other jurisdictions (annexed as Annexure 2.1 of the complaint). Despite notice, the Respondent has failed to prove any rights or legitimate interests in the disputed domain name/trademark 'Ferrero'. Thus, Respondent has failed to establish legitimate interest and/or rights in the

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disputed domain name. Complainant has also submitted that it has not authorized nor licensed Respondent to use its 'Ferrero' mark.

The Complainant submitted that the disputed domain name 'www.Ferrero.in' is being used to take advantage of the Complainant's reputation in violation of the Complainant's protected rights and that the Respondent has registered the disputed domain name with a view to engage in unfair commercial use of the mark 'Ferrero' with the sole aim to make illicit benefits from unauthorised use of the goodwill and reputation of the Complainant's mark 'Ferrero'. The Arbitrator is of the view that incorporation of an identical mark in the disputed domain name to unfairly capitalise on reputation of another's brand does not provide right or legitimate interest in a domain name. (*Fiskars Corporation v. Lina / Doublefist Limited [INDRP/1067]*, *Paris Hilton v Deepak Kumar, WIPO case no. D 2010/1364*). The Complainant has relied on *Pharmacia & Upjohn Company v. Moreonline, [WIPO Case No. D2000-0134]*, *Perfetti Van Melle Benelux BV v. Jing Zi Xin [INDRP Case No. 665]* to support its submissions.

Further, the Complainant submits that the Respondent is clearly attempting to confuse Internet users by use of Complainant's widely-known trademark in the domain name to lure Internet users to the website, and thereby benefit commercially from "pay-per-click" feature wherein several sponsored links related to chocolate products (i.e. the same products manufactured and sold by Complainant) are featured and redirecting to other commercial web sites, including websites of Complainant's competitors. Moreover, via a link published on

Respondent's website, users are redirected to a website where the disputed domain name "www.Ferrero.in" is offered for sale (Annexure 10.1 and 10.2).

In view of the prima facie evidence established by the complainant for Respondent's lack of rights and legitimate interests, the burden of proof shifts on the Respondent to prove its rights or legitimate interest in the mark, if any which it has failed to discharge as no reply was filed by the Respondent.

(Luigi Lavazza S.p.A. v. Flying Stingrays Ltd, WIPO Case No. D2012-1391 and also Lancôme Parfums et Beaute & Compagnie v. D Nigam, Privacy Protection Services / Pluto Domains Services Private Limited, WIPO Case No. D2009-0728)

Thus, for the aforesaid reasons, the Arbitrator finds that the Respondent has neither rights and/or legitimate interests in the disputed domain name.

7.4 The Registrant's domain name has been registered or is being used in bad faith (Para 4(c))

For the purpose of Para 4 (c) of .IN Policy, under paragraph 7 of the policy, the Complainant is required to establish that the domain name was registered or is being used in bad faith.

The Complainant submitted that 'Ferrero' trademark has acquired considerable amount of goodwill worldwide including India. The

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Complainant has secured registration of the mark 'Ferrero' in India under class 30 (annexed as **Annexure 2.1** with the Complaint).

Complainant has submitted sufficient evidence showing widespread use, goodwill and trademark rights in 'Ferrero' mark in various countries, including India which long predates Respondent's registration of the disputed domain name which incorporates completely the registered trademark 'Ferrero' of the Complainant. *WIPO Overview 3.0 notes in Section 3.14 "panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith".* The same principle is relied on in *Adobe Inc. v. Amin Mohammad Salehi, Uranos*, case no. DIR2020-0006, June 30, 2020.

Moreover, when complainant served a cease and desist notice upon the Respondent seeking transfer of the disputed domain name, Respondent demanded Euro 2800, which is exorbitant amount, way beyond meeting basic expenses for transfer of domain and amount to cybersquatting. (Annexure 12.2) (*FMTM Distribution Ltd v Bel Arbor* (INDRP/681).

The Complainant also submitted Respondent used fake company names to register unfairly well known marks with a view to make illegal gains. The Complainant relied on cases such as <deloitte.in> (INDRP/1032), <colgate.in> (INDRP/887), <mozilla.co.in> (INDRP/934),

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<goldmansachs.in> (INDRP/936), <lesaffre.in> (INDRP/914) amongst other cases.

Thus, Arbitrator finds that Respondent registered the disputed domain name in bad faith. The Respondent's disputed domain name is likely to mislead the consumers by creating a likelihood of confusion with the complainant's name or mark. (*Yusuf A. Alghanism & sons WLL v Anees Salah Salahmeh* (WIPO case no. D2018-1231). The Arbitrator finds that the Respondent has registered the disputed domain name to prevent Complainant from registering or using the mark in India. Despite notice, Respondent failed to submit its response and evidence to support bonafide registration of disputed domain name in respect of its offering of goods. Such registration and use is likely to mislead the consumers of an affiliation with Complainant which amounts to bad faith registration under .IN policy. For the aforesaid reasons, the Arbitrator in the present case finds bad faith in the registration and use of the disputed domain name (Ref. *Virgin Enterprises Limited v. Syed Hussain*, WIPO Case no. D2012-2395).

Moreover, it is settled law that the incorporation of a well-known trademark into a domain name by a registrant having no plausible explanation for doing so may be, in and of itself, an indication of bad faith. (*Microsoft Corporation vs. Montrose Corporation*, (WIPO Case No. D2000-1568, January 25, 2001). It is also settled principle that registration of a domain name with the intention to create confusion in the mind of internet users and attract internet traffic based on the goodwill associated with the trademark is considered bad faith

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registration (*PepsiCo Ins. Vs. Wang Shaung*, INDRP case no.400, December 13, 2012).

For the aforesaid reasons, the Arbitrator finds the third ground is also established by the Complainant under the .IN Policy.

8. DECISION

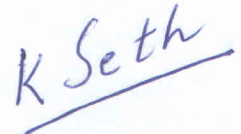
On the basis of the abovesaid findings the Sole Arbitrator finds that:

- a) The Complainant has successfully established three grounds required under the policy to succeed in these proceedings.
- b) Respondent has failed to rebut averments, contentions and submissions of the Complainant

The Arbitrator directs the .IN Registry of NIXI to transfer the domain name ww.Ferrero.in to the Complainant.

The Award is passed on this 24 February 2022.

Place: Noida



Dr. Karnika Seth
Sole Arbitrator